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JAN 22 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. 95/000,406 Deposited on: 20 October 2008 For: US Patent No. 6,654,400	:	

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 25 November 2003 US patent No. 6,654,400 was granted.

2. On 20 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 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 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
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Alexandria, VA 22313-1450

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

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

4. Telephone inquiries with regard to this decision should be directed to Mark Reinhart, at (571) 272-1611, 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 Patent Owner)

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(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/000,406
Filed: October 20, 2008
For: U.S. Patent No. 6,654,400

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 November 25, 2003, United States Patent Number 6,654,400 (the '400 patent) issued.

2. On October 20, 2008, a request for *inter partes* reexamination of the '400 patent, assigned Reexamination Control No. 95/000,406 (the '406 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 '406 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 62 pages in length and that, in rejecting claims 1-76 of the '400 patent, "the Office Action incorporates by reference many of the detailed explanations from the 152 page Request for Reexamination submitted by the Requester." Pet. at 2. Patent owner further indicates that the Office action applies 33 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," 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." 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 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 '400 patent is related to two other patents that are the subject of co-pending *inter partes* reexamination proceedings, as well as proceedings 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" and that due to the relationship of the '400 patent to the two related patents, the results of the '406 reexamination proceeding "are vitally important." Pet. at 3-4. Thus, patent owner 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 (62 pages) and the length of the request (151 pages) in some unspecified fashion.

A cursory review of the record in the '406 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 38-40, 41-42, 46-47, 48-49, and 54). 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.
95/000,406	10/20/2008	6654400	G&C 235.1-US-RX	8449

25764 7590 05/13/2009

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 05/13/2009

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/000,406	10/20/08	6654400	

EXAMINER
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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.

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(For Patent Owner)

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CENTRAL REEXAMINATION UNIT

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12390 EL CAMINO REAL
SAN DIEGO, CA 92130

(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/000,406
Filed: October 20, 2008
For: U.S. Patent No. 6,654,400

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 November 25, 2003, United States Patent Number 6,654,400 (the '400 patent) issued.

2. On October 20, 2008, a request for *inter partes* reexamination of the '400 patent, assigned Reexamination Control No. 95/000,406 (the '406 proceeding), was filed by a third party requester.

3. On December 19, 2008, the Office issued an order granting *inter partes* reexamination in the '406 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 138 pages of arguments: 70 pages from the remarks section of the response, 60 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 88 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 88 pages.

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[1] The total number of pages of the response and accompanying declarations asserted by patent owner to contain arguments adds up to 138 pages (70 pages from the remarks section of the response, 60 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 138 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 the 88 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 the 88 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 '406 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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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,406	10/20/2008	6654400	G&C 235.1-US-RX	8449

25764 7590 09/11/2009

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/11/2009

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

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Minneapolis, MN 55440-1022

Date:
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CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000406
PATENT NO. : 6654400
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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(For Patent Owner)

MAILED

SEP 11 2009

CENTRAL REEXAMINATION UNIT

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(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/000,406
Filed: October 20, 2008
For: U.S. Patent No. 6,654,400

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 November 25, 2003, United States Patent Number 6,654,400 (the '400 patent) issued.

2. On October 20, 2008, a request for *inter partes* reexamination of the '400 patent, assigned Reexamination Control No. 95/000,406 (the '406 proceeding), was filed by a third party requester.

3. On December 19, 2008, the Office issued an order granting *inter partes* reexamination in the '406 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 '406 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 '406 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 '406 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 '406 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 '406 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 '406 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 '406 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 '406 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

Kenpet7/IP
9-10-09

[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. 95/000,406
Filed: October 20, 2008
For: U.S. Patent No. 6,654,400

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 November 25, 2003, United States Patent Number 6,654,400 (the '400 patent) issued.

2. On October 20, 2008, a request for *inter partes* reexamination of the '400 patent, assigned Reexamination Control No. 95/000,406 (the '406 proceeding), was filed by a third party requester.

3. On December 19, 2008, the Office issued an order granting *inter partes* reexamination in the '406 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 '406 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 '406 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 '406 *inter partes* reexamination proceeding.[5] Thus, only a single party (patent owner) will now participate in the '406 *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 '406 *inter partes* proceeding would not be anticipated to potentially hinder the ability of the Office to conduct the '406 *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 four hundred (400) individual rejections applied to the 76 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 138-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. 6,654,400, assigned PTO Control No. 95/000,406 and initiated by a request filed on October 20, 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 '406 *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 '406 *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 <u>is granted to the extent that a single interview will be permitted</u>, 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 '406 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

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

kenInterview/
11-18-09

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,407	10/21/2008	7140443	069669-003	2662

35979 7590 04/20/2009

BRACEWELL & GIULIANI LLP
P.O. BOX 61389
HOUSTON, TX 77208-1389

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/20/2009

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
MORGAN LEWIS & BOCKIUS LLP
1111 PENNSYLVANIA AVENUE NW
WASHINGTON, DC 20004

Date:

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APR 2 0 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000407
PATENT NO. : 7140443
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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(For Patent Owner)

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(For Third Party Requester)

In re Beierbach et al.
Inter Partes Reexamination Proceeding
Control No. 95/000,407
Filed: October 21, 2008
For: U.S. Patent No. 7,140,443

: **DECISION**
: **GRANTING-IN-PART**
: **PETITION**

This is a decision on the patent owner paper entitled "PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE THE REQUIREMENTS OF 37 C.F.R. § 1.943(b)," filed on February 6, 2009.

The patent owner petition and *inter partes* reexamination control number 95/000,407 are before the Office of Patent Legal Administration.

For the reasons set forth below, patent owner's petition under 37 CFR 1.183 to waive the 37 CFR 1.943(b) limit as to the number of pages permitted in a patent owner response is granted to the extent that the page limit for the patent owner response is extended to not exceed 75 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

Furthermore, patent owner is reminded that the page limit of 37 CFR 1.943 excludes response components containing formal matters only (e.g. signature and cover pages).

FEES

A fee of $400.000 under 37 CFR 1.17(f) is required for a petition under 37 CFR 1.183. No fee was remitted with, or authorized by, the patent owner petition paper. On April 3, 2009, patent owner's representatives, Todd Mattingly and Tamara Ross, transmitted via EFS-WEB a charge of $400.00 petition fee against a credit card. Payment was successfully received by the Office.

REVIEW OF THE RELEVANT FACTS

1. On November 28, 2006, U.S. patent No. 7,140,443 ("the '443 patent") issued to Beierbach et *al.*

2. On October 21, 2008, a 317 page request for *inter partes* reexamination of the '443 patent, assigned control No. 95/000,407 (the '407 proceeding), was filed by third party requester Paul E. Krieger, in which Weatherford International, Inc. was identified as the real party in interest (hereafter "third party requester").

3. On January 14, 2009, the Office issued an order granting the request for *inter partes* reexamination of claims 1-70, i.e., all of the '443 patent claims.

4. On January 26, 2009 the Office issued a 74 page non-final Office action, rejecting claims 1-3, 5-17, 19-42, 51-59 and 61-69, and confirming claims 4, 18, 43-50, 60 and 70.

4. On February 6, 2009, patent owner filed the present petition entitled "PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE THE REQUIREMENTS OF 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.

I. PATENT OWNER'S PETITION OF FEBRUARY 6, 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 increase the page limit for patent owner's response to 391 pages.[1] In support of waiver of the rule, patent owner asserts that the February 10, 2009 Office action is 74 pages long, and rejects 54 [sic] claims, 11 of which are independent claims, with multiple prior art references with a total of 18 rejections under § 102(b), 5 under § 102(e) and 44 under § 103(a), may of which are incorporated by reference from the October 21, 2008 request for reexamination. When all the rejections are parsed out against all the claims under

[1] Petition at page 5 (patent owner noting that a 391 page limit is reasonable, as it is the sum of the number of pages in Office Action and the Request for Reexamination).

rejection and summed up the Office action is alleged by patent owner to contain 1370 rejections being leveled against 58 claims.[2]

II. ANALYSIS AND FINDINGS

The record shows that the January 26, 2009 non-final Office action is 74 pages in total length. A review of the action reveals that 3 pages are cover sheets, 1 page contains discussions of administrative matters regarding extensions of time and litigation, 1 page contains a statement of confirmation of claims 4, 18, 43-50, 60 and 70 with a substantial zone of blank space and contact information. Further, 1 page contains contact information, signatures and a substantial zone of blank space; and 2 pages consist of USPTO forms PTO/SB/81B (Power of Attorney) and PTO/SB/96 (Statement under 37 CFR 3.73(b)). Also, the format of the non-final Office action utilizes significant amounts of white space as a break between each proposed rejection discussion with a statement as to whether or not the rejection is or is not adopted. Further, it is noted that the proposed rejections discussed in paragraphs 5, 8,9, 11, 16, 19, 20, 24, 25, 71, 80, 82, 83, 85, 87, 94 and 97 were not adopted by the examiner. Thus, a substantial portion of the non-final Office action would appear to involve concurrence on the part of patent owner in its response with some additive non-cumulative comments; petitioner has not shown a need for a substantial discussion of the non-adopted rejections, and a showing of extraordinary circumstances (as is required for this petition) would have required a showing of such a need.

The non-final Office action restates a substantial portion of the proposed rejections, but does often make use of permissible "incorporation by reference" mechanism instead of making length restatements of the facts that support the rejections. Such incorporation by reference does not appear to be excessive, and while patent owner cites a single six page incorporation by reference, patent owner does not provide a complete summation of the entire volume of material incorporated by reference. Therefore, in terms of substance the non-final Office action is not excessively lengthy. The non-final Office action consists of approximately 66 substantive pages, utilizes a format that is generous in its use of blank space and contains a substantial portion that favors patent owner's position on patentability.[3]

As to the request for reexamination, it is shown to be 317 pages, but it includes a number of pages satisfying many requirements which the patent owner need not address in the response. These include a transmittal, a table of contents, a showing of the existence of a substantial new question of patentability (a patent owner response is concerned only with addressing the application of the art to the claims). It is conceded that the portion of the request to be address is lengthy, but, in the final analysis, the examiner's Office action was able to address the request with 74 pages (with some incorporation by reference to add to the matter to be addressed, and some refusal to adopt comments that patent owner need not address) but certainly much less than the **391 pages (!)** that petitioner is requesting. By filing the present petition under 37 CFR 1.183, petitioner, a registered practitioner, is asserting and representing for patent owner that **an extraordinary situation** exists, where justice requires that **391 pages** be present in the response.

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[2] Petition at page 2.

[3] Presumably outside of a simple concurrence and bolstering statement a significant amount of pages would not be needed to expound on those matters where a finding favors the patent owner.

Yet, petitioner has not pointed out the details and specifics of what will require 391 pages, and why. It would appear that, as pointed out above, a number of the 391 pages need not be addressed in the response, and petitioner has not pointed out why petitioner needs more than the number of pages that need not be addressed. And, as pointed out above, the Office was able to address the matter in 74 pages, with some incorporation by reference to add to the matter to be addressed (which petitioner could specify as to number of pages), and some refusal to adopt comments that patent owner need not address. Petitioner did not deal with this point.

A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) to increase the page limit to a given amount could have been an attempt to draft a patent owner's response in compliance with the 50-page limit, submitted concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b) to increase the page limit, requesting entry of the submitted response. Such a response could be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, as opposed to attempting to rely on a general allegation that patent owner needs at least the total number of pages equal to the entire request for reexamination plus the entire non-final Office action (the formal, as well as substantive, components), petitioner could attempt to rely on the proposed response (1) for justification that more pages are needed to complete the response and (2) to set forth an accurate determination of exactly how many additional pages are needed to complete the response.

37 CFR 1.183 permits waiver of the page limitation requirement of the regulations in an **extraordinary** situation when justice requires, NOT ordinary. Under the facts and circumstances record in the '407 *inter partes* reexamination proceeding, the present patent owner petition does not establish that a waiver of 37 CFR 1.943(b) is necessary to the extent requested. Accordingly, the petition is not granted to the extent requested.

In this instance, the Office has taken upon itself to *sua sponte* conduct an analysis as to what is deemed a reasonable balancing of the page limit provisions of 37 CFR 1.943(b) which permit the Office to conduct *inter partes* reexamination proceedings with special dispatch, as required by 35 U.S.C. 314(c), and the patent owner's concern in fully addressing the number of permutations of proposed rejections that were adopted by the examiner in the first Office action, and the number of instances in which the examiner incorporated by reference various pages of the request. The substantive portion of the first Office action is 66 pages long, (excluding the cover page, page 2, which is directed to extensions of time and a litigation reminder, and the signature page). The proposed rejections discussed in paragraphs 5, 8, 9, 16, 19, 24, 71, 80, 82, 83, 94, and 97 were not adopted by the examiner. In addition, a portion of the proposed rejections discussed in paragraphs 11, 20, 25, 85, and 87 were also not adopted by the examiner. Furthermore, the format of the first Office action utilizes significant amounts of space as a break between discussions of proposed rejections. After balancing the equities and circumstances of the present situation, patent owner's request for waiver is granted to the extent that the patent owner is permitted to submit a response up to (and including) 75 pages long. The petition is granted only as to the next immediate response filed by the patent owner, in response to the Office action mailed on January 26, 2009.

SERVICE OF COPIES

Patent owner is reminded that any future communications filed by patent owner in this proceeding (including any response to this decision) must include proof of service on the third party requester in accordance with 37 CFR 1.248(a). The patent owner is advised that the address for the third party requester's counsel associated with Customer Number 09629 is MORGAN, LEWIS & BOCKIUS LLP, 1111 PENNSYLVANIA AVENUE NW, WASHINGTON, DC 20004. The third party requester address stated on patent owner's February 6, 2009 Certificate of Service is MORGAN, LEWIS & BOCKIUS LLP, 1000 LOUISIANA ST., SUITE 4200, HOUSTON, TX 77002. Future patent owner communications **may be considered incomplete and accordingly not considered, because they would be defective papers,** if service is not made on the third party requester at **the address of record**.

ADDITIONAL DISCUSSION

The page limits of 37 CFR 1.943 represent a balance between protecting the rights and interests of the parties and public in terms of timely disposition of proceedings, which undergird the statutory mandate set forth in 35 U.S.C. 314 that reexamination proceedings must be conducted "with special dispatch within the Office." Equities in specific cases can permit the modification of the page limit requirement, only if it is clearly established that there is an additional compelling need in a specific case to properly preserve the right. In the instant case patent owner has not established a compelling need for its requested waiver. Formal matters are not counted against the page limit, *e.g.* cover and signature pages, appendices of claims. The judicious use of space and the incorporation by reference of matters and information all ready of record (as well as keeping evidence separate, and simply applying it in the response) should be utilized and attempted before asking for such **extraordinary** relief that would thwart the statutory mandate of special dispatch. The very fact that patent owner submitted the request and non-final Office action, despite the fact that they are already of record, instead of merely citing to them in a single line of the petition speaks to patent owner's misapprehension as to the nature of the proceeding and the need to present an efficient, economizing response.

Note that if a party does make an initial attempt to respond and submits it, yet exceeds the permitted page limit, the party is given an opportunity to file another paper based on the Office's comments. If the Office does not grant a petition to the full extent of a proposed response/ comments paper submitted with (or before) a petition for waiver of page limit, the submitting party would be given a period of 15 days within which to submit a compliant response/comments paper in accordance with the page limit set forth in the decision on the petition. *See* MPEP 2667(I)(A) and (B). Further, a stated need for submission of supporting expert declarations or other appendix evidence as a basis for page limit waiver is not a basis for waiver of 37 CFR 1.943(b), because the party can fashion the content of such declarations or other appendix evidence to avoid having those pages count toward the page limit. *See* MPEP 2667(I)(A)(2) and (B)(2).[4]

[4] That is, patent owner or requester 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 petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b) is granted to the extent that the page limit for the patent owner's forthcoming response is extended to not exceed 75 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

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 related to the present decision should be directed to Joseph F. Weiss, Jr., Legal Advisor, at 571-272-7759.

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

4/13/09
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,407	10/21/2008	7140443	069669-003	2662

35979 7590 07/14/2009
BRACEWELL & GIULIANI LLP
P.O. BOX 61389
HOUSTON, TX 77208-1389

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 07/14/2009

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MORGAN LEWIS & BOCKIUS LLP
1111 PENNSYLVANIA AVENUE NW
WASHINGTON, DC 20004

Date:

MAILED

JUL 14 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000407
PATENT NO. : 7140443
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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TODD MATTINGLY
BRACEWELL & GIULIANI LLP
711 LOUISIANA STREET
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HOUSTON, TX 77002-2770

(For Patent Owner)

MAILED

JUL 14 2009

CENTRAL REEXAMINATION UNIT

MORGAN, LEWIS & BOCKIUS LLP
1111 PENNSYLVANIA AVENUE NW
WASHINGTON, DC 20004

(For Third Party Requester)

In re Beierbach et al.
Inter Partes Reexamination Proceeding
Control No. 95/000,407
Filed: October 21, 2008
For: U.S. Patent No. 7,140,443

:DECISION DISMISSING
:PETITION AND
:CLARIFYING
:PAGE LIMIT
:

This is a decision of the third party requester submission of June 4, 2009 "PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE THE REQUIREMENTS OF 37 C.F.R. § 1.943(b)".

The third party requester's petition and *inter partes* reexamination control number 95/000,407 are before the Office of Patent Legal Administration.

For the reasons set forth below, the petition is dismissed; however the page limit requirements of 37 CFR 1.943(b) are *sua sponte* waived to the extent and subject to the conditions set forth below.

REVIEW OF THE RELEVANT FACTS

1. On November 28, 2006, U.S. patent No. 7,140,443 ("the '443 patent") issued to Beierbach et *al.*

2. On October 21, 2008, a 317 page request for *inter partes* reexamination of the '443 patent, assigned control No. 95/000,407 (the '407 proceeding), was filed by third party requester Paul E. Krieger, in which Weatherford International, Inc. was identified as the real party in interest (hereafter "third party requester").

3. On January 14, 2009, the Office issued an order granting the request for *inter partes* reexamination of claims 1-70, i.e., all of the '443 patent claims.

4. On January 26, 2009 the Office issued a 74 page non-final Office action, rejecting claims 1-3, 5-17, 19-42, 51-59 and 61-69, and confirming claims 4, 18, 43-50, 60 and 70.

5. On February 6, 2009, patent owner filed the present petition entitled "PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE THE REQUIREMENTS OF 37 C.F.R. § 1.943(b)."

6. On April 20, 2009, the Office issued a decision granting-in-part the petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b). The decision waived the rule to the extent that it authorized patent owner to submit a response not to exceed 75 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

7. On May 5, 2009 the patent owner filed a "REVISED RESPONSE TO OFFICE ACTION MAILED ON JANUARY 26, 2009 IN VIEW OF THE DECISION ON THE PETITION MAILED APRIL 20, 2009 GRANTING THE PATENT OWNER ADDITIONAL PAGES TO THE RESPONSE TO THE OFFICE ACTION MAILED JANUARY 26, 2009". The response presented 11 pages of claims and 61 pages if remarks. The remarks section was presented in a very small font.

8. On June 4, 2009 the third party requester submitted a "PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE THE REQUIREMENTS OF 37 C.F.R. § 1.943(b)" and a response to the Patent Owner's revised response.

9. On July 13, 2009 the Office issued a decision addressing patent owner's May 5, 2009 revised response and titled "DECISION EXPUNGING IMPROPER PAPER AND CLARIFYING PAGE LIMIT WAIVER OF APRIL 20, 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.

I. DISCUSSION

In the petition of June 4, 2009 the third party requester asks for the suspension of 37 CFR 1.943(b), which limits the third party requester's responses to 50 pages in length, to increase the

page limit for the third party requester up to 75 pages, the same relief granted to the patent owner in the April 20, 2009 petition decision. In support of the waiver of the rule, the third party requester asserts that the request is warranted as the relief is the same as granted to the patent owner, the length of the reexamination proceeding and the number of grounds of rejections presented by the examiner, and the patent owner revised response containing the 332 pages originally presented response compressed into 61 pages of arguments.

The April 20, 2009 Office decision stated that the Office conducted an analysis as to what is deemed a reasonable balancing of the page limit provisions of 37 CFR 1.943(b) which permit the Office to conduct *inter partes* reexamination proceedings with special dispatch, as required by 35 U.S.C. 314(c), and the patent owner's concern in fully addressing the number of permutations of proposed rejections that were adopted by the examiner in the first Office action, and the number of instances in which the examiner incorporated by reference various pages of the request. After balancing the equities and circumstances of the situation, patent owner's request for waiver was granted to the extent that the patent owner was permitted to submit a response up to (and including) 75 pages long. The petition was granted only as to the next immediate response filed by the patent owner, in response to the Office action mailed on January 26 2009. [1]

II. ANALYSIS AND FINDINGS

The Office issued a "DECISION EXPUNGING IMPROPER PAPER AND CLARIFYING PAGE LIMIT PETITION ON WAIVER OF APRIL 20, 2009" on July 10, 2009. The decision clarified the font size, spacing, and margins that are acceptable in a response that takes advantage of a waiver of the page limits set by 37 CFR 1.943. ***Specifically, any response that exceeds 50 pages and thus requires recourse to a waiver must be in a font no smaller than 12-point and must be double spaced.***

In light of this decision, 37 CFR 1.943(b) is *sua sponte* waived to permit the third party requester the same number of pages for its comments that has been permitted to the patent owner. Therefore, the third party requester may file an acceptable comments paper of up to 75 pages, with the same limitations enumerated for the patent owner.

The waiver petition of June 4, 2009 is dismissed as being premature because as of the date of this decision no response by patent owner has been entered upon which to file comments; however, the 50 page limit set in 37 CFR 1.943(b) is *sua sponte* waived to the extent that the third party requester's submission to the patent owner's immediate subsequent response under 37 CFR 1.943(b) (consistent with the "DECISION EXPUNGING IMPROPER PAPER AND CLARIFYING PAGE LIMIT WAIVER OF APRIL 2009", mailed on July 13, 2009) may be greater than 50 pages but is not to exceed 75 pages in length, excluding reference materials such as prior art references. This waiver is not dependent on the patent owner's response exceeding the 50 page limit. A submission that takes advantage of this waiver must have text of minimum

[1] Decision on Petition mailed April 20, 2009 at page 4

size of 12 points, double spaced, conforming with the margin requirements of 37 CFR 1.52(a)(1)(ii), and with sufficient clarity and contrast to permit direct reproduction, such as electronic capture by digital imaging and optical character recognition.

CONCLUSION

1. The petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b) is dismissed as being premature. However, the page limit of 37 CFR 1.943(b) is waived to the extent that the third party requester may file a response under 37 CFR 1.943(b), greater than 50 pages and up to 75 pages, conforming to the requirements imposed on the patent owner's submission in the "DECISION EXPUNGING IMPROPER PAPER AND CLARIFYING PAGE LIMIT PETITION ON WAIVER OF APRIL 2009" issued by the Office. (See page 5 of the decision of mail date July 10, 2009.)

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 related to the present decision should be directed to Maria Nuzzolillo, Legal Advisor, at 571-272-8150 or Pinchus M. Laufer, Legal Advisor, at 571-272-7726.

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

Kenpet7\IP\length
7-13-09

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,407	10/21/2008	7140443	069669-003	2662

35979 7590 04/20/2010
BRACEWELL & GIULIANI LLP
P.O. BOX 61389
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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/20/2010

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CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000407
PATENT NO. : 7140443
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.
95/000,407	10/21/08	7140443	069669-003

EXAMINER
KAUFMAN, JOSEPH A.

MORGAN LEWIS & BOCKIUS LLP
1111 PENNSYLVANIA AVENUE, NW
WASHINGTON, DC 20004

ART UNIT	PAPER
3993	

DATE MAILED:

INTER PARTES REEXAMINATION COMMUNICATION

BELOW/ATTACHED YOU WILL FIND A COMMUNICATION FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE OFFICIAL(S) IN CHARGE OF THE PRESENT REEXAMINATION PROCEEDING.

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

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HOUSTON, TX 77002-2770

(For Patent Owner)

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CENTRAL REEXAMINATION UNIT

MORGAN, LEWIS & BOCKIUS LLP
1111 PENNSYLVANIA AVENUE NW
WASHINGTON, DC 20004

(For Third Party Requester)

In re Beierbach et al.
Inter Partes Reexamination Proceeding
Control No. 95/000,407
Filed: October 21, 2008
For: U.S. Patent No. 7,140,443

DECISION DISMISSING AND EXPUNGING PETITION

This is a decision on the third party requester paper entitled "PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE ONE OPPORTUNITY LIMITATION UNDER 37 C.F.R. § 1.951(b)," filed on April 2, 2010.

The petition is before the Office of Patent Legal Administration.

The petition is dismissed.

FEES

A petition fee of $400 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR §§ 1.183 was charged to requester's Deposit Account No. 50-0310, as authorized by requester's EFS-WEB fee transmittal on April 2, 2010.

REVIEW OF THE RELEVANT FACTS

1. On November 28, 2006, U.S. patent No. 7,140,443 ("the '443 patent") issued to Beierbach et *al.*

2. On October 21, 2008, a 317 page request for *inter partes* reexamination of the '443 patent, assigned control No. 95/000,407 (the '407 proceeding), was filed by third party requester. Weatherford International, Inc. was identified as the real party in interest (hereafter "third party requester").

3. On January 14, 2009, the Office issued an order granting the request for *inter partes* reexamination on all the claims of the '443 patent. The order indicated that an Office action on the merits would issue in due course.

4. On January 26, 2009 the Office issued a non-final Office action on the merits in the '407 proceeding.

5. The proceeding progressed until, on January 20, 2010, the Office issued an Action Closing Prosecution (ACP).

6. On April 2, 2010, third party requester submitted a paper entitled, "PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE ONE OPPORTUNITY LIMITATION UNDER 37 C.F.R. § 1.951(b)."

7. This decision addresses the April 2, 2010 third party requester petition.

DECISION

35 U.S.C. 314(2)(b) 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 1.183 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 1.951(b) provides:

> 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. [Emphasis added]

37 CFR 1.985(b) provides:

> Notwithstanding any provision of the rules, any person at any time may file a paper in an *inter partes* reexamination proceeding notifying the Office of a prior or concurrent proceedings in which the same patent is or was involved, including but not limited to

interference, reissue, reexamination, or litigation and the results of such proceedings. Such paper must be limited to merely providing notice of the other proceeding without discussion of issues of the current *inter partes* reexamination proceeding. Any paper not so limited will be returned to the sender. [Emphasis added]

MPEP 2282 provides in pertinent part:

It is important for the Office to be aware of any prior or concurrent proceedings in which a patent undergoing *ex parte* reexamination is or was involved, such as interferences, reissues, *inter partes* reexaminations, other *ex parte* reexaminations or litigations, and any results of such proceedings. In accordance with 37 CFR 1.565(a), the patent owner is required to provide the Office with information regarding the existence of any such proceedings, and the results thereof, if known. **Ordinarily, no submissions of any kind by third parties filed after the date of the order are entered into the reexamination or patent file while the reexamination proceeding is pending. However, in order to ensure a complete file, with updated status information regarding prior or concurrent proceedings regarding the patent under reexamination, the Office will, at any time, accept from any parties, for entry into the reexamination file, copies of notices of suits and other proceedings involving the patent and copies of decisions or papers filed in the court from litigations or other proceedings involving the patent**. Such decisions include final court decisions (even if the decision is still appealable), decisions to vacate, decisions to remand, and decisions as to the merits of the patent claims. Non-merit decisions on motions such as for a new venue, a new trial/discovery date, or sanctions will not be entered into the patent file, and will be expunged from the patent file by closing the appropriate paper if they were entered before discovery of their nature. Further, papers filed in the court from litigations or other proceedings involving the patent will not be entered into the record (and will be expunged if already entered) if they provide a party's arguments, such as a memorandum in support of summary judgment. If the argument has an entry right in the reexamination proceeding, it must be submitted via the vehicle (provision(s) of the rules) that provides for that entry right. It is not required nor is it permitted that parties submit copies of copending reexamination proceedings and applications (which copies can be mistaken for a new request/filing); rather, submitters may provide a notice identifying the application/proceeding number and its status. It is to be noted that if the Office, in its sole discretion, deems the volume of the papers filed from litigations or other proceedings to be too extensive/lengthy, the Office may return, expunge or discard, at its sole discretion all or part of the submission. In such an instance, a party may limit the submission in accordance with what is deemed relevant, and resubmit the papers. **Persons making such submissions must limit the submissions to the notification, and must not include further arguments or information.** *Where a submission is not limited to bare notice of the prior or concurrent proceedings (in which a patent undergoing reexamination is or was involved), the submission will be returned by the Office.* It is to be understood that highlighting of certain text by underlining, fluorescent marker, etc., goes beyond bare notice of the prior or concurrent proceedings. [Emphasis added]

REQUESTER'S APRIL 2, 2010 PETITION

The requester petitions the Office under 37 CFR 1.183 to waive the regulatory restrictions of 37 CFR 1.951(b) which precludes a third party requester from responding to a patent owner's comments more than once in an *inter partes* proceeding. The basis for the requested relief is to inform the Office of an updated status regarding concurrent proceedings involving the '443 patent. The requested relief cannot be granted by the Office. The limitation of a third party to a single response to a patent owner's comments in an *inter partes* reexamination is imposed by statute, and cannot be waived. See 35 U.S.C. 314(b)(2). In addition, 37 CFR 1.183 does not apply to the facts of this case, because the requester has failed to show that the requested relief, i.e., a review by the Office of court documents, cannot be obtained by filing a notice of concurrent proceedings, which would be permitted pursuant to 37 CFR 1.985(b) and MPEP 2282.

Accordingly, the petition is **dismissed.**

Furthermore, the present petition includes arguments and comments regarding a court deposition, contrary to 37 CFR 1.985(b), which provides, in pertinent part:

> . . . 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 . . . **Such paper must be limited to merely providing notice of the other proceeding without discussion of issues of the current *inter partes* reexamination proceeding. Any paper not so limited will be returned to the sender.** [Emphasis added]

For this reason, the April 2, 2010 requester petition paper is an **improper paper**. Because the present petition paper has been scanned into the electronic Image File Wrapper (IFW), the present petition paper is **expunged** from the record by marking it "closed" and "non-public," and will not constitute part of the record of the present reexamination proceeding.[1]

The requester may consult 37 CFR 1.985(b) and the guidance of MPEP 2282 regarding any submission to the Office regarding the updated status of any concurrent proceedings on the '443 patent. Submissions that do not comply with the requirements of 37 CFR 1.985(b) and MPEP 2282 will not be entered in the record. For example, exhibits 1 and 2, attached to the present petition, do not appear to be court documents, and may be expunged if resubmitted. Furthermore, "[w]here a submission is not limited to bare notice of the prior or concurrent proceedings (in which a patent undergoing reexamination is or was involved), the submission will be returned by the Office". See MPEP 2282.

The requester may also wish to file another request for reexamination, asserting the deposition, at a time when it is permitted to do so, if the request is based on at least one substantial new question.

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[1] See MPEP 2267.

CONCLUSION

- The petition under 37 CFR 1.183 for waiver of 37 CFR 1.951(b) is **dismissed.**
- The petition paper filed by the third party requester on December 3, 2009 is **expunged** from the record as not having an entry right. This will be carried out by closing the petition paper (document) in the Office's Image File Wrapper (IFW) file of the '407 *inter partes* reexamination proceeding and marking the paper "closed" and "not public."
- No copy of the petition papers will be maintained of record in the electronic Image File Wrapper (IFW) for the proceeding, or elsewhere in the Office.
- A copy of this decision will be made of record in the reexamination file.
- Jurisdiction over this proceeding is being returned to the Central Reexamination Unit.
- Telephone inquiries related to the present decision should be directed to Joseph F. Weiss, Jr., Legal Advisor, at 571-272-7759.

Kenneth M. Schor

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,407	10/21/2008	7140443	069669-003	2662

35979 7590 05/04/2010
BRACEWELL & GIULIANI LLP
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HOUSTON, TX 77208-1389

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 05/04/2010

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/000,407	10/21/08	7140443	069669-003

EXAMINER
KAUFMAN, JOSEPH A.

MORGAN LEWIS & BOCKIUS LLP
1111 PENNSYLVANIA AVENUE, NW
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ART UNIT	PAPER
3993	

DATE MAILED: MAILED

MAY 04 2010

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(For Patent Owner)

MAILED

MAY 04 2010

CENTRAL REEXAMINATION UNIT

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WASHINGTON, DC 20004

(For Third Party Requester)

In re Beierbach et al.
Inter Partes Reexamination Proceeding
Control No. 95/000,407
Filed: October 21, 2008
For: U.S. Patent No. 7,140,443

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

This is a decision on the third party requester paper entitled "PETITION TO REOPEN UNDER 37 C.F.R. § 1.182," filed on March 22, 2010.

The petition is before the Office of Patent Legal Administration.

The petition is dismissed.

FEES

A petition fee of $400 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.182 was charged to requester's Deposit Account No. 50-0310, as authorized by requester's EFS-WEB fee transmittal on March 22, 2010.

REVIEW OF THE RELEVANT FACTS

1. On November 28, 2006, U.S. patent No. 7,140,443 ("the '443 patent") issued to Beierbach et *al.*

2. On October 21, 2008, a 317 page request for *inter partes* reexamination of the '443 patent, assigned control No. 95/000,407 (the '407 proceeding), was filed by third party requester Paul E. Krieger, in which Weatherford International, Inc. was identified as the real party in interest (hereafter "third party requester").

3. On January 14, 2009, the Office issued an order granting the request for *inter partes* reexamination on all the claims of the '443 patent. The order stated that an Office action on the merits would issue in due course.

4. On January 26, 2009 the Office issued a non-final Office action on the merits in the '407 proceeding, setting a two month time period for patent owner to respond.

5. On February 6, 2009, patent owner filed a petition requesting waiver the regulatory 50-page limit requirement of 37 CFR 1.943(b), requesting 391 pages.

6. On March 26, 2009, patent owner timely filed a 335 page response to the non-final Office action, which was non-compliant with the regulatory 50-page limit requirement of 37 CFR 1.943(b).

7. On April 6, 2009, the Office issued a decision granting-in-part patent owner's February 6, 2009 petition, granting patent owner 75 pages to respond to the non-final Office action.

8. On May 5, 2009, patent owner submitted a 61-page response to the non-final Office action, which was non-compliant with the font standards of 37 CFR 1.52.

9. On June 4, 2009, third party requester filed a 74-page comment document. Concurrently, third party requester filed a petition requesting waiver of the regulatory 50-page limit requirement of 37 CFR 1.943(b).

10. On July 10, 2009, the Office *sua sponte* issued a decision expunging patent owner's May 5, 2009 submission as improper for not complying with 37 CFR 1.52.

11. On July 14, 2009, the Office issued a decision dismissing as premature third party requester's June 4, 2009 petition in light of the July 10, 2009 Office decision expunging patent owner's May 5, 2009 submission.

12. On July 27, 2009, patent owner timely submitted comments compliant with the relevant regulations and decisions in the '407 proceeding.

13. On August 26, 2009, third party requester timely submitted comments that were entered in view of the relevant regulations and decisions in the '407 proceeding.

14. On November 24, 2009, patent owner submitted an information disclosure statement.

15. On January 20, 2010, the Office issued an Action Closing Prosecution (ACP). The ACP included an examiner-initialed copy of PTO form SB-08a, reflecting that all the references submitted on November 24, 2009 were considered.

16. On February 19, 2010, patent owner timely filed comments under 37 CFR 1.951(a).

17. On March 22, 2010, third party requester timely filed comments under 37 CFR 1.951(b). Concurrently, third party requester filed a paper entitled, "PETITION TO REOPEN UNDER 37 C.F.R. § 1.183."

18. This decision addresses the March 22, 2010 third party requester petition requesting a reopening of prosecution in the '407 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 1.953(c) provides:

> The Right of Appeal Notice shall be a final action, which comprises a final rejection setting forth each ground of rejection and/or final decision favorable to patentability including each determination not to make a proposed rejection, an identification of the status of each claim, and the reasons for decisions favorable to patentability and/or the grounds of rejection for each claim. No amendment can be made in response to the Right of Appeal Notice. The Right of Appeal Notice shall set a one-month time period for either party to appeal. If no notice of appeal is filed, prosecution in the *inter partes* reexamination proceeding will be terminated, and the Director will proceed to issue and publish a certificate under § 1.997 in accordance with the Right of Appeal Notice.

FINDINGS AND ANALYSIS

Requester petitions the Office under 37 CFR 1.182 to reopen prosecution in the present proceeding in light of prior art submitted by the patent owner on November 24, 2009, and initialed as considered by the examiner on a copy of PTO form SB-08a that accompanied the issuance of an ACP on January 20, 2010. Requester's petition also seeks waiver of the regulatory restrictions of 37 CFR 1.953(c), which provides for a Right of Appeal Notice (RAN) as a final action from which the parties to the proceeding can appeal and which precludes the filing of any further amendments after issuance of a RAN.

The basis for the requested relief of reopening prosecution and waiver of 37 CFR 1.953(c) asserted by requester is the allegation that patent owner withheld a reference until after all "briefing" was submitted for consideration, a reference which allegedly renders confirmed claims unpatentable.[1] Furthermore, in support of the request for waiver of 37 CFR 1.953(c),

[1] Usage of the term "briefing" refers to submissions made by the parties during the appeal phase of a reexamination proceeding for a determination by the Board of Patent Appeals and Interferences and not during the prosecution of a reexamination proceeding.

requester asserts that the allegedly late submission of prior art precluded the examiner from not having an opportunity to properly consider the reference.

The reference at issue was submitted by patent owner on November 24, 2009, before issuance of an ACP and after completion of the comment phase for the initial non-final Office action on the merits. Therefore, the reference was not submitted late. Nor was the reference submitted after briefing was complete. The present proceeding is currently not in the appeal phase; not has a RAN, from which a Notice of Appeal can be filed, issued in the present proceeding. Furthermore, the record reflects that the reference submitted on November 24, 2009 was considered by the examiner.[2] Therefore, the examiner did have an opportunity to properly consider the reference. Requester has provided no extraordinary facts or circumstances to justify waiver of 37 CFR 1.953(c). Furthermore, to date, a RAN has not issued to trigger the provisions of 37 CFR 1.953(c). Thus an extraordinary situation created by 37 CFR 1.953(c) that justice would require waiver, cannot yet exist. Accordingly, the petition is dismissed.

ADDITIONAL DISCUSSION

The record indicates that the art submitted by patent owner on November 24, 2009, was considered, and no rejection based on that art was made. Thus, there is no reason to reopen prosecution and back up the proceeding contrary to the statutory mandate of 35 U.S.C. 314(c) for special dispatch. Thus, reopening is not granted under 37 CFR 1.182. If, however, requester in fact believes that the references under discussion, or any other reference submitted raises a substantial question of patentability as to at least one claim of the patent *different* than raised in this proceeding, the requester can always file a new request for reexamination for consideration of such reference(s). An *ex parte* request can be filed at any time in accordance with 35 U.S.C. 302, but an *inter partes* request could not be filed until the present proceeding is concluded in accordance with 35 U.S.C. 317(a).

CONCLUSION

1. Requester's March 22, 2010 petition under 37 CFR 1.182 to reopen prosecution and to waive 37 CFR 1.953(c) is dismissed.

2. Jurisdiction over this proceeding is being returned to the Central Reexamination Unit.

3. Telephone inquiries related to the present decision should be directed to Joseph F. Weiss, Jr., Legal Advisor, at 571-272-7759.

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

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[2] See fact paragraph 15 of this decision, which notes that the examiner issued an initialed copy of an SB-08a on January 20, 2010, indicated that the reference at issue was considered by the examiner.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,407	10/21/2008	7140443	069669-003	2662

35979 7590 05/06/2010
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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 05/06/2010

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95/000,407	10/21/08	7140443	069669-003

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WASHINGTON, DC 20004

(For Third Party Requester)

In re Beierbach et al.
Inter Partes Reexamination Proceeding
Control No. 95/000,407
Filed: October 21, 2008
For: U.S. Patent No. 7,140,443

: **DECISION**
: **DISMISSING**
: **PETITION AND**
: ***SUA SPONTE* EXPUNGING**
: **IMPROPER PAPERS**

This is a decision on the February 19, 2010 patent owner petition entitled, "PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE THE REQUIREMENTS OF 37 C.F.R. § 1.943(b)," and also on the March 22, 2010 third party requester petition requesting waiver of 37 CFR 1.943(b) under 37 CFR 1.183.

The petitions are before the Office of Patent Legal Administration.

SUMMARY

Patent owner's petition to waive 37 CFR 1.943(b) is dismissed as set forth below.

Third party requester's petition to waiver of 37 CFR 1.943(b) is dismissed as moot.

Patent owner's comments submitted February 19, 2010 are expunged as set forth below.

FEES

A petition fee of $400 pursuant to 37 CFR 1.17(f) for the patent owner petition under 37 CFR 1.183 was charged to patent owner's credit card, as authorized by patent owner's EFS-WEB fee transmittal on February 19, 2010.

A petition fee of $400 pursuant to 37 CFR 1.17(f) for the requester petition under 37 CFR 1.183 will be charged to requester's Deposit Account No. 50-0310, as authorized by requester's comments signature page, page No. 53, submitted on March 22, 2010.

REVIEW OF THE RELEVANT FACTS

1. On November 28, 2006, U.S. patent No. 7,140,443 ("the '443 patent") issued to Beierbach et *al.*

2. On October 21, 2008, a 317 page request for *inter partes* reexamination of the '443 patent, assigned control No. 95/000,407 (the '407 proceeding), was filed by third party requester Paul E. Krieger, in which Weatherford International, Inc. was identified as the real party in interest (hereafter "third party requester").

3. On January 14, 2009, the Office issued an order granting the request for *inter partes* reexamination on all the claims of the '443 patent. The order stated that an Office action on the merits would issue in due course.

4. On January 26, 2009 the Office issued a non-final Office action on the merits in the '407 proceeding, setting a two month time period for patent owner to respond.

5. On February 6, 2009, patent owner filed a petition requesting waiver the regulatory 50-page limit requirement of 37 CFR 1.943(b), requesting 391 pages.

6. On March 26, 2009, patent owner timely filed a 335 page response to the non-final Office action, which was non-compliant with the regulatory 50-page limit requirement of 37 CFR 1.943(b).

7. On April 6, 2009, the Office issued a decision granting-in-part patent owner's February 6, 2009 petition, granting patent owner 75 pages to respond to the non-final Office action.

8. On May 5, 2009, patent owner submitted a 61-page response to the non-final Office action, which was non-compliant with the font standards of 37 CFR 1.52.

9. On June 4, 2009, third party requester filed a 74-page comment. Concurrently, third party requester filed a petition requesting waiver of the regulatory 50-page limit requirement of 37 CFR 1.943(b).

10. On July 10, 2009, the Office *sua sponte* issued a decision expunging patent owner's May 5, 2009 submission as improper for not complying with 37 CFR 1.52.

11. On July 14, 2009, the Office issued a decision dismissing as premature third party requester's June 4, 2009 petition in light of the July 10, 2009 Office decision expunging patent owner's May 5, 2009 submission.

12. On July 27, 2009, patent owner timely submitted comments compliant with the relevant regulations and decisions in the '407 proceeding.

13. On August 26, 2009, third party requester timely submitted comments that were entered in view of the relevant regulations and decisions in the '407 proceeding.

14. On January 20, 2010, the Office issued an Action Closing Prosecution (ACP).

15. On February 19, 2010, patent owner timely filed comments under 37 CFR 1.951(a). Concurrently, patent owner filed a paper entitled, "PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE THE REQUIREMENTS OF 37 C.F.R. § 1.943(b)."

16. On March 22, 2010, third party requester timely filed comments under 37 CFR 1.951(b). On the caption page of requester's comments, requester states that a petition to increase the page limit set forth in 37 CFR 1.943(b) has been filed with the requester comments requesting an additional five pages; however, the record does not reveal that any separate petition for page limit waiver increase was filed with the March 22, 2010 submission nor in any subsequent submission by requester. See below as to how this matter is addressed.

17. This decision addresses patent owner's February 19, 2010 comments submission and petition and requester's March 22, 2010 comments submission.

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.

FINDINGS AND ANALYSIS

A. Patent Owner's February 19, 2010 Petition and § 1.951(a) Comments Submission

Patent owner's February 19, 2010 response to the January 20, 2010 Office action consists of a ninety-eight (98) pages of comments and a declaration under 37 CFR 1.132, totaling eighty (80) pages. The declaration was reviewed and found free of improper legal argument. The declaration has twelve (12) documents attached as evidentiary exhibits. The exhibited documents are being used for their relevant factual content and do not contain legal argument or legal conclusions. Therefore, the exhibited documents are not subjected to the regulatory 50-page limit.

Accordingly, only the ninety-eight (98) pages of comments are subject to the 50-page limit. The ninety-eight (98) pages of patent owner comments include a cover sheet, a twenty (20) page amendment/listing of the claims, and a signature page. Thus, the substantive portion of the comments consists of seventy-six (76) pages of substantive remarks, exceeding the 50–page limit established by 37 CFR 1.943(b) by a total of twenty-six (26) pages, in eleven point font and 1.5

line spacing.[1] Patent own has submitted a petition requesting waiver of the regulatory 50-page limit, requesting 100-pages to respond to the January 20, 2010 ACP. Patent owner is silent as to the fact that the remarks section has not been submitted in twelve (12) point sized font. Patent owner has been informed in multiple decisions that any page limit waiver grant in the present proceeding is pre-conditioned upon the comments being a font size of 12 points.[2] Furthermore, it is uncertain and at best speculative as to whether or not, once the submitted remarks are corrected for improper font size and line spacing, the comments would be within any granted page length wavier. Therefore, the submitted response is not a condition for which a page limit waiver can be granted.

Patent owner asserts four separate arguments or justifications in the February 19, 2010 petition to substantiate the need for 100-pages to respond or twenty-six (26) pages presented in eleven point font:

> 1) The January 20, 2010 ACP is alleged to be an overly voluminous eight-six (86) page Office action on the merits rejecting fifty-eight (58) total claims, to include ten (10) independent claims. Furthermore, patent owner notes that the requester's comments in response to the Office action of January 26, 2009 was sixty-three (63) pages and that the examiner has stated patent owner's conclusory arguments were not persuasive. Patent owner attributes the ineffectiveness of the previously submitted argument to be a function of the length permitted for the patent owner comment submission, 75-pages due to a previously granted waiver of 37 CFR 1.943(b).
>
> 2) The January 20, 2010 ACP is alleged to be more length that it appears and is exceedingly complex because of the presence of twenty-one (21) anticipation rejections and forty-seven (47) obviousness rejections. The complexity of the January 20, 2010, ACP's complexity is exacerbated due to the presence of several compound obviousness rejections where multiple references are applied in the alternative, the full rationale and arguments for rejections are incorporated by reference from other documents of record and/or by dint of the cross- referencing of rejections within the ACP, thus greatly expanding the actual length of the ACP several multiples beyond its eighty-six page length.
>
> 3) The January 20, 2010 ACP is alleged to be exceedingly complex because of eight different prior art references are being used in the alternative across all the different grounds of rejection, compelling patent owner to distinguish each reference from the claimed invention on a rejection-by-rejection basis. To this end patent owner asserts the need for additional pagination.
>
> 4) The regulatory 50-page length limitation prevents patent owner's counsel from providing competent representation of the patent owner, as the page length limitations prevents counsel from providing thorough response to the January 20, 2010 ACP on behalf of the patent owner.

---

[1] I precise replication of the submitted document cannot be performed without an undue burden upon the Office, however a test document was created consisting of seventh-six pages of eleven point font text with 1.5 line spacing. When the text document was placed in twelve point font with double line spacing a 110-page document resulted.

[2] See Office decision dated July 10, 2009, pages 4-5; See also Office decision dated July 14, 2009, pages 3-4.

Patent owner has NOT made an adequate showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) to 100-pages of twelve (12) point font. Patent owner has not presented an attempt to draft a response in compliance with the 50-page limit. Nor has patent owner attempted to provide a response that exceeds the regulatory 50-page limit in twelve (12) point font. Instead patent owner has provided a seventy-six (76) page response that is not in twelve (12) point font, and has asked for a waiver of the 50-page regulatory page length limitation for 100 pages, while being fully noticed that any page length waiver is pre-conditioned in the present proceeding upon a twelve (12) point font, double line spaced format. Furthermore, Patent owner has provided no explanation of how the submitted response economizes, excludes extraneous material, and is arranged so as not to repeat information already of record. The merits of the case has not been shown to contain any unique and/or inordinately complex legal issue, but instead appears to consist of common issues of patent law that arise in patent examination proceedings, e.g. anticipation, obviousness, etc.

The January 20, 2010 ACP is eight-nine (89) pages in length, which includes two (2) pages of address cover sheets, an ACP Summary form PTOL-2065, an administrative/housekeeping reminder page,[3] and a signature page. Therefor the ACP consists of a total of eight-four (84) pages of substance in **twelve (12) point double line spaced format** and which liberally uses multiple double-carriages between each rejection to distinguish between rejections and to highlight whether or not a rejection is adopted or not adopted. Patent owner has only focused upon the length of the ACP without noting that a substantial portion of the content of the ACP sets forth favorable withdrawn rejections and non-adopted rejections. The withdrawn rejection section is from page 64 to page 70 of the action, and *in toto*, the ACP discusses the non-adoption of approximately thirty proposed rejections. These portions of the ACP should not require significant commentary by patent owner, thus significantly reducing the action's substantive length to which patent owner is compelled to address. Regarding patent owner's four specific arguments, the following is noted:

1) Patent owner's assertions regarding the length of the ACP and the number of claims that stand rejection contains some merit; however, patent owner's asserted substantive length of the action is "off" significantly. The asserted substantive length of eight-six pages is off by two pages and does not account for the pages dedicated to actions favorable to patent owner that would not require significant commentary from patent owner, i.e. the five to six page discussion regarding withdrawn rejections and the pages attributable to the thirty withdrawn rejections. The length of third party requester's comments in response to the January 26, 2009 Office action are not directly relevant to patent owner's current response, as patent owner is responding to the January 20, 2010 ACP and not requester's prior comments of record.

2) Patent owner's assertions regarding the length and complexity of the ACP due the use of incorporation by reference from other documents of record as well as internal cross referencing and incorporation by reference within the ACP has merit; however, patent owner makes no attempt to quantify to what extent the incorporation by reference and internal cross referencing lengthens the ACP that justifies additional pages beyond the 50-page regulatory limit. Patent

[3] Page 2 of the ACP with discussions regarding extensions of time, a litigation reminder and notes that a previously signed declaration was not signed.

owner merely alleges the actual length is greatly expanded by several multiples of the erroneously asserted ACP page length of eight-six pages.

3) Patent owner's assertions regarding the using of only eight prior art references in the January 20, 2010 ACP for all the grounds of rejection asserted has little merit. While the multiple usage of a few references in several different combinations may cause some difficult in tracking all the nuances of each rejection, the fact that such a small finite set of teachings also should tend to limit the burden of distinguishing the references from the claimed invention and thus not create the need for a significant addition of pagination in any response beyond the 50-page regulatory limit.

4) Finally in regards to patent owner's assertions that additional pages are necessary for counsel to discharge the ethical duty of thoroughly represent patent owner, the argument in principle has merit; however, patent owner had provided no specific facts or circumstances as to this specific case to support the assertion. Patent merely cites a rule of the Model Rules of Professional Conduct for the principle, and says nothing about how the specific facts and circumstances place counsel in an ethical quandary that can only be alleviated by the granting of additional pages.

Considering the equities, having to respond to the January 20, 2010 ACP which consisted of approximately seventy (70) pages of substantive with an un-quantified incorporation by reference component, permitting patent owner to have a response of seventy-six (76) pages of substance in a compressed format that could be significantly over the 100 pages requested does not balance the equities between the parties in this *inter partes* proceeding. In this instance, exceeding the page limits of 37 CFR 1.943(b) by patent owner disturbs the equitable balance set by the length-limiting rule in light of the facts and circumstances of the instant case. Therefore, patent owner's requested relief will not be granted, the February 19, 2010 response will not be entered into the IFW record, and thus will not be reviewed as to the merits.

Patent owner has not provided the sufficient specificity of a showing to establish an extraordinary situation for which justice compels a grant of equitable relief. Waiver of the rules under 37 CFR 1.183 may be suspended in an extraordinary situation when justice requires. As noted above patent owner did not provide a sufficient showing that the response represented an effort to economize its content nor provide sufficient specificity of the facts and circumstances to justify the relief requested. Furthermore, patent owner did not present comments that exceeded the regulatory 50-page limit in the proper font size and line spacing. The failure of patent owner to comply with the rules, in the form of submitting an economized set of comments in accordance with 37 CFR 1.943(b), without a sufficiently specific showing to justify the grant of extraordinary relief does not rise to an ***extraordinary situation*** under 37 CFR 1.183 to justifying suspension of the rules. Therefore, justice does not require suspension of 37 CFR 1.943(b). Therefore, the petition requesting waiver of 37 CFR 1.943(b) 50-page limit to accept patent owner's comments of February 19, 2010 is dismissed. Accordingly, the comments are improper and expunged.

B. Third Party Requester's March 22, 2010 Comments and "Petition" Submission

Third party requester's March 22, 2010 comments are in response to an improper paper; therefore, it is also improper without a right of entry into the record of the present reexamination

proceeding. As third party requester's petition and comments were filed using the EFS-Web system and have already been incorporated into the electronic Image File Wrapper (IFW), they will all be expunged from the record by marking them as "closed" and "non-public" in the IFW. A copy of the present decision will be made of record in the reexamination file.

On the caption page of requester's March 22, 2010 comments, requester states that a petition to increase the page limit set forth in 37 CFR 1.943(b) was being concurrently filed. However, no separate petition paper was made of record as part of the March 22, 2010 submission. Requester's statement on the caption page states the relief being requested, specifically for five additional pages beyond the 50-page regulatory limit. This statement is being treated as a petition for waiver of the page limit requirement in 37 CFR 1.943(b) as to the submitted comments paper. It is to be noted that the submission is improper, as it runs contrary to the strictures of 37 CFR 1.4(c), which requires separate submissions for separately distinct and different matters. Additionally, third party requester's March 22, 2010 petition is dismissed as moot, as requester's comments have been expunged as improper due to the dismissal of patent owner's petition for waiver of 37 CFR 1.943(b) and expungement of patent owner's comments.

C. Submission of Comments Responsive to the January 20, 2010 ACP

Patent owner's February 19, 2010 submission is improper and subject to return. See MPEP 2667, Part I.A.2. The copy of the February 19, 2010 submission however, was scanned into the electronic Image File Wrapper (IFW) of the proceeding, before discovery of the impropriety. Thus, the submission cannot be physically returned to patent owner. Therefore, the IFW copy of the submission is being expunged, by closing it in the IFW file of the present proceeding and marking it "not public." It will not constitute part of the record of the present reexamination proceeding.

For the reasons given above, the February 19, 2010 submission by patent owner exceeded the 50-page limit established by 37 CFR 1.943(b). However, from the record it appears that patent owner's submission was a *bona fide* attempt to respond and advance prosecution. Accordingly, patent owner may, within 15 days from the date of this notice, exercise one of the following two options:

1. Submit re-drafted remarks that do not exceed the 50 page limit; or,

2. File a copy of the original remarks with pages redacted to satisfy the page limit requirement.

This 15-day period for reply is not extendable.

The declarations and exhibits are also being expunged as they are part of an improper submission. Therefore upon resubmission, patent owner should either request that the declarations and exhibits be unsealed and made public, or should include the declarations and exhibits (as long as they are not re-drafted or altered to include improper legal argument or conclusions, they would not be counted against the regulatory 50-page limit or the page limit permitted by any granted waiver of the regulatory 50-page limit).

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

Third party requester is advised that in accordance with 37 CFR 1.947 upon Notice of service of patent owner's resubmitted comments, third party requester has a thirty (30) day time period to submit comments.

Both parties should consider the following when drafting comments in an *inter partes* reexamination proceeding in light of the regulatory page limitation:
(1) Use of lengthy block quotes and figures should be given careful consideration and instead citation to the relevant portion(s) of the document(s) of record to economize space should be considered;
(2) Remarks regarding an inventor's business and/or credentials can be submitted as an exhibit to the comments and thus not be counted against the regulatory page limit;
(3) Restating the legal analysis and rationale of any rejection or record can be minimized by citation to the relevant rejection in the record and then include patent owner's response to efficiently identify and provide relevant arguments to the rejections of record;
(4) Arguing issues in the comments which are properly addressed by petition should not be included, because while the issues raised might be treated as a petition, the pages will still be considered as part of the substantive comments; and
(5) Extensive discussion sections regarding the current state of the law maybe minimized by citations to the relevant section(s) of the Manual of Patent Examination Procedure (MPEP) along with supplemental citation to the most current on point case law, if necessary, as patent owner argues the merits of the case.

Both parties are advised that submissions should be of sufficient size, 12 point font, 1.5 spaced, conform to the margin requirements of 37 CFR 1.52(a)(1)(ii) and have sufficient clarity and contrast to permit direct reproduction, and electronic capture by digital imaging and optical character recognition. See 37 CFR 1.52. If a waiver is requested equal to the length of the relevant Office action pages (here, an ACP) plus those pages incorporated by the Office action, then the submission must be double spaced, since the Office action is double spaced.

If no response from patent owner is received, the reexamination proceeding will be forwarded to the examiner for appropriate action, without entry of written comments (and attachments) from patent owner or third party requester.

ADDITIONAL DISCUSSION

MPEP 2609 states (in part):

> Patent owners and third party requesters are cautioned that the reexamination statute, regulations, and published examining procedures do not countenance so-called "litigation tactics" in reexamination proceedings. The parties are expected to conduct themselves accordingly.

Patent owner has been informed in multiple decisions the format and font standards for the submission of comments for an *inter partes* reexamination proceeding when a page limit waiver is sought.[4] The subsequent submission of comments in conjunction with a request for waiver of the regulatory 50-page limit waiver that does not comply with the relevant standards is inappropriate. Any subsequent submissions that are non-compliant with the relevant standards **will not** be considered a *bona fide* attempt to respond and advance prosecution in the *inter partes* proceeding. The consequences of not submitting a *bona fide* attempt to respond and advance prosecution in the *inter partes* proceeding will be expungement of the submission WITHOUT an opportunity of resubmission.

CONCLUSION

1. Patent owner's February 19, 2010 petition under 37 CFR 1.183 to waive 37 CFR 1.943(b) is dismissed. Therefore, patent owner's February 19, 2010 comments submission is improper and expunged. As the documents are already scanned into the Image File Wrapper (IFW), expungement will occur by closing the documents in IFW and marking them as "non-public," removing any access to the documents by the public. The comments submission will, therefore, not form a part of the record of the reexamination proceeding.

2. Third party requester's March 22, 2010 comments submission is in response to an improper paper, therefore it is also improper without a right of entry into the record of the present reexamination proceeding and is expunged.

3. Third party requester's March 22, 2010 petition is dismissed as moot as requester's comments have been expunged as improper due to the expungement of patent owner's comments.

4. As third party requester's petition and comments paper was filed using the EFS-Web system and have already been incorporated into the electronic Image File Wrapper (IFW), it will be expunged from the record by marking them as "closed" and "non-public" in the IFW. A copy of the present decision will be made of record in the reexamination file.

5. Patent owner has a period of 15 DAYS from the date of this decision to submit a response to the January 20, 2010 ACP that either complies with 37 CFR 1.943(b) or contains a grantable petition for waiver of the 50-page limit. The text of any comments submission for which page limit waiver is requested MUST be a minimum font size of 12 points, 1.5 line spaced, conform to the margin requirements of 37 CFR 1.52(a)(1)(ii), and in accordance with 37 CFR 1.903 service requirement.

6. Third party requester will have a period of 30 DAYS from the date of service of patent owner's comment submission to submit a response to the January 20, 2010 ACP that either complies with 37 CFR 1.943(b) or contains a grantable petition for waiver of the 50-page limit. The text of any comments submission for which page limit waiver is requested MUST be a minimum font size of 12 points with a double spacing of the text lines, conform

[4] See Office decision dated July 10, 2009, pages 4-5; See also Office decision dated July 14, 2009, pages 3-4.

to the margin requirements of 37 CFR 1.52(a)(1)(ii), and in accordance with 37 CFR 1.903 service requirement.

7. Jurisdiction over this proceeding is being returned to the Central Reexamination Unit (CRU) to await the filing of any party papers and to process any and all party papers when there is no further time remaining for filing such papers. After the CRU has processed all party papers, or there are no such papers and the time for filing has expired, jurisdiction will be transferred to the examiner of record for appropriate action.

8. Telephone inquiries related to the present decision should be directed to Joseph F. Weiss, Jr., Legal Advisor, at 571-272-7759.

/Kenneth M. Schor/

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

Kenpet8
5-5-10

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,407	10/21/2008	7140443	069669-003	2662

35979 7590 05/18/2010

BRACEWELL & GIULIANI LLP
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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 05/18/2010

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/000,407	10/21/08	7140443	069669-003

EXAMINER
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3993	

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MAY 18 2010

CENTRAL REEXAMINATION UNIT

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95/000,407	10/21/08	7140443	069669-003

EXAMINER
KAUFMAN, JOSEPH A.

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ART UNIT	PAPER
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HOUSTON, TX 77002-2770

(For Patent Owner)

MAILED

MAY 18 2010

CENTRAL REEXAMINATION UNIT

MORGAN, LEWIS & BOCKIUS LLP
1111 PENNSYLVANIA AVENUE NW
WASHINGTON, DC 20004

(For Third Party Requester)

In re Beierbach et al.
Inter Partes Reexamination Proceeding
Control No. 95/000,407
Filed: October 21, 2008
For: U.S. Patent No. 7,140,443

DECISION DISMISSING AND EXPUNGING PETITION

This is a decision on the third party requester paper entitled "PETITION [TO] TERMINATE PROSECUTION PURSUANT TO 37 C.F.R. §§ 1.181(a)(3) and 1.182," filed on March 22, 2010.

The petition is before the Office of Patent Legal Administration.

The petition is dismissed and expunged.

FEES

A petition fee of $400 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.182 was charged to requester's Deposit Account No. 50-0310, as authorized by requester's EFS-WEB fee transmittal on March 22, 2010.

REVIEW OF THE RELEVANT FACTS

1. On November 28, 2006, U.S. patent No. 7,140,443 ("the '443 patent") issued to Beierbach et *al.*

2. On October 21, 2008, a 317 page request for *inter partes* reexamination of the '443 patent, assigned control No. 95/000,407 (the '407 proceeding), was filed by third party requester Paul E. Krieger, in which Weatherford International, Inc. was identified as the real party in interest (hereafter "third party requester").

3. On January 14, 2009, the Office issued an order granting the request for *inter partes* reexamination on all the claims of the '443 patent. The order indicated that an Office action on the merits would issue in due course.

4. On January 26, 2009 the Office issued a non-final Office action on the merits in the '407 proceeding.

5. The proceeding progressed until, on January 20, 2010, the Office issued an Action Closing Prosecution (ACP).

6. On March 22, 2010, third party requester submitted a paper entitled, "PETITION [TO] TERMINATE PROSECUTION PURSUANT TO 37 C.F.R. §§ 1.181(a)(3) and 1.182."

7. This decision addresses the March 22, 2010 third party requester petition.

8. The '443 patent is subject to litigation in the United States District Court for the Southern District of Texas, *Tesco Corporation v. Weatherford International, Inc et al.*, 4:08cv2531, initiated on August 18, 2008 ("the litigation").

DECISION

35 U.S.C. 314 (c) provides:

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

37 CFR 1.181(a) provides:

(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 1.182 provides:

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

37 CFR 1.906 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 1.957 provides:

(a) 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.

(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.

(d) When action by the patent owner is a *bona fide* attempt to respond and to advance the prosecution and is substantially a complete response to the Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, an opportunity to explain and supply the omission may be given.

I. REQUESTER'S MARCH 22, 2010 PETITION

Requester petitions the Office under 37 CFR §§ 1.181(a) (3) and 1.182 to terminate prosecution in accordance with 37 CFR 1.957(c) which permits the Office to limit prosecution in an *inter partes* reexamination proceeding to claims found patentable, if the patent owner fails to timely file an appropriate response. Requester's basis for the requested relief is grounded in the statutory mandate of special dispatch and the allegation that the patent owner's conduct frustrates special dispatch. Specifically, requester alleges that patent owner's pattern of filing non-compliant responses violates 37 CFR 1.957(c). Petitioner references three papers which allegedly support granting the petition, dated February 6, 2009, May 5, 2009 and February 18, 2010, all relating to page limits. The requested relief cannot be granted by the Office. The record indicates that no patent owner response as being found to not constitute a *bona fide* response. Additionally, two of the three papers petitioner relies upon were accompanied by petitions under 37 CFR 1.183 seeking waiver of the page limit. Therefore, to grant such relief would be contrary to the requirements of 37 CFR 1.957(d). Accordingly, the petition is dismissed.

II. EXPUNGEMENT OF THE MARCH 22, 2010 REQUESTER PETITION

Requester's petition contains comments and allegations directed to the conduct of patent owner. A reexamination proceeding, (which is an administrative proceeding conducted under the provisions of the reexamination statute and rules, and 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. Comments on party conduct are not proper for a reexamination proceeding. The Office will not waive the provisions of 37 CFR 1.906, because such provisions are contained in the reexamination statute, which limits reexamination proceedings to consideration of prior patents and printed publications. Therefore, requester's petition is an improper paper. Accordingly, requester's petition is expunged.

III. ADDITIONAL DISCUSSION

MPEP 2609 states (in part):

> Patent owners and third party requesters are cautioned that the reexamination statute, regulations, and published examining procedures do not countenance so-called "litigation tactics" in reexamination proceedings. The parties are expected to conduct themselves accordingly. For example, it is expected that submissions of papers that are not provided for in the reexamination regulations and/or appear to be excluded by the regulation will either be filed with an appropriate petition to accept the paper and/or waive the regulation(s), or not filed at all. Parties are advised that multiple submissions, such as a reply to a paper opposing a petition and a sur-reply directed to such a reply are not provided for in the regulations or examining procedures governing *inter partes* reexamination. It is expected that the parties will adhere to the provisions of 37 CFR 10.18(b) [11.18(b)] throughout the course of a reexamination proceeding.

Both parties are reminded that submissions that are non-compliant with the relevant standards and are beyond the scope of an administrative reexamination proceeding **will not** be considered a *bona fide* attempt to advance prosecution in the *inter partes* proceeding and expunged from the record. The parties are reminded to insure all submissions are in accordance with the professional rules of conduct and practice before the office, 37 CFR 10.1 *et seq.*

The petition will be expunged from the record by being marked "closed" and "non-public" in the electronic Image File Wrapper (IFW) of the files comprising the merged reexamination proceeding.

CONCLUSION

1. Requester's March 22, 2010 petition under 37 CFR §§ 1.181(a) (3) and 1.182 requesting termination of the proceeding in accordance with 37 CFR 1.957(c) is dismissed and expunged.

2. Requester's March 22, 2010 petition is an improper paper. The petition is being expunged by being closed in the '407 proceeding's Image File Wrapper (IFW) and marked "non-public." The petition will not constitute part of the record of the '407 proceeding.

3. A copy of this decision will be made of record in the '407 proceeding.

4. Jurisdiction over this proceeding is being returned to the Central Reexamination Unit.

5. Telephone inquiries related to the present decision should be directed to Joseph F. Weiss, Jr., Legal Advisor, at 571-272-7759.

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.
95/000,408	10/27/2008	6835887	2202A/529	9553

909 7590 05/07/2009

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EXAMINER

ART UNIT	PAPER NUMBER

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/000,408	10/27/08	6835887	2202A/529

EXAMINER
GAGLIARDI, ALBERT

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3992	

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05/07/09

INTER PARTES REEXAMINATION COMMUNICATION

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CENTRAL REEXAMINATION UNIT

PILLSBURY WINTHROP SHAW PITTMAN (For Patent Owner)
P.O. BOX 10500
MCLEAN, VA 22102

BROMBERG & SUNSTEIN L.L.P (For *Inter Partes* Requester)
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In re Devecka :
Reissue Application :
Application No. 11/646,617 :
Filed: December 28, 2006 :
For: U.S. Patent No. 6,835,887 : **DECISION DISMISSING**
: **PETITION TO MERGE REISSUE**
: **AND *INTER PARTES***
Inter Partes Reexamination Proceeding : **REEXAMINATION**
Control No. 95/000,408 : **PROCEEDINGS**
Filed: October 27, 2008 :
For: U.S. Patent No. 6,835,887 :

This is a decision on the third party requester petition entitled "Petition Under 37 C.F.R. §§1.182, 1.183 and MPEP § 2686.03(V) To Merge Co-Pending *Inter Partes* Reexamination and Reissue Proceedings for U.S. Patent No. 6,835,887" filed January 13, 2009, in *inter partes* reexamination control number 95/000,408, requesting that (1) the reissue application number 11/646,617 and *inter partes* reexamination proceeding control number 95/000,408 be merged, or in the alternative, that the reissue application be stayed, and (2) the requirement of 37 CFR 1.939(b) that no paper shall be filed prior to the initial Office action on the merits of the *inter partes* proceeding be waived to permit consideration of the petition.

Reissue application number 11/646,617 and *inter partes* reexamination control number 95/000,408 are before the Office of Patent Legal Administration for consideration of the petition.

Summary:

(1) The petition is granted to the extent that 37 CFR 1.939(b) is waived to permit consideration of the instant petition

(2) The petition is dismissed as to the request that the reissue application number 11/646,617 and *inter partes* reexamination proceeding control number 95/000,408 be merged, or in the alternative, that the reissue application be stayed.

(3) The prosecution of reissue application number 11/646,617 and *inter partes* reexamination will continue separately, but constrained as set forth hereinbelow.

FEES

The petition was not accompanied by the petition fee required under 37 CFR 1.17(f). However, the petition included an authorization to charge any required fees in connection with the petition to be charged to third party requester's deposit account. Accordingly, after mailing of this decision, the $400.00 petition fee will be charged to third party requester's deposit account No. 19-4972.

BACKGROUND

1. U.S. Patent No. 6,835,887 (the '887 patent) issued to John R. Devecka on December 28, 2004.

2. On December 28, 2006, the patent owner filed a "broadening" reissue application based on the '887 patent, which application was assigned application number 11/646,617 (the '617 reissue application). Broadening in the '617 reissue application is present based on at least the replacement of "buttons" by the broader "inputs" in all independent patent claims and the use of "input," "input means" or "input device" in all added independent claims.

3. A request for *inter partes* reexamination of claims 1-9 of the '887 patent was filed on October 27, 2008, by the third party requester, and the request was assigned control number 95/000,408 (the '408 *inter partes* proceeding).

4. On January 9, 2009, *inter partes* reexamination was ordered for claims 1-9 of the '887 patent based on the examiner's determination that the October 27, 2008 request

raised a substantial new question of patentability affecting these claims. The order was not accompanied by an Office action on the patentability of the claims, and no action on the patentability of claims 1-9 has been taken.

5. No action has been taken by the Office on the '617 reissue application.

DECISION

I. RELEVANT AUTHORITY

35 U.S.C. § 251 provides:

> Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Director shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.
>
> The Director may issue several reissued patents for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued patents.
>
> The provisions of this title relating to applications for patent shall be applicable to applications for reissue of a patent, except that application for reissue may be made and sworn to by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent.
>
> No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent.

37 CFR 1.171 provides:

> An application for reissue must contain the same parts required for an application for an original patent, complying with all the rules relating thereto except as otherwise provided, and in addition, must comply with the requirements of the rules relating to reissue applications.

37 CFR 1.176(a) provides:

> A reissue application will be examined in the same manner as a non-reissue, non-provisional application, and will be subject to all the requirements of the rules related to non-reissue applications. Applications for reissue will be acted on by the examiner in advance of other applications.

35 U.S.C. § 314(a) and (c) provide:

> (a) IN GENERAL. – Except as otherwise provided in this section, reexamination shall be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133. In any *inter partes* reexamination proceeding under this chapter, the patent owner shall be permitted to propose any amendment to the patent and a new claim or claims, except that no proposed amended or new claim enlarging the scope of the claims of the patent shall be permitted.

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

37 CFR 1.906(b) provides:

Claims in an *inter partes* reexamination proceeding will not be permitted to enlarge the scope of the claims of the patent.

37 CFR 1.937 provides, in part:

(a) All *inter partes* reexamination proceedings, including any appeals to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office, unless the Director makes a determination that there is good cause for suspending the reexamination proceeding.

(b) The *inter partes* reexamination proceeding will be conducted in accordance with §§ 1.104 through 1.116, the sections governing the application examination process, and will result in the issuance of an inter partes reexamination certificate under § 1.997, except as otherwise provided.

37 CFR 1.955 provides:

There will be no interviews in an *inter partes* reexamination proceeding which discuss the merits of the proceeding.

37 CFR 1.987 provides:

If a patent in the process of *inter partes* reexamination is or becomes involved in litigation, the Director shall determine whether or not to suspend the *inter partes* reexamination proceeding.

37 CFR 1.991 provides:

If a reissue application and an *inter partes* reexamination proceeding on which an order pursuant to § 1.931 has been mailed are pending concurrently on a patent, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger of a reissue application and an *inter partes* reexamination proceeding is ordered, the merged proceeding will be conducted in accordance with §§ 1.171 through 1.179, and the patent owner will be required to place and maintain the same claims in the reissue application and the *inter partes* reexamination proceeding during the pendency of the merged proceeding. In a merged proceeding the third party requester may participate to the extent provided under §§ 1.902 through 1.997 and 41.60 through 41.81, except that such participation shall be limited to issues within the scope of *inter partes* reexamination. The examiner's actions and any responses by the patent owner or third party requester in a merged proceeding will apply to both the reissue application and the *inter partes* reexamination proceeding and be physically entered into both files. Any *inter partes* reexamination proceeding merged with a reissue application shall be concluded by the grant of the reissued patent.

MPEP § 2686.03 provides, in part:

The general policy of the Office is that the examination of a reissue application and an *inter partes* reexamination proceeding will not be conducted separately at the same time as to a particular patent. The reason for this policy is to permit timely resolution of both the reissue and the reexamination to the extent possible and to prevent inconsistent, and possibly conflicting, amendments from being

introduced into the two files on behalf of the patent owner. 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. Consideration will also be given to the status of the reissue application examination at the time the order to reexamine the patent pursuant to 37 CFR 1.931 is mailed.

II. DISCUSSION REGARDING MERGER

As evidenced by the above review of facts, the '617 reissue application and the '408 *inter partes* reexamination proceeding are currently pending. The two proceedings are in their early stages of prosecution. Since reexamination has been ordered pursuant to § 1.931 in the '408 *inter partes* reexamination proceeding, a decision under § 1.991 is timely for consideration as to whether the '617 reissue application and the '408 *inter partes* reexamination proceeding should be merged.

The decision to merge, or not to merge, is made on a case-by-case basis. Normally, the proceedings will be merged when it is desirable to do so in the interest of expediting the prosecution of both of the proceedings, i.e., when merger would serve to expedite both proceedings. In this instance, the complexities of a possible merger would result in the proceedings not being expedited via 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 1.191 **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.*

As to suspension of the reissue application, such is also not an option in this case. Initially, it is noted that the '617 reissue application was the first filed proceeding. The '408 *inter partes* reexamination proceeding was filed nearly 22 months after the filing of the '617 reissue application. Further, patent owner has not expressed a willingness to have the reissue application suspended. Accordingly, and based on the present fact situation, the reissue application will not be suspended. Third party requester has requested that the reissue application be stayed if the Office decides that merger is inappropriate. It is noted that third party requester does not have standing to request the Office to stay the reissue application.

As to suspension of the reexamination proceeding, 35 U.S.C. 314(c) statutorily requires "special dispatch," unless the Director determines there is good cause for suspension. In this instance, if at all possible, it is desirable to prevent the delay in resolving the raised statutory new question of patentability while patent owner prosecutes the reissue application, and any continuation reissue applications that may be filed. This can be attained by the conduct of the proceedings conducted separately and at the same time, as will now be discussed.

III. CONDUCTING THE REISSUE AND REEXAMINATION PROCEEDINGS SEPARATELY, AND AT THE SAME TIME

Generally, a reissue application and a concurrently pending reexamination proceeding are not examined separately, and at the same time, for a single patent. Such separate

examination is not conducted in order to prevent inconsistent and possibly conflicting amendments from being introduced into the multiple proceedings on behalf of the patent owner. In this instance, however, the only viable option is separate examination, and such will be carried out. In order to preclude inconsistent and possibly conflicting amendments from being introduced into the two proceedings, the following procedure is imposed for the separate prosecution of the two proceedings:

A. Conduct of '617 reissue application prosecution:

1. Conduct of the '617 reissue application will be carried out as prescribed in MPEP Chapter 1400.

2. All non-broadened claims will be held as withdrawn from consideration in the reissue application, and will be prosecuted in the'408 *inter partes* reexamination which can accommodate the resolution of those claims in light of the prior patents and printed publications.

3. Prosecution of the '617 reissue application will be strictly limited to claims broader than those of the '887 patent.

4. All claim amendments presented in the' 617 reissue application prosecution will be for claim broadening amendments and will be solely presented and prosecuted in the reissue application. Any amendment presenting non-broadened claims in the reissue application will be denied entry. In such an instance, if a *bona fide* attempt to reply is made pursuant to 37 CFR 1.135(c), an opportunity to correct the amendment will be provided via a notice.

5. Should the reissue application be placed in condition for allowance, except for the claims held in abeyance, prior to the termination of the '408 *inter partes* reexamination prosecution, patent owner must either: (a) request suspension of the reissue application, or (b) cancel the claims held in abeyance and pay the issue fee. In such a situation, it is suggested applicant consider filing a continuation reissue application containing the patented claims held in abeyance, followed by canceling the claims held in abeyance in the '617 reissue application and payment of the issue fee. Patent owner is cautioned that should the non-broadened claims not be filed in a continuation reissue at this point, the *inter partes* reexamination proceeding will be terminated based on the surrender of the '887 patent upon its reissue as a reissue patent.

If such a continuation reissue application is filed, after it is processed and forwarded to the Technology Center, it would be suspended to await conclusion of the ' 408 *inter partes* reexamination proceeding. When the *inter partes* reexamination proceeding would be terminated, a conforming amendment would be required in the continuation reissue application, the two proceedings merged, and a second reissue patent would be

issued to the second set of claims, if a 35 U.S.C. 251 error is corrected in the continuation reissue application. [1]

6. Jurisdiction and examination of the '617 reissue will reside in the Technology Center. Prior to the indication of allowance of any claim, the examiner of the '617 reissue application will consult and conference with the examiner of the '408 *inter partes* reexamination proceeding, and may, if desired, also consult with a Legal Advisor from the Office of Patent Legal Administration.

B. Conduct of the '408 *inter partes* reexamination proceeding

1. Conduct of the '408 *inter partes* reexamination proceeding will be carried out as prescribed in MPEP Chapter 2600.

2. All non-broadened amendments desired by patent owner will be presented and prosecuted in the '408 *inter partes* reexamination proceeding. Any amendment presenting broadened claims in the reexamination proceeding will be denied entry.

3. If the reexamination proceeding is terminated prior to the conclusion of the reissue prosecution, a reexamination certificate will be issued and the reissue application will be conformed to the results of the certificate by amending the reissue application claims as needed.

4. Jurisdiction and examination of the '408 *inter partes* reexamination proceeding will reside in the Central Reexamination Unit. Prior to the indication of patentability of or confirmation of any claim, the examiner of the '408 *inter partes* reexamination proceeding will consult and conference with the examiner of the '617 reissue application, and may, if desired, also consult with a Legal Advisor of the Office of Patent Legal Administration.

CONCLUSION

1. The petition is granted to the extent that 37 CFR 1.939(b) is waived to permit consideration of the instant petition.

2. The petition is dismissed as to the request that the reissue application number 11/646,617 and *inter partes* reexamination proceeding control number 95/000,408 be merged, or in the alternative, that the reissue application be stayed.

[1] If a 35 U.S.C. 251 error is not corrected in the continuation reissue application, the claims in the reissue continuation would be lost.

3. The prosecution of reissue application number 11/646,617 and *inter partes* reexamination will continue separately, but constrained as set forth above.

4. After mailing of this decision, the required $400.00 petition fee under 37 CFR 1.17(f) will be charged to third party requester's deposit account No. 19-4972 as authorized in the petition.

5. A copy of this decision will be placed in the IFW of the '617 reissue application and the '408 *inter partes* reexamination proceeding.

6. Jurisdiction over the reexamination proceeding is being returned to the Central Reexamination Unit, for preparation of a Office action pursuant to the procedure set forth above.

7. Jurisdiction over the reexamination proceeding is being returned to the Technology Center, in which the reissue application is assigned, for preparation of a Office action pursuant to the procedure set forth above.

6. Any questions concerning this communication should be directed to Jessica Harrison, SPE, Central Reexamination Unit, at 571-272-4449 or Eugenia Jones, Senior Legal Advisor, at 571-272-7727.

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

5-6-09
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,410	10/27/2008	6225547	2202A/528	3077

38834 7590 07/14/2009

WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP
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WASHINGTON, DC 20036

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 07/14/2009

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

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Date: JUL 1 4 2009

CENTRAL REEXAMINATION UNIT

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
BROMBERG & SUNTEIN LLP
TIMOTHY M. MURPHY, ESQ., JOHN J. STICKEVERS, ESQ.,
125 SUMMER STREET
BOSTON, MA 02110-1618

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000410
PATENT NO. : 6225547
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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WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP (For Patent Owner)
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MAILED
JUL 14 2009
CENTRAL REEXAMINATION UNIT

BROMBERG & SUNSTEIN LLP (For 95/000,410 Requester)
125 SUMMER STREET
BOSTON, MA 02110-1618

Inter Partes Reexamination Proceeding
Control No. 95/000,410
Filed: October 27, 2008
For: U.S. Patent No. 6,225,547

In re reissue application of
Toyama et al.
Application No. 11/535,462
Filed: September 26, 2006
For: U.S. Patent No. 6,225,547

In re reissue application of
Toyama et al.
Application No. 11/754,562
Filed: May 29, 2007
For: U.S. Patent No. 6,225,547

In re reissue application of
Toyama et al.
Application No. 11/754,580
Filed: May 29, 2007
For: U.S. Patent No. 6,225,547

DECISION GRANTING PETITION UNDER 37 CFR 1.182 TO STAY REISSUE PROCEEDINGS

This is a decision on the April 6, 2009 patent owner petition entitled "Petition Under 37 C.F.R. § 1.182 To Stay Examination Of Reissue Application 11/535,462 And To Keep Separate And Stay Reissue Continuation Applications 11/754,562 And 11/754,580," filed in *inter partes* Reexamination Control No. 95/000,410.

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

The petition is granted.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,225,547 (the '547 patent) issued to Toyama et al. on May 1, 2001.

2. On September 26, 2006, the patent owner filed a reissue application based on the '547 patent, which application was assigned application No. 11/535,462 (the '462 reissue application).

3. On May 29, 2007, the patent owner filed two continuation applications of reissue application No. 11/535,462, which were assigned application Nos. 11/754,562 and 11/754,580.

4. On July 30, 2007, a petition under 37 CFR 1.182 was filed in '562 application requesting that the '562 continuation application be converted to a reissue continuation application and a petition under 37 CFR 1.182 was filed in the '580 application requesting that the '580 continuation application be converted to a reissue continuation application.

5. A request for *inter partes* reexamination of claims 1-24 of the '547 patent was filed on October 27, 2008, by a third party requester, and the request was assigned control number 95/000,410 (the '410 *inter partes* proceeding).

6. On January 15, 2009, the Office mailed: (1) a decision dismissing the July 30, 2007 petition to convert the '562 continuation application to a reissue continuation application, and (2) a decision dismissing the July 30, 2007 petition to convert the '580 continuation application to a reissue continuation application.

7. On January 16, 2009, *inter partes* reexamination was ordered in the '410 *inter partes* proceeding for claims 1-24 of the '547 patent, based on the examiner's determination that the October 27, 2008 request raised a substantial new question of patentability affecting these claims.

8. On January 23, 2009, a merger petition was filed in the '410 *inter partes* proceeding by the third party requester.

9. On March 12, 2009, the patent owner filed a renewed petition under 37 CFR 1.182 in the '562 continuation application requesting that the '562 continuation application be converted to a reissue continuation application, and a renewed petition under 37 CFR 1.182 in the '580 continuation application requesting that the '580 continuation application be converted to a reissue continuation application.

10. On April 6, 2009, the patent owner filed the instant petition under 37 CFR 1.182 in the '410 *inter partes* proceeding, requesting that the examination of the reissue applications be stayed instead of merging with the '410 *inter partes* proceeding.

11. On April 15, 2009, the third party requester filed an opposition to the patent owner's April 6, 2009 petition.

12. On April 28, 2009, the patent owner filed an opposition to the third party requester's January 23, 2009 merger petition.

13. On April 28, 2009, the Office mailed a decision granting the March 12, 2009 petition in the '580 application.

14. On July 1, 2009, a corrected decision on the March 12, 2009 petition was mailed in the '580 application stating that the '580 application will be reprocessed as a reissue continuation of reissue application No. 11/535, 462. The Office also mailed a decision granting the March 12, 2009 petition in the '562 application stating that the '562 application will be reprocessed as a reissue continuation of reissue application No. 11/535,462.

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 1.937 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 third party requester. If such issues are raised, merger would ordinarily **not** be ordered, and one of the two proceedings stayed. Consideration will also be given to the status of the reissue application examination at the time the order to reexamine the patent pursuant to 37 CFR 1.931 is mailed.

II. DISCUSSION

Pursuant to 37 CFR 1.183, the Office is *sua sponte* waiving the requirement of 37 CFR 1.939(b) that no paper shall be filed prior to the initial Office action on the merits of the *inter partes* proceeding in order to, in this decision, consider on the merits the April 6, 2009 patent owner petition to stay.

As evidenced by the above review of facts, '462 reissue application, the '562 reissue application, the '580 reissue application, and the '410 *inter partes* reexamination proceeding are currently pending. All of the proceedings are in their early stages of prosecution. In the instant petition, patent owner requests that examination of the '462 reissue application be stayed during the examination of the '410 *inter partes* reexamination proceeding, and that the '562 and '580 reissue applications also be kept separate from the '410 *inter partes* reexamination proceeding and stayed. Patent owner states that each of the reissue applications include different sets of new claims that raise issues that would not be proper for consideration in the reexamination proceeding and/or would not be proper for comment by the third party requester.

The decision to merge, or not to merge, is made on a case-by-case basis. The grant or refusal of merger of reissue and *inter partes* reexamination proceedings under 37 CFR 1.991 is **discretionary**, [1] 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.

Based on the above, action in each of the reissue applications is hereby **suspended** in favor of the reexamination proceeding. The suspensions of the reissue applications shall remain in effect until the conclusion of the '410 *inter partes* reexamination proceeding by the issuance of a reexamination certificate. The '410 *inter partes* reexamination proceeding will continue with special dispatch.

---

[1] See MPEP § 2686.03(II), "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."

CONCLUSION

1. The petition is granted.

2. Action in each of the reissue application Nos. 11/535,462, 11/754,562, and 11/754,580 is **suspended** until completion of the *inter partes* reexamination proceeding Control No. 95/000,410 by the issuance of the reexamination certificate.

3. After the reexamination certificate for the '410 reexamination proceeding has issued, an Office action will be mailed for each of the reissue applications.

4. At the time that a reexamination certificate is issued for the '410 reexamination proceeding, the patent owner is advised to call the issuance of the certificate to the attention of the Office in each of the three reissue applications, and to request a resumption of examination of the reissue applications. At that time, the patent owner may include an amendment of the reissue application claims in each reissue application, if such is deemed appropriate based on the results of the reexamination proceeding.

5. Jurisdiction over the reexamination proceeding is being returned to the Central Reexamination Unit (CRU) for the preparation of an Office action to be issued in due course.

6. Jurisdiction over reissue application Nos. 11/535,462, 11/754,562, and 11/754,580 is being returned to the Technology Center having responsibility for the applications.

7. 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

7-13-09

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,411	11/06/2008	6,597,854	065484-0008B	4667

23552 7590 12/29/2009

MERCHANT & GOULD PC
P.O. BOX 2903
MINNEAPOLIS, MN 55402-0903

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/29/2009

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DYKEMA GOSSETT PLLC
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CHICAGO, IL 60606

Date:
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DEC 29 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000411
PATENT NO. : 6597854
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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MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS MN 55402-0903	: : :	(For Patent Owner)

MAILED

DEC 29 2009

CENTRAL REEXAMINATION UNIT

DYKEMA GOSSETT PLLC 10 S. WACKER DR., STE. 2300 CHICAGO, IL 60606	: : :	(For Third Party Requester)

	:	CORRECTED
In re: Haataja *et alia*	:	DECISION
Inter Partes Reexamination Proceeding	:	DISMISSING
Control No. 95/000,411	:	PETITION FOR EXTENSION
Deposited on: 06 November 2008	:	OF TIME
For: US Patent No. 6,597,854	:	[37 CFR § 1.956 and § 1.181]

This is a corrected decision on the 21 December 2009, "Petition for Extension of Time Under 37 CFR 1.956" requesting that the time for responding to the Right of Appeal Notice mailed 04 December 2009, be extended by one (1) month. The petition was timely filed with certificate of service. This decision corrects the decision mailed 22 December 2009.

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

The petition is dismissed for the reasons set forth below.

Discussion

The Patent Owner's representative requests the period of time be extended in which to file a response to the Right of Appeal Notice mailed 04 December 2009, which set a one (1) month time for filing a response thereto. The petition for extension of time was timely filed on 21 December 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 petition is dismissed for the reasons set forth below.

> **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.

37 CFR § 41.61 Notice of appeal and cross appeal to Board. (in-part)

(e) The time periods for filing a notice of appeal or cross appeal may not be extended. (emphasis added)

Decision

The patent owner's representative petitions under 37 CFR § 1.956 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.

Pursuant to 37 CFR 41.61(e) [t]he time periods for filing a notice of appeal or cross appeal may not be extended.

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

CONCLUSION

1. The patent owner's petition for extension for time in which to file a response to the Right of Appeal Notice dated 04 December 2009 is hereby **dismissed.**

2. This decision corrects the decision mailed 22 December 2009.

3. The Patent Owner's response is due **04 January 2010.**

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

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

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

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

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

reexamination proceeding, which offers parties the opportunity to review the content of their submissions after the "soft scanning" process is complete.

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

/Mark Reinhart/

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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(For Patent Owner)

MAILED
MAY 24 2010
CENTRAL REEXAMINATION UNIT

Oliff & Berridge, PLC
PO BOX 320850
Alexandria, VA 22320-4850

(For Third Party Requestor)

In re Haataja, et al.
Inter Partes Reexamination Proceeding
Control No. 95/000,411
Filed: Nov. 6, 2008
For: U.S. Patent No. 6,597,854

: **DECISION DISMISSING**
: **PETITIONS TO WAIVE PAGE**
: **LIMIT FOR BRIEFS**
: **AND RETURNING BRIEFS**
: **AS IMPROPER**

This is a decision on the following petitions requesting waiver of 37 CFR 1.943(c):

(1) Petition filed March 4, 2010 by third party requestor entitled "MISCELLANEOUS PETITION UNDER 37 CFR § 1.183".

(2) Petition filed April 5, 2010 by third party requestor entitled "MISCELLANEOUS PETITION UNDER 37 CFR § 1.183".

(3) Petition filed April 8, 2010, by patent owner entitled "PETITION UNDER 37 CFR § 1.183".

The proceeding, the third party requestor's petitions, and the patent owner's petition are before the Office of Patent Legal Administration.

The petition fee of $400.00 pursuant to 37 CFR 1.17(f) for each of the petitions under 37 CFR 1.183 has been received.

SUMMARY

(1) The third party requester's March 4, 2010 petition requesting waiver of its appellant brief page limit restrictions under 37 CFR 1.943(c) is dismissed as the situation has not been shown to be extraordinary as explained below. The brief filed March 4, 2010 is expunged as improper, since it does not comply with 37 CFR 1.943(c). Third party requestor's brief shall not exceed 30

pages (thirty) pages. Third party requester appellant is given 15 days from the date of this decision to file a corrected or redacted brief that does not exceed 30 pages. [1]

(2) The third party requester's April 5, 2010 petition requesting waiver of its respondent brief page limit restrictions under 37 CFR 1.943(c) is dismissed as the situation has not been shown to be extraordinary as explained below. The respondent brief filed April 5, 2010 is expunged as improper, since it does not comply with 37 CFR 1.943(c). Third party requestor's respondent brief shall not exceed 15 pages (fifteen) pages. Third party requester is given 15 days from the date of this decision to file a corrected or redacted respondent brief that does not exceed 15 pages.

(3) The patent owner's April 8, 2010 petition requesting waiver of its respondent brief page limit restrictions under 37 CFR 1.943(c) is dismissed as the situation has not been shown to be extraordinary as explained below. The respondent brief filed April 8, 2010 is expunged as improper, since it does not comply with 37 CFR 1.943(c). Patent owner's respondent brief shall not exceed 15 pages (fifteen) pages. Patent owner may file a corrected or redacted respondent brief that does not exceed 15 pages in response to third party requester's appellant brief once filed, within one month from the date of service of the appellant brief.

REVIEW OF THE RELEVANT FACTS

1. On July 22, 2003, U.S. Patent No. 6,597,854 ('the '854 patent) issued with sixty-seven claims to Haataja *et al.* and is assigned on its face to ADC Telecommunications, Inc.

2. On November 6, 2008, a request for *inter partes* reexamination of claims 1-67 of the '854 patent was submitted by a third party requester, Panduit Corp., which request was assigned control number 95/000,411 ("the '411 proceeding").

3. On January 12, 2009, an Order was granted for *inter partes* reexamination of claims 1-67 of the '854 patent in the '411 proceeding.

4. The '411 proceeding then progressed to the point where, on December 14, 2009, a Right of Appeal Notice (RAN) was mailed in the '411 proceeding.

5. On January 4, 2010, patent owner filed a Notice of Appeal for claims 1, 22-32, 34-44, 51-53, and 74-77.

6. On January 4, 2010, third party requestor filed a Notice of Appeal for claims 2-21, 54-73, 78 and 79.

7. On March 4, 2010, third party requestor filed an appellant brief, along with a petition under 37 CFR 1.183 requesting waiver of the page limit requirements of 37 CFR 1.943(c).

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

8. On March 8, 2010, patent owner filed an appellant brief.

9. On April 5, 2010, third party requester filed a respondent's brief, along with a petition under 37 CFR 1.183 requesting waiver of page limit requirements of 37 CFR 1.943(c).

10. On April 8, 2010, patent owner filed a respondent's brief, along with a petition under 37 CFR 1.183 requesting waiver of the page limit requirements of 37 CFR 1.943(c).

RELEVANT AUTHORITY

37 CFR 1.183 provides:

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

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

MPEP § 2667 I.B.2 (Response filed by Third Party Requester that is too long) provides:

For additional information with respect to the length of papers, see Subsection I.A.2 above.

37 CFR 41.67. Appellant's brief (selected sections) provides:

...(c)(1) The appellant's brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(i) through (c)(1)(xi) of this section.

...

(ix) Evidence appendix. An appendix containing copies of any evidence submitted pursuant to § § 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See § 41.63 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner in any ground of rejection to be reviewed on appeal.

(x) Related proceedings appendix. An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section.

...

(d) If a brief is filed which does not comply with all the requirements of paragraph (a) and paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and given a non-extendable time period within which to file an amended brief. If appellant does not file an amended brief within the set time period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, that appellant's appeal will stand dismissed.

37 CFR 41.68. Respondent's brief (selected sections) provides:

...(b)(1) The respondent brief shall contain the following items under appropriate headings and in the order here indicated, and may include an appendix containing only those portions of the record on which reliance has been made.

...

(viii) Evidence appendix. An appendix containing copies of any evidence submitted pursuant to § § 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by respondent in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the respondent 's brief. See § 41.63 for treatment of evidence submitted after appeal.

(ix) Related proceedings appendix. An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (b)(1)(ii) of this section.

...

(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.

DECISION

I. Third Party Requester Petition of March 4, 2010

The third party requester requests waiver of 37 CFR 1.943(c), which limits third party requestor's appellant brief to thirty (30) pages or 14,000 words in length. The third party requester states that the brief as filed is 115 pages and approximately 39,000 words. It is noted, as explained below, that the filed brief includes 111 pages that count toward the page limit.

Waiver is requested for the following reasons, which, according to the third party requester, present an extraordinary situation:

(1) The formal requirements of 37 CFR 41.67(c)(1)(i)-(iv) consume 12 pages of the brief leaving only 18 pages for argument.
(2) There are 80 claims at issue, including nine independent.
(3) Seven separate rejections that were not adopted are being appealed, and five of the original twelve rejections have been abandoned to reduce the length of the brief.
(4) Under 37 CFR 41.67(c)(1)(vii), arguments not included in the appellant brief will not be considered by the Board, while each claim must be argued separately under a separate heading.
(5) The third party requester is unable to address each of the claims separately for each of the proposed seven rejections and remain within 18 pages.

II. Third Party Requester Petition of April 5, 2010

The third party requester requests waiver of 37 CFR 1.943(c), which limits third party requestor's respondent brief to fifteen (15) pages or 7,000 words in length. The third party requester states that the brief as filed is 35 pages and approximately 10,750 words. It is noted, as explained below, that the filed brief includes 31 pages that count toward the page limit.

Waiver is requested for the following reasons,[2] which, according to the third party requester, present an extraordinary situation:
(1) The formal requirements of 37 CFR 41.68(b)(1)(i)-(vi) consume 6 pages of the brief leaving only 9 pages for argument.
(2) There are 80 claims at issue, including nine independent.
(3) Patent owner is appealing four separate rejections that were adopted by the examiner and each disputed issue must be disputed under a separate heading.
(4) The third party requester is unable to address each of the issues raised by the patent owner and remain within 9 pages.

III. Patent Owner Petition of April 8, 2010

The patent owner requests waiver of 37 CFR 1.943(c), which limits the respondent brief to fifteen (15) pages or 7,000 words in length. The patent owner states that the brief as filed is 78 pages and approximately 26,000 words. It is noted, as explained below, that the filed brief includes 71 pages that count toward the page limit.

Waiver is requested for the following reasons, which, according to the patent owner, present an extraordinary situation:
(1) Patent owner is unable to respond to each of the issues raised in the third party requester's appellant brief, which is 115 pages in length.
(2) Should waiver be granted to increase the length of third party requester's appellant brief, waiver of the length of the corresponding respondent brief should be granted to avoid prejudice to the patent owner.

[2] The petition lists only 4 reasons although they are numbered (1), (2), (3), and (5).

IV. Analysis and findings

Determining Page Length

As noted in MPEP 2667(I)(A)(2), 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 of the appellant brief or 15 page limit of the respondent brief. Additionally, by its terms, 37 CFR 1.943(c) excludes from the count of the pages in an appellant's brief claim appendices and "reference materials such as prior art references." The sections of the appellant's briefs required under 37 CFR 41.67(c)(1)(i)-(iv) and (ix)-(xi)[3] are deemed to be included in "reference materials" that do not count toward the page limits. However, if any portion of the relevant section includes material that goes beyond that which is required by those sections, then the entire section will be counted toward the page total. Partial pages are tallied as whole pages for this purpose.

Prosecution History Does Not Present An Extraordinary Situation

Upon review of the prosecution history of this proceeding, it is noted that the patent owner and third party requester responses and comments prior to appeal have been well within the page limit requirements. Reviewing the substantive pages of argument in this proceeding, it is found that the request for reexamination for 67 claims was 93 pages, the order for reexamination was 10 pages, the first Office action was 15 pages, the action closing prosecution (after the additional 13 claims were added) was 27 pages, and the right of appeal notice was 16 pages.

However, with the notable exception of the patent owner's appellant brief that is within the limit and includes 13,982 words (40 pages), the briefs filed subsequent to appeal have been significantly longer, while the rules require that the appellant brief and respondent brief be more limited than pre-appeal responses. Third party requester's appellant brief filed on March 4, 2010 has a length of 111 pages that count toward the limit of 30 pages. Third party requester's respondent brief filed April 5, 2010 has a length of 31 pages that count toward the limit of 15 pages. Patent owner's respondent brief filed April 8, 2010 has a length of 71 pages that count toward the limit of 15 pages.

The reasons provided in support of waiving the page/word limits, detailed above, essentially relate to the number of claims and rejections/issues raised during prosecution. Yet, prior to appeal the claims and rejections/issues were adequately addressed in significantly fewer pages than in the appellant and respondent briefs. No reason why an increase in pages is now warranted has been provided, and certainly no extraordinary situation has been shown to exist. Third party requester also requests additional pages based on an inaccurate interpretation of the rule. As explained above and in the MPEP, the portions of the brief including sections (i) to (iv) are not counted against the page limit.

---

[3] *i.e.*, (i) *Real Party in Interest*; (ii) *Related Appeals and Interferences*, (iii) *Status of Claims*, (iv) *Status of Amendments*, (ix) *Evidence Appendix*, (x) *Related Proceedings Appendix, and* (xi) *Certificate of Service.* The Claims Appendix is already explicitly included in the rule.

Neither petitioner has made of showing of any efforts made to reduce the number of pages or words, by for example referring back to prior arguments, consolidating issues or eliminating unnecessary portions of the argument. The page limits are intentionally designed to focus the issues and require a concise presentation of arguments. For example, it is not necessary or desirable to reproduce claim charts in the brief that were originally presented in the request for reexamination, as third party requester has in the appeal brief. Based on the facts of this proceeding, it is apparent that measures that could have been taken to reduce the pages/words in order to comply with the limits were not taken.

A persuasive showing has not been made that this situation is extraordinary such that significantly more pages be allotted compared to prior responses and actions issued by the Office.

Petitions Requesting Waiver of 37 CFR 1.943(c) are DISMISSED

The instant petitions under 37 CFR 1.183 have 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.

As noted above, neither petitioner has made a showing that an extraordinary situation exists that would require a waiver of the requirements of 37 CFR 1.943(c) in the interest of justice.

Improper Content in the Appendices in the Briefs

The Evidence appendices required in 37 CFR 41.67(c)(1)(ix) and 37 CFR 41.68(b)(1)(viii) should only include evidence that has been entered in the record pursuant to 37 CFR 1.130, 1.131, or 1.132, other similar evidence, or evidence relied upon by the examiner in a ground of rejection (appellant brief) or evidence entered by the examiner and relied upon by the respondent in the appeal (respondent brief). The appendix must include a statement where the evidence was entered into the record. The evidence appendix is not to include copies of the patent under reexamination, copies of Office actions in related cases or copies of prior art references. To the extent that such items are submitted, any arguments that go to a rejection or patentability of the claims will be counted against the page limits.

The Related Proceedings appendices required by 37 CFR 41.67(c)(1)(x) and 37 CFR 41.68(b)(1)(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 submitted (such as Office actions, requests for reexamination, etc.) may be counted toward the page limit of the brief. The related proceedings appendix is not to include copies of Office actions from related proceedings within the Office that have not risen to the Board. To the extent that such items are submitted, any arguments that go to a rejection or patentability of the claims will be counted against the page limits.

The patent owner improperly included items in the evidence appendix that go beyond evidence that was entered into the record in accordance with the rules. These items may be counted toward the page limit if resubmitted. The third party requester also improperly included items in the related proceedings appendix that go beyond copies of court and board papers. These items may be counted toward the page limit if resubmitted. The third party requester also included items that are not specifically listed in the related proceedings appendix and are not proper submissions; see for example "Defendant's Memorandum" dated November 7, 2008. As this paper is not a decision rendered by a court and presents arguments made by the third party requester, it will be counted toward the page limit.

Related copending proceedings are more appropriately identified prior to appeal in a notification of prior or concurrent proceedings in *inter partes* reexamination in accordance with 37 CFR 1.985. It is noted that notification of these copending proceedings has not been properly made of record in this proceeding.

Prior art references should be identified and made of record through a listing of patents and printed publications as provided for in 37 CFR 1.98. See MPEP 2657. It is not necessary or desirable to file duplicate copies of references and Office actions with the brief.

Improper Papers 'Expunged'

The third party requester appellant brief, the third party requester respondent brief, and the patent owner respondent brief exceed the page limit and are therefore improper papers. These papers including all of the appendices and attachments will not be entered in this proceeding. As the papers have already been scanned into the image file wrapper (IFW), they are being expunged from the record by closing the documents in the IFW and marking them as 'non-public'. They will not be available to the public or considered as part of the file wrapper.

CONCLUSION

1. The third party requester petition filed March 4, 2010 under 37 CFR 1.183 to waive the provisions of 37 CFR 1.943(c) for the appellant brief is dismissed. The appellant brief filed March 4, 2010 is expunged from IFW by closing it in the IFW and marking it as non-public. Third party requester has 15 days from the date of this decision to file a compliant appellant brief. The time for filing an appellant brief may not be extended.

2. The third party requester petition filed April 5, 2010 under 37 CFR 1.183 to waive the provisions of 37 CFR 1.943(c) for the respondent brief is dismissed. The respondent brief filed April 5, 2010 is expunged from IFW by closing it in the IFW and marking it as non-public. Third party requester has 15 days from the date of this decision to file a compliant respondent brief. The time for filing a respondent's brief may not be extended.

3. The patent owner petition filed April 8, 2010 under 37 CFR 1.183 to waive the provisions of 37 CFR 1.943(c) for the respondent brief is dismissed. The respondent brief filed April 8, 2010 is expunged from IFW by closing it in the IFW and marking it as non-public. Patent

owner has one month from the date of service of third party requester's appellant brief to file a compliant respondent brief. The time for filing a respondent's brief may not be extended.

4. Jurisdiction over the '411 reexamination proceeding is hereby returned to the Central Reexamination Unit.

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

5-24-2010

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,412	11/06/2008	6,868,220	065484-0014	8084

23552 7590 12/29/2009
MERCHANT & GOULD PC
P.O. BOX 2903
MINNEAPOLIS, MN 55402-0903

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/29/2009

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

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Date:

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DEC 29 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000412
PATENT NO. : 6868220
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
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MERCHANT & GOULD PC : (For Patent Owner)
P.O. BOX 2903 :
MINNEAPOLIS MN 55402-0903 :

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CENTRAL REEXAMINATION UNIT

DYKEMA GOSSETT PLLC : (For Third Party Requester)
10 S. WACKER DR., STE. 2300 :
CHICAGO, IL 60606 :

	:	CORRECTED
In re: Haataja *et alia*	:	DECISION
Inter Partes Reexamination Proceeding	:	DISMISSING
Control No. 95/000,412	:	PETITION FOR EXTENSION
Deposited on: 06 November 2008	:	OF TIME
For: US Patent No. 6,868,220	:	[37 CFR § 1.956 and § 1.181]

This is a corrected decision on the 21 December 2009, "Petition for Extension of Time Under 37 CFR 1.956" requesting that the time for responding to the Right of Appeal Notice mailed 04 December 2009, be extended by one (1) month. The petition was timely filed with certificate of service. This decision corrects the decision mailed 22 December 2009.

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

The petition is dismissed for the reasons set forth below.

Discussion

The Patent Owner's representative requests the period of time be extended in which to file a response to the Right of Appeal Notice mailed 04 December 2009, which set a one (1) month time for filing a response thereto. The petition for extension of time was timely filed on 21 December 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 petition is dismissed for the reasons set forth below.

> **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.

37 CFR § 41.61 Notice of appeal and cross appeal to Board. (in-part)

(e) The time periods for filing a notice of appeal or cross appeal may not be extended. (emphasis added)

Decision

The patent owner's representative petitions under 37 CFR § 1.956 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.

Pursuant to 37 CFR 41.61(e) [t]he time periods for filing a notice of appeal or cross appeal may not be extended.

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

CONCLUSION

1. The patent owner's petition for extension for time in which to file a response to the Right of Appeal Notice dated 04 December 2009 is hereby **dismissed.**

2. This decision corrects the decision mailed 22 December 2009.

3. The Patent Owner's response is due **04 January 2010.**

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

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

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

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

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

reexamination proceeding, which offers parties the opportunity to review the content of their submissions after the "soft scanning" process is complete.

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

/Mark Reinhart/

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

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
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(For Patent Owner)

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MAY 24 2010

CENTRAL REEXAMINATION UNIT

Oliff & Berridge, PLC
PO BOX 320850
Alexandria, VA 22320-4850

(For Third Party Requestor)

In re Haataja, et al.
Inter Partes Reexamination Proceeding
Control No. 95/000,412
Filed: Nov. 6, 2008
For: U.S. Patent No. 6,868,220

: **DECISION DISMISSING**
: **PETITIONS TO WAIVE PAGE**
: **LIMIT FOR BRIEFS**
: **AND RETURNING BRIEFS**
: **AS IMPROPER**

This is a decision on the following petitions requesting waiver of 37 CFR 1.943(c):

(1) Petition filed April 19, 2010 by third party requestor entitled "MISCELLANEOUS PETITION UNDER 37 CFR § 1.183".

(2) Petition filed April 21, 2010, by patent owner entitled "PETITION UNDER 37 CFR § 1.183".

The proceeding, the third party requestor's petition, and the patent owner's petition are before the Office of Patent Legal Administration.

The petition fee of $400.00 pursuant to 37 CFR 1.17(f) for each of the petitions under 37 CFR 1.183 has been received.

SUMMARY

(1) The third party requester's April 19, 2010 petition requesting waiver of its respondent brief page limit restrictions under 37 CFR 1.943(c) is dismissed as the situation has not been shown to be extraordinary as explained below. The respondent brief filed April 19, 2010 is expunged as improper, since it does not comply with 37 CFR 1.943(c). Third party requestor's respondent brief shall not exceed 15 pages (fifteen) pages. Third party requester appellant is given 15 days

from the date of this decision to file a corrected or redacted respondent brief that does not exceed 15 pages. [1]

(2) The patent owner's April 21, 2010 petition requesting waiver of its respondent brief page limit restrictions under 37 CFR 1.943(c) is dismissed as the situation has not been shown to be extraordinary as explained below. The respondent brief filed April 21, 2010 is expunged as improper as it does not comply with 37 CFR 1.943(c). Patent owner's respondent brief shall not exceed 15 pages (fifteen) pages. Patent owner is given 15 days from the date of this decision to file a corrected or redacted respondent brief that does not exceed 15 pages.

REVIEW OF THE RELEVANT FACTS

1. On March 15, 2005, U.S. Patent No. 6,868,220 ('the '220 patent) issued with sixteen claims to Haataja *et al.* and is assigned on its face to ADC Telecommunications, Inc.

2. On November 6, 2008, a request for *inter partes* reexamination of claims 1-16 of the '220 patent was submitted by a third party requester, Panduit Corp., which request was assigned control number 95/000,412 ("the '412 proceeding").

3. On January 12, 2009, an Order was granted for *inter partes* reexamination of claims 1-16 of the '220 patent in the '412 proceeding.

4. The '412 proceeding then progressed to the point where, on December 4, 2009, a Right of Appeal Notice (RAN) was mailed in the '412 proceeding.

5. On January 4, 2010, patent owner filed a Notice of Appeal for claims 1-10, 12-16, 18-21, 23, and 26.

6. On January 19, 2010, third party requester filed a Notice of Cross Appeal for claims 11, 17, 22, 24, and 25.

7. On March 19, 2010, third party requester filed an appellant brief.

8. On March 22, 2010, patent owner filed an appellant brief.

9. On April 19, 2010, third party requester filed a respondent's brief, along with a petition under 37 CFR 1.183 requesting waiver of page limit requirements of 37 CFR 1.943(c).

10. On April 21, 2010, patent owner filed a respondent's brief, along with a petition under 37 CFR 1.183 requesting waiver of the page limit requirements of 37 CFR 1.943(c).

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

RELEVANT AUTHORITY

37 CFR 1.183 provides:

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

37 CFR 1.943(c) provides:

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

MPEP § 2667 I.A.2 (Response filed by Patent Owner that is too long) 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). Any affidavit or declaration (or a clearly defined portion thereof) that contains opinion(s) of the affiant/declarant, or argument(s) that the art either does or does not anticipate or render obvious the claims, or specific claim elements, of the patent under reexamination, is considered to be part of the comments submitted by the patent owner, or by the third party requester, and is subject to the page limit requirements of 37 CFR 1.943. Affidavits or declarations that are excluded from the page limit requirements include, for example, declarations attempting to swear behind (antedate) the filing date of a reference, or to establish the date of a printed publication, or declarations that provide comparative test data and an analysis of same. However, if the patent owner's affidavit or declaration includes any argument as to how an outstanding/proposed rejection is overcome, then the page(s) of the affidavit or declaration upon which the argument appears would be included against of the page limit count. Likewise, if a third party requester affidavit or declaration includes any argument as to how a rejection is supported, then the page(s) of the affidavit or declaration upon which the argument appears would be included against of the page limit count. Similarly, attached exhibits presenting data or drawings are not included against the page limit count, unless an exhibit or drawing includes argument as to how the outstanding rejection is overcome. Any page(s) of the exhibit or sheet(s) of drawings that include such argument would be included against the page limit count.

MPEP § 2667 I.B.2 (Response filed by Third Party Requester that is too long) provides:

For additional information with respect to the length of papers, see Subsection I.A.2 above.

37 CFR 41.67. Appellant's brief (selected sections) provides:

...(c)(1) The appellant's brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(i) through (c)(1)(xi) of this section.

...

(ix) Evidence appendix. An appendix containing copies of any evidence submitted pursuant to § § 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See § 41.63 for treatment of

evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner in any ground of rejection to be reviewed on appeal.
(x) Related proceedings appendix. An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section.
...
(d) If a brief is filed which does not comply with all the requirements of paragraph (a) and paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and given a non-extendable time period within which to file an amended brief. If appellant does not file an amended brief within the set time period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, that appellant's appeal will stand dismissed.

37 CFR 41.68. Respondent's brief (selected sections) provides:

...(b)(1) The respondent brief shall contain the following items under appropriate headings and in the order here indicated, and may include an appendix containing only those portions of the record on which reliance has been made.
...
(viii) Evidence appendix. An appendix containing copies of any evidence submitted pursuant to § § 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by respondent in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the respondent 's brief. See § 41.63 for treatment of evidence submitted after appeal.
(ix) Related proceedings appendix. An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (b)(1)(ii) of this section.
...
(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.

DECISION

I. Third Party Requester Petition of April 19, 2010

The third party requester requests waiver of 37 CFR 1.943(c), which limits third party requestor's respondent brief to fifteen (15) pages or 7,000 words in length. The third party requester states that the brief as filed is 32 pages and approximately 9,400 words. It is noted, as explained below, that the filed brief includes 28 pages that count toward the page limit.

Waiver is requested for the following reasons,[2] which, according to the third party requester, present an extraordinary situation:
(1) The formal requirements of 37 CFR 41.68(b)(1)(i)-(vi) consume 6 pages of the brief leaving only 9 pages for argument.
(2) There are 25 claims at issue.
(3) Patent owner is appealing four separate rejections that were adopted by the examiner and each disputed issue must be disputed under a separate heading.

[2] The petition lists only 4 reasons although they are numbered (1), (2), (3), and (5).

(4) The third party requester is unable to address each of the issues raised by the patent owner and remain within 9 pages.

II. Patent Owner Petition of April 21, 2010

The patent owner requests waiver of 37 CFR 1.943(c), which limits the respondent brief to fifteen (15) pages or 7,000 words in length. The patent owner states that the brief as filed is 36 pages and approximately 11,480 words. It is noted, as explained below, that the filed brief includes 32 pages that count toward the page limit.

Waiver is requested for the following reasons, which, according to the patent owner, present an extraordinary situation:
(1) Patent owner is unable to respond to each of the four issues raised in the third party requester's appellant brief.
(2) The formal requirements of the brief consume 6 pages, which leaves only 9 pages for argument.
(2) Should waiver be granted to increase the length of third party requester's appellant brief, waiver of the length of the corresponding respondent brief should be granted to avoid prejudice to the patent owner.

III. Analysis and findings

Determining Page Length

As noted in MPEP 2667(I)(A)(2), 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 of the appeal brief or 15 page limit of the respondent brief. Additionally, by its terms, 37 CFR 1.943(c) excludes from the count of the pages in an appellant's brief claim appendices and "reference materials such as prior art references." The sections of the appellant's briefs required under 37 CFR 41.67(c)(1)(i)-(iv) and (ix)-(xi)[3] are deemed to be included in "reference materials" that do not count toward the page limits. However, if any portion of the relevant section includes material that goes beyond that which is required by those sections, then the entire section will be counted toward the page total. Partial pages are tallied as whole pages for this purpose.

Prosecution History Does Not Present An Extraordinary Situation

Upon review of the prosecution history of this proceeding, it is noted that the patent owner and third party requester responses and comments prior to appeal have been well within the page limit requirements. Reviewing the substantive pages of argument in this proceeding, it is found that the request for reexamination for sixteen claims was 35 pages, the order for reexamination was 9 pages, the first Office action was 12 pages, the action closing prosecution (after the additional 10 claims were added) was 20 pages, and the right of appeal notice was 14 pages.

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[3] *i.e.*, (i) *Real Party in Interest*; (ii) *Related Appeals and Interferences*, (iii) *Status of Claims*, (iv) *Status of Amendments*, (ix) *Evidence Appendix*, (x) *Related Proceedings Appendix, and* (xi) *Certificate of Service.* The Claims Appendix is already explicitly included in the rule.

However, with the notable exceptions of both the patent owner's appellant brief that is within the limit and includes 12,107 words (35 pages) and the third party requester's appellant brief that is within the limit and includes 13,311 words (43 pages), the respondent briefs have been longer, while the rules require that the appellant brief and respondent brief be more limited than pre-appeal responses. Third party requester's respondent brief filed April 19, 2010 has a length of 28 pages that count toward the limit of 15 pages. Patent owner's respondent brief filed April 21, 2010 has a length of 32 pages that count toward the limit of 15 pages.

The reasons provided in support of waiving the page/word limits, detailed above, essentially relate to the number of claims and rejections/issues raised during prosecution. Yet, prior to appeal the claims and rejections/issues were adequately addressed in significantly fewer pages than in the respondent briefs. No reason why an increase in pages is now warranted has been provided, and certainly no extraordinary situation has been shown to exist. Third party requester and patent owner also request additional pages based on an inaccurate interpretation of the rule. As explained above and in the MPEP, the portions of the brief including sections (i) to (iv) are not counted against the page limit.

Neither petitioner has made of showing of any efforts made to reduce the number of pages or words, by for example referring back to prior arguments, consolidating issues or eliminating unnecessary portions of the argument. The page limits are intentionally designed to focus the issues and require a concise presentation of arguments. Based on the facts of this proceeding, it is apparent that measures that could have been taken to reduce the pages/words in order to comply with the limits were not taken.

A persuasive showing has not been made that this situation is extraordinary such that significantly more pages be allotted compared to prior responses, comments, and actions issued by the Office.

Petitions Requesting Waiver of 37 CFR 1.943(c) are DISMISSED

The instant petitions under 37 CFR 1.183 have 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.

As noted above, neither petitioner has made a showing that an extraordinary situation exists that would require a waiver of the requirements of 37 CFR 1.943(c) in the interest of justice.

Improper Content in the Appendices in the Briefs

The Evidence appendices required in 37 CFR 41.67(c)(1)(ix) and 37 CFR 41.68(b)(1)(viii) should only include evidence that has been entered in the record pursuant to 37 CFR 1.130, 1.131, or 1.132, other similar evidence, or evidence relied upon by the examiner in a ground of rejection (appellant brief) or evidence entered by the examiner and relied upon by the respondent in the appeal (respondent brief). The appendix must include a statement where the evidence was entered into the record. The evidence appendix is not to include copies of the

patent under reexamination, copies of Office actions in related cases or copies of prior art references. To the extent that such items are submitted, any arguments that go to a rejection or patentability of the claims will be counted against the page limits.

The Related Proceedings appendices required by 37 CFR 41.67(c)(1)(x) and 37 CFR 41.68(b)(1)(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 submitted (such as Office actions, requests for reexamination, etc.) may be counted toward the page limit of the brief. The related proceedings appendix is not to include copies of Office actions from related proceedings within the Office that have not risen to the Board. To the extent that such items are submitted, any arguments that go to a rejection or patentability of the claims will be counted against the page limits.

The patent owner improperly included items in the evidence appendix that go beyond evidence that was entered into the record in accordance with the rules. These items may be counted toward the page limit if resubmitted. The third party requester also improperly included items in the related proceedings appendix that go beyond copies of court and board papers. These items may be counted toward the page limit if resubmitted. The third party requester also included items that are not specifically listed in the related proceedings appendix and are not proper submissions; see for example "Defendant's Memorandum" dated November 7, 2008. As this paper is not a decision rendered by a court and presents arguments made by the third party requester, it will be counted toward the page limit.

Related copending proceedings are more appropriately identified prior to appeal in a notification of prior or concurrent proceedings in *inter partes* reexamination in accordance with 37 CFR 1.985. It is noted that notification of these copending proceedings has not been properly made of record in this proceeding.

Prior art references should be identified and made of record through a listing of patents and printed publications as provided for in 37 CFR 1.98. See MPEP 2657. It is not necessary or desirable to file duplicate copies of references and Office actions with the brief.

Improper Papers 'Expunged'

The third party requester respondent brief and the patent owner respondent brief exceed the page limit and are therefore improper papers. These papers including all of the appendices and attachments will not be entered in this proceeding. As the papers have already been scanned into the image file wrapper (IFW), they are being expunged from the record by closing the documents in the IFW and marking them as 'non-public'. They will not be available to the public or considered as part of the file wrapper.

CONCLUSION

1. The third party requester petition filed April 19, 2010 under 37 CFR 1.183 to waive the provisions of 37 CFR 1.943(c) for its respondent brief is dismissed. The respondent brief filed April 19, 2010 is being expunged from IFW by closing it in the IFW and marking it as non-public. Third party requester has 15 days from the date of this decision to file a compliant respondent brief. The time for filing a respondent's brief may not be extended.

2. The patent owner petition filed April 21, 2010 under 37 CFR 1.183 to waive the provisions of 37 CFR 1.943(c) for its respondent brief is dismissed. The respondent brief filed April 21, 2010 is being expunged from IFW by closing it in the IFW and marking it as non-public. Patent owner has 15 days from the date of this decision to file a compliant respondent brief. The time for filing a respondent's brief may not be extended.

3. Jurisdiction over the '412 reexamination proceeding is hereby returned to the Central Reexamination Unit.

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

5-24-2010

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,413	12/02/2008	7167625	065484-0016	9150

7590 12/29/2009

KAREN A.FITZSIMMONS
MERCHANT & GOULD P.C.
P.O. BOX 2903
MINNEAPOLIS, MN 55402-0903

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/29/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patents and Trademark Office
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SUITE 2300
CHICAGO, IL 60606

Date:
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DEC 29 2009
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000413
PATENT NO. : 7167625
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
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MERCHANT & GOULD PC : (For Patent Owner)
P.O. BOX 2903 :
MINNEAPOLIS MN 55402-0903 :

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CENTRAL REEXAMINATION UNIT

DYKEMA GOSSETT PLLC : (For Third Party Requester)
10 S. WACKER DR., STE. 2300 :
CHICAGO, IL 60606 :

	:	CORRECTED
In re: Haataja *et alia*	:	DECISION
Inter Partes Reexamination Proceeding	:	DISMISSING
Control No. 95/000,413	:	PETITION FOR EXTENSION
Deposited on: 06 November 2008	:	OF TIME
For: US Patent No. 7,167,625	:	[37 CFR § 1.956 and § 1.181]

This is a corrected decision on the 21 December 2009, "Petition for Extension of Time Under 37 CFR 1.956" requesting that the time for responding to the Right of Appeal Notice mailed 04 December 2009, be extended by one (1) month. The petition was timely filed with certificate of service. This decision corrects the decision mailed 22 December 2009.

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

The petition is dismissed for the reasons set forth below.

Discussion

The Patent Owner's representative requests the period of time be extended in which to file a response to the Right of Appeal Notice mailed 04 December 2009, which set a one (1) month time for filing a response thereto. The petition for extension of time was timely filed on 21 December 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 petition is dismissed for the reasons set forth below.

> **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.

37 CFR § 41.61 Notice of appeal and cross appeal to Board. (in-part)

(e) The time periods for filing a notice of appeal or cross appeal may not be extended. (emphasis added)

Decision

The patent owner's representative petitions under 37 CFR § 1.956 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.

Pursuant to 37 CFR 41.61(e) [t]he time periods for filing a notice of appeal or cross appeal may not be extended.

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

CONCLUSION

1. The patent owner's petition for extension for time in which to file a response to the Right of Appeal Notice dated 04 December 2009 is hereby **dismissed.**

2. This decision corrects the decision mailed 22 December 2009.

3. The Patent Owner's response is due **04 January 2010.**

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

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

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

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

By EFS: Registered users of EFS-Web may alternatively submit such correspondence via the electronic filing system EFS-Web, at https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html. EFS-Web offers the benefit of quick submission to the particular area of the Office that needs to act on the correspondence. Also, EFS-Web submissions are "soft

scanned" (i.e., electronically uploaded) directly into the official file for the reexamination proceeding, which offers parties the opportunity to review the content of their submissions after the "soft scanning" process is complete.

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

/Mark Reinhart/

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,413	12/02/2008	7167625	065484-0016	9150

7590 05/25/2010

KAREN A.FITZSIMMONS
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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 05/25/2010

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
OLIFF & BERRIDGE, PLLC
P.O. BOX 320850
ALEXANDRIA, VA 22320-4850

Date: **MAILED**

MAY 25 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000413
PATENT NO. : 7167625
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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MAY 25 2010

CENTRAL REEXAMINATION UNIT

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Minneapolis, MN 55402-0903

(For Patent Owner)

Oliff & Berridge, PLC
PO BOX 320850
Alexandria, VA 22320-4850

(For Third Party Requestor)

In re Haataja, et al.
Inter Partes Reexamination Proceeding
Control No. 95/000,413
Filed: Dec. 2, 2008
For: U.S. Patent No. 7,167,625

: DECISION DISMISSING
: PETITIONS TO WAIVE PAGE
: LIMIT FOR BRIEF
: AND RETURNING BRIEF
: AS IMPROPER

This is a decision on the following petition requesting waiver of 37 CFR 1.943(c):

Petition filed April 26, 2010, by patent owner entitled "PETITION UNDER 37 CFR § 1.183".

The proceeding and the patent owner's petition are before the Office of Patent Legal Administration.

The petition fee of $400.00 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183 has been received.

SUMMARY

The patent owner's April 26, 2010 petition requesting waiver of its respondent brief page limit restrictions under 37 CFR 1.943(c) is dismissed as the situation has not been shown to be extraordinary as explained below. The respondent brief filed April 26, 2010 is expunged as improper, since it does not comply with 37 CFR 1.943(c). Patent owner's respondent brief shall not exceed 15 pages (fifteen) pages. Patent owner is given 15 days from the date of this decision to file a corrected or redacted respondent brief that does not exceed 15 pages. [1]

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

REVIEW OF THE RELEVANT FACTS

1. On January 23, 2007, U.S. Patent No. 7,167,625 ('the '625 patent) issued with eight claims to Haataja *et al.* and is assigned on its face to ADC Telecommunications, Inc.

2. On November 6, 2008, a request for *inter partes* reexamination of claims 1-8 of the '625 patent was submitted by a third party requester, Panduit Corp., which request was assigned control number 95/000,413 ("the '413 proceeding"). In response to a Notification of Incomplete *Inter partes* reexamination request, a corrected request was submitted and received a filing date of Dec. 2, 2008.

3. On January 12, 2009, an Order was granted for *inter partes* reexamination of claims 1-8 of the '625 patent in the '413 proceeding.

4. The '413 proceeding then progressed to the point where, on December 14, 2009, a Right of Appeal Notice (RAN) was mailed in the '413 proceeding.

5. On January 6, 2010, patent owner filed a Notice of Appeal for claims 1-8 and 11.

6. On January 20, 2010, third party requestor filed a Notice of Cross Appeal for claims 9, 10, and 12.

7. On March 22, 2010, third party requestor filed an appellant brief.

8. On March 24, 2010, patent owner filed an appellant brief.

9. On April 22, 2010, third party requester filed a respondent's brief.

10. On April 26, 2010, patent owner filed a respondent's brief, along with a petition under 37 CFR 1.183 requesting waiver of the page limit requirements of 37 CFR 1.943(c).

RELEVANT AUTHORITY

37 CFR 1.183 provides:

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

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

MPEP § 2667 I.B.2 (Response filed by Third Party Requester that is too long) provides:

For additional information with respect to the length of papers, see Subsection I.A.2 above.

37 CFR 41.67. Appellant's brief (selected sections) provides:

...(c)(1) The appellant's brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(i) through (c)(1)(xi) of this section.

...

(ix) Evidence appendix. An appendix containing copies of any evidence submitted pursuant to § § 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See § 41.63 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner in any ground of rejection to be reviewed on appeal.

(x) Related proceedings appendix. An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section.

...

(d) If a brief is filed which does not comply with all the requirements of paragraph (a) and paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and given a non-extendable time period within which to file an amended brief. If appellant does not file an amended brief within the set time period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, that appellant's appeal will stand dismissed.

37 CFR 41.68. Respondent's brief (selected sections) provides:

...(b)(1) The respondent brief shall contain the following items under appropriate headings and in the order here indicated, and may include an appendix containing only those portions of the record on which reliance has been made.

...

(viii) Evidence appendix. An appendix containing copies of any evidence submitted pursuant to § § 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by respondent in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the respondent 's brief. See § 41.63 for treatment of evidence submitted after appeal.
(ix) Related proceedings appendix. An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (b)(1)(ii) of this section.
...
(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.

DECISION

I. Patent Owner Petition of April 26, 2010

The patent owner requests waiver of 37 CFR 1.943(c), which limits the respondent brief to fifteen (15) pages or 7,000 words in length. The patent owner states that the brief as filed is 30 pages and approximately 9,190 words. It is noted, as explained below, that the filed brief includes 26 pages that count toward the page limit.

Waiver is requested for the following reasons, which according to the patent owner, present an extraordinary situation:
(1) Patent owner is unable to respond to each of the four issues raised in the third party requester's appellant brief.
(2) The formal requirements of the brief consume 6 pages of the 15 page limit leaving only 9 pages for argument, which are inadequate to address each of the claim rejections raised in the third party requester's brief.

II. Analysis and findings

Determining Page Length

As noted in MPEP 2667(I)(A)(2), 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 of the appeal brief or 15 page limit of the respondent brief. Additionally, by its terms, 37 CFR 1.943(c) excludes from the count of the pages in an appellant's brief claim appendices and "reference materials such as prior art references." The sections of the appellant's 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. However, if any portion of the relevant section includes material

[2] *i.e.*, (i) *Real Party in Interest*; (ii) *Related Appeals and Interferences*, (iii) *Status of Claims*, (iv) *Status of Amendments*, (ix) *Evidence Appendix*, (x) *Related Proceedings Appendix, and* (xi) *Certificate of Service.* The Claims Appendix is already explicitly included in the rule.

that goes beyond that which is required by those sections, then the entire section will be counted toward the page total. Partial pages are tallied as whole pages for this purpose.

Prosecution History Does Not Present An Extraordinary Situation

Upon review of the prosecution history of this proceeding, it is noted that the patent owner and third party requester responses and comments prior to appeal have been well within the page limit requirements. Reviewing the substantive pages of argument in this proceeding, it is found that the request for reexamination for eight claims was 24 pages, the order for reexamination was 8 pages, the first Office action was 12 pages, the action closing prosecution (after the additional 4 claims were added) was 14 pages, and the right of appeal notice was 10 pages.

All of the briefs filed to date, with the exception of the respondent brief subject to this petition, have been within the page limit. The patent owner's appellant brief includes 7,963 words (24 pages), the third party requester's appellant brief includes 8,028 words (29 pages), and the third party requester's respondent brief includes 6,591 words (18 pages). The rules require that the appellant brief and respondent brief be more limited than pre-appeal responses. Patent owner's respondent brief filed April 26, 2010 has a length of 26 pages (9,190 words) that count toward the limit of 15 pages (7,000 words).

The reasons provided in support of waiving the page/word limits, detailed above, essentially relate to the number of claims and rejections/issues raised during prosecution. Yet, prior to appeal and in the appellant briefs, the claims and rejections/issues were adequately addressed in significantly fewer pages. No reason why an increase in pages is now warranted has been provided, and certainly no extraordinary situation has been shown to exist. Patent owner also requests additional pages based on an inaccurate interpretation of the rule. As explained above and in the MPEP, the portions of the brief including sections (i) to (iv) are not counted against the page limit.

Petitioner has made no showing of any efforts made to reduce the number of pages or words, by for example referring back to prior arguments, consolidating issues or eliminating unnecessary portions of the argument. The page limits are intentionally designed to focus the issues and require a concise presentation of arguments. Based on the facts of this proceeding, it is apparent that measures that could have been taken to reduce the pages/words in order to comply with the limits were not taken.

A persuasive showing has not been made that this situation is extraordinary such that significantly more pages be allotted compared to prior responses, comments, and actions issued by the Office.

Petition Requesting Waiver of 37 CFR 1.943(c) are DISMISSED

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.

As noted above, petitioner has not made a showing that an extraordinary situation exists that would require a waiver of the requirements of 37 CFR 1.943(c) in the interest of justice.

Improper Content in the Appendices in the Briefs

The Evidence appendices required in 37 CFR 41.67(c)(1)(ix) and 37 CFR 41.68(b)(1)(viii) should only include evidence that has been entered in the record pursuant to 37 CFR 1.130, 1.131, or 1.132, other similar evidence, or evidence relied upon by the examiner in a ground of rejection (appellant brief) or evidence entered by the examiner and relied upon by the respondent in the appeal (respondent brief). The appendix must include a statement where the evidence was entered into the record. The evidence appendix is not to include copies of the patent under reexamination, copies of Office actions in related cases or copies of prior art references. To the extent that such items are submitted, any arguments that go to a rejection or patentability of the claims will be counted against the page limits.

The Related Proceedings appendices required by 37 CFR 41.67(c)(1)(x) and 37 CFR 41.68(b)(1)(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 submitted (such as Office actions, requests for reexamination, etc.) may be counted toward the page limit of the brief. The related proceedings appendix is not to include copies of Office actions from related proceedings within the Office that have not risen to the Board. To the extent that such items are submitted, any arguments that go to a rejection or patentability of the claims will be counted against the page limits.

The patent owner improperly included items in the evidence appendix that go beyond evidence that was entered into the record in accordance with the rules. These items may be counted toward the page limit if resubmitted. The third party requester also improperly included items in the related proceedings appendix that go beyond copies of court and board papers. These items may be counted toward the page limit if resubmitted. The third party requester also included items that are not specifically listed in the related proceedings appendix and are not proper submissions; see for example "Defendant's Memorandum" dated November 7, 2008. As this paper is not a decision rendered by a court and presents arguments made by the third party requester, it will be counted toward the page limit.

Related copending proceedings are more appropriately identified prior to appeal in a notification of prior or concurrent proceedings in *inter partes* reexamination in accordance with 37 CFR 1.985. It is noted that notification of these copending proceedings has not been properly made of record in this proceeding.

Prior art references should be identified and made of record through a listing of patents and printed publications as provided for in 37 CFR 1.98. See MPEP 2657. It is not necessary or desirable to file duplicate copies of references and Office actions with the brief.

Improper Paper 'Expunged'

The patent owner respondent brief exceeds the page limit and is therefore an improper paper. This paper including all of the appendices and attachments will not be entered in this proceeding. As the paper has already been scanned into the image file wrapper (IFW), they are being expunged from the record by closing the documents in the IFW and marking them as non-public. It will not be available to the public or considered as part of the file wrapper.

CONCLUSION

1. The patent owner petition filed April 26, 2010 under 37 CFR 1.183 to waive the provisions of 37 CFR 1.943(c) for its respondent brief is dismissed. The respondent brief filed April 26, 2010 is being expunged from IFW by closing it in the IFW and marking it as 'non-public'. Patent owner has 15 days from the date of this decision to file a compliant respondent brief. The time for filing a respondent's brief may not be extended.

2. Jurisdiction over the '413 reexamination proceeding is hereby returned to the Central Reexamination Unit.

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

5-24-2010

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,415	11/06/2008	6925242	065484-0015	7623

23552 7590 12/29/2009

MERCHANT & GOULD PC
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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/29/2009

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Dykema Gossett PLLC
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Suite 2300
Chicago, IL 60606

Date:
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DEC 29 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000415
PATENT NO. : 6925252
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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MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS MN 55402-0903	: : :	(For Patent Owner)
DYKEMA GOSSETT PLLC 10 S. WACKER DR., STE. 2300 CHICAGO, IL 60606	: : :	(For Third Party Requester)
In re: Haataja *et alia* *Inter Partes* Reexamination Proceeding Control No. 95/000,415 Deposited on: 06 November 2008 For: US Patent No. 6,925,242	: : : : : :	CORRECTED DECISION DISMISSING PETITION FOR EXTENSION OF TIME [37 CFR § 1.956 and § 1.181]

MAILED

DEC 29 2009

CENTRAL REEXAMINATION UNIT

This is a corrected decision on the 21 December 2009, "Petition for Extension of Time Under 37 CFR 1.956" requesting that the time for responding to the Right of Appeal Notice mailed 04 December 2009, be extended by one (1) month. The petition was timely filed with certificate of service. This decision corrects the decision mailed 22 December 2009.

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

The petition is dismissed for the reasons set forth below.

Discussion

The Patent Owner's representative requests the period of time be extended in which to file a response to the Right of Appeal Notice mailed 14 December 2009, which set a one (1) month time for filing a response thereto. The petition for extension of time was timely filed on 21 December 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 petition is dismissed for the reasons set forth below.

> **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.

37 CFR § 41.61 Notice of appeal and cross appeal to Board. (in-part)

(e) The time periods for filing a notice of appeal or cross appeal may not be extended. (emphasis added)

Decision

The patent owner's representative petitions under 37 CFR § 1.956 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.

Pursuant to 37 CFR 41.61(e) [t]he time periods for filing a notice of appeal or cross appeal may not be extended.

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

CONCLUSION

1. The patent owner's petition for extension for time in which to file a response to the Right of Appeal Notice dated 14 December 2009 is hereby **dismissed.**

2. This decision corrects the decision mailed 22 December 2009.

3. The Patent Owner's response is due **14 January 2010.**

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

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

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

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

By EFS: Registered users of EFS-Web may alternatively submit such correspondence via the electronic filing system EFS-Web, at

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

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

/Mark Reinhart/

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

UNITED STATES PATENT AND TRADEMARK OFFICE

MAILED

MAY 25 2010

CENTRAL REEXAMINATION UNIT

COMMISSIONER FOR PATENTS
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ALEXANDRIA, VA 22313-1450
www.uspto.gov

Merchant & Gould, PC (For Patent Owner)
PO BOX 2903
Minneapolis, MN 55402-0903

Oliff & Berridge, PLC (For Third Party Requestor)
PO BOX 320850
Alexandria, VA 22320-4850

In re Haataja, et al.
Inter Partes Reexamination Proceeding
Control No. 95/000,415
Filed: Nov. 6, 2008
For: U.S. Patent No. 6,925,242

: DECISION DISMISSING
: PETITIONS TO WAIVE PAGE
: LIMIT FOR BRIEFS
: AND RETURNING BRIEFS
: AS IMPROPER

This is a decision on the following petitions requesting waiver of 37 CFR 1.943(c):

(1) Petition filed March 22, 2010 by third party requestor entitled "MISCELLANEOUS PETITION UNDER 37 CFR § 1.183".

(2) Petition filed April 22, 2010 by third party requestor entitled "MISCELLANEOUS PETITION UNDER 37 CFR § 1.183".

(3) Petition filed April 26, 2010, by patent owner entitled "PETITION UNDER 37 CFR § 1.183".

The proceeding, the third party requestor's petitions, and the patent owner's petition are before the Office of Patent Legal Administration.

The petition fee of $400.00 pursuant to 37 CFR 1.17(f) for each of the petitions under 37 CFR 1.183 has been received.

SUMMARY

(1) The third party requester's March 22, 2010 petition requesting waiver of its appellant brief page limit restrictions under 37 CFR 1.943(c) is dismissed as the situation has not been shown to be extraordinary as explained below. The appellant brief filed March 22, 2010 is expunged as improper, since it does not comply with 37 CFR 1.943(c). Third party requestor's

brief shall not exceed 30 pages (thirty) pages. Third party requester appellant is given 15 days from the date of this decision to file a corrected or redacted brief that does not exceed 30 pages.[1]

(2) The third party requester's April 22, 2010 petition requesting waiver of its respondent brief page limit restrictions under 37 CFR 1.943(c) is dismissed as the situation has not been shown to be extraordinary as explained below. The respondent brief filed April 22, 2010 is expunged as improper as it does not comply with 37 CFR 1.943(c). Third party requestor's respondent brief shall not exceed 15 pages (fifteen) pages. Third party requester appellant is given 15 days from the date of this decision to file a corrected or redacted respondent brief that does not exceed 15 pages.

(3) The patent owner's April 26, 2010 petition requesting waiver of its respondent brief page limit restrictions under 37 CFR 1.943(c) is dismissed as the situation has not been shown to be extraordinary as explained below. The respondent brief filed April 26, 2010 is expunged as improper as it does not comply with 37 CFR 1.943(c). Patent owner's respondent brief shall not exceed 15 pages (fifteen) pages. Patent owner may file a corrected or redacted respondent brief that does not exceed 15 pages in response to third party requester's appellant brief once filed, within one month from the date of service of the appeal brief.

REVIEW OF THE RELEVANT FACTS

1. On August 2, 2005, U.S. Patent No. 6,925,242 ('the '242 patent) issued with eighteen claims to Haataja *et al.* and is assigned on its face to ADC Telecommunications, Inc.

2. On November 6, 2008, a request for *inter partes* reexamination of claims 1-18 of the '242 patent was submitted by a third party requester, Panduit Corp., which request was assigned control number 95/000,415 ("the '415 proceeding").

3. On January 12, 2009, an Order was granted for *inter partes* reexamination of claims 1-18 of the '242 patent in the '415 proceeding.

4. The '415 proceeding then progressed to the point where, on December 14, 2009, a Right of Appeal Notice (RAN) was mailed in the '415 proceeding.

5. On January 6, 2010, patent owner filed a Notice of Appeal for claims 6-8, 20, 21, and 24, and on January 13, 2010, patent owner filed a second Notice of Appeal for claims 19 and 22.

6. On January 20, 2010, third party requestor filed a Notice of Cross Appeal for claims 1-5, 20 and 24.

7. On March 22, 2010, third party requestor filed an appellant brief, along with a petition under 37 CFR 1.183 requesting waiver of the page limit requirements of 37 CFR 1.943(c).

---

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

8. On March 24, 2010, patent owner filed an appellant brief.

9. On April 22, 2010, third party requester filed a respondent's brief, along with a petition under 37 CFR 1.183 requesting waiver of page limit requirements of 37 CFR 1.943(c).

10. On April 26, 2010, patent owner filed a respondent's brief, along with a petition under 37 CFR 1.183 requesting waiver of the page limit requirements of 37 CFR 1.943(c).

RELEVANT AUTHORITY

37 CFR 1.183 provides:

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

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

MPEP § 2667 I.B.2 (Response filed by Third Party Requester that is too long) provides:

For additional information with respect to the length of papers, see Subsection I.A.2 above.

37 CFR 41.67. Appellant's brief (selected sections) provides:

...(c)(1) The appellant's brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(i) through (c)(1)(xi) of this section.

...

(ix) Evidence appendix. An appendix containing copies of any evidence submitted pursuant to § § 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See § 41.63 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner in any ground of rejection to be reviewed on appeal.

(x) Related proceedings appendix. An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section.

...

(d) If a brief is filed which does not comply with all the requirements of paragraph (a) and paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and given a non-extendable time period within which to file an amended brief. If appellant does not file an amended brief within the set time period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, that appellant's appeal will stand dismissed.

37 CFR 41.68. Respondent's brief (selected sections) provides:

...(b)(1) The respondent brief shall contain the following items under appropriate headings and in the order here indicated, and may include an appendix containing only those portions of the record on which reliance has been made.

...

(viii) Evidence appendix. An appendix containing copies of any evidence submitted pursuant to § § 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by respondent in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the respondent 's brief. See § 41.63 for treatment of evidence submitted after appeal.

(ix) Related proceedings appendix. An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (b)(1)(ii) of this section.

...

(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.

DECISION

I. Third Party Requester Petition of March 22, 2010

The third party requester requests waiver of 37 CFR 1.943(c), which limits third party requestor's appellant brief to thirty (30) pages or 14,000 words in length. The third party requester states that the brief as filed is 53 pages and approximately 15,750 words. It is noted, as explained below, that the filed brief includes 49 pages that count toward the page limit.

Waiver is requested for the following reasons, which, according to the third party requester, present an extraordinary situation:

(1) The formal requirements of 37 CFR 41.67(c)(1)(i)-(iv) consume 8 pages of the brief leaving only 22 pages for argument.
(2) There are 24 claims at issue, including three independent.
(3) Five separate rejections that were not adopted are being appealed, and one of the original six rejections has been abandoned to reduce the length of the brief.
(4) Under 37 CFR 41.67(c)(1)(vii), arguments not included in the appeal brief will not be considered by the Board, while each claim must be argued separately under a separate heading.
(5) The third party requester is unable to address each of the claims separately for each of the proposed seven rejections and remain within 22 pages.

II. Third Party Requester Petition of April 22, 2010

The third party requester requests waiver of 37 CFR 1.943(c), which limits third party requestor's respondent brief to fifteen (15) pages or 7,000 words in length. The third party requester states that the brief as filed is 26 pages and approximately 7,286 words. It is noted, as explained below, that the filed brief includes 25 pages that count toward the page limit.

Waiver is requested for the following reasons,[2] which according to the third party requester present an extraordinary situation:
(1) The formal requirements of 37 CFR 41.68(b)(1)(i)-(vi) consume 6 pages of the brief leaving only 9 pages for argument.
(2) There are 24 claims at issue, including three independent.
(3) Patent owner is appealing three separate rejections that were adopted by the examiner and each disputed issue must be disputed under a separate heading.
(4) The third party requester is unable to address each of the issues raised by the patent owner and remain within 9 pages.
(5) This proceeding is further complicated due to the existence of three related *inter partes* reexaminations also on appeal.

III. Patent Owner Petition of April 26, 2010

The patent owner requests waiver of 37 CFR 1.943(c), which limits the respondent brief to fifteen (15) pages or 7,000 words in length. The patent owner states that the brief as filed is 45 pages and approximately 14,700 words. It is noted, as explained below, that the filed brief includes 41 pages that count toward the page limit.

Waiver is requested for the following reasons, which according to the patent owner present an extraordinary situation:
(1) Patent owner is unable to respond to each of the issues raised in the third party requester's appellant brief, which is 53 pages in length.
(2) Should waiver be granted to increase the length of third party requester's appellant brief, waiver of the length of the corresponding respondent brief should be granted to avoid prejudice to the patent owner.

[2] The petition lists only 5 reasons although they are numbered (1), (2), (3), (5), and (6).

IV. Analysis and findings

Determining Page Length

As noted in MPEP 2667(I)(A)(2), 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 of the appeal brief or 15 page limit of the respondent brief. Additionally, by its terms, 37 CFR 1.943(c) excludes from the count of the pages in an appellant's brief claim appendices and "reference materials such as prior art references." The sections of the appellant's briefs required under 37 CFR 41.67(c)(1)(i)-(iv) and (ix)-(xi)[3] are deemed to be included in "reference materials" that do not count toward the page limits. However, if any portion of the relevant section includes material that goes beyond that which is required by those sections, then the entire section will be counted toward the page total. Partial pages are tallied as whole pages for this purpose.

Prosecution History Does Not Present An Extraordinary Situation

Upon review of the prosecution history of this proceeding, it is noted that the patent owner and third party requester responses and comments prior to appeal have been well within the page limit requirements. Reviewing the substantive pages of argument in this proceeding, it is found that the request for reexamination for eighteen claims was 38 pages, the order for reexamination was 8 pages, the first Office action was 12 pages, the action closing prosecution (after the additional 7 claims were added) was 16 pages, and the right of appeal notice was 11 pages.

However, with the notable exception of the patent owner's appellant brief that is within the limit and includes 10,770 words (31 pages), the briefs filed subsequent to appeal have been significantly longer, while the rules require that the appellant brief and respondent brief be more limited than pre-appeal responses. Third party requester's appellant brief filed on March 22, 2010 has a length of 49 pages that count toward the limit of 30 pages. Third party requester's respondent brief filed April 22, 2010 has a length of 25 pages that count toward the limit of 15 pages. Patent owner's respondent brief filed April 26, 2010 has a length of 41 pages that count toward the limit of 15 pages.

The reasons provided in support of waiving the page/word limits, detailed above, essentially relate to the number of claims and rejections/issues raised during prosecution. Yet, prior to appeal, the claims and rejections/issues were adequately addressed in significantly fewer pages than in the appellant and respondent briefs. No reason why an increase in pages is now warranted has been provided, and certainly no extraordinary situation has been shown to exist. Third party requester also requests additional pages based on an inaccurate interpretation of the rule. As explained above and in the MPEP, the portions of the brief including sections (i) to (iv) are not counted against the page limit. Finally, the third party requester states that this proceeding is further complicated by the related proceedings, but provides no reasons why the mere existence of related proceedings would require an increase in pages.

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[3] *i.e.*, (i) *Real Party in Interest*; (ii) *Related Appeals and Interferences*, (iii) *Status of Claims*, (iv) *Status of Amendments*, (ix) *Evidence Appendix*, (x) *Related Proceedings Appendix, and* (xi) *Certificate of Service.* The Claims Appendix is already explicitly included in the rule.

Neither petitioner has made of showing of any efforts made to reduce the number of pages or words, by for example referring back to prior arguments, consolidating issues or eliminating unnecessary portions of the argument. The page limits are intentionally designed to focus the issues and require a concise presentation of arguments. For example, it is not necessary or desirable to reproduce claim charts in the brief that were originally presented in the request for reexamination, as third party requester has in the appellant brief. Based on the facts of this proceeding, it is apparent that measures that could have been taken to reduce the pages/words in order to comply with the limits were not taken.

A persuasive showing has not been made that this situation is extraordinary, such that significantly more pages be allotted compared to prior responses, comments, and actions issued by the Office.

Petitions Requesting Waiver of 37 CFR 1.943(c) are DISMISSED

The instant petitions under 37 CFR 1.183 have 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.

As noted above, neither petitioner has made a showing that an extraordinary situation exists that would require a waiver of the requirements of 37 CFR 1.943(c) in the interest of justice.

Improper Content in the Appendices in the Briefs

The Evidence appendices required in 37 CFR 41.67(c)(1)(ix) and 37 CFR 41.68(b)(1)(viii) should only include evidence that has been entered in the record pursuant to 37 CFR 1.130, 1.131, or 1.132, other similar evidence, or evidence relied upon by the examiner in a ground of rejection (appellant brief) or evidence entered by the examiner and relied upon by the respondent in the appeal (respondent brief). The appendix must include a statement where the evidence was entered into the record. The evidence appendix is not to include copies of the patent under reexamination, copies of Office actions in related cases, or copies of prior art references. To the extent that such items are submitted, any arguments that go to a rejection or patentability of the claims will be counted against the page limits.

The Related Proceedings appendices required by 37 CFR 41.67(c)(1)(x) and 37 CFR 41.68(b)(1)(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 submitted (such as Office actions, requests for reexamination, etc.) may be counted toward the page limit of the brief. The related proceedings appendix is not to include copies of Office actions from related proceedings within the Office that have not risen to the Board. To the extent that such items are submitted, any arguments that go to a rejection or patentability of the claims will be counted against the page limits.

The patent owner improperly included items in the evidence appendix that go beyond evidence that was entered into the record in accordance with the rules. These items may be counted toward the page limit if resubmitted. The third party requester also improperly included items in the related proceedings appendix that go beyond copies of court and board papers. These items may be counted toward the page limit if resubmitted. The third party requester also included items that are not specifically listed in the related proceedings appendix and are not proper submissions; see for example "Defendant's Memorandum" dated November 7, 2008. As this paper is not a decision rendered by a court and presents arguments made by the third party requester, it will be counted toward the page limit.

Related copending proceedings are more appropriately identified prior to appeal in a notification of prior or concurrent proceedings in *inter partes* reexamination in accordance with 37 CFR 1.985. It is noted that notification of these copending proceedings has not been properly made of record in this proceeding.

Prior art references should be identified and made of record through a listing of patents and printed publications as provided for in 37 CFR 1.98. See MPEP 2657. It is not necessary or desirable to file duplicate copies of references and Office actions with the brief.

Improper Papers Expunged

The third party requester appellant brief, the third party requester respondent brief, and the patent owner respondent brief exceed the page limit and are therefore improper papers. These papers, including all of the appendices and attachments, will not be entered in this proceeding. As the papers have already been scanned into the image file wrapper (IFW), they are being expunged from the record by closing the documents in the IFW and marking them as non-public. They will not be available to the public or considered as part of the file wrapper.

CONCLUSION

1. The third party requester petition filed March 22, 2010 under 37 CFR 1.183 to waive the provisions of 37 CFR 1.943(c) for its appellant brief is dismissed. The appellant brief filed March 22, 2010 is being expunged from IFW by closing it in IFW and marking it as non-public. Third party requester has 15 days from the date of this decision to file a compliant appellant brief. The time for filing an appellant brief may not be extended.

2. The third party requester petition filed April 22, 2010 under 37 CFR 1.183 to waive the provisions of 37 CFR 1.943(c) for its respondent brief is dismissed. The respondent brief filed April 22, 2010 is being expunged from IFW by closing it in IFW and marking it as non-public. Third party requester has 15 days from the date of this decision to file a compliant respondent brief. The time for filing a respondent's brief may not be extended.

3. The patent owner petition filed April 26, 2010 under 37 CFR 1.183 to waive the provisions of 37 CFR 1.943(c) for its respondent brief is dismissed. The respondent brief filed April 26, 2010 is being expunged from IFW by closing it in IFW and marking it as non-public. Patent

owner has one month from the date of service of third party requester's appellant brief to file a compliant respondent brief. The time for filing a respondent's brief may not be extended.

4. Jurisdiction over the '415 reexamination proceeding is hereby returned to the Central Reexamination Unit.

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

5-24-2010

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.
95/000,418	11/25/2008	7377324	069669-0003	4212

74954 7590 04/07/2009

Bracewell & Giuliani LLP
711 Louisiana Street
Suite 2300
Houston, TX 77002-2770

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/07/2009

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 Patents and Trademark Office
P.O.Box 1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
MORGAN LEWIS & BOCKIUS LLP
1111 PENNSYLVANIA AVENUE NW
WASHINGTON, DC 20004

Date:

MAILED

APR 07 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000418
PATENT NO. : 7377324
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 Patent
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

MAILED

APR 07 2009

CENTRAL REEXAMINATION UNIT

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(For Patent Owner)

MORGAN, LEWIS & BOCKIUS LLP
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(For Third Party Requester)

In re Beierbach et al.
Inter Partes Reexamination Proceeding
Control No. 95/000,418
Filed: November 25, 2008
For: U.S. Patent No. 7,377,324

DECISION
GRANTING-IN-PART
PETITION

This is a decision on the patent owner paper entitled "PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE THE REQUIREMENTS OF 37 C.F.R. § 1.943(b)," filed on March 23, 2009.

The patent owner petition and *inter partes* reexamination control number 95/000,418 are before the Office of Patent Legal Administration.

For the reasons set forth below, patent owner's petition under 37 CFR 1.183 to waive the 37 CFR 1.943(b) limit as to the number of pages permitted in a patent owner response is granted to the extent that the page limit for the patent owner response is extended to not exceed 115 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

FEES

A fee of $400.000 under 37 CFR 1.17(f) is required for a petition under 37 CFR 1.183. No fee was remitted with, or authorized by, the patent owner petition paper. On April 3, 2009, patent owner's representative, Todd Mattingly, authorized a charge of the $400.00 petition fee against Deposit Account No. 50-0259 in a telephone conversation with Legal Advisor Susy Tsang-Foster. (The telephone conversation did not address the merits of the present petition or any other substantive issues, but was confined merely to the procedural matter of a fee authorization.) Accordingly, the $400.000 petition fee has been charged to petitioner's Deposit Account No. 50-0259.

REVIEW OF THE RELEVANT FACTS

1. On May 27, 2008, U.S. patent No. 7,377,324 ("the '324 patent") issued to Beierbach et *al.*

2. On November 25, 2008, a request for *inter partes* reexamination of the '324 patent, assigned control No. 95/000,418 (the '418 proceeding), was filed by third party requester Paul E. Krieger, in which Weatherford International, Inc. was identified as the real party in interest (hereafter "third party requester").

3. On February 10, 2009, the Office issued an order granting the request for *inter partes* reexamination of claims 1-34, i.e., all of the '324 patent claims. A non-final Office action, rejecting claims 1-3 and 5-34, and confirming claim 4, was mailed concurrently with the order granting reexamination.

4. On March 23, 2009, patent owner filed the present petition entitled "PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE THE REQUIREMENTS OF 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.

I. PATENT OWNER'S PETITION OF MARCH 23, 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 increase the page limit for patent owner's response to the February 10, 2009 Office action to 201 pages.[1] In support of waiver of the rule, patent owner asserts that the February 10, 2009 Office action is 34 pages long, includes compound rejections by cross-referencing previous rejections within the Office action, and incorporates by reference 125 pages of the Request for Reexamination.[2]

II. ANALYSIS AND FINDINGS

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[1] Petition at page 5 (patent owner noting that a 201 page limit is reasonable, as it is the sum of the number of pages in the 34-page Office Action and the 167-page Request for Reexamination).
[2] Petition at page 3.

The record shows that the non-final Office action dated February 10, 2009 is 32 pages in length (excluding 3 pages of cover sheets and 1 page of contact information and signatures), and it incorporates by reference 83 pages of the request for reexamination.[3] Hence, the non-final Office action is effectively substantively 115 pages in length.

37 CFR 1.183 permits waiver of the page limitation requirement of the regulations in an extraordinary situation when justice requires. Under the facts and circumstances currently of record in the '418 *inter partes* reexamination proceeding, the present patent owner petition is deemed to establish that a waiver of 37 CFR 1.943(b) to the extent of permitting patent owner's forthcoming response to run 115 pages in length is appropriate in the interest of justice.

Petitioner has not pointed out the specifics of what will require 201 pages, and why. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) to increase the page limit to 201 pages could have been an attempt to draft a patent owner's response in compliance with the 50-page limit, submitted concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b) to increase the page limit to 201 pages, requesting entry of the submitted response. Such a response could be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, as opposed to attempting to rely on a general statement that patent owner needs at least the total number of pages of the request for reexamination plus the non-final Office action, petitioner could attempt to rely on the proposed response (1) for justification that more pages are needed to complete the response and (2) to set forth an accurate determination of exactly how many additional pages are needed to complete the response.

THIRD PARTY REQUESTER

This decision, *sua sponte,* waives the provisions of 37 CFR 1.943(b) to the extent that that any written comments by the third party requester filed in response to patent owner's response as set forth in this decision shall not exceed 115 pages in length, excluding appendices of claims and reference materials such as prior art references.

SERVICE OF COPIES

Patent owner is reminded that any future communications filed by patent owner in this proceeding (including any response to this decision) must include proof of service on the third party requester in accordance with 37 CFR 1.248(a). The patent owner is advised that third party requester filed a power of attorney and change in correspondence address on November 25, 2008. The address for the third party requester associated with Customer Number 09629 is MORGAN, LEWIS & BOCKIUS LLP, 1111 PENNSYLVANIA AVENUE NW, WASHINGTON, DC 20004. The third party requester address stated on patent owner's March

[3] Pages 3-6 of the action incorporates pp. 48-50 of the Request; pp. 7-8 of the action incorporates pp. 40-41 of the Request; pp. 9-10 of the action incorporates pp. 45-46 of the Request; p. 12 of the action incorporates pp. 48-50 of the Request; p. 13 of the action incorporates pp. 50-58 and 61-66 of the Request; p. 14 of the action incorporates pp. 58-60 of the Request; p. 15 of the action incorporates pp. 61-62 of the Request; p. 16 of the action incorporates pp. 62-63 of the Request; p. 17 of the action incorporates pp. 64-65 of the Request; p. 18 of the action incorporates p. 66 of the Request; pp. 19-32 of the action incorporates pp. 67-111 of the Request; and p. 22 of the action incorporates pp. 62-63 of the Request.

23, 2009 Certificate of Service is MORGAN, LEWIS & BOCKIUS LLP, 1000 LOUISIANA ST., SUITE 4200, HOUSTON, TX 77002. Future patent owner communications **may be considered incomplete and accordingly not considered, since they would be defective papers,** if service is not made on the third party requester at **the address of record.**

ADDITIONAL DISCUSSION

Note that if the Office does not grant a petition to the full extent of a proposed response/ comments paper submitted with (or before) a petition for waiver of page limit, the submitting party would be given a period of 15 days within which to submit a compliant response/comments paper in accordance with the page limit set forth in the decision on the petition. *See* MPEP 2667(I)(A) and (B). Further, a stated need for submission of supporting expert declarations or other appendix evidence as a basis for page limit waiver is not a basis for waiver of 37 CFR 1.943(b), because the party can fashion the content of such declarations or other appendix evidence to avoid having those pages count toward the page limit. *See* MPEP 2667(I)(A) and (B).[4]

CONCLUSION

1. The petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b) is granted to the extent that the page limit for the patent owner's forthcoming response is extended to not exceed 115 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

2. The provisions of 37 CFR 1.943(b) have been waived to the extent that that any written comments submission by the third party requester that is responsive to patent owner's response as set forth in this decision shall not exceed 115 pages in length, excluding appendices of claims and reference materials such as prior art references.

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] That is, patent owner or requester 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.

4. Telephone inquiries related to the present decision should be directed to the Susy Tsang-Foster, Legal Advisor, at 571-272-7711.

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

4/6/09
C:\Kiva\Kenpet7\IP\length\95_0418_PO waive p-limit_granted in part- 6 Apr 2009.doc

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,418	11/25/2008	7377324	069669-0003	4212

74954 7590 03/18/2010

Bracewell & Giuliani LLP
711 Louisiana Street
Suite 2300
Houston, TX 77002-2770

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/18/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
MORGAN LEWIS & BOCKIUS LLP
1111 PENNSYLVANIA AVENUE NW
WASHINGTON, DC 20004

Date:

MAILED

MAR 18 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000418
PATENT NO. : 7377324
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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BRACEWELL & GIULIANI LLP (For Patent Owner)
711 LOUISIANA STREET
SUITE 2300
HOUSTON, TX 77002-2770

MAILED

MAR 18 2010

CENTRAL REEXAMINATION UNIT

MORGAN LEWIS & BOCKIUS LLP (For Requester)
1111 PENNSYLVANIA AVENUE NW
WASHINGTON, DC 20004

In re Beierbach et al.	:	
Reexamination Proceeding	:	DECISION ON PETITION
Control No.: 95/000,418	:	FOR REOPENING
Filed: November 25, 2008	:	PROSECUTION
For: U.S. Patent No.: 7,377,324	:	UNDER 37 CFR 1.181

This is a decision on a petition filed by the patent owner on February 18, 2010. The petition is entitled "PETITION UNDER 37 C.F.R. § 1.181 TO REQUEST CORRECTED OFFICE ACTION," and is a request to the Director to exercise his discretion pursuant to 37 CFR 1.181 and order a corrected Office action in place of the Action Closing Prosecution issued on January 20, 2010.

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

The petition under 37 CFR 1.181 to invoke the supervisory authority of the Director dated February 18, 2010 is granted with respect to withdrawing the ACP dated January 20, 2010 in the *Inter Partes* reexamination proceeding 95/000,418.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 7,377,324 (hereinafter, the '324 patent) issued on May 27, 2008.

2. A request for *inter partes* reexamination, assigned control No. 95/000,418, was filed by a third party requester on November 25, 2008.

3. *Inter partes* reexamination was ordered for the '418 reexamination proceeding on February 10, 2009. On the same day, a non-final Office action was mailed in the '418 reexamination proceeding.

4. Prosecution advanced and on January 20, 2010, the Office issued an Action Closing Prosecution (ACP), which addressed the patent owner's response and the third party comments.

5. On February 18, 2010, the patent owner filed the above-mentioned petition under 37 CFR 1.181 to invoke the supervisory authority of the Director and requesting that a corrected Office action be mailed. The patent owner also filed comments in response to the ACP.

6. The third party requester did not file comments to date.

DECISION

The patent owner (petitioner) states that the ACP dated January 20, 2010 does not clearly develop the issues of patentability, because the cross references used in the explanations of the rejections do not make sense. Patent owner listed several examples on pages 2-3 of the petition, in which the cross references that are used to provide part of the basis for the rejection do not fully and clearly explain the rejection. Therefore, patent owner states that the ACP fails to clearly develop the issues adequately to allow for patent owner to fully respond to the ACP. Patent owner states he is forced to make many assumptions about what is the basis of the rejections in the ACP. The patent owner states that public policy and Office procedures support the patent owner's position that the ACP was improperly issued and cites to MPEP 2671.02 and 37 CFR 1.949 for support. Because of these grounds, petitioner requests that a corrected Office action should replace the ACP dated January 20, 2010.

In response to patent owner's arguments for mailing a corrected Office action 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 examples of cross references, cited on pages 2-3 of the petition, render the explanation of the rejections unclear. Therefore, the ACP of January 20, 2010 cannot fairly be said to have fully developed the issues of patentability.

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."

Therefore, the examiner improperly closed prosecution because the ACP dated January 20, 2010 fails to clearly set forth all rejections and the grounds therefor, in accordance with 37 CFR 1.949. See also MPEP 2671.01 for more information.

Accordingly, good and sufficient reasons to withdraw the ACP dated January 20, 2010 in the reexamination proceeding have been provided and the patent owner's petition, as it relates to withdrawing the ACP dated January 20, 2010, is granted.

CONCLUSION

1. The petition under 37 CFR 1.181 for reconsideration of the Action Closing Prosecution dated January 20, 2010 is **granted**.

2. The Office action, dated January 20, 2010, is hereby **vacated** and the examiner will issue a **corrected** Office action, in due course, to replace the January 20, 2010 Office action.

3. The patent owner's comments, dated February 18, 2010, will be closed and returned. As the paper has been entered into the electronic Image File Wrapper (IFW) record, the paper will be "returned" by closing the paper in the IFW, and marking the paper nonpublic to expunge it from the record.

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.
95/000,423	12/18/2008	6666377	02100.8059	8648

23844 7590 10/29/2009

SCOTT C HARRIS
P O BOX 927649
SAN DIEGO, CA 92192

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 10/29/2009

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

Date: MAILED
OCT 2 9 2009
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000423
PATENT NO. : 6666377
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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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/493,053	06/26/2009	Scott C. Harris	9341.002.000000	8561

68769 7590 10/29/2009
HOUSTON OFFICE OF
NOVAK DRUCE AND QUIGG LLP
1000 LOUISIANA STREET
FIFTY-THIRD FLOOR
HOUSTON, TX 77002

EXAMINER
WALSH, DANIEL I

ART UNIT	PAPER NUMBER
2887	

MAIL DATE	DELIVERY MODE
10/29/2009	PAPER

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

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CENTRAL REEXAMINATION UNIT

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SAN DIEGO, CA 92192

(For Patent Owner)

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(For Third Party Requester)

HOUSTON OFFICE OF
NOVAK DRUCE AND QUIGG LLP
1000 LOUISIANA STREET
FIFTY-THIRD FLOOR
HOUSTON TX 77002

(For Reissue Applicant)

Inter Partes Reexamination Proceeding
Control No. 95/000,423
Filed: December 18, 2008
For: U.S. Patent No. 6,666,377

In re Harris
Reissue Application
Application No. 12/493,053
Filed: June 26, 2009
For: U.S. Patent No. 6,666,377

DECISION REFUSING ENTRY OF IMPROPER REQUESTER PAPER AND DISMISSING PATENT OWNER PETITION AS MOOT

This is a decision on third party requester's petition paper entitled "PETITION UNDER 37 C.F.R. § 1.182 AND MPEP § 2686.03(V) TO SUSPEND AND STAY THE NEWLY FILED REISSUE APPLICATION DURING THE *INTER PARTES* REEXAMINATION OF U.S. PATENT NO. 6,666,377," filed in *inter partes* reexamination proceeding control no. 95/000,423 and filed in reissue application no. 12/493,053 on July 23, 2009, as supplemented on July 24, 2009.

This is also a decision on patent owner's petition paper entitled "PETITION UNDER 37 C.F.R. § 1.181, § 1.182 AND § 1.183 TO STRIKE AND SEAL FEDEX CORPORATION'S PETITION PAPERS TO STAY REISSUE APPLICATION FILED ON JULY 23, 2009 AND JULY 24,

2009," filed in *inter partes* reexamination proceeding control no. 95/000,423 and filed in reissue application no. 12/493,053 on July 31, 2009.

The petitions are before the Office of Patent Legal Administration for consideration.

The July 23, 2009 third party requester petition under 37 CFR 1.182, is refused entry into the record of *inter partes* reexamination proceeding control no. 95/000,423 and is also refused entry into the record of the 12/493,053 reissue application, and both papers are expunged from the respective records, for the reasons set forth below. The July 31, 2009 patent owner petition under 37 CFR 1.181, 1.182 and 1.183 is dismissed as directed to papers expunged from the file, for the reasons set forth below.

FEES

The petition fee of $400.00 pursuant to 37 CFR 1.17(f) was paid by third party requester on July 23, 2009 for the petition under 37 CFR 1.182, filed in the '423 reexamination proceeding, and for the petition under 37 CFR 1.182, filed in the '053 reissue application. The petition fee of $400.00 pursuant to 37 CFR 1.17(f) is being charged to patent owner's Deposit Account No. 14-1437, pursuant to the authorization on page 7 of patent owner's July 31, 2009 petitions, for the petition under 37 CFR 1.181, 1.182 and 1.183, filed in the '423 proceeding, and for the petition under 37 CFR 1.181, 1.182 and 1.183, filed in the '053 reissue application.

REVIEW OF THE RELEVANT FACTS

1. On December 23, 2003 United States Patent No. 6,666,377 (the '377 patent) issued to Scott C. Harris.

2. On December 18, 2008, a request for *inter partes* reexamination of the '377 patent was filed by a third party requester, which request was assigned Reexamination Control No. 95/000,423 (the '423 reexamination proceeding).

3. On February 20, 2009, an order for *inter partes* reexamination was mailed in the '423 reexamination proceeding, concurrently with a first Office action on the merits.

4. On May 26, 2009, patent owner filed a response in the '423 reexamination proceeding entitled "RESPONSE TO FEBRUARY 20, 2009 OFFICE ACTION."

5. On June 22, 2009, third party requester filed comments in the '423 reexamination proceeding entitled "REQUESTER'S THIRD PARTY COMMENTS SUBSEQUENT TO BARTEX'S RESPONSE TO OFFICE ACTION."

6. On June 26, 2009, patent owner filed an application for reissue of the '377 patent, which application was assigned application number 12/493,053 (the '053 reissue application).

7. On July 23, 2009, third party requester filed, in both the '423 reexamination and '053 reissue application proceedings, a petition paper entitled "PETITION UNDER 37 C.F.R. § 1.182 AND MPEP § 2686.03(V) TO SUSPEND AND STAY THE NEWLY FILED REISSUE APPLICATION DURING THE *INTER PARTES* REEXAMINATION OF U.S. PATENT NO. 6,666,377." These two petition papers are the subject of this decision.

8. On July 24, 2009, third party requester filed, in both the '423 reexamination and '053 reissue application proceedings, a paper entitled "SUBMISSION OF EXHIBITS TO PETITION UNDER 37 C.F.R. § 1.182 AND MPEP § 2686.03(V) TO SUSPEND AND STAY THE NEWLY FILED REISSUE APPLICATION DURING THE *INTER PARTES* REEXAMINATION OF U.S. PATENT NO. 6,666,377," supplementing the July 23, 2009 petition under 37 CFR 1.182. These papers are also addressed in this decision.

9. Concurrently, on July 24, 2009, the '053 reissue application was docketed to an examiner for examination. No Office action on the merits has been mailed to date for the '053 reissue application.

10. On July 31, 2009, patent owner filed, in both the '423 reexamination and '053 reissue application proceedings, a petition paper entitled "PETITION UNDER 37 C.F.R. § 1.181, § 1.182 AND § 1.183 TO STRIKE AND SEAL FEDEX CORPORATION'S PETITION PAPERS TO STAY REISSUE APPLICATION FILED ON JULY 23, 2009 AND JULY 24, 2009." These papers are also the subject of this decision.

11. On August 4, 2009, the filing of the '053 reissue application was announced in the *Official Gazette*.

12. On August 10, 2009, third party requester filed a petition paper in the '423 reexamination proceeding entitled "PETITION UNDER 37 C.F.R. § 1.182 IN RESPONSE TO PATENT OWNER'S PETITION UNDER 37 C.F.R. § 1.181, § 1.182 AND § 1.183 TO STRIKE AND SEAL FEDEX CORPORATION'S PETITION PAPERS TO STAY REISSUE APPLICATION FILED ON JULY 23, 2009 AND JULY 24, 2009."

13. On August 13, 2009, patent owner filed a petition paper in the '423 reexamination proceeding entitled "PETITION UNDER 37 C.F.R. § 1.182 TO MERGE REISSUE APPLICATION AND *INTER PARTES* REEXAMINATION PROCEEDING IN ACCORDANCE WITH THE PROVISIONS OF 37 C.F.R. § 1.991."

DECISION

I. RELEVANT STATUTES, REGULATIONS, AND EXAMINING PROCEDURE

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 1.291(a) provides:

> A protest may be filed by a member of the public against a pending application, and it will be matched with the application file if it adequately identifies the patent application. A protest submitted within the time frame of paragraph (b) of this section, which is not matched in a timely manner to permit review by the examiner during prosecution, due to inadequate identification, may not be entered and may be returned to the protestor where practical, or, if return is not practical, discarded.

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 1.947 provides:

> Each time the patent owner files a response to an Office action on the merits pursuant to § 1.945, a third party requester may once file written comments within a period of 30 days from the date of service of the patent owner's response. These comments shall be limited to issues raised by the Office action or the patent owner's response. The time for submitting comments by the third party requester may not be extended. For the purpose of filing the written comments by the third party requester, the comments will be considered as having been received in the Office as of the date of deposit specified in the certificate under § 1.8.

II. DISCUSSION

A. The '423 Reexamination Proceeding: Requester's Petition is an Improper Paper

On July 23, 2009, third party requester filed the petition under 37 CFR 1.182 in the '423 reexamination proceeding, requesting that the Office stay the '053 reissue application. On July 24, 2009, third party requester filed, in the '423 reexamination proceeding, exhibits that were inadvertently omitted from the July 23, 2009 petition submission.

The third party requester in an ordered *inter partes* reexamination proceeding has, pursuant to 35 U.S.C. § 314(b)(2), 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 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.

Additionally, there are some limited circumstances when a third party requester is not precluded from filing certain other papers in a reexamination proceeding that are not expressly authorized by 35 U.S.C. 314(b)(2), such as papers pursuant to 37 CFR 1.985(b) [1] and MPEP 2646(II).[2]

The decision on whether to merge the reissue application examination and reexamination proceeding, or stay one of them, is made on a case-by-case basis, and 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. *See* MPEP 2686.03(II). 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 in the legislative history of the *inter partes* reexamination statute that the requester was granted any right to request that the Office stay a patent owner's reissue application that is copending with the *inter partes* reexamination proceeding. Such a right was 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 a right was ever contemplated by Congress.

MPEP 2686.03(V) inaccurately provides that "[t]he third party requester may file a petition under 37 CFR 1.182 to merge a reexamination proceeding and a reissue application examination, or stay the reexamination proceeding, after the order to reexamine (37 CFR 1.931), in the event the Office has not acted prior to that date to merge or stay" (emphasis added). However, neither the statute, regulations nor the MPEP provides for a third party requester petition under 37 CFR 1.182 to stay a patent owner's reissue application that is copending with an *inter partes* reexamination proceeding. To the extent that the guidance provided in MPEP 2686.03(V), indicates that a third party requester may file a petition under 37 CFR 1.182 to merge reexamination and reissue application proceedings or to stay the reexamination proceeding, it is inconsistent with 35 U.S.C. 314(b), and the statute governs.[3]

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[1] 37 CFR 1.985(b) permits any party to notify the Office, at any time, of a prior or concurrent proceeding in which the same patent was involved. Third party requester may not submit substantive arguments in a submission pursuant to 37 CFR 1.985(b), as such submissions are limited to bare notice only; the party may not challenge an action of the Office in the paper. *See* MPEP 2686. This is not participation in the proceeding; but is rather a bare notification as to proceedings directed to the patent. Note that, under MPEP 2207, the Office accepts third party notification as to proceedings directed to the patent, even when the Office has no jurisdiction over the patent, such as when there is no pending reexamination.

[2] MPEP 2646(II) permits a third party requester to file an opposition to a patent owner petition filed under 37 CFR 1.181 to vacate a reexamination order. Such petition pertains to an *ultra vires* action by the Office, that is, a petition requesting the Office vacate an action that is argued to be outside the scope of the statute. Such an action goes to the merits of the proceeding since it will terminate the proceeding. In general, no statutory authority is required for third party requester to oppose patent owner petitions pertaining to *ultra vires* actions by the Office, since the patent owner is challenging the correctness (propriety) of the Office's action, and requester has a right to support the correctness of the Office's action. This is not the same as a requester petition advising the Office not to exercise its discretion, where the Office is not required to act, or refrain from acting, as requester says it should, when the failure to do so would not be an *ultra vires* action by the Office.

[3] MPEP 2686.01(VI) states (in-part), "A requester of any of the multiple reexamination proceedings may also petition to merge the proceedings at any time after the order to reexamine the second request," and MPEP 2696.03(V) states (in-part), "The third party requester may file a petition under 37 CFR 1.182 to merge a reexamination proceeding and a reissue application examination, or stay the reexamination proceeding, after the order to reexamine (37 CFR 1.931), in the event the Office has not acted prior to that date to merge or stay." Revision of these MPEP sections is being considered in view of 37 CFR 1.985(b), which affords the third party

Third party requester's petition under in 37 CFR 1.182 to stay the '053 reissue application is not a paper that is permitted by the statute governing *inter partes* reexamination proceedings, and accordingly was not provided for (*i.e.*, was not permitted) in the regulations that implemented the *inter partes* reexamination statute. Requester's July 23, 2009 petition under 37 CFR 1.182, therefore, is not enterable into the record. 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." Requester's July 23, 2009 petition under 37 CFR 1.182 and July 24, 2009 exhibits do not have a right of entry into the record of the '423 proceeding and, as such, are not authorized papers. Because requester's July 23, 2009 petition under 37 CFR 1.182 and July 24, 2009 exhibits have been scanned into the electronic Image File Wrapper (IFW), these papers are being expunged by marking them "closed" and "non-public" in the IFW, and will not constitute part of the record of the '423 proceeding. *See* MPEP 2267.

B. The '053 Reissue Application: Requester's Petition is not an Authorized Paper

On July 23, 2009, third party requester filed, via the Office's web-based electronic filing system (EFS-Web), the petition under 37 CFR 1.182 in the '053 reissue application, requesting that the Office stay the '053 reissue application. On July 24, 2009, third party requester filed, via EFS-Web, exhibits in the '053 reissue application that were inadvertently omitted from the July 23, 2009 petition submission.

Third party requester is not a party to the '053 reissue application. Therefore, third party requester was not authorized to file the July 23, 2009 petition under 37 CFR 1.182 and the July 24, 2009 exhibits in the '053 reissue application. At all times relevant herein, Mr. Berkowitz has not been appointed to and did not represent the sole inventor, Scott C. Harris, named in the '377 patent or the assignee, Bartex Research, LLC. Mr. Berkowitz has not acted in a representational capacity of Mr. Harris, or his respective interests. Thus, at all times relevant herein, Mr. Berkowitz lacked authority to submit papers and otherwise control prosecution of '053 reissue application. See 37 CFR §§ 1.32(b), 1.33(b), and 1.34.

An *Official Gazette* Notice dated April 22, 2003, in pertinent part states, "The USPTO may also refer third-party inquiries or submissions not provided for in 37 CFR 1.99 by registered practitioners in published applications in which the applicant has not provided an express written consent to protest or pre-issuance opposition to the Office of Enrollment and Discipline for appropriate action." Since third parties have no standing to challenge Office actions (outside of an interference) during the prosecution of an application for patent, the presentation of a petition to suspend another party's patent application may be prejudicial to the administration of justice, for delay of issuance of a patent, or harassment of the applicant. See, 37 CFR §§ 10.23(b)(5), 10.23(c)(15) and 10.18(b)(2)(i)(now 11.18(b)(2)(i)).

Further, while 37 CFR 1.291 permits a protest to be filed by a member of the public against a pending application, neither third party requester's July 23, 2009 petition under 37 CFR 1.182

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requester in an *inter partes* reexamination proceeding a mechanism for notifying the Office of prior or concurrent proceedings.

nor the July 24, 2009 exhibits satisfy the requirements for protests under 37 CFR 1.291. Additionally, protests under 37 CFR 1.291 may not be filed electronically via EFS-Web. *See Legal Framework for EFS-Web*, Section XXXI (September 2008).

Accordingly, requester's July 23, 2009 petition under 37 CFR 1.182 and July 24, 2009 exhibits are not authorized papers in the '053 reissue application. Because requester's July 23, 2009 petition under 37 CFR 1.182 and July 24, 2009 exhibits have been scanned into the electronic Image File Wrapper (IFW), these papers are being expunged by marking them "closed" and "non-public" in the IFW, and will not constitute part of the record of the '053 reissue application.

C. Patent Owner's Petition under 37 CFR 1.181, 1.182 and 1.183 is Moot

In the July 31, 2009 petition under 37 CFR 1.181, 1.182 and 1.183, patent owner requests that the Office strike and seal the following third party requester papers, which were filed on July 23, 2009 and July 24, 2009, respectively, in both the '423 reexamination and '053 reissue application proceedings: (1) "PETITION UNDER 37 C.F.R. § 1.182 AND MPEP § 2686.03(V) TO SUSPEND AND STAY THE NEWLY FILED REISSUE APPLICATION DURING THE *INTER PARTES* REEXAMINATION OF U.S. PATENT NO. 6,666,377" and (2) "SUBMISSION OF EXHIBITS TO PETITION UNDER 37 C.F.R. § 1.182 AND MPEP § 2686.03(V) TO SUSPEND AND STAY THE NEWLY FILED REISSUE APPLICATION DURING THE *INTER PARTES* REEXAMINATION OF U.S. PATENT NO. 6,666,377."

In view of this decision expunging third party requester's July 23, 2009 petition under 37 CFR 1.182 and July 24, 2009 exhibits in both the '423 reexamination and '053 reissue application proceedings, patent owner's July 31, 2009 petition under 1.181, 1.182 and 1.183 to strike and seal third party requester's July 23, 2009 and July 24, 2009 papers is directed to papers expunged from the file. Thus, patent owner's July 31, 2009 petition under 37 CFR 1.181, 1.182 and 1.183 is dismissed in the '423 reexamination and '053 reissue application proceedings.

CONCLUSION

1. Third party requester's July 23, 2009 petition under 37 CFR 1.182 and July 24, 2009 exhibits are refused entry into the '423 *inter partes* reexamination proceeding as improper papers.

2. Because the July 23, 2009 petition under 37 CFR 1.182 and the July 24, 2009 exhibits were previously incorporated into the IFW of the '423 reexamination proceeding, the papers are being expunged from the record by marking them "closed" and "non-public" in the IFW of the '423 reexamination proceeding.

3. Third party requester's July 23, 2009 petition under 37 CFR 1.182 and July 24, 2009 exhibits are refused entry into the '053 reissue application as unauthorized papers.

4. Because the July 23, 2009 petition under 37 CFR 1.182 and the July 24, 2009 exhibits

were previously incorporated into the IFW of the '053 reissue application, the papers are being expunged from the record by marking them "closed" and "non-public" in the IFW of the '053 reissue application.

5. No copy of the July 23, 2009 petition under 37 CFR 1.182 will be maintained of record in the Office. A copy of this decision will be made of record in the IFW of the '423 reexamination proceeding and in the IFW of the '053 reissue application.

6. Patent owner's July 31, 2009 petitions under 37 CFR 1.181, 1.182 and 1.183, filed in both the '423 reexamination and '053 reissue application proceedings, are dismissed as directed to papers expunged from the file.

7. On an even date herewith, decisions are being mailed (a) dismissing patent owner's August 13, 2009 petition under 37 CFR 1.182 in the '423 reexamination proceeding and (b) suspending action in the 12/493,053 reissue application.

8. Also on an even date herewith, a decision is being mailed expunging third party requester's August 10, 2009 petition under 37 CFR 1.182 as an improper paper in the '423 reexamination proceeding.

9. Telephone inquiries with regard to this decision should be directed to Nicole Dretar, Legal Advisor, at 571-272-7717.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,423	12/18/2008	6666377	02100.8059	8648

23844 7590 10/29/2009

SCOTT C HARRIS
P O BOX 927649
SAN DIEGO, CA 92192

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 10/29/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

Date:
MAILED
OCT 2 92009
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000423
PATENT NO. : 6666377
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

SCOTT C. HARRIS
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(For Patent Owner)

FINNEGAN, HENDERSON, FARABOW,
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901 NEW YORK AVENUE, NW
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(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No.: 95/000,423
Filed: December 18, 2008
For: U.S. Patent No. 6,666,377

DECISION DISMISSING PETITION FOR MERGER OF REISSUE AND *INTER PARTES* REEXAMINATION

This is a decision on patent owner's August 13, 2009 "PETITION UNDER 37 C.F.R. § 1.182 TO MERGE REISSUE APPLICATION AND *INTER PARTES* REEXAMINATION PROCEEDING IN ACCORDANCE WITH THE PROVISIONS OF 37 C.F.R. § 1.991."

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

The petition is dismissed, for the reasons set forth herein.

REVIEW OF THE RELEVANT FACTS

1. On December 23, 2003 United States Patent No. 6,666,377 (the '377 patent) issued to Scott C. Harris.

2. On December 18, 2008, a request for *inter partes* reexamination of the '377 patent was filed by a third party requester, which request was assigned Reexamination Control No. 95/000,423 (the '423 reexamination proceeding).

3. On February 20, 2009, an order for *inter partes* reexamination was mailed in the '423 reexamination proceeding, concurrently with a first Office action on the merits.

4. On May 26, 2009, patent owner filed a response in the '423 reexamination proceeding entitled "RESPONSE TO FEBRUARY 20, 2009 OFFICE ACTION."

5. On June 22, 2009, third party requester filed comments in the '423 reexamination proceeding entitled "REQUESTER'S THIRD PARTY COMMENTS SUBSEQUENT TO BARTEX'S RESPONSE TO OFFICE ACTION."

6. On June 26, 2009, patent owner filed an application for reissue of the '377 patent, which application was assigned application number 12/493,053 (the '053 reissue application).

7. On July 23, 2009, third party requester filed, in both the '423 reexamination and '053 reissue application proceedings, a petition paper entitled "PETITION UNDER 37 C.F.R. § 1.182 AND MPEP § 2686.03(V) TO SUSPEND AND STAY THE NEWLY FILED REISSUE APPLICATION DURING THE *INTER PARTES* REEXAMINATION OF U.S. PATENT NO. 6,666,377."

8. On July 24, 2009, third party requester filed, in both the '423 reexamination and '053 reissue application proceedings, a supplemental petition paper entitled "SUBMISSION OF EXHIBITS TO PETITION UNDER 37 C.F.R. § 1.182 AND MPEP § 2686.03(V) TO SUSPEND AND STAY THE NEWLY FILED REISSUE APPLICATION DURING THE *INTER PARTES* REEXAMINATION OF U.S. PATENT NO. 6,666,377."

9. Concurrently, on July 24, 2009, the '053 reissue application was docketed to an examiner for examination. No Office action on the merits has been mailed to date for the '053 reissue application.

10. On July 31, 2009, patent owner filed, in both the '423 reexamination and '053 reissue application proceedings, a petition paper entitled "PETITION UNDER 37 C.F.R. § 1.181, § 1.182 AND § 1.183 TO STRIKE AND SEAL FEDEX CORPORATION'S PETITION PAPERS TO STAY REISSUE APPLICATION FILED ON JULY 23, 2009 AND JULY 24, 2009."

11. On August 4, 2009, the filing of the '053 reissue application was announced in the *Official Gazette*.

12. On August 10, 2009, third party requester filed a petition paper in the '423 reexamination proceeding entitled "PETITION UNDER 37 C.F.R. § 1.182 IN RESPONSE TO PATENT OWNER'S PETITION UNDER 37 C.F.R. § 1.181, § 1.182 AND § 1.183 TO STRIKE AND SEAL FEDEX CORPORATION'S PETITION PAPERS TO STAY REISSUE APPLICATION FILED ON JULY 23, 2009 AND JULY 24, 2009."

13. On August 13, 2009, patent owner filed a petition paper in the '423 reexamination proceeding entitled "PETITION UNDER 37 C.F.R. § 1.182 TO MERGE REISSUE APPLICATION AND *INTER PARTES* REEXAMINATION PROCEEDING IN ACCORDANCE WITH THE PROVISIONS OF 37 C.F.R. § 1.991." This paper is the subject of the present decision.

DECISION

A. Relevant Statutes, Regulations and Practice

35 U.S.C. § 314 provides, in part:

> (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 1.103 provides, in pertinent parts:

> (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. Any petition for suspension of action under this paragraph must specify a period of suspension not exceeding six months.
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> ****
>
> (e) *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 1.991 provides, in part:

> 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.

MPEP 2686.03 provides, in part (emphasis added):

> The general policy of the Office is that a reissue application examination and an *inter partes* reexamination proceeding will not be conducted separately at the same time as to a particular patent. ... The decision as to whether the reissue application examination and the reexamination proceeding are to be merged, or which of the two **(if any)** is to be stayed is made in the Office of Patent Legal Administration (OPLA).

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> The decision on whether to merge the reissue application examination and reexamination proceeding, or stay one of them, will be made on a case-by-case basis.

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> Where reexamination has already been ordered prior to the filing of a reissue application, the OPLA should be notified as promptly as possible after the reissue application reaches the TC, that the proceedings are ready for consideration of merger.

****

> 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 proper for comment by the reexamination third party requester. If such issues are raised, merger would ordinarily not be ordered, and one of the two proceedings stayed. In addition, consideration will also be given to the status of the reexamination proceeding. For example, if the reexamination proceeding is on appeal to the Board or to the Court of Appeals for the Federal Circuit, or a Notice of Intent to Issue a Reexamination Certificate was issued for the reexamination proceeding, that fact would be considered in making a decision whether to merge the reissue application examination and the reexamination proceeding or stay one of them.

B. Patent Owner's Request for Merger under 37 CFR 1.182

The '053 reissue application and the '423 reexamination proceeding are currently pending for the same patent. The order has been mailed pursuant to 37 CFR 1.931 for the '423 reexamination proceeding, and the '053 reissue application has been announced in the *Official Gazette* more than two months ago. Accordingly, consideration of patent owner's August 13, 2009 request for merger of the '053 reissue application and the '423 reexamination proceeding is appropriate at this time.

In support of its request for merger of the '423 reexamination proceeding and the '053 reissue application (reissue proceeding), patent owner points out that the '053 reissue application is not a broadening reissue application and asserts that "the mechanics of the merger and the prosecution of the merged proceeding should not unduly increase overall prosecution time.[1] Further in support of its request for merger of the reexamination and reissue proceedings, patent owner asserts that suspension of the '423 reexamination proceeding is "not a viable option" because the '377 patent is the subject of copending litigation that is not at an advanced stage and does not involve identical claims as the '423 reexamination proceeding.[2] Patent owner further asserts that suspension of the '053 reissue application is "not a viable option" because the '053 reissue application was filed to correct an error which rendered dependent claim 15 of the '377 patent invalid due to missing antecedent basis for a limitation in claim 15 and that "[i]t would be

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[1] *See* petition at pages 4-5.

[2] *See* petition at page 5 (asserting that these factors "all argue against suspension of the '423 reexamination proceeding.")

patently unfair to suspend reissue of a patent that is in litigation, when it is clear that at least one claim of that patent is facially invalid."[3]

Additionally, patent owner asserts that merger of the '053 reissue application and the '423 reexamination proceeding will not cause undue delay because "neither proceeding is at an advanced stage of prosecution."[4] Patent owner also asserts that conducting a merged proceeding will conserve Office and party resources, that no issues upon which third party requester could not comment would be presented in the merged proceeding, that third party requester would enjoy the rights afforded an *inter partes* reexamination requester under the rules, and that "total prosecution time would not be unduly increased, because the necessary housekeeping amendment to place identical claims in both the '053 reissue application and the '423 reexamination proceeding can be, and will be, promptly filed by patent Owner."[5]

Finally, patent owner asserts that "[m]erger will avoid the issue of whether a claim may be added in a reexamination proceeding in response to a rejection when the response otherwise does not amend any of the claims rejected in the Office action addressed by the response."[6]

C. Status of Proceedings and Claims of Record

In the '423 reexamination proceeding, an Office action was mailed on February 20, 2009, patent owner filed a "RESPONSE TO FEBRUARY 20, 2009 OFFICE ACTION" on May 26, 2009, and third party requester filed "REQUESTER'S THIRD PARTY COMMENTS SUBSEQUENT TO BARTEX'S RESPONSE TO OFFICE ACTION" on June 22, 2009. No Office action has been mailed in the '053 reissue application.

In the '423 reexamination proceeding, claims 1-23 are pending. Claims 1-22 are the original claims under reexamination and new claim 23 has been added. In the '053 reissue application, claims 1-25 are pending. Original claims 3, 9 and 15 have been amended and new claims 23-25 have been added. Thus, the claims of the '423 reexamination proceeding and the '053 reissue application are not identical.

D. Analysis and Findings

In considering patent owner's instant request for merger, the following options have been evaluated: (1) merging the '053 reissue application and '423 reexamination proceedings, (2) conducting the '053 reissue application and '423 reexamination proceedings separately and at the same time, and (3) suspending one of the '053 reissue application and '423 reexamination

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[3] *See* petition at page 6.

[4] *See* petition at page 7 (stating that the '423 reexamination proceeding is not ripe for an Office action due to outstanding issues regarding the propriety of third party requester's June 22, 2009 comments).

[5] *See* petition at page 7 (stating that the there would be no issues of claim broadening, lack of support, or indefiniteness, with respect to any original, unamended claims of the '377 patent).

[6] *See* petition at pages 7 and 9 (patent owner states that it added a new independent claim 23 in both the '423 reexamination proceeding and the '053 reissue application and that "[a]lthough Patent Owner believes that it is appropriate and proper under the reexamination statute to present a new independent claim while traversing, (i.e. not amending), rejected patent claims, the case law on this point is ambiguous.")

proceedings.

1. The Merger Option

The merger of proceedings is within the discretion of the Office. In this instance, the '053 reissue application was filed more than two years after the issue date of the '377 patent; thus, applicant/patent owner will not have the opportunity to provide broadening claims in the reissue application. However, the reissue application is subject to an entirely new examination not only on new art but also on previously applied art, whereas examination in a reexamination proceeding is limited to art that raises a substantial new question of patentability. Thus, even if the claims are not broadened in the reissue application, the examiner of a merger as proposed would need to (a) consider any grounds of rejection of the patent claims other than those based solely on prior patents and printed publications, (b) consider any grounds of rejection of the patent claims other than those based solely on art that raises a substantial new question of patentability, and (c) evaluate the adequacy and propriety of the reissue declaration. These additional issues would retard the prompt resolution of the reexamination proceeding in contradiction to the statutory mandate of 35 U.S.C. § 314(c) for special dispatch. In addition, issues pertaining to reissue (*e.g.*, a 35 U.S.C. § 112 rejection of an original patent claim), upon which the third party requester would not be permitted to comment, may arise if the reexamination and reissue application proceedings are merged as proposed, which would further complicate examination for the proposed merged proceeding.

In view of the foregoing considerations, it is not deemed beneficial to consolidate the '053 reissue application and '423 reexamination proceedings within the Office. Accordingly, patent owner's instant request under 37 CFR 1.182 for merger of the '053 reissue application and the '423 reexamination proceedings is dismissed.

2. The Option to Conduct Proceedings Separately

The general policy of the Office is that prosecution in a reissue application and in a reexamination proceeding will not be conducted separately, and at the same time, as to a particular patent.[7] The reason for this policy is to prevent inconsistent, and possibly conflicting, amendments from being introduced into the two proceedings on behalf of the patent owner, as well as to prevent unduly complicated action on, and processing of, each proceeding. In this instance, there is no compelling reason to conduct the two proceedings separately and thereby unduly complicate both. Thus, the '053 reissue application and the '423 reexamination proceedings will not be conducted separately, and at the same time, within the Office.

3. The Suspension Option

Given that the examination of the '053 reissue application and the '423 reexamination proceeding will not be merged and will not be conducted separately and at the same time, for the

[7] *See* MPEP 2686.03.

reasons stated above, the only remaining option is to suspend one of the proceedings. The question remains as to which of the two proceedings should proceed, and which should be suspended.

Initially, it is observed that there is a statutory requirement for "special dispatch" in *inter partes* reexamination proceedings pursuant to 35 U.S.C. 314(c). Because 35 U.S.C. 314(c) provides the statutory requirement that *inter partes* reexamination proceedings must be conducted with special dispatch, the examination of the '423 reexamination proceeding must take precedence in this instance.

Furthermore, in making a decision on whether or not to merge a reissue application and a reexamination proceeding, consideration is given to the status of each proceeding. *See* MPEP 2686.03.

In the '423 reexamination proceeding, an order granting reexamination was issued on February 20, 2009, accompanied by a non-final Office action rejecting the original claims of the '377 patent. A patent owner response to the Office action was filed on May 26, 2009, adding new claim 23, and third party requester comments were filed on June 22, 2009. Thus, it is not unreasonable that the next action in the '423 reexamination proceeding will be an action closing prosecution.[8] In contrast, the '053 reissue application was not filed until June 26, 2009, and the '053 reissue application was not forwarded to the Technology Center and docketed for examination until July 24, 2009. No first Office action on the merits has been issued for the '053 reissue application.

Thus, a suspension of the '053 reissue application proceeding would not result in a delay of a proceeding that has already progressed substantially toward its resolution; while a suspension of the '423 reexamination proceeding would result in such a delay, contrary to the statutory mandate for special dispatch in reexamination.

It is to be noted that no determination has been made regarding whether the '053 reissue application raises a proper error under 35 U.S.C. 251. If the '053 reissue application is suspended, such determination (*i.e.*, whether all of the requirements for a proper reissue application have been met) would be made upon reactivation of the reissue application following issuance of the reexamination certificate in the '423 reexamination proceeding. Applicant/patent owner's right to present new narrower claims and narrowing claim amendments in the '053 reissue application would be preserved, should the reissue application be deemed proper upon reactivation - as a result of what takes place in the reexamination proceeding. Moreover, if patent owner prefers not to wait to until reactivation of the '053 reissue application, patent owner may address, in the '423 reexamination proceeding, the missing antecedent basis for a limitation in claim 15, which is asserted by patent owner to render dependent claim 15 of the '377 patent invalid due to missing antecedent basis for a limitation in claim 15. Claim 15 is subject to reexamination in the '423 proceeding and, therefore, under the jurisdiction of the Central

---

[8] Following a decision on patent owner's July 31, 2009 petition paper entitled "PETITION UNDER 37 CFR §§ 1.181, 1.182 AND 1.183 TO STRIKE AND SEAL REQUESTER'S WRITTEN COMMENTS FILED ON JUNE 22, 2009" and third party requester's August 14, 2009 opposition paper entitled "THIRD PARTY REQUESTER'S PETITION TO DISMISS PATENT OWNER'S PETITION UNDER 37 C.F.R. § 1.181, 1.182, AND 1.183 TO STRIKE AND SEAL REQUESTER'S WRITTEN COMMENTS FILED ON JUNE 22, 2009."

Reexamination Unit, and addressing this issue would not raise issues requiring more than nominal consideration, and would not delay the statutorily required special dispatch in reexamination. Thus, the error in antecedent basis that is asserted to have "rendered claim 15 invalid"[9] can be corrected by way of claim amendment in the '423 reexamination proceeding.[10] And thus, patent owner's argument that "[i]t would be patently unfair to suspend reissue of a patent that is in litigation, when it is clear that at least one claim of that patent is facially invalid" has been dealt with. It should be noted, however, that such claim amendment in the '423 reexamination proceeding may result in no error remaining to support a reissue.

Based on the above, a decision is being issued concurrently herewith, *sua sponte* suspending action in the '053 reissue application pursuant to 37 CFR 1.103(e) in favor of the '423 reexamination proceeding.

CONCLUSION

1. Patent owner's August 13, 2009 "PETITION UNDER 37 C.F.R. § 1.182 TO MERGE REISSUE APPLICATION AND *INTER PARTES* REEXAMINATION PROCEEDING IN ACCORDANCE WITH THE PROVISIONS OF 37 C.F.R. § 1.991" is dismissed.

2. On an even date herewith, a decision is being mailed in the '053 reissue application *sua sponte* suspending action in the '053 reissue application.

3. Also on an even date herewith, a decision is being mailed in both the '423 reexamination and '053 reissue application proceedings refusing entry of third party requester's July 23, 2009 petition under 37 CFR 1.182 and July 24, 2009 exhibits and dismissing as moot patent owner's July 31, 2009 petition under 37 CFR 1.181, 1.182 and 1.183.

4. Also on an even date herewith, a decision is being mailed in the '423 reexamination proceeding expunging third party requester's August 10, 2009 petition under 37 CFR 1.182 as an improper paper.

5. Telephone inquiries relating to the examination of the '053 reissue application should be directed to the primary examiner, Daniel Walsh, at (571) 272-2409.

---

[9] *See* petition at page 6 and section B on pages 4and 5 of this decision.

[10] In this instance, the amendment to claim 15, which was filed in the '053 reissue application to correct antecedent basis, does not enlarge the scope of the patent's coverage as the '053 reissue application was filed more than two years after the '377 patent issued and, therefore, is not a broadening reissue application. *See Cordis Corp. v. Medtronic Ave, Inc.*, 511 F.3d, 1157, 1185 (Fed. Cir. 2008) (stating "Claims added under either clause [of 35 U.S.C. 305] must satisfy section 305's substantive limitation, which prevents patent owners from adding new claims that enlarge the scope of the patent's coverage. ... Section 305 does not require the patent owner to include an express statement that the new claims distinguish the prior art or remarks indicating how the new claims distinguish the prior art references. If the claims fail to distinguish the prior art, the claims will be rejected on the appropriate grounds; for that reason, it may frequently be in the patent owner's interest to include such remarks, but they are not necessary to satisfy section 305. For purposes of assessing validity under section 305, the MPEP directs the examiner to determine only whether any added claims impermissibly "enlarge the scope of the original claims." 37 C.F.R. § 1.552(b).").

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,423	12/18/2008	6666377	Bartex-Reexam	8648

23844 7590 05/14/2010

SCOTT C HARRIS
Law Office of Scott C Harris, Inc
P O BOX 1389
Rancho Santa Fe, CA 92067-1389

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 05/14/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patents and Trademark Office
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Alexandria, VA 22313-1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

Date:

MAILED

MAY 14 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000423
PATENT NO. : 6666377
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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SCOTT C HARRIS Law Office of Scott C Harris, Inc P O BOX 1389 Rancho Santa Fe CA 92067-1389	:	(For Patent Owner)
Jeffrey A, Berkowitz FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413	:	(For Third Party Requester)
In re: Harris *Inter Partes* Reexamination Proceeding Control No. 95/000,423 Deposited on: 18 December 2008 For: US Patent No. 6,666,377 B1	:	CORRECTED DECISION GRANTING PETITION FOR EXTENSION OF TIME [37 CFR § 1.956 and § 1.181]

MAILED

MAY 14 2010

CENTRAL REEXAMINATION UNIT

This is a corrected decision on the 28 April 2010, "Petition for Extension of Time (37 C.F.R. § 1.956 and MPEP § 2665)" requesting that the time for responding to the Action Closing Prosecution mailed 30 March 2010, be extended by one (1) month. The petition was timely filed. This decision corrects the incorrectly calculated due date.

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 23 December 2003 US patent No. 6,666,377 was granted to Scott C. Harris.

2. On 18 December 2008 a request for reexamination was deposited by a third party requester for *Inter Partes* Reexamination with the Office.

3. On 20 February 2009 an Order Granting Request for *Inter Partes* Reexamination was mailed.

4. On 30 March 2010 an Action Closing Prosecution was mailed setting the time for response at one (1) month.

5. On 28 April 2010 the instant petition for a one (1) month extension of time was submitted by the patent owner's representative.

Discussion

The Patent Owner's representative requests the period of time to be extended in which to file a response to the Office action mailed 30 March 2010, which set a one (1) months date for filing a response thereto. The Office action is an Action Closing Prosecution. The petition for extension of time was timely filed on 28 April 2010, 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.

> **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 patent owner's representative petitions under 37 CFR § 1.956 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 Action Closing Prosecution was mailed 30 March 2010. The patent owner submitted a timely filed the petition on 28 April 2009 with the appropriate fee. The petitioner notes concurrently filed petitions as support for "sufficient cause" for extension of time. The petitioner is reminded that the mere filing of a petition will not stay any period for reply that may be running, nor act as a stay of proceedings. The petitioner further notes the need to collect evidence for support of a declaration under 37 CFR § 1.131. It is noted that this was the same reasoning given for petition for extension of time filed 08 April 2009. On balance, the petitioner has demonstrated "sufficient cause" to grant a one (1) month extension of time.

The petition request to extend the response time by one (1) month is hereby granted.

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 30 March 2010 is hereby **granted**

2. The period for response is extended by one (1) month.

3. The Patent Owner's response is due **30 May 2010.**

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

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

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

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

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

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

/Mark Reinhart/
for

Gregory Morse,
Director,
Central Reexamination Unit

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BERENATO, WHITE, & STAVISH
SUITE 240
6650 ROCK SPRING DRIVE
BETHESDA, MD 20817

(For Patent Owner)

MAILED

JUL 24 2009

CENTRAL REEXAMINATION UNIT

JAMES J. FOSTER
WOLF, GREENFIELD, & SACKS, P.C.
600 ATLANTIC AVENUE
BOSTON, MA 02210-2211

(For Requesters)

Ex parte Reexamination Proceeding
Control No. 90/009,292
Filed: October 2, 2008
For: U.S. Patent No. 7,220,022

Inter Partes Reexamination Proceeding
Control No. 95/000,425
Filed: December 23, 2008
For: U.S. Patent No. 7,220,022

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.

Copied from 90009292 on 10/29/2009

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 7,220,022 (the '022 patent) issued to Allen *et al.* on May 22, 2007.

2. A request for *ex parte* reexamination of claims 1-25, 27-33, 35-59, 61-67, and 69-70 of the '022 patent was filed on October 2, 2008, by third party requester James J. Foster. The resulting reexamination proceeding was assigned control number 90/009,292 (the '9292 *ex parte* proceeding).

3. A request for *inter partes* reexamination of claims 1-25, 27-33, 35-59, 61-67, and 69-70 of the '022 patent was filed on December 23, 2008, by third party requester New England Pottery, the real party in interest, and the request was assigned control number 95/000,425 (the '425 *inter partes* proceeding).

4. On October 30, 2008, *ex parte* reexamination was ordered for claims 1-25, 27-33, 35-59, 61-67, and 69-70 of the '022 patent based on the examiner's determination that the October 2, 2008 request raised a substantial new question of patentability affecting these claims.

5. On February 17, 2009, *inter partes* reexamination was ordered for claims 1-25, 27-33, 35-59, 61-67, and 69-70 of the '022 patent based on the examiner's determination that the December 23, 2008 request raised a substantial new question of patentability affecting these claims.

6. There has been no further Office action in either the '425 *inter partes* proceeding or the '9292 *ex parte* proceeding. The time period for filing a patent owner's statement in the '9292 *ex parte* proceeding has expired.

DECISION

I. MERGER OF PROCEEDINGS

37 CFR 1.989 provides:

> (a) If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the merged examination will normally result in the issuance of a single reexamination certificate under § 1.997.
>
> (b) An *inter partes* reexamination proceeding filed under § 1.913 which is merged with an *ex parte* reexamination proceeding filed under § 1.510 will result in the merged proceeding being governed by §§ 1.902 through 1.997, except that the rights of any third party requester of the *ex parte* reexamination shall be governed by §§ 1.510 through 1.560.

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As evidenced by the above review of facts, both the '9292 and the '425 reexamination proceedings are currently pending. An order granting reexamination of claims 1-25, 27-33, 35-59, 61-67, and 69-70 of the '022 patent has been mailed in each of the reexamination proceedings, and the time for filing a patent owner's statement has expired in the '9292 *ex parte* proceeding. Therefore, consideration of merger pursuant to 37 CFR 1.989 is appropriate at this time.

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 95/000,425 and 90/009,292 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. Patent owner is required to maintain the same claims (and specification) in both files throughout the merged proceeding.

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

The present decision merges an *ex parte* reexamination proceeding with an *inter partes* reexamination proceeding. Pursuant to 37 CFR 1.989(b), the merged proceeding is governed by 37 CFR 1.902 through 1.997, except that the rights of the third party requester of the *ex parte* reexamination are governed by 37 CFR 1.510 through 1.560. In this instance, New England Pottery LLC has full *inter partes* reexamination participation rights. The examiner will conduct reexamination in the merged proceeding for claims 1-25, 27-33, 35-59, 61-67, and 69-70 of the '022 patent.

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.

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

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

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

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

By EFS:

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

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

C. Amendments:

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

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

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

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D. Fees:

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

E. Citation of Patents and Printed Publications:

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

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/000,425 and *ex parte* Reexamination Control No. 90/009,292 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 Michael Cygan, Legal Advisor, at 571-272-7700.

Pinchus M. Laufer
Legal Advisor
Office of Patent Legal Administration

Copied from 90009292 on 10/29/2009

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UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,428	01/22/2009	6818020		5713

530 7590 06/08/2009

LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK
600 SOUTH AVENUE WEST
WESTFIELD, NJ 07090

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/08/2009

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

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

HUNTON & WILLIAMS, LLP

INTELLECTUAL PROPERTY DEPARTMENT

1900 K STREET, NW SUITE 1200

WASHINGTON, DC 20006-1109

MAILED

JUN 08 2009

CENTRAL REEXAMINATION UNIT

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

REEXAMINATION CONTROL NUMBER *95/000,428*.

PATENT NUMBER *6818020*.

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.

UNITED STATES PATENT AND TRADEMARK OFFICE

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Alexandria, VA 22313-1450
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Raymond W. Augustin
Lerner, David, Littenberg,
Krumholz & Mentlik, LLP
600 South Avenue West
Westfield, New Jersey 07090

For Patent Owner

MAILED

JUN 08 2009

CENTRAL REEXAMINATION UNIT

Jeff B. Vockrodt
Hunton & Williams LLP
Intellectual Property department
1900 K Street, N.W. Suite 1200
Washington, DC 20006-1109

For Requester

Ex Parte Reexamination Proceeding
Control No. 95/000,428
Filed: January 22, 2009
For: US Patent No. 6,818,020

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

This is a decision on the petition filed May 21, 2009 to request a two-month extension of time pursuant to 37 CFR 1.956 for filing a response to the Office action mailed April 9, 2009.

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

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

Decision

The Patent Owner requests an extension of time in which to file a response to the Office action dated April 9, 2009, which set a two-month date for filing a response thereto. The Office action is a non-final Office action. The request is timely filed and includes authorization to debit a deposit account for the $200.00 petition fee as required by 37 CFR 1.17(g).

37 CFR 1.956 (c) states:

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

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

> Evaluation of whether "sufficient cause" has been shown for an extension must be made by **balancing** the desire to provide a fair opportunity to respond, **against** the requirement of the statute, 35 U.S.C. 314 (c), that the proceedings be conducted with special dispatch.
>
> Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor.

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

The petition for extension of time states that the extension will allow for time for the USPTO to rule on the Petition to Suspend filed on May 13, 2009 and provide their prosecution counsel time to prepare a response to the Office action of April 9, 2009. Additionally, the extension will allow time for the District Court to resolve the dispute as to litigation counsel's participation.

Analysis and Findings

On balance, it is considered that the petition lacks the "sufficient cause" for an extension of time. 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. When balanced against the

requirement of 35 USC 314(c) that this proceeding be handled with special dispatch, Owner's showing is inadequate to justify the grant of a two-month extension of time in which to file a response to the Office action. Accordingly, the response is due June 9, 2009. Patent Owner should expect that future requests for extensions will not be granted absent strong and compelling reasons that establish the existence of an extraordinary situation necessitating the additional time. Patent Owner should also note that Petitions to Suspend are not granted when a reply is outstanding. See 37 CFR 1.103(a).

Conclusion

1. The Patent Owner's petition for extension of time in which to file a response to the Office action of April 9, 2009 is **dismissed**.

2. The Patent Owner's response is due June 9, 2009.

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
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for Deborah Jones

Gregory Morse,
Director, Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,428	01/22/2009	6818020		5713

530 7590 07/06/2009

LERNER, DAVID, LITTENBERG,
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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 07/06/2009

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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Date:

MAILED

JUL 06 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000428
PATENT NO. : 6818020
TECHNOLOGY CENTER : 3999
ART UNIT : 3993

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

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

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

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

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MAILED

JUL 06 2009

CENTRAL REEXAMINATION UNIT

In re Sun *et al.*
Reexamination Proceeding
Control No. 95/000,428
Filed: January 22, 2009
For: U.S. Patent No. 6,818,020

: DECISION
: DISMISSING
: PETITION

This is a decision on patent owner's May 13, 2009 patent owner petition entitled "PETITION TO SUSPEND 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 was charged to petitioner's Deposit Account 12-1095 on May 14, 2009, pursuant to the authorization for same in patent owner's EFS-WEB fee transmittal.

The petition is before the Office of Patent Legal Administration (OPLA) for decision.

The petition is dismissed for the reasons set forth below.

BACKGROUND

1. On November 16, 2004, the Office issued U.S. Patent No. 6,818,020 (the '020 patent) to Sun *et al.*

2. A request for *inter partes* reexamination of all the claims (claims 1-12) of the '020 patent was filed by third party requester (requester) Smith & Nephew Inc and Zimmer Inc., on January 22, 2009. The request was assigned Control No. 95/000,428 (the '428 proceeding).

3. The '020 patent is subject to litigation in the United States District Court for the District of New Jersey, in *Howmedica Osteonics Corp. v. Zimmer, Inc. et al.*, {Civil Action No.

2:05-cv-00897-WHW-SDW}. The initial complaint was filed February 15, 2005. Based upon the initial complaint, patent owner appear to be enforcing at least one of '020 patent claims 1-12 against the requester in the litigation.

4. On April 9, 2009, the Office issued an order granting the '428 request for reexamination of all of the '020 patent claims. A first Office action on the merits concurrently issued with the order granting reexamination.

5. On May 13, 2009, patent owner filed the present petition, citing 35 U.S.C. § 314(c) and 37 CFR 1.987, and requesting suspension of the '428 *inter partes* reexamination proceeding.

6. On May 27, 2009, the requester filed an opposition petition to patent owner's May 13, 2009 petition to suspend. Based upon papers filed by the third party requester, patent claims 1-3, 5-7, and 10-12 are the '020 patent claims being asserted by the patent owner in the litigation. (See Exhibit A, Plaintiff Howmedica's Responses to Zimmer's First Set of Interrogatories, p. 5, submitted concurrently with May 27, 2009 requester opposition)

7. On June 9, 2009, patent owner submitted a response to the April 9, 2009 Office action.

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 requests for suspension of *inter partes* reexamination):

> . . . . 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.

DECISION

I. Preliminary Matters

A. Proper Legal Authority and Procedural Matters Regarding the Petition

In regard to patent owner's request to suspend the '428 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. MPEP 2686.04 III provides a procedure that, if followed, facilitates the timely consideration of a petition to suspend an *inter partes* reexamination by a participant in the proceeding. Suspension will not be considered if there is an outstanding Office action. Therefore, the procedure requires (1) the filing of a response to an outstanding Office action; (2) a petition under 37 CFR 1.182 requesting a suspension of the reexamination; and (3) a petition requesting that the OPLA take jurisdiction over the proceeding to facilitate the rendering of a timely decision on the petition to suspend. 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 because, (1) while a response to an outstanding Office action was not filed concurrently with the petition to suspend, a response was subsequently filed before the OPLA took jurisdiction of the proceeding to decide the petition; (2) patent owner has presented a petition requesting suspension of the proceeding, which is a situation not specifically provided for in the regulations, and paid the fee set forth in 37 CFR 1.17(f) for a § 1.182 petition is $400 as noted above; and (3) the

OPLA has timely taken jurisdiction of the case and is now rendering a decision prior to the examiner acting on the proceeding, thus resulting in harmless error as to these matters. [1]

B. 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

[1] The failure to file a petition requesting OPLA to take jurisdiction may result in an Office action issuing before the petition for suspension can be acted upon. The recommendation to file a jurisdiction petition is only to benefit the petitioner by ensuring that the examiner does not act in the proceeding before OPLA can consider the merits of the petition to suspend.

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 through 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; <u>but once one proceeding finally ends</u>, 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. <u>Until that time, however</u>, the Office is obligated, by statutory mandate, to move forward in the *inter partes* reexamination with "special dispatch." Only "good cause" will permit the Office to deviate from that statutory mandate.

C. Introduction

Patent owner urges that, pursuant to 35 U.S.C. § 314 (c), there is good cause to suspend the '428 *inter partes* reexamination proceeding. Patent owner asserts the existence of matters raised in the concurrent litigation that are more appropriate for resolution by the courts rather than by the Office in the '428 *inter partes* reexamination proceeding. Specifically patent owner argues that suspension of the proceeding is appropriate because of: (1) The four year delay that has already

accrued in reaching a decision during the concurrent litigation; (2) The unique circumstances that exist in the proceeding which a court is better suited to address and resolve; (3) The inherent unfairness and prejudice that would occur in the proceeding because patent owner's litigation counsel cannot participate in the reexamination proceeding; and (4) The looming dispositive summary judgment motion rules the court is about to render.

The third party requester argues that all four patent owner arguments raised in support of suspension of reexamination do not merit suspension of the proceeding, and requester further asserts that patent owner's failure to follow Office procedure as outlined in MPEP 2686.04(III) warrants dismissal of the petition. In regards to patent owner's four arguments in support of suspension, they are each addressed below in the Analysis and Response to Arguments, section II and III of this decision, respectively. In regards to requester's argument that the petition should be dismissed on procedural grounds, the issue is addressed above in the Preliminary Matter section I.A of this decision.

D. 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 with both proceedings 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 as to whether 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 [2] 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. 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.[3] 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 for suspension 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 suspension criteria establish a benchmark and standard which the Office uses 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.

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[2] See the '093 and '094 proceedings, Decision Granting Petitions To Suspend, November 17, 2005

[3] *Id.*, Decision Granting Petitions to Suspend, November 17, 2005, footnote 6.

E. In the *Sony* scenario

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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. [4] 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 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

[4] *Id.*, Decision Denying Petitions, August 23, 2005, at page 6.

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.

II. Analysis

The facts and circumstances in the present '428 *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 opposition for a stay of reexamination reveals an apparent lack of congruence between the claims at issue in the litigation and the claims at issue in the present '428 *inter partes* reexamination. Exhibit A, submitted with the May 27, 2009 opposition for a stay of reexamination, contains a patent owner response to an interrogatory from the related civil action stating only claims 1-3, 5-7 and 10-12 of the '020 patent as being asserted against the defendant (requester). The requestor, in its January 22, 2009 reexamination request, requested that all of the claims, claims 1-12, be subject to a reexamination proceeding. The Office on April 9, 2009, issued an order granting the requester's January 22, 2009 request to initiate a reexamination proceeding of all the claims of the '020 patent, i.e. claims 1-12. Therefore, even if patent owner/petitioner's request for a stay of the '428 proceeding were granted to await judgment in the federal courts, it appears that not all the claims in the '428 proceeding would be disposed of by the litigation. (*i.e.* even if the patent owner prevails in the litigation, there is no showing that claims 4 and 8-9 would be addressed by the court's decision). Therefore, suspension of the '428 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 '020 patent is actually at an early stage, relative to a final disposition of the matter, despite the fact that pre-trial litigation has been on going for over four years. For example, the case is still at the pre-trial stage of summary judgment motions and briefing. Furthermore, the result of the any decision on summary judgment by the court would likely not result in a final decision regarding the claims, as the court's decision may not preclude the need for a trial phase, and even if it does so, there is the potential for an appeal. 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 still at a very early stage in regards to a final disposition on the merits of the case regarding the '020 patent. No final holding of claim validity in the litigation is forthcoming in the very near future that could justify the Director to exercise his narrow "good cause" discretion exception to the statutory special dispatch mandate to

suspend the '428 *inter partes* proceeding. In this instance, not even a District Court finding is forthcoming in the immediate future. Accordingly, good cause to suspend the '428 *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 AFTER the District Court judgment was entered in Immersion's favor in the litigation. Had Sony filed its requests for reexamination BEFORE entry of the District Court judgment, the reexamination proceedings could have been farther along in the process, and may likely have been completed at the Office before the District Court issued a decision. Further, the District Court would have had access to the Office's ongoing input via the reexamination proceedings, prior to issuing the court's decision. In the present instance, however, the requester has filed the '428 *inter partes* reexamination 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 determinations in the reexamination proceeding.

For all these reasons, patent owner's arguments are not persuasive, however in response to patent owner's arguments the following is noted:

III. Response to Patent Owner Arguments

A. In regards to Patent Owner's concern of delay

Patent owner alleges the existence of "good cause" to suspend the reexamination proceeding due to the requesters "delay" in filing a request for reexamination using the same references and similar legal lines of logic as the '428 *inter partes* reexamination proceeding. Further, it is asserted that the court will be addressing such issues in the immediate future, the court and not the Office is the better forum by which to decide such matters and the courts will do so before the conclusion of the reexamination proceeding. This is not persuasive in view of what follows.

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. [Emphasis added]

The statute permits ANY third party at ANY time to file a request for inter partes reexamination based upon ANY prior art. The statute places no limitations as to litigant status of a requester, as to the timing of filing a request relative to the filing of parallel patent litigation, nor as to the

source of the prior art cited, and parallel patent litigation and reexamination is clearly envisioned as pointed out in the above-cited case law. Therefore, patent owner's arguments in this regard are not persuasive, as there can be no "delay" in the filing of a reexamination proceeding. The existence of a parallel reexamination proceeding in no way requires a court to delay a decision in the parallel patent litigation proceeding. If a final decision does issue from a court that renders the reexamination proceeding moot, then administrative procedures exist by which the reexamination proceeding can be terminated.[5] Accordingly, patent owner's arguments that requester's filing of the request for reexamination four years after the initiation of litigation is not persuasive as a basis for "good cause" suspension of a reexamination proceeding.

B. In regards to Patent Owner's "Unique Circumstances"

Patent owner alleges the existence of "good cause" to suspend the reexamination proceeding due to the court's "better" ability to address the evidentiary challenges the issue inherent disclosure poses, as the same references are present in both proceedings. Furthermore, patent owner alleges that the law of the case in the parallel patent litigation, on these same issues of inherency merits a "good cause" suspension of the reexamination proceeding.

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 all be subject to a stay. Such a result would render the intent and mandate of Congress a nullity, because any party to an *inter partes* reexamination need merely allege the inherency doctrine in a Federal District Court to then demand a stay of the reexamination 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) 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.

Secondly what petitioner alleges as better can also be considered different and not without parallel, corollary power/force of law in a reexamination proceeding. The Office has rules in place that require 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.[6] As an *inter partes* proceeding is adversarial in nature, a third party requester is in fact incentivized to apprise the Office of additional prior art under the rules which govern *inter partes* reexamination. Also, the initiation of a new reexamination proceeding would not be precluded as long as the reference raised a substantial new question of patentability, i.e. it was not merely cumulative. Finally, while a reexamination proceeding may be limited to prior art in the form of patents and printed publications, court papers which document the evaluation of other forms of

[5] See 37 CFR 1.907(b) and MPEP 2686.04 (Revision 7, July 2008)
[6] See 37 CFR 1.933 and 1.985

prior art may be made of record in a reexamination proceeding by both parties by dint of 37 CFR 1.985. 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* rules in no way curtail or alter the use of declarations and affidavits to submit expert testimony in a reexamination proceeding. Therefore, petitioner's assertion that an present imbalance of power exists between the Federal District Court and the Office to probe the merits of an inherency allegation as being sufficient to invoke the "good cause" exception to special dispatch to justify a suspension of the reexamination proceeding is not persuasive. As pointed out, these arguments could be made in any parallel reexamination and litigation proceedings; yet the statute and case law provides for the two to be carried out at the same time, to obtain the benefits of both types of proceedings.

C. In regards to Patent Owner's concerns of "Inherent Unfairness"

Patent owner alleges the existence of "good cause" to suspend the reexamination proceeding due to inherent unfairness caused by the requester's objection to patent owner's litigation counsel participating in the reexamination proceeding, based upon a court issued protective order, while simultaneously requester's litigation counsel is participating in the reexamination proceeding. Requester, in their opposition, has stated that the disagreement between the parties on this issue is resolved, and hence any possible inherent unfairness no longer is present. Accordingly, the Office deems this argument moot. Further, the question of whether patent owner's litigation counsel can participate in the reexamination proceeding is a matter that can timely be brought before the courts, given that the statute permits parallel reexamination (with special dispatch) and litigation proceedings.

D. In regards to the court's "looming dispositive summary judgment motion rulings"

Patent owner alleges the existence of "good cause" to suspend the reexamination proceeding due to dispositive motions on validity, which are the exact same issues before the Office in the reexamination proceeding. As noted in the analysis section, the "looming dispositive summary judgment motion" rulings, are not final decisions, they do not address all the claims that are under reexamination of the present proceeding, they are subject to appeal, and any court ruling on summary judgment may include a finding that the litigation must enter the trial phase to be resolved; therefore, a pending district court ruling on summary judgment motions is insufficient to establish the existence of "good cause" to suspend a reexamination proceeding. Furthermore, patent owner alleges that if the court's rulings regarding inherent disclosure of the references at issue are in patent owner's favor then maintenance of the Office's rejections would have no merit.[7] This is not the current state of the law. *In re Trans Texas Holdings Corp.*, 498 F.3d 1290, 83 USPQ2d 1835 (Fed. Cir. 2007) and *In re Translogic Technology, Inc.*, 504 F.3d 1249, 84 USPQ2d 1929 (Fed. Cir. 2007) are two Federal Circuit decisions involving reexamination

[7] See Patent owner petition at page 6, footnote 2

proceedings where the court affirmed the Office's rejections, even though parallel district court proceeding upheld the claims as valid and infringed.

In *Trans Texas*, the patent being reexamined was subject to an infringement suit, in which the district court had issued its claim construction ruling (in a district court opinion) as to the definition of a term. The parties ultimately reached a settlement before trial, and the district court issued an "Order of Dismissal with Prejudice." The patent owner relied on that district court claim construction ruling in a reexamination proceeding, and argued that the Office was bound by that district court claim construction ruling, under the doctrine of issue preclusion. The Federal Circuit stated that issue preclusion could not be applied against the Office based on a district court holding in an infringement proceeding, since the Office was not a party to that earlier infringement proceeding.

In *Translogic*, a district court infringement suit proceeded in parallel with a reexamination proceeding. The district court upheld the validity of the patent in the infringement suit, while the reexamination examiner found the claim combination to be obvious. The examiner's rejection was affirmed by the Board of Patent Appeals and Interferences (Board). The defendant (the alleged infringer) of the infringement suit appealed the district court decision to the Federal Circuit, while the patent owner appealed the Board's decision to the Federal Circuit. The Federal Circuit consolidated the appeals, and then addressed only the patent owner's reexamination appeal from the Board. The Federal Circuit affirmed the examiner's conclusion of obviousness by relying upon and providing an extensive discussion of *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 82 USPQ2d 1385 (2007).

Accordingly, the petition to stay the '428 *inter partes* reexamination is dismissed.

CONCLUSION

1. The May 13, 2009 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

07-1-09 C:\kiva\kenpet7\IP\suspend\

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.
95/000,428	01/22/2009	6818020		5713

530 7590 03/02/2010

LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK
600 SOUTH AVENUE WEST
WESTFIELD, NJ 07090

EXAMINER

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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United States Patent and Trademark Office
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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

HUNTON & WILLIAMS, LLP

INTELLECTUAL PROPERTY DEPARTMENT

1900 K STREET, NW SUITE 1200

WASHINGTON, DC 20006-1109

MAILED

MAR 02 2010

CENTRAL REEXAMINATION UNIT

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

REEXAMINATION CONTROL NUMBER *95/000,428*.

PATENT NUMBER *6818020*.

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.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

RAYMOND W. AUGUSTIN (For Patent Owner)
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Jeff B. Vockrodt (For Third Party
Hunton & Williams, LLP
Intellectual Property Department
1900 K Street, NW Suite 1200
Washington, D.C. 20006-1109

MAILED

MAR 02 2010

CENTRAL REEXAMINATION UNIT

In re: Sun et al.
Inter Partes Reexamination Proceeding
Control Number: 95/000,428
Filed: January 22, 2009
For: U.S. Patent 6,818,020

DECISION GRANTING PETITION TO EXPUNGE PAPERS UNDER 37 CFR 1.59(b)

This is a decision on the petition of July 8, 2009 filed by the Patent Owner under 37 CFR 1.59(b) requesting that unintentionally submitted and quoted confidential papers filed June 9, 2009, be expunged from the *inter partes* reexamination proceeding.

The petition requesting expunging of confidential papers under 37 CFR 1.59(b) and MPEP 724.05 is **GRANTED**.

Legal Standard

37 CFR §1.59(b) reads in part:

An applicant may request that the Office expunge information, other than what is excluded by paragraph 9(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 724.05 reads in part:

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 indication 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).

Analysis and Findings

In Patent Owner's response dated June 9, 2009 filed in response to the non-final Office action mailed April 9, 2009, Respondents unintentionally submitted and quoted from a document designated as confidential by Requester Smith & Nephew under the Protective Order in the co-pending litigation in the District of New Jersey. Smith & Nephew is a named defendant charged with infringement in that lawsuit. Requesters first informed Respondents on July 6, nearly one month later, of this unintentional submission. Respondents respectfully petition to expunge the unintentionally submitted confidential information under 37 CFR §1.59(b) and MPEP §724.05.

In particular, Exhibit 23 to the Declaration of Lisa Pruitt and Exhibit 26 to the Declaration of Stephen Li (the same document, bearing Bates No. SN-045270-276) is a document designated confidential by Requester Smith & Nephew. Dr. Li's and Dr. Pruitt's declarations contain confidential information from this document. (See Li Decl. at ¶144; Pruitt Decl. at ¶119.) Smith & Nephew alleges that the document contains its confidential information. As submitted, SN-045270-276- is marked "Outside Attorney Eyes Only," as are all other documents that were produced by Smith & Nephew prior to the entry of the Protective Order (Exhibit A) in the pending lawsuit. Once the Protective Order was entered, Smith & Nephew designated its documents marked "Outside Attorney's Eyes Only." The documents were then re-designated as "Confidential" or non-confidential (public). The documents themselves, however, were never re-marked to show the correct designation. Patent Owner submitted SN-045270-276 with the mistaken belief that it was one of the numerous Smith & Nephew production documents re-designated as non-confidential.

The failure to obtain the return of these confidential document and information would irreparably harm Requester Smith & Nephew.

To the best of Respondent's knowledge, SN-045270-276 and certain information contained therein has not otherwise been made public.

Respondents have committed to retaining the unintentionally submitted document for the period of the patent under reexamination.

According to the Patent Owner, the information contained in this document and disclosed in the Declarations of Dr. Li and Dr. Pruitt is not itself material to patententability of the '020 patent under reexamination. Instead, SN-045270-276 (1) is merely a supportive document, (2) the information contained therein supports, rather than refutes, patentability, and (3) the information is consistent with Respondents' position in opposing an argument of unpatentability or in asserting patentability. See 37 CFR §1.555(b) (2).

Repondents submit that the Office can return the un-redacted version of the Declarations to Respondents, and substitute the redacted versions in the reexamination proceeding.

Finally, the petition fee of $200 as set forth in 37 CFR 1.17(g) has been paid.

The Patent Owner has paid the petition fee and has established that the designated documents should be expunged according to 37 CFR 1.59(b). Furthermore, the Patent Owner has also met requirements (A) through (E) of MPEP 724.05.

Conclusion

1. The Patent Owner's petition requesting that the confidential document and quotations therefrom be expunged under 37 CFR 1.59.(b) is **GRANTED**.

2. Exhibit 23 to the Declaration of Lisa Pruitt and Exhibit 26 to the Declaration of Stephen Li have been closed out of IFW and is no longer available to the public. This "closing out" process is considered to be the equivalent of actually returning the papers to the Respondent.

3. Response may be submitted as follows:

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

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

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

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

Deborah Jones

Deborah Jones, Supervisory Patent Examiner
Art Unit 3991

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,431	01/29/2009	6,663,347	038569/340597	5913

71274 7590 03/18/2009

BORGWARNER INC. C/O PATENT CENTRAL LLC
1401 HOLLYWOOD BOULEVARD
HOLLYWOOD, FL 33020-5237

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/18/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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(For Patent Owner)

BORGWARNER INC.
C/O PATENT CENTRAL LLC
1401 HOLLYWOOD BOULEVARD
HOLLYWOOD, FL 33020-5237

MAILED

MAR 18 2009

CENTRAL REEXAMINATION UNIT

(For Third Party Requester)

ALTON & BIRD LLP
BANK OF AMERICA PLAZA
101 SOUTH TRYON STREET, SUITE 4000
CHARLOTTE, NC 28280-4000

In re Decker et al.	:	
Inter Partes Reexamination Proceeding	:	DECISION ON
Control No. 95/000,431	:	PETITION UNDER
Filed: January 29, 2009	:	37 CFR 1.181 & 1.927
For: U.S. Patent No. 6,663,347	:	

The third party request filed a paper on March 9, 2009, entitled "Petition Under 37 C.F.R. § 1.181(a)(1) and 1.927 to Review Order Denying *Inter Partes* Reexamination," (hereinafter the Petition). The Petition is before the Director of the Central Reexamination Unit (CRU). Petitioner, the reexamination requester, seeks review of the Order Denying Request for *Inter Partes* Reexamination mailed February 27, 2009.

The Petition is **GRANTED**.

REVIEW OF FACTS

1. U.S. Patent No. 6,663,347 (hereinafter, the '347 patent) issued on December 16, 2003.

2. A request for *ex parte* reexamination was filed by a third party requester, Honeywell International, Inc., on March 18, 2008. The resulting reexamination proceeding was assigned Control No. 90/009,085 (hereinafter, the '085 proceeding). Reexamination was requested for claims 1-7 of the '347 patent based upon a SAE Technical Paper 790278 to Kahn et al, U.S. Patent No. 5, 124,105 to Broughton et al., JP 62-11717 to Yoshinaga et al, U.S. Patent No. 4,706,928 to Hyll, EP 0908629 to Fuller, U.S. Patent No. 6, 164,931 to Norton et al., U.S. Patent No. 4, 808,249 to Eylon et al., and the DOD "Aerospace Structural Metal Handbook."

3. On May 16, 2008, an order granting reexamination was mailed in the '085 proceeding.

4. On October 10, 2008, a "Notice of Intent to Issue Ex Parte Reexamination Certificate" was mailed in the '085 proceeding.

5. A request for *inter partes* reexamination was filed by the same third party requestor, Honeywell International, Inc., on January 29, 2009. The resulting reexamination proceeding was assigned Control No. 95/000,431 (hereinafter, the '431 proceeding). Reexamination was requested for claims 1-7 of the '347 patent based upon EP 0728545A2 to Hofmeister et al., DoD Report No. AVRADCOM TR 80-F-10 (hereinafter "Solar"), U.S. Patent No. 4,706,928 to Hyll and DE 1806757 to Fabiani.

6. A Notice of Reexamination Request Filing Date for the '431 proceeding was issued on February 4, 2009.

7. An order denying the request for reexamination for claims 1-7 in the '431 proceeding was mailed on February 27, 2009.

8. On March 9, 2009, the third party requester filed the present Petition under 37 CFR §§ 1.181 and 1.927 in the '431 proceeding.

9. On March 17, 2009, the reexamination certificate issued in the '085 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 misinterpreted the teachings of the Solar and Hofmeister references. Specifically, the petitioner advances the examiner incorrectly concluded that the request in the '431 proceeding does not raise a substantial new question of patentability (SNQ) different from the SNQ raised in the '085 proceeding. The examiner determined that request in the '431 proceeding did not raise a SNQ different from the SNQ raised in the '085 proceeding because the teachings of Hofmeister and Solar relied upon to raise the SNQ were cumulative to the teachings relied upon in the '085 proceeding. See pages 2-4 of the order denying reexamination mailed February 27, 2009.

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 1-7 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 1-7 of the '347 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).

III. Analysis of the Request for Reexamination in the '431 proceeding

The Request in the '431 proceeding sets forth the following proposed rejection based upon a substantial new question (SNQ) of patentability:

(1) Claims 1-7 are unpatentable under 35 U.S.C. §102 or 103 over Hofmeister (with additional imitations in some dependent claims taught by U.S. Patent No. 4, 706,928 to Hyll or DE 1 806 757 to Fabiani).

(2) Claims 1-7 are unpatentable under 35 U.S.C. §103 over the Solar reference in view of Hofmeister (with additional imitations in some dependent claims taught by U.S. Patent No. 4, 706,928 to Hyll or DE 1 806 757 to Fabiani).

The Request was denied in the February 27, 2009 Order Denying Request for *Inter Partes* Reexamination, wherein the examiner maintained that a SNQ was not raised by the Hofmeister and Solar references that is different from the SNQ raised in the '085 *ex parte* proceeding. The examiner determined that the teachings of the Hofmeister and Solar references set forth in the Request were cumulative to the teachings of the prior art set forth in the request in the '085 proceeding. Therefore, the examiner stated that

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

the Request did not present a new non-cumulative technical teaching. Thus, the teachings of the Hofmeister and Solar references presented in the Request in the '431 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, page 7 states that the Solar reference teaches that compressor wheels or impellers made of predominantly titanium are well known in the art. The request cites to the Abstract and Table 3 on page 10 of the Solar reference for support. See also the first page of the claim chart attached as Appendix A. The Solar reference, as acknowledged by the examiner in the order denying reexamination, teaches use of a material "Ti-6Al-4V" in casing impellers or wheels. The examiner interpreted this material name as a chemical composition formula, which resulted in the examiner concluding that this material only contained 11.6% by weight of titanium. The examiner, therefore, concluded that the Solar reference did not meet the claim limitation of the wheel or impeller being titanium.

The petition states that the examiner misinterpreted the teaching provided by "Ti-6AL-4V" by concluding that this name is a chemical formulation of one atom of titanium, 6 atoms of aluminum, and 4 atoms of vanadium. The petition states that one of ordinary skill in the art would know that "Ti-6AL-4V" is a material that is approximately 90% by weight titanium, 6% by weight of aluminum, and 4% by weight vanadium. See pages 2-4 in the petition.

Upon review of the record, the director agrees that one of ordinary skill in the art would interpret "Ti-6AL-4V" as a material that is approximately 90% by weight titanium, 6% by weight of aluminum, and 4% by weight vanadium. This interpretation is supported by Table 3 on page 10 in the Solar reference and further corroborated by the evidence listed on pages 3-4 of the petition. Therefore, the Solar reference does teach the use of titanium in the casting process. As noted in the petition and in the order denying reexamination, the claims were indicated patentable in the prior '085 reexamination proceeding because the prior art did not teach the die inserts in combination with a titanium compressor wheel. This new technical teaching of the Solar reference, when viewed in combination with the teachings of Hofmeister, would be important to a reasonable examiner in determining the patentability of the claims because the teachings are relevant to the claim limitations stated to be lacking in the prior art of record in the '085 proceeding.

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 Solar

reference for reasons set forth above. Accordingly, the petition is granted, and reexamination is hereby ordered. None of the other issues presented in the petition are addressed in this decision; it is not necessary to do so after it is determined that at least one substantial new question has been raised by the request for reexamination, as to all the claims requested. The examiner to whom this proceeding will be assigned may wish to reevaluate whether (1) the other references cited in the request raise a substantial new question of patentability, and (2) if so, whether rejections based upon these references should be made.

CONCLUSION

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

2. Accordingly, the request for *inter partes* reexamination of claims 1-7 of the '347 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. 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

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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ALSTON & BIRD LLP. (For *Inter Partes* Requester)
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CHARLOTTE, NC 28280-4000

MAILED
AUG 07 2009
CENTRAL REEXAMINATION UNIT

In re Decker, et al.
Inter Partes Reexamination Proceeding
Control Number 95/000,431
Filed: January 29, 2009
For: U.S. Patent No. 6,663,347

DECISION DISMISSING PETITION TO SUSPEND

This is a decision on the April 13, 2009 Patent Owner petition under 37 CFR 1.181, 1.182 and 1.183 requesting that the *inter partes* reexamination of March 30, 2009 of U.S. Patent No. 6,663,347 (the "347' patent") be suspended. In addition, on April 23, 2009, Third Party Requester filed a paper in opposition to Patent Owner's petition

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

For the reasons discussed below, the petition to suspend is **dismissed**.

REVIEW OF FACTS

1. U.S. Patent No. 6,663,347 issued to Decker, et al. on December 16, 2003.

2. The inventors of record for the '347 patent, David Decker and Steve Roby, assigned their entire rights in the '347 patent to Patent Owner in an assignment dated June 4, 2001, and recorded in the Office on August 27, 2001.

4. Assignment records maintained by the Office do not reveal that there was any other assignment associated with the '347 patent.

5 A request for *inter partes* reexamination of the '347 patent was filed by Third Party Requester on January 29, 2009, and was assigned reexamination control no. 95/000,431 (the '431 proceeding).

6. On March 18, 2009, reexamination was ordered. To date, no Office action has been mailed in the '431 proceeding.

7. On April 13, 2009, Patent Owner filed the instant petition under 37 CFR 1.181, 1.182 and 1.183 requesting that the *inter partes* reexamination of the '347 patent be suspended, based upon Patent Owner's position that Third Party Requester had an ownership interest in the '347 patent.

8. On April 23, 2009, Third Party Requester filed a petition under 37 CFR 1.183, in opposition to Patent Owner's petition along with a Statutory Disclaimer and Public Dedication under 35 USC 253 and 37 CFR 1.321(a) and an Assignment and License Back dated July 1, 2003.

9. A Title Report was filed with the Office on February 4, 2009, reflecting the assignment from Decker and Roby to Patent Owner.

10. A statement under 37 CFR 3.73(b) was never filed during the prosecution of the '347 patent.

11. There is ongoing litigation between Patent Owner and Third Party Requester in the case *BorgWarner Inc. v. Honeywell International.*, Case No.1:07CV184 MR- DLH (W.D. N.C.).

STATUTES AND REGULATIONS

37 CFR 1.4(c) provides:

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

37 CFR 1.181 provides in relevant 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 1.182 provides:

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

37 CFR 1.183 provides:

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

37 CFR 1.913 provides:

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

37 CFR 1.939 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 an *inter partes* reexamination.

37 CFR 1.987 provides:

If a patent in the process of *inter partes* reexamination is or becomes involved in litigation, the Director shall determine whether or not to suspend the *inter partes* reexamination proceeding.

DECISION

As Third Party Requester points out, all reexamination proceedings are to be conducted with special dispatch. See 35 U.S.C. 305 (*ex parte* reexamination) and 35 U.S.C. 314(c) (*inter partes* reexamination). However, unlike *ex parte* reexamination, the *inter partes* reexamination statute allows the Director to proceed by other than special dispatch if good cause be shown. If the Director finds good cause for suspension, the Director has no statutory preclusion in suspending a proceeding for a defined, temporary period. *Ethicon v. Quigg*, 849 F. 2d. 1422 (Fed. Cir. 1998), precluded a suspension for (a) an indefinite length of time (b) in an *ex parte* reexamination, and, accordingly is not controlling authority on the present issue.

Patent Owner contends that the *inter partes* reexamination should be suspended under 37 CFR 1.987 based on the allegations that (1) there is underlying litigation between Third Party Requester and Patent Owner over the '347 patent and (2) Third Party Requester has an ownership interest in the '347 patent.

These issues will be addressed in turn:

I. Underlying Litigation Between Patent Owner and Third Party Requester

Patent Owner asks the Office to suspend the *inter partes* reexamination of the '347 patent based on co-pending litigation between Patent Owner ("Plaintiff" or "BorgWarner") and Third Party Requester ("Defendant" or "Honeywell"). In the petition, Patent Owner cites the ongoing case of *BorgWarner Inc. v. Honeywell International.*, Case No. 1:07CV184 MR-DLH (W.D. N.C.) and submits several documents filed in that matter. As stated above, the Office will only suspend a reexamination proceeding based on co-pending litigation for good cause under 37 CFR 1.987. Patent Owner has not met this burden. First, Patent Owner has not even notified the Office of the current status of the litigation. Rather, Patent Owner states that co-pending litigation with Third Party Requester is ongoing, and Patent Owner presents certain pleadings filed in that litigation, namely Third Party Requester/Defendant's "First Amended Answer to Second Amended Complaint for Patent Infringement; Counterclaim for Declaratory Relief" (the "First Amended Answer") and Patent Owner/Plaintiff's "Reply First Amended Answer to Second Amended Complaint for Patent Infringement; Counterclaim for Declaratory Relief" (the "Reply to First Amended Answer"). It is impossible for the Office to determine the status of the underlying litigation based on these documents alone. Without knowledge as to the current stage of the litigation, the Office cannot even begin to determine whether suspension of the reexamination is appropriate.

Moreover, even if the status of the litigation were clear, Patent Owner has provided no arguments that rise to the level of good cause under 37 CFR 1.987. Patent Owner's petition completely lacks factual and legal support. Rather, it appears from the face of the petition that Patent Owner wants the Office to find that good cause exists based on the mere existence of the litigation. Existence of litigation by itself does not meet the requirements of good cause under 37 CFR 1.987. C.f. *Sony Computer Entertainment America Inc. v. Dudas, 85 USPQ2d 1594; 2006 U.S. Dist. LEXIS 36856* (E.D. VA 2006). [1]

In addition, the granting of stays based upon ongoing litigation to be completed would eviscerate the statute for litigated patents, since such stays would effectively guarantee that the litigations would finish before the reexamination, thus effectively terminating the reexaminations mid-course and rendering them moot. And, suspension of an *inter partes* reexamination proceeding without cause would contravene Congress' mandate to conduct such proceedings with special dispatch.

In view of the above, Patent Owner has not met its burden of showing good cause why such proceeding should be temporarily stayed pending conclusion of the on-going litigation in the District Court proceeding.

II. Ownership Contention

Patent Owner's second argument for suspending the *inter partes* reexamination of the '347 patent is that Honeywell *might* not be a third party requester as provided by 35 U.S.C. 311 and 37 CFR 1.913, but rather a Patent Owner. Based on this assertion, Patent Owner argues that the Third Party Requester *may* have been ineligible to make the January 29, 2009 request for *inter partes* reexamination under 37 CFR 1.913. The ownership rights to the '347 patent are allegedly the subject of dispute in the litigation, *BorgWarner Inc. v. Honeywell International.*, Case No. 1:07CV184 MR-DLH (W.D. N.C.), a case pending before the District Court. Patent Owner asserts that, as long as the ownership rights to the patent are still being litigated and until a court decision has been made granting priority to either Patent Owner or Third Party Requester, the *inter partes* reexamination should be suspended under 37 CFR 1.987. Patent Owner's argument is not persuasive for the reasons set forth below.

Patent Owner's only asserted evidence - that Third Party Requester has an ownership stake in the '347 patent - is an assertion made by Third Party Requester in its First Amended Answer, submitted to the District Court, that "[Patent Owner's] claims are barred, in whole or in part, because Honeywell has license rights, including an assignment of rights from Undisclosed

[1] In *Sony,* although the district court upheld the Office's determination to suspend the *inter partes* reexamination based on parallel litigation, the litigation was at a much more advanced stage than the litigation in the instant case. Specifically, the parties in *Sony* had been in litigation for two years and had conducted a jury trial before the case was appealed. At the Federal Circuit, the case had been fully briefed on the merits and was awaiting oral argument. The *inter partes* reexamination in *Sony* was initiated by the third party requester shortly after the case was appealed to the Federal Circuit, and the court held that the Office did not abuse its discretion in suspending the *inter partes* reexamination based on how far advanced the litigation had gotten and its view that "there was ample good cause to suspend the reexamination proceedings pending completion of the Federal Circuit appeal." *Sony*, 85 USPQ2d 1594, 1597. In this case, the litigation is nowhere close to that of *Sony*.

Inventor Brent Robinson."[2] This statement, however, does not prove that Third Party Requester is an actual Patent Owner. Patent Owner's reliance on this assertion by Third Party Requester is speculative and not dispositive of actual Patent Owner rights. Patent Owner has not submitted any additional documentation or evidence indicative that the patent rights for the '347 patent properly belongs to Honeywell. Without more proof that Third Party Requester is a patent owner, the Office cannot suspend the *inter partes* reexamination under 37 CFR 1.987.

In addition, there is nothing in the Patent Office records indicating that Honeywell has been assigned patent rights to the '347 patent from "undisclosed inventor" Brent Johnson. The Office records on the Image File Wrapper reveal that Steven Roby and David Decker are the only inventors of this patent. Moreover, the assignment records maintained by this Office reflect that Roby and Decker assigned their rights to the patent application to Patent Owner BorgWorner on June 4, 2001. That assignment was recorded in the Office on August 27, 2001. No other assignments have been made with respect to the '347 patent. Also, Honeywell never filed a 3.73(b) statement in this matter indicating that it had the right to prosecute the application of the '347 patent. Instead, Honeywell filed a statutory disclaimer under 35 USC 253 and 37 CFR 1.321(a) along with its opposition response disclaiming all rights it may have had in the '347 patent. Thus, based on Office records, BorgWorner, not Honeywell, is the owner of the '347 patent.

An Assignment and License Back ("Assignment") dated July 1, 2003, has been submitted by Third Party Requester along with its opposition petition, between unknown entity B&R Mold, Inc., Brent Robinson and Steve Reigel and Honeywell; this Assignment is insufficient proof that Honeywell has ownership rights. Although the Assignment provides that B&R Mold, Robinson and Reigel hereby "sell, assign, quitclaim and transfer to Honeywell International, Inc...the entirety of whatever rights, titles, and/or interests [they] ***may*** have in or to any and all inventions disclosed in, claimed in or supported by the following patent applications, which are also attached in Exhibit A..." (emphasis added), the Assignment goes on to list only U.S. pre-grant publications ("PG Pubs"), a European Patent Application and a Japanese Patent Application. There is nothing in the Assignment that makes reference to the '347 patent or its underlying patent application. Thus, the Assignment does not show that it conferred patent rights in the '347 patent to Honeywell. Also, the petition does not provide evidence establishing that entity B&R Mold, Inc., Brent Robinson and/or Steve Reigel had rights in the patent to assign. Because Patent Owner has not presented persuasive evidence as to Honeywell's ownership rights in the '347 patent, the Office is relying on its own records to determine the ownership of the '347 patent. Patent Owner is free to renew its petition for suspension of the *inter partes* reexamination if the District Court makes a final determination of Requester's present ownership in the '347 patent or presents other new evidence of Honeywell's ownership.

III. Impropriety of Petition

The Patent Owner's petition is filed under 37 CFR 1.181, 1.182 and 1.183. The filing of a single paper directed to separate matters is improper under 37 CFR 1.4(c). 37 CFR 1.4(c) requires separate submissions for each separately distinct and different matter. It is to be noted that relief

[2] See First Amended Answer, p17.

under 37 CFR 1.181 (presumably based upon the Office's grant of a filing date for the *inter partes* reexamination request filed by a part owner), and relief under 37 CFR 1.182 and 1.183 (for suspension) are considered by a separate parts of the Office.

IV. Consideration of Papers

Patent Owner's and Requester's petitions were both filed before the first office action on the merits in the '431 reexamination proceeding. Under 37 CFR 1.939, no paper may be filed with the Office prior to the first office action in an *inter partes* reexamination unless specifically authorized. However, both petitions were filed under 37 CFR 1.183, and 37 CFR 1.939 is hereby waived to address the issue that was brought before the Office.

CONCLUSION

1. The petition is **dismissed**.
2. Jurisdiction over the proceeding is returned to the Central Reexamination Unit.
3. Telephone inquiries with regard to this decision should be directed to Kery Fries, Senior Legal Advisor, at (571) 272-7757.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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C/O PATENT CENTRAL LLC
1401 HOLLYWOOD BOULEVARD
HOLLYWOOD FL 33020-5237

(For Patent Owner)

MAILED

OCT 26 2009

CENTRAL REEXAMINATION UNIT

ALSTON & BIRD LLP.
101 SOUTH TRYON STREET, SUITE 4000
CHARLOTTE, NC 2820-4000

(For Third Party Requester)

In re *Decker et al.*	:	
Inter partes Reexamination Proceeding	:	**DECISION DENYING**
Control No: 95/000,431	:	**PETITION TO SUSPEND**
Filing Date: January 29, 2009	:	***INTER PARTES* PROCEEDING**
For: U.S. Patent No.: 6,663,347	:	

This is a decision on the patent owner petition filed on August 18, 2009, entitled "Petition To the Director Under 37 C.F.R. § 1.183 and § 1.987." (the "Petition".) In addition, third party requester filed a paper on September 1, 2009, entitled "Requester's Opposition to Patent Owner's Renewed Petition to Suspend *Inter Partes* Reexamination" (the "Opposition").

The Petition, Opposition, and *inter partes* reexamination control number 95/000,431 are before the Office of Patent Legal Administration for consideration as to whether the relief requested by patent owner is to be granted.

The patent owner's petition is **denied** for the reasons below, and reexamination will continue with special dispatch.

This decision is designated as a final agency action under 5 U.S.C. § 704.

BACKGROUND

1. Patent number 6,663,347 (the '347 patent) issued on December 16, 2003, with claims 1-7.

2. The '347 patent is the subject of a concurrent proceeding styled *BorgWarner v. Honeywell International, Case No. 1:07CV184 MR-DLH (W.D.N.C.)*. The complaint was filed on May 30, 2007.

3. On January 29, 2009, a third party, Honeywell International, filed a request for *inter partes* reexamination of claims 1-7 that was assigned control no. 95/000,431(the '431 proceeding).

4. On March 18, 2009, reexamination was ordered in the '431 proceeding for claims 1-7 of the '347 patent.

5. On April 13, 2009, patent owner filed a petition under 37 CFR §§ 1.181, 1.182, and 1.183, to suspend the '431 proceeding.

6. On April 23, 2009, third party requester filed a petition entitled "Requester's Opposition to Patent Owner's Petition to Suspend *Inter Partes* Reexamination."

7. On August 8, 2009, the Office issued a decision dismissing patent owner's April 13, 2009 petition to suspend the '431 proceeding.

8. On August 18, 2009, patent owner filed the instant petition, entitled "Petition To the Director Under 37 C.F.R. § 1.183 and § 1.987."

9. On September 1, 2009, third party requester filed a petition entitled "Requester's Opposition to Patent Owner's Renewed Petition to Suspend *Inter Partes* Reexamination."

DECISION

I. Pertinent Regulations

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 '347 patent, being conducted in the U.S. District Court for the Western District of Northern Carolina. Petitioner patent owner requests that this *inter partes* reexamination proceeding be suspended pending completion of the concurrent proceeding. The action at the district court remains open, with discovery and a Markman hearing completed, and the deadline for pretrial motions having been set at November 2, 2009. Patent owner petition, exhibit B, at 2-3.

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.)*

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 asserts that termination or suspension of this proceeding is proper because the

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[1] *Ethicon v. Quigg, 849 F.2d 1422 (Fed. Cir. 1988)*
[2] *Id. at 1425*

reexamination request was filed nearly twenty months after suit was filed for infringement of the '347 patent. As phrased by patent owner, "Honeywell chose its horse to ride well before filing the Request [for *inter partes* reexamination]." Patent owner petition at 5.

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 trial information set forth in the petition show that the discovery phase has just been completed, and the pretrial motions will be due on November 2, 2009. There has been no decision on the claims, let alone a final decision following exhaustion of all appeals. Even further, any final decision that could be rendered would not bear on all of the claims that are under reexamination in this proceeding, which include claims 1-7 of the '347 patent, since invalidity is contended only for claims 1, 3, and 7 of the '347 patent.[3] Regardless of the outcome of the court proceedings on claims 1, 3, and 7, reexamination will continue for claims 2 and 4-6.

Good cause for suspension has not been shown. For *inter partes* reexamination, 35 U.S.C. 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 continued with special dispatch in accordance with § 314. The related court proceeding is still in the pretrial motions phase. 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 that would bear on the validity of claims 1, 3, and 7 of the '347 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 the court proceeding, 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, and, in any case, the district court has stated that a previous motion for stay of the lawsuit was denied "without prejudice to refiling it in the event that the USPTO takes action which indicates a high likelihood that the claims . . . will be invalidated or substantially modified." Patent owner's petition, exhibit C, page 6. 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. Unlike this proceeding, in *Sony*, reexamination was limited to the claims that were being litigated. Further, a District Court decision had issued in favor of patent owner, and a final decision on appeal was on the horizon in the *Sony* fact situation, which is far from the case here. As stated in *Sony*, "a party can choose to run horses in both races," and, in the instant case, the race is far from over in the litigation.

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[3] Requester's Amended Invalidity Contentions (redacted), filed with the Information Disclosure Statement of August 31, 2009, at 1.

In view of the above, the petition is denied, and the reexamination proceeding will be continued with special dispatch within the Office.

CONCLUSION

1. The patent owner petition for suspension filed on August 18, 2009 is denied.

2. Jurisdiction over the proceeding is returned to the Central Reexamination Unit to take appropriate action on the proceeding.

3. This decision is designated as a final agency action under 5 U.S.C. § 704.

4. 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

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

10-26-09
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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.
95/000,431	01/29/2009	6,663,347	038569/340597	5913

71274 7590 06/22/2010

BORGWARNER INC. C/O PATENT CENTRAL LLC
1401 HOLLYWOOD BOULEVARD
HOLLYWOOD, FL 33020-5237

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/22/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patents and Trademark Office
P.O.Box 1450
Alexandria, VA 22313-1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
ALTON & BIRD LLP
BANK OF AMERICA PLAZA
101 SOUTH TRYON STREET, SUITE 4000
CHARLOTTE, NC 28280-4000

Date:
MAILED

JUN 22 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000431
PATENT NO. : 6663347
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)

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JUN 22 2010

CENTRAL REEXAMINATION UNIT

ALTON & BIRD LLP
BANK OF AMERICA PLAZA
101 SOUTH TRYON STREET, SUITE 4000
CHARLOTTE, NC 28280-4000

(For *Inter Partes* Requester)

Inter Partes Reexamination Proceeding
Control No. 95/000,431
Filed: January 29, 2009
For: U.S. Patent No. 6,663,347

DECISION DISMISSING PETITION

This is a decision addressing patent owner's April 13, 2010 petition paper entitled "CONDITIONAL PETITION TO SUSPEND RULE 37 CFR § 1.943 PURSUANT TO THE PROVISIONS OF 37 C.F.R. § 1.183."

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

FEES

The fee set forth in 37 CFR 1.17(f) for a petition under 37 CFR 1.183 is $400, which will be charged to petitioner's deposit account no. 16-0877, pursuant to the authorizations on pages four and five of the April 13, 2010 petition.

DISCUSSION

On April 13, 2010, patent owner filed a "RESPONSE BY PATENT OWNER PURSUANT TO 37 CFR § 1.941" with two accompanying declarations. Concurrently, on April 13, 2010, patent owner filed the instant "CONDITIONAL PETITION TO SUSPEND RULE 37 CFR § 1.943 PURSUANT TO THE PROVISONS OF 37 C.F.R. § 1.183." In the petition patent owner states that its response *in toto* contains 45 pages of substantive legal argument, which includes the remarks section of the response and one of the accompanying declarations. Patent states that "in the event that the USPTO should classify the pages differently and determine that the 50-page limit has been exceeded, it is requested that this petition be entered and considered and that the 50 page limit be waived to the extent that the USPTO considers the page limit to have been

exceeded."[1] Thus, the necessity of patent owner's request for relief is conditioned on the Office first determining that patent owner's April 13, 2010 response in fact exceeds the 50-page limit of 37 CFR 1.943(b). Facially, patent owner's April 13, 2010 response appears compliant, and currently there is no official notice of response non-compliance from the Office, of record in the 95/000,431 reexamination proceeding, which would be in need of waiver relief.[2] Accordingly, because patent owner's request for waiver of the 50-page limit of 37 CFR 1.943(b) is premature at this time, the petition is **dismissed**.

The petition to waive 37 CFR 1.943(b) is subject to renewal if a determination is made that such relief is necessary; however, such a renewed petition would not hold in abeyance any time periods for response that may be running against the parties in the 95/000,431 reexamination proceeding. Further, patent owner is directed to MPEP 2667(I)(A)(2), which provides guidance on how to determine which pages of any affidavit, declaration, attached exhibit, or drawings will be subject to the page limit requirements of 37 CFR 1.943.[3] A patent owner may make use of such guidance to determine if, and how many, pages in excess of 50 are necessary to prepare a response and make a request for waiver of the rule as to a specific number of pages.

CONCLUSION

1. The April 13, 2010 petition to waive the page limit requirement of 37 CFR 1.943(b) is **dismissed** as premature.

2. Telephone inquiries with regard to this decision should be directed to Joseph F. Weiss, Jr., Legal Advisor, Office of Patent Legal Administration, at (571) 272-7759.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examining Policy

6-21-10
Penpet8/IP/length

[1] *See* petition at page 2.
[2] The remarks/arguments section of patent owner's April 13, 2010 response is only 18 pages long, which is in compliance with the rule. It appears the accompanying declarations have not been evaluated in accordance with MPEP 2667(I)(A)(2).
[3] MPEP 2667(I)(A)(2) provides that "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 ... and is subject to the page limit requirements of 37 CFR 1.943."

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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.
95/000,433	01/29/2009	6904949	038569/340605	9014

71274 7590 08/07/2009

BORGWARNER INC. C/O PATENT CENTRAL LLC
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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 08/07/2009

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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CHARLOTTE, NC 28280-4000

Date:
MAILED
AUG 07 2009
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000433
PATENT NO. : 6904949
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)

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(For *Inter Partes* Requester)

MAILED

AUG 07 2009

CENTRAL REEXAMINATION UNIT

In re Decker, et al.
Inter Partes Reexamination Proceeding
Control Number 95/000,433
Filed: January 29, 2009
For: U.S. Patent No. 6,904,949

DECISION DISMISSING PETITION TO SUSPEND

This is a decision on the April 13, 2009 Patent Owner petition under 37 CFR 1.181, 1.182 and 1.183 requesting that the *inter partes* reexamination of March 30, 2009 of U.S. Patent No. 6,904,949 (the "949' patent") be suspended. In addition, on April 23, 2009, Third Party Requester filed a paper in opposition to Patent Owner's petition

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

For the reasons discussed below, the petition to suspend is **dismissed**.

REVIEW OF FACTS

1. U.S. Patent No. 6,904,949 issued to Decker, et al. on June 14, 2005.

2. The inventors of record for the '949 patent, David Decker and Steve Roby, assigned their entire rights in the '949 patent to Patent Owner in an assignment dated June 4, 2001, and recorded in the Office on May 25, 2007.

4. Assignment records maintained by the Office do not reveal that there was any other assignment associated with the '949 patent.

5 A request for *inter partes* reexamination of the '949 patent was filed by Third Party Requester on January 29, 2009, and was assigned reexamination control no. 95/000,433 (the '433 proceeding).

6. On March 30, 2009, reexamination was ordered. To date, no Office action has been mailed in the '433 proceeding.

7. On April 13, 2009, Patent Owner filed the instant petition under 37 CFR 1.181, 1.182 and 1.183 requesting that the *inter partes* reexamination of the '949 patent be suspended, based upon Patent Owner's position that Third Party Requester had an ownership interest in the '949 patent.

8. On April 23, 2009, Third Party Requester filed a petition under 37 CFR 1.183, in opposition to Patent Owner's petition along with a Statutory Disclaimer and Public Dedication under 35 USC 253 and 37 CFR 1.321(a) and an Assignment and License Back dated July 1, 2003.

9. A Title Report was filed with the Office on February 2, 2009, reflecting the assignment from Decker and Roby to Patent Owner.

10. A statement under 37 CFR 3.73(b) was never filed during the prosecution of the '949 patent.

11. There is ongoing litigation between Patent Owner and Third Party Requester in the case *BorgWarner Inc. v. Honeywell International.*, Case No.1:07CV184 MR- DLH (W.D. N.C.).

STATUTES AND REGULATIONS

37 CFR 1.4(c) provides:

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

37 CFR 1.181 provides in relevant 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 1.182 provides:

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

37 CFR 1.183 provides:

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

37 CFR 1.913 provides:

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

37 CFR 1.939 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 an *inter partes* reexamination.

37 CFR 1.987 provides:

If a patent in the process of *inter partes* reexamination is or becomes involved in litigation, the Director shall determine whether or not to suspend the *inter partes* reexamination proceeding.

DECISION

As Third Party Requester points out, all reexamination proceedings are to be conducted with special dispatch. See 35 U.S.C. 305 (*ex parte* reexamination) and 35 U.S.C. 314(c) (*inter partes* reexamination). However, unlike *ex parte* reexamination, the *inter partes* reexamination statute allows the Director to proceed by other than special dispatch if good cause be shown. If the Director finds good cause for suspension, the Director has no statutory preclusion in suspending a proceeding for a defined, temporary period. *Ethicon v. Quigg*, 849 F. 2d. 1422 (Fed. Cir. 1998), precluded a suspension for (a) an indefinite length of time (b) in an *ex parte* reexamination, and, accordingly is not controlling authority on the present issue.

Patent Owner contends that the *inter partes* reexamination should be suspended under 37 CFR 1.987 based on the allegations that (1) there is underlying litigation between Third Party Requester and Patent Owner over the '949 patent and (2) Third Party Requester has an ownership interest in the '949 patent.

These issues will be addressed in turn:

I. Underlying Litigation Between Patent Owner and Third Party Requester

Patent Owner asks the Office to suspend the *inter partes* reexamination of the '949 patent based on co-pending litigation between Patent Owner ("Plaintiff" or "BorgWarner") and Third Party Requester ("Defendant" or "Honeywell"). In the petition, Patent Owner cites the ongoing case of *BorgWarner Inc. v. Honeywell International.*, Case No. 1:07CV184 MR-DLH (W.D. N.C.) and submits several documents filed in that matter. As stated above, the Office will only suspend a reexamination proceeding based on co-pending litigation for good cause under 37 CFR 1.987. Patent Owner has not met this burden. First, Patent Owner has not even notified the Office of the current status of the litigation. Rather, Patent Owner states that co-pending litigation with Third Party Requester is ongoing, and Patent Owner presents certain pleadings filed in that litigation, namely Third Party Requester/Defendant's "First Amended Answer to Second Amended Complaint for Patent Infringement; Counterclaim for Declaratory Relief" (the "First Amended Answer") and Patent Owner/Plaintiff's "Reply First Amended Answer to Second Amended Complaint for Patent Infringement; Counterclaim for Declaratory Relief" (the "Reply to First Amended Answer"). It is impossible for the Office to determine the status of the underlying litigation based on these documents alone. Without knowledge as to the current stage of the litigation, the Office cannot even begin to determine whether suspension of the reexamination is appropriate.

Moreover, even if the status of the litigation were clear, Patent Owner has provided no arguments that rise to the level of good cause under 37 CFR 1.987. Patent Owner's petition completely lacks factual and legal support. Rather, it appears from the face of the petition that Patent Owner wants the Office to find that good cause exists based on the mere existence of the litigation. Existence of litigation by itself does not meet the requirements of good cause under 37 CFR 1.987. C.f. *Sony Computer Entertainment America Inc. v. Dudas, 85 USPQ2d 1594; 2006 U.S. Dist. LEXIS 36856* (E.D. VA 2006). [1]

In addition, the granting of stays based upon ongoing litigation to be completed would eviscerate the statute for litigated patents, since such stays would effectively guarantee that the litigations would finish before the reexamination, thus effectively terminating the reexaminations mid-course and rendering them moot. And, suspension of an *inter partes* reexamination proceeding without cause would contravene Congress' mandate to conduct such proceedings with special dispatch.

In view of the above, Patent Owner has not met its burden of showing good cause why such proceeding should be temporarily stayed pending conclusion of the on-going litigation in the District Court proceeding.

II. Ownership Contention

Patent Owner's second argument for suspending the *inter partes* reexamination of the '949 patent is that Honeywell *might* not be a third party requester as provided by 35 U.S.C. 311 and 37 CFR 1.913, but rather a Patent Owner. Based on this assertion, Patent Owner argues that the Third Party Requester *may* have been ineligible to make the January 29, 2009 request for *inter partes* reexamination under 37 CFR 1.913. The ownership rights to the '949 patent are allegedly the subject of dispute in the litigation, *BorgWarner Inc. v. Honeywell International.*, Case No. 1:07CV184 MR-DLH (W.D. N.C.), a case pending before the District Court. Patent Owner asserts that, as long as the ownership rights to the patent are still being litigated and until a court decision has been made granting priority to either Patent Owner or Third Party Requester, the *inter partes* reexamination should be suspended under 37 CFR 1.987. Patent Owner's argument is not persuasive for the reasons set forth below.

Patent Owner's only asserted evidence - that Third Party Requester has an ownership stake in the '949 patent - is an assertion made by Third Party Requester in its First Amended Answer, submitted to the District Court, that "[Patent Owner's] claims are barred, in whole or in part, because Honeywell has license rights, including an assignment of rights from Undisclosed

[1] In *Sony,* although the district court upheld the Office's determination to suspend the *inter partes* reexamination based on parallel litigation, the litigation was at a much more advanced stage than the litigation in the instant case. Specifically, the parties in *Sony* had been in litigation for two years and had conducted a jury trial before the case was appealed. At the Federal Circuit, the case had been fully briefed on the merits and was awaiting oral argument. The *inter partes* reexamination in *Sony* was initiated by the third party requester shortly after the case was appealed to the Federal Circuit, and the court held that the Office did not abuse its discretion in suspending the *inter partes* reexamination based on how far advanced the litigation had gotten and its view that "there was ample good cause to suspend the reexamination proceedings pending completion of the Federal Circuit appeal." *Sony,* 85 USPQ2d 1594, 1597. In this case, the litigation is nowhere close to that of *Sony.*

Inventor Brent Robinson."[2] This statement, however, does not prove that Third Party Requester is an actual Patent Owner. Patent Owner's reliance on this assertion by Third Party Requester is speculative and not dispositive of actual Patent Owner rights. Patent Owner has not submitted any additional documentation or evidence indicative that the patent rights for the '949 patent properly belongs to Honeywell. Without more proof that Third Party Requester is a patent owner, the Office cannot suspend the *inter partes* reexamination under 37 CFR 1.987.

In addition, there is nothing in the Patent Office records indicating that Honeywell has been assigned patent rights to the '949 patent from "undisclosed inventor" Brent Johnson. The Office records on the Image File Wrapper reveal that Steven Roby and David Decker are the only inventors of this patent. Moreover, the assignment records maintained by this Office reflect that Roby and Decker assigned their rights to the patent application to Patent Owner BorgWorner on June 4, 2001. That assignment was recorded in the Office on May 25, 2007. No other assignments have been made with respect to the '949 patent. Also, Honeywell never filed a 3.73(b) statement in this matter indicating that it had the right to prosecute the application of the '949 patent. Instead, Honeywell filed a statutory disclaimer under 35 USC 253 and 37 CFR 1.321(a) along with its opposition response disclaiming all rights it may have had in the '949 patent. Thus, based on Office records, BorgWorner, not Honeywell, is the owner of the '949 patent.

An Assignment and License Back ("Assignment") dated July 1, 2003, has been submitted by Third Party Requester along with its opposition petition, between unknown entity B&R Mold, Inc., Brent Robinson and Steve Reigel and Honeywell; this Assignment is insufficient proof that Honeywell has ownership rights. Although the Assignment provides that B&R Mold, Robinson and Reigel hereby "sell, assign, quitclaim and transfer to Honeywell International, Inc...the entirety of whatever rights, titles, and/or interests [they] ***may*** have in or to any and all inventions disclosed in, claimed in or supported by the following patent applications, which are also attached in Exhibit A..." (emphasis added), the Assignment goes on to list only U.S. pre-grant publications ("PG Pubs"), a European Patent Application and a Japanese Patent Application. There is nothing in the Assignment that makes reference to the '949 patent or its underlying patent application. Thus, the Assignment does not show that it conferred patent rights in the '949 patent to Honeywell. Also, the petition does not provide evidence establishing that entity B&R Mold, Inc., Brent Robinson and/or Steve Reigel had rights in the patent to assign. Because Patent Owner has not presented persuasive evidence as to Honeywell's ownership rights in the '949 patent, the Office is relying on its own records to determine the ownership of the '949 patent. Patent Owner is free to renew its petition for suspension of the *inter partes* reexamination if the District Court makes a final determination of Requester's present ownership in the '949 patent or presents other new evidence of Honeywell's ownership.

III. Impropriety of Petition

The Patent Owner's petition is filed under 37 CFR 1.181, 1.182 and 1.183. The filing of a single paper directed to separate matters is improper under 37 CFR 1.4(c). 37 CFR 1.4(c) requires separate submissions for each separately distinct and different matter. It is to be noted that relief

[2] See First Amended Answer, p17.

under 37 CFR 1.181 (presumably based upon the Office's grant of a filing date for the *inter partes* reexamination request filed by a part owner), and relief under 37 CFR 1.182 and 1.183 (for suspension) are considered by a separate parts of the Office.

IV. Consideration of Papers

Patent Owner's and Requester's petitions were both filed before the first office action on the merits in the '433 reexamination proceeding. Under 37 CFR 1.939, no paper may be filed with the Office prior to the first office action in an *inter partes* reexamination unless specifically authorized. However, both petitions were filed under 37 CFR 1.183, and 37 CFR 1.939 is hereby waived to address the issue that was brought before the Office.

CONCLUSION

1. The petition is **dismissed**.
2. Jurisdiction over the proceeding is returned to the Central Reexamination Unit.
3. Telephone inquiries with regard to this decision should be directed to Kery Fries, Senior Legal Advisor, at (571) 272-7757.

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

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.
95/000,433	01/29/2009	6904949	038569/340605	9014

71274 7590 10/27/2009

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 10/27/2009

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Date:

MAILED

OCT 27 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000433
PATENT NO. : 6904949
TECHNOLOGY CENTER : 3999
ART UNIT : 3991

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

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

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

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

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OCT 27 2009

CENTRAL REEXAMINATION UNIT

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(For Patent Owner)

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(For Third Party Requester)

In re *Decker et al.*
Inter partes Reexamination Proceeding
Control No: 95/000,433
Filing Date: January 29, 2009
For: U.S. Patent No.: 6,904,949

DECISION DENYING PETITION TO SUSPEND *INTER PARTES* PROCEEDING

This is a decision on the patent owner petition filed on August 18, 2009, entitled "Petition To the Director Under 37 C.F.R. § 1.183 and § 1.987." (the "Petition".) In addition, third party requester filed a paper on September 1, 2009, entitled "Requester's Opposition to Patent Owner's Renewed Petition to Suspend *Inter Partes* Reexamination" (the "Opposition").

The Petition, Opposition, and *inter partes* reexamination control number 95/000,433 are before the Office of Patent Legal Administration for consideration as to whether the relief requested by patent owner is to be granted.

The patent owner's petition is **denied** for the reasons below, and reexamination will continue with special dispatch.

This decision is designated as a final agency action under 5 U.S.C. § 704.

BACKGROUND

1. Patent number 6,904,949 (the '949 patent) issued on June 14, 2005, with claims 1-14.

2. The '949 patent is the subject of a concurrent proceeding styled *BorgWarner v. Honeywell International, Case No. 1:07CV184 MR-DLH (W.D.N.C.)*. The complaint was filed on May 30, 2007.

3. On January 29, 2009, a third party, Honeywell International, filed a request for *inter partes* reexamination of claims 1-14 that was assigned control no. 95/000,433(the '433 proceeding).

4. On March 18, 2009, reexamination was ordered in the '433 proceeding for claims 1-14 of the '949 patent.

5. On April 13, 2009, patent owner filed a petition under 37 CFR §§ 1.181, 1.182, and 1.183, to suspend the '433 proceeding.

6. On April 23, 2009, third party requester filed a petition entitled "Requester's Opposition to Patent Owner's Petition to Suspend *Inter Partes* Reexamination."

7. On August 7, 2009, the Office issued a decision dismissing patent owner's April 13, 2009 petition to suspend the '433 proceeding.

8. On August 18, 2009, patent owner filed the instant petition, entitled "Petition To the Director Under 37 C.F.R. § 1.183 and § 1.987."

9. On September 1, 2009, third party requester filed a petition entitled "Requester's Opposition to Patent Owner's Renewed Petition to Suspend *Inter Partes* Reexamination."

DECISION

I. Pertinent Regulations

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 '949 patent, being conducted in the U.S. District Court for the Western District of Northern Carolina. Petitioner patent owner requests that this *inter partes* reexamination proceeding be suspended pending completion of the concurrent proceeding. The action at the district court remains open, with discovery and a Markman hearing completed, and the deadline for pretrial motions having been set at November 2, 2009. Patent owner petition, exhibit B, at 2-3.

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.)*

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 asserts that termination or suspension of this proceeding is proper because the

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[1] *Ethicon v. Quigg, 849 F.2d 1422 (Fed. Cir. 1988)*
[2] *Id. at 1425*

reexamination request was filed nearly twenty months after suit was filed for infringement of the '949 patent. As phrased by patent owner, "Honeywell chose its horse to ride well before filing the Request [for *inter partes* reexamination]." Patent owner petition at 5.

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 trial information set forth in the petition show that the discovery phase has just been completed, and the pretrial motions will be due on November 2, 2009. There has been no decision on the claims, let alone a final decision following exhaustion of all appeals. Even further, any final decision that could be rendered would not bear on all of the claims that are under reexamination in this proceeding, which include claims 1-14 of the '949 patent, since invalidity is contended only for claims 1, 2, 3, 4, 5, 7, 10, 12, 13, and 14 of the '949 patent.[3] Regardless of the outcome of the court proceedings on claims 1, 2, 3, 4, 5, 7, 10, 12, 13, and 14, reexamination will continue for claims 6, 8, 9, and 11.

Good cause for suspension has not been shown. For *inter partes* reexamination, 35 U.S.C. 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 continued with special dispatch in accordance with § 314. The related court proceeding is still in the pretrial motions phase. 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 that would bear on the validity of claims 1, 2, 3, 4, 5, 7, 10, 12, 13, and 14 of the '949 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 the court proceeding, 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, and, in any case, the district court has stated that a previous motion for stay of the lawsuit was denied "without prejudice to refiling it in the event that the USPTO takes action which indicates a high likelihood that the claims . . . will be invalidated or substantially modified." Patent owner's petition, exhibit C, page 6. 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. Unlike this proceeding, in *Sony*, reexamination was limited to the claims that were being litigated. Further, a District Court decision had issued in favor of patent owner, and a final decision on appeal was on the horizon in the *Sony* fact situation, which is far from the case here. As stated in *Sony*, "a party can choose to run horses in both races," and, in the instant case, the race is far from over in the litigation.

In view of the above, the petition is denied, and the reexamination proceeding will be continued

[3] Requester's Amended Invalidity Contentions (redacted), filed with the Information Disclosure Statement of August 31, 2009, at 1.

with special dispatch within the Office.

CONCLUSION

1. The patent owner petition for suspension filed on August 18, 2009 is denied.

2. Jurisdiction over the proceeding is returned to the Central Reexamination Unit to take appropriate action on the proceeding.

3. This decision is designated as a final agency action under 5 U.S.C. § 704.

4. 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

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

10-26-09
C:\kiva\kenpet7\IP\suspend\

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.
95/000,433	01/29/2009	6904949	038569/340605	9014

71274 7590 11/09/2009

BORGWARNER INC. C/O PATENT CENTRAL LLC
1401 HOLLYWOOD BOULEVARD
HOLLYWOOD, FL 33020-5237

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/09/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patents and Trademark Office
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Alexandria, VA 22313-1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
ALSTON & BIRD LLP
BANK OF AMERICA PLAZA
101 SOUTH TRYON STREET, SUITE 4000
CHARLOTTE, NC 28280-4000

Date:

MAILED

NOV 0 92009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000433
PATENT NO. : 6904949
TECHNOLOGY CENTER : 3999
ART UNIT : 3991

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,084	04/18/2008	6904949	03856/340605	6065

71274 7590 11/09/2009

BORGWARNER INC. C/O PATENT CENTRAL LLC
1401 HOLLYWOOD BOULEVARD
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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/09/2009

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

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United States Patents and Trademark Office
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
ALSTON & BIRD LLP
BANK OF AMERICA PLAZA
101 SOUTH TRYON STREET, SUITE 4000
CHARLOTTE, NC 28280-4000

Date:
MAILED
NOV 0 92009
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009084
PATENT NO. : 6904949
ART UNIT : 3991

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

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

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CENTRAL REEXAMINATION UNIT

BorgWarner Inc.
c/o Patent Central LLC
1401 Hollywood Boulevard
Hollywood Florida 33020-5237

(For Patent Owner)

Alston & Bird LLP
101 South Tryon Street, Suite 4000
Charlotte, North Carolina 2820-4000

(For Third Party Requester)

Ex parte Reexamination Proceeding
Control No. 90/009,084
Filed: April 18, 2008
For: U.S. Patent No. 6,904,949

Inter Partes Reexamination Proceeding
Control No. 95/000,433
Filing Date: January 29, 2009
For: U.S. Patent No.: 6,904,949

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.

BACKGROUND

1. Patent number 6,904,949 (the '949 patent) issued on June 14, 2005, with claims 1-14.

2. The '949 patent is the subject of a concurrent proceeding styled *BorgWarner v. Honeywell International, Case No. 1:07CV184 MR-DLH (W.D.N.C.)*. The complaint was filed on May 30, 2007.

3. On April 18, 2008, a third party, Honeywell International, met the filing date requirements for a request for *ex parte* reexamination of claims 1-14 that was assigned control number 90/009,084 (the '9084 proceeding).

4. On May 28, 2008, reexamination was ordered in the '9084 proceeding for claims 1-14 of the '949 patent.

5. On January 29, 2009, a third party, Honeywell International, filed a request for *inter partes* reexamination of claims 1-14 that was assigned control no. 95/000,433 (the '433 proceeding).

6. On March 18, 2009, reexamination was ordered in the '433 proceeding for claims 1-14 of the '949 patent.

7. On April 13, 2009, patent owner filed a petition under 37 CFR §§ 1.181, 1.182, and 1.183, to suspend the '433 proceeding.

8. On April 23, 2009, third party requester filed a paper in the '433 proceeding entitled "Requester's Opposition to Patent Owner's Petition to Suspend *Inter Partes* Reexamination."

9. On August 7, 2009, the Office issued a decision dismissing patent owner's April 13, 2009 petition to suspend the '433 proceeding.

10. On August 18, 2009, patent owner filed a petition in the '433 proceeding, entitled "Petition To the Director Under 37 C.F.R. § 1.183 and § 1.987."

11. On September 1, 2009, third party requester filed a paper in the '433 proceeding entitled "Requester's Opposition to Patent Owner's Renewed Petition to Suspend *Inter Partes* Reexamination."

12. On October 27, 2009, the Office issued a decision denying patent owner's August 18, 2009 petition for suspension.

DECISION

I. MERGER OF PROCEEDINGS

37 CFR 1.989 provides:

> (a) If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the merged examination will normally result in the issuance of a single reexamination certificate under § 1.997.
>
> (b) An *inter partes* reexamination proceeding filed under § 1.913 which is merged with an *ex parte* reexamination proceeding filed under § 1.510 will result in the merged proceeding being governed by §§ 1.902 through 1.997, except that the rights of any third party requester of the *ex parte* reexamination shall be governed by §§ 1.510 through 1.560.

As evidenced by the above review of facts, both the '9084 and the '433 reexamination proceedings are currently pending. An order granting reexamination of claims 1-14 of the '949 patent has been mailed in each of the reexamination proceedings, and the time for filing a patent owner's statement has expired in the '9084 *ex parte* proceeding. Therefore, consideration of merger pursuant to 37 CFR 1.989 is appropriate at this time.

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 95/000,433 and 90/009,084 reexamination proceedings would address these considerations. Thus, pursuant to 37 CFR 1.989(a), the 95/000,433 and 90/009,084 reexamination proceedings <u>are hereby merged</u>. The merged proceeding will be conducted in accordance with the guidelines and requirements which follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

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

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

The present decision merges an *ex parte* reexamination proceeding with an *inter partes* reexamination proceeding. Pursuant to 37 CFR 1.989(b), the merged proceeding is governed by 37 CFR 1.902 through 1.997, except that the rights of the third party requester of the *ex parte* reexamination are governed by 37 CFR 1.510 through 1.560. In this instance, Honeywell International has full *inter partes* reexamination participation rights. The examiner will conduct reexamination in the merged proceeding for claims 1-14 of the '949 patent.

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) <u>must</u> consist of a single paper, filed in duplicate, each bearing a signature and identifying data for both files, for entry into each file.

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

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

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

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

By EFS:

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

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

C. Amendments:

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

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

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

D. Fees:

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

E. Citation of Patents and Printed Publications:

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

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/000,433 and *ex parte* Reexamination Control No. 90/009,084 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 Michael Cygan, Legal Advisor, at 571-272-7700.

Pinchus M. Laufer
Legal Advisor
Office of Patent Legal Administration

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,433	01/29/2009	6904949	038569/340605	9014

71274 7590 05/19/2010

BORGWARNER INC. C/O PATENT CENTRAL LLC
1401 HOLLYWOOD BOULEVARD
HOLLYWOOD, FL 33020-5237

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 05/19/2010

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BANK OF AMERICA PLAZA
101 SOUTH TRYON STREET, SUITE 4000
CHARLOTTE, NC 28280-4000

Date:

MAILED

MAY 19 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000433
PATENT NO. : 6904949
TECHNOLOGY CENTER : 3999
ART UNIT : 3991

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,084	04/18/2008	6904949	03856/340605	6065

71274 7590 05/19/2010

BORGWARNER INC. C/O PATENT CENTRAL LLC
1401 HOLLYWOOD BOULEVARD
HOLLYWOOD, FL 33020-5237

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 05/19/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
ALSTON & BIRD LLP
BANK OF AMERICA PLAZA
101 SOUTH TRYON STREET, SUITE 4000
CHARLOTTE, NC 28280-4000

Date:
MAILED

MAY 19 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009084
PATENT NO. : 6904949
ART UNIT : 3991

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

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

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United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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MAY 19 2010

CENTRAL REEXAMINATION UNIT

BorgWarner Inc.
c/o Patent Central LLC
1401 Hollywood Boulevard
Hollywood, Florida 33020-5237

(For Patent owner)

Alston & Bird LLP
101 South Tryon Street, Suite 4000
Charlotte, North Carolina 28280-4000

(For Third Party Requester)

Ex parte Reexamination Proceeding
Control No. 90/009,084
Filed: April 18, 2008
For: U.S. Patent No. 6,904,949

Inter Partes Reexamination Proceeding
Control No. 95/000,433
Filing Date: January 29, 2009
For: U.S. Patent No. 6,904,949

DECISION GRANTING-IN-PART PATENT OWNER PETITION AND *SUA SPONTE* WAIVING REQUESTER PAGE LIMIT

This is a decision on the March 31, 2010 patent owner petition entitled "Petition to Suspend Rule 37 CFR § 1.943 Pursuant to the Provisions of 37 CFR § 1.183." On April 22, 2010, patent owner filed a timely response to the January 22, 2010 non-final Office action. On April 23, 2010, patent owner filed a supplemental response to include exhibits that were inadvertently omitted.

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

Patent owner's petition under 37 CFR 1.183 to waive the 37 CFR 1.943(b) limit as to the number of pages permitted in a patent owner response is granted to the extent that the page limit for the patent owner response is extended to not exceed 56 pages in length, excluding amendment, appendices of claims, and reference materials such as prior art references.

FEES

The petition fee of $400.00 pursuant to 37 CFR 1.17(f) for the March 31, 2010 petition under 37 CFR 1.183 has been paid.

BACKGROUND

1. U.S. Patent No. 6,904,949 (the '949 patent) issued on June 14, 2005, with claims 1-14.

2. On April 18, 2008, a third party requester, Honeywell International Inc., met the filing date requirements for a request for *ex parte* reexamination of claims 1-14 of the '949 patent that was assigned control number 90/009,084 (the '9084 proceeding).

3. On May 28, 2008, reexamination was ordered in the '9084 proceeding for claims 1-14 of the '949 patent.

4. On January 29, 2009, the same third party requester, Honeywell International Inc., filed a request for *inter partes* reexamination of claims 1-14 of the '949 patent that was assigned control no. 95/000,433 (the '433 proceeding).

5. On March 18, 2009, reexamination was ordered in the '433 proceeding for claims 1-14 of the '949 patent.

6. On November 9, 2009, the Office mailed a decision merging, *sua sponte,* the '433 and '9084 reexamination proceedings into a single, merged proceeding.

7. On January 22, 2010, the Office mailed a non-final Office action.

8. On February 16, 2010, patent owner filed a request for a one-month extension of time pursuant to 37 CFR 1.956 for filing a response to the January 22, 2010 non-final Office action.

9. On March 1, 2010, the Office mailed a decision granting the requested one-month extension, setting the response due date to April 22, 2010.

10. On March 31, 2010 patent owner filed the instant petition entitled "Petition to Suspend Rule 37 CFR § 1.943 Pursuant to the Provisions of 37 C.F.R. § 1.183."

11. On April 22, 2010 patent owner timely filed a response to the January 22, 2010 non-final Office action. On page 5 of the response, patent owner expressly renewed the petition of March 31, 2010, requesting that the 50 page limit pursuant to 37 CFR 1.943(b) be extended to 59 pages.

12. On April 23, 2010, patent owner filed a paper entitled "Submission of Exhibits by Patent Owner," to supplement the April 22, 2010 patent owner 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

I. Patent Owner's Petition

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 January 22, 2010 non-final action, not to exceed 75 pages in length.[1] Pet. at 4. In support of waiver of the rule, patent owner indicates that "the first Office Action is comprised of 64 separate paragraphs on 19 pages with 17 grounds of rejection, relying on many hundreds of pages of prior art, and incorporating by reference a further 17 pages of text from the Request for Reexamination, which for its part comprised a 48 page statement and 143 pages of reference material." Pet. at 2.

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[1] It is noted that on page 5 of the petition, patent owner requests waiver of the 50 page limit of up to 75 pages; however, also on page 4, at the end of the first full paragraph of the petition, patent owner requests 70 pages.

Patent owner further states that in order to adequately prepare a response, not only does each reference have to be addressed, but a discussion on the development of the turbocharger technology over time must also be presented since this is a highly specialized technology. Pet. at 3.

Patent owner submitted a response to the non-final Office action on April 22, 2010, with two accompanying declarations under 37 CFR 1.132 by Dr. Baines. On April 23, 2010, patent owner submitted exhibits that were inadvertently omitted from the April 22, 2010 submission. Patent owner included in the remarks section of the April 22, 2010 response a request to renew the petition of the March 31, 2010 petition, which had not yet been decided by the Office. In the renewed petition request, patent owner requests waiver of the 50-page limit to allow a response of 59 pages.[2]

II. Analysis and Findings

The present petition under 37 CFR 1.183 has been fully considered. 37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. In this instance, the petitioner has made a showing in support of the request for waiver of 37 CFR 1.943(b) by attempting to draft a response in compliance with the 50-page limit, and submitting the response entitled "Response by Patent Owner Pursuant to 37 CFR § 1.941" on April 22, 2010.

The April 22, 2010 patent owner response, as supplemented by the exhibits filed on April 23, 2010, is accompanied by the two declarations of Dr. Baines. The response includes a "Remarks" section that consists of 32 pages. The following sections of the "Remarks" section are not included in the page limit: the cover page, the two pages of claim appendices, the signature page, and the certificate of service page.

It is noted that, any portion of an affidavit/declaration that does not strictly adhere to presenting and explaining the evidence is subject to the 50-page limit of 37 CFR 1.943(b). Thus, opinion evidence that goes beyond explaining the evidence - legal arguments, e.g. assertions of obviousness and anticipation, are counted as remarks, and are thus part of the 50-page limit of 37 CFR 1.943(b).

The first declaration by Dr. Baines entitled "Declaration under 37 CFR 1.132, Background" comprises 9 pages that do not count toward the page count as the declaration focuses on technological background and does not include any legal arguments. The second declaration by Dr. Baines, entitled "Declaration under 37 CFR 1.132 Patentability" comprises 41 pages. Of these 41 pages, 24 contain legal argument and thus are counted toward the page limit. Examples of legal arguments in the second declaration, which are not exhaustive, that count toward the page limit are: On page 7, paragraph 25, declarant states: "It is my opinion that this disclosure of Hofmeister would motivate one of ordinary skill in the art against using two or more die inserts per air passage." On page 12, paragraph 42, Dr. Baines states: "The disclosure of Hyll is not

[2] Patent owner response at page 5.

relevant to the claims of the '949 Patent, so one of ordinary skill in the art would not look to Hyll for solutions to manufacture a compressor wheel."[3] The submission of the exhibits of April 23, 2010, comprising only drawing with no legal arguments, does not count toward the page limit.

It is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance, based on (a) the specific facts set forth in the petition under 37 CFR 1.183, (b) patent owner's showing in support of the request for waiver of the 50-page limit 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 (c) the individual facts and circumstances of this case,. In particular, the 50-page limit of 37 CFR 1.943(b) is waived to the extent of permitting patent owner's April 22, 2010 response (as supplemented on April 23, 2010) which exceeds the 50-page limit by 6 pages.

Accordingly, patent owner's petition under 37 CFR 1.183 is **granted** to the extend that the page limit of 37 CFR 1.943(b) is waived as to **6 pages** of the portions of patent owner's April 22, 2010 response (as supplemented on April 23, 2010), which are included in the regulatory page count, that exceed the 50-page limit. This waiver makes the patent owner's response to the January 22, 2010 non-final Office action page-length compliant.

III. Time Period and Page Limit for Submission of Third Party Requester Comments

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 56 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 and making patent owner's April 22, 2010 response (as supplemented on April 23, 2010) page-length compliant, to file a comments paper pursuant to 37 CFR 1.947. *See* MPEP 2667(I)(A)(2).

IV. Sua Sponte Waiver

As to the April 23, 2010 patent owner supplemental response entitled "Submission of Exhibits by Patent Owner," 37 CFR 1.945(b) is *sua sponte* waived, since the supplemental response is limited to exhibits missing from the April 22, 2010 patent owner response.

CONCLUSION

1. Patent owner's petition under 37 CFR 1.183 is granted-in-part, and the page limit of 37 CFR 1.943(b) is waived to the extent that the patent owner's April 22, 2010 response, as supplemented on April 23, 2010, is not to exceed 56 pages in length, excluding appendices of claims and reference materials, such as prior art references. This waiver makes the patent owner's response to the January 22, 2010 non-final Office action page-length compliant.

[3] Other examples of legal arguments are on pages 8, 9, 11, 14-15, 17, 22-37 and 39 of the second Baines declaration.

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 after patent owner's response to the January 22, 2010 non-final Office action shall not exceed 56 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.**

3. Requester has **30 days from the mailing date of this decision** to file a comments paper pursuant to 37 CFR 1.947

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

5. Any questions concerning this communication should be directed to Maria Nuzzolillo, Legal Advisor, at 571-272-8150 or Susy Tsang-Foster, Legal Advisor, at 571-272-7711.

Kenneth M. Schor

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

Kenpet8
5-17-10

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UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,434	01/29/2009	6629556	038569/340590	6529

71274 7590 08/07/2009

BORGWARNER INC. C/O PATENT CENTRAL LLC
1401 HOLLYWOOD BOULEVARD
HOLLYWOOD, FL 33020-5237

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 08/07/2009

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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101 SOUTH TRYON STREET, SUITE 4000
CHARLOTTE, NC 28280-4000

Date:

MAILED

AUG 07 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000434
PATENT NO. : 6629556
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)

ALSTON & BIRD LLP.
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CHARLOTTE, NC 28280-4000

(For *Inter Partes* Requester)

MAILED

AUG 07 2009

CENTRAL REEXAMINATION UNIT

In re Decker, et al.
Inter Partes Reexamination Proceeding
Control Number 95/000,434
Filed: January 29, 2009
For: U.S. Patent No. 6,629,556

DECISION DISMISSING PETITION TO SUSPEND

This is a decision on the April 13, 2009 Patent Owner petition under 37 CFR 1.181, 1.182 and 1.183 requesting that the *inter partes* reexamination of March 30, 2009 of U.S. Patent No. 6,629,556 (the "556' patent") be suspended. In addition, on April 23, 2009, Third Party Requester filed a paper in opposition to Patent Owner's petition

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

For the reasons discussed below, the petition to suspend is **dismissed**.

REVIEW OF FACTS

1. U.S. Patent No. 6,629,556 issued to Decker, et al. on October 7, 2003.

2. The inventors of record for the '556 patent, David Decker and Steve Roby, assigned their entire rights in the '556 patent to Patent Owner in an assignment dated June 4, 2001, and recorded in the Office on May 25, 2007.

4. Assignment records maintained by the Office do not reveal that there was any other assignment associated with the '556 patent.

5 A request for *inter partes* reexamination of the '556 patent was filed by Third Party Requester on January 29, 2009, and was assigned reexamination control no. 95/000,434 (the '434 proceeding).

6. On March 30, 2009, reexamination was ordered. To date, no Office action has been mailed in the '434 proceeding.

7. On April 13, 2009, Patent Owner filed the instant petition under 37 CFR 1.181, 1.182 and 1.183 requesting that the *inter partes* reexamination of the '556 patent be suspended, based upon Patent Owner's position that Third Party Requester had an ownership interest in the '556 patent.

8. On April 23, 2009, Third Party Requester filed a petition under 37 CFR 1.183, in opposition to Patent Owner's petition along with a Statutory Disclaimer and Public Dedication under 35 USC 253 and 37 CFR 1.321(a) and an Assignment and License Back dated July 1, 2003.

9. A Title Report was filed with the Office on February 2, 2009, reflecting the assignment from Decker and Roby to Patent Owner.

10. A statement under 37 CFR 3.73(b) was never filed during the prosecution of the '556 patent.

11. There is ongoing litigation between Patent Owner and Third Party Requester in the case *BorgWarner Inc. v. Honeywell International.*, Case No.1:07CV184 MR- DLH (W.D. N.C.).

STATUTES AND REGULATIONS

37 CFR 1.4(c) provides:

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

37 CFR 1.181 provides in relevant 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 1.182 provides:

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

37 CFR 1.183 provides:

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

37 CFR 1.913 provides:

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

37 CFR 1.939 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 an *inter partes* reexamination.

37 CFR 1.987 provides:

If a patent in the process of *inter partes* reexamination is or becomes involved in litigation, the Director shall determine whether or not to suspend the *inter partes* reexamination proceeding.

DECISION

As Third Party Requester points out, all reexamination proceedings are to be conducted with special dispatch. See 35 U.S.C. 305 (*ex parte* reexamination) and 35 U.S.C. 314(c) (*inter partes* reexamination). However, unlike *ex parte* reexamination, the *inter partes* reexamination statute allows the Director to proceed by other than special dispatch if good cause be shown. If the Director finds good cause for suspension, the Director has no statutory preclusion in suspending a proceeding for a defined, temporary period. *Ethicon v. Quigg*, 849 F. 2d. 1422 (Fed. Cir. 1998), precluded a suspension for (a) an indefinite length of time (b) in an *ex parte* reexamination, and, accordingly is not controlling authority on the present issue.

Patent Owner contends that the *inter partes* reexamination should be suspended under 37 CFR 1.987 based on the allegations that (1) there is underlying litigation between Third Party Requester and Patent Owner over the '556 patent and (2) Third Party Requester has an ownership interest in the '556 patent.

These issues will be addressed in turn:

I. Underlying Litigation Between Patent Owner and Third Party Requester

Patent Owner asks the Office to suspend the *inter partes* reexamination of the '556 patent based on co-pending litigation between Patent Owner ("Plaintiff" or "BorgWarner") and Third Party Requester ("Defendant" or "Honeywell"). In the petition, Patent Owner cites the ongoing case of *BorgWarner Inc. v. Honeywell International.*, Case No. 1:07CV184 MR-DLH (W.D. N.C.) and submits several documents filed in that matter. As stated above, the Office will only suspend a reexamination proceeding based on co-pending litigation for good cause under 37 CFR 1.987. Patent Owner has not met this burden. First, Patent Owner has not even notified the Office of the current status of the litigation. Rather, Patent Owner states that co-pending litigation with Third Party Requester is ongoing, and Patent Owner presents certain pleadings filed in that litigation, namely Third Party Requester/Defendant's "First Amended Answer to Second Amended Complaint for Patent Infringement; Counterclaim for Declaratory Relief" (the "First Amended Answer") and Patent Owner/Plaintiff's "Reply First Amended Answer to Second Amended Complaint for Patent Infringement; Counterclaim for Declaratory Relief" (the "Reply to First Amended Answer"). It is impossible for the Office to determine the status of the underlying litigation based on these documents alone. Without knowledge as to the current stage of the litigation, the Office cannot even begin to determine whether suspension of the reexamination is appropriate.

Moreover, even if the status of the litigation were clear, Patent Owner has provided no arguments that rise to the level of good cause under 37 CFR 1.987. Patent Owner's petition completely lacks factual and legal support. Rather, it appears from the face of the petition that Patent Owner wants the Office to find that good cause exists based on the mere existence of the litigation. Existence of litigation by itself does not meet the requirements of good cause under 37 CFR 1.987. C.f. *Sony Computer Entertainment America Inc. v. Dudas, 85 USPQ2d 1594; 2006 U.S. Dist. LEXIS 36856* (E.D. VA 2006). [1]

In addition, the granting of stays based upon ongoing litigation to be completed would eviscerate the statute for litigated patents, since such stays would effectively guarantee that the litigations would finish before the reexamination, thus effectively terminating the reexaminations mid-course and rendering them moot. And, suspension of an *inter partes* reexamination proceeding without cause would contravene Congress' mandate to conduct such proceedings with special dispatch.

In view of the above, Patent Owner has not met its burden of showing good cause why such proceeding should be temporarily stayed pending conclusion of the on-going litigation in the District Court proceeding.

II. Ownership Contention

Patent Owner's second argument for suspending the *inter partes* reexamination of the '556 patent is that Honeywell *might* not be a third party requester as provided by 35 U.S.C. 311 and 37 CFR 1.913, but rather a Patent Owner. Based on this assertion, Patent Owner argues that the Third Party Requester *may* have been ineligible to make the January 29, 2009 request for *inter partes* reexamination under 37 CFR 1.913. The ownership rights to the '556 patent are allegedly the subject of dispute in the litigation, *BorgWarner Inc. v. Honeywell International.*, Case No. 1:07CV184 MR-DLH (W.D. N.C.), a case pending before the District Court. Patent Owner asserts that, as long as the ownership rights to the patent are still being litigated and until a court decision has been made granting priority to either Patent Owner or Third Party Requester, the *inter partes* reexamination should be suspended under 37 CFR 1.987. Patent Owner's argument is not persuasive for the reasons set forth below.

Patent Owner's only asserted evidence - that Third Party Requester has an ownership stake in the '556 patent - is an assertion made by Third Party Requester in its First Amended Answer, submitted to the District Court, that "[Patent Owner's] claims are barred, in whole or in part,

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[1] In *Sony,* although the district court upheld the Office's determination to suspend the *inter partes* reexamination based on parallel litigation, the litigation was at a much more advanced stage than the litigation in the instant case. Specifically, the parties in *Sony* had been in litigation for two years and had conducted a jury trial before the case was appealed. At the Federal Circuit, the case had been fully briefed on the merits and was awaiting oral argument. The *inter partes* reexamination in *Sony* was initiated by the third party requester shortly after the case was appealed to the Federal Circuit, and the court held that the Office did not abuse its discretion in suspending the *inter partes* reexamination based on how far advanced the litigation had gotten and its view that "there was ample good cause to suspend the reexamination proceedings pending completion of the Federal Circuit appeal." *Sony,* 85 USPQ2d 1594, 1597. In this case, the litigation is nowhere close to that of *Sony*.

because Honeywell has license rights, including an assignment of rights from Undisclosed Inventor Brent Robinson."[2] This statement, however, does not prove that Third Party Requester is an actual Patent Owner. Patent Owner's reliance on this assertion by Third Party Requester is speculative and not dispositive of actual Patent Owner rights. Patent Owner has not submitted any additional documentation or evidence indicative that the patent rights for the '556 patent properly belongs to Honeywell. Without more proof that Third Party Requester is a patent owner, the Office cannot suspend the *inter partes* reexamination under 37 CFR 1.987.

In addition, there is nothing in the Patent Office records indicating that Honeywell has been assigned patent rights to the '556 patent from "undisclosed inventor" Brent Johnson. The Office records on the Image File Wrapper reveal that Steven Roby and David Decker are the only inventors of this patent. Moreover, the assignment records maintained by this Office reflect that Roby and Decker assigned their rights to the patent application to Patent Owner BorgWorner on June 4, 2001. That assignment was recorded in the Office on May 25, 2007. No other assignments have been made with respect to the '556 patent. Also, Honeywell never filed a 3.73(b) statement in this matter indicating that it had the right to prosecute the application of the '556 patent. Instead, Honeywell filed a statutory disclaimer under 35 USC 253 and 37 CFR 1.321(a) along with its opposition response disclaiming all rights it may have had in the '556 patent. Thus, based on Office records, BorgWorner, not Honeywell, is the owner of the '556 patent.

An Assignment and License Back ("Assignment") dated July 1, 2003, has been submitted by Third Party Requester along with its opposition petition, between unknown entity B&R Mold, Inc., Brent Robinson and Steve Reigel and Honeywell; this Assignment is insufficient proof that Honeywell has ownership rights. Although the Assignment provides that B&R Mold, Robinson and Reigel hereby "sell, assign, quitclaim and transfer to Honeywell International, Inc...the entirety of whatever rights, titles, and/or interests [they] ***may*** have in or to any and all inventions disclosed in, claimed in or supported by the following patent applications, which are also attached in Exhibit A..." (emphasis added), the Assignment goes on to list only U.S. pre-grant publications ("PG Pubs"), a European Patent Application and a Japanese Patent Application. There is nothing in the Assignment that makes reference to the '556 patent or its underlying patent application. Thus, the Assignment does not show that it conferred patent rights in the '556 patent to Honeywell. Also, the petition does not provide evidence establishing that entity B&R Mold, Inc., Brent Robinson and/or Steve Reigel had rights in the patent to assign. Because Patent Owner has not presented persuasive evidence as to Honeywell's ownership rights in the '556 patent, the Office is relying on its own records to determine the ownership of the '556 patent. Patent Owner is free to renew its petition for suspension of the *inter partes* reexamination if the District Court makes a final determination of Requester's present ownership in the '556 patent or presents other new evidence of Honeywell's ownership.

III. Impropriety of Petition

The Patent Owner's petition is filed under 37 CFR 1.181, 1.182 and 1.183. The filing of a single paper directed to separate matters is improper under 37 CFR 1.4(c). 37 CFR 1.4(c) requires

[2] See First Amended Answer, p17.

separate submissions for each separately distinct and different matter. It is to be noted that relief under 37 CFR 1.181 (presumably based upon the Office's grant of a filing date for the *inter partes* reexamination request filed by a part owner), and relief under 37 CFR 1.182 and 1.183 (for suspension) are considered by a separate parts of the Office.

IV. Consideration of Papers

Patent Owner's and Requester's petitions were both filed before the first office action on the merits in the '434 reexamination proceeding. Under 37 CFR 1.939, no paper may be filed with the Office prior to the first office action in an *inter partes* reexamination unless specifically authorized. However, both petitions were filed under 37 CFR 1.183, and 37 CFR 1.939 is hereby waived to address the issue that was brought before the Office.

CONCLUSION

1. The petition is **dismissed**.
2. Jurisdiction over the proceeding is returned to the Central Reexamination Unit.
3. Telephone inquiries with regard to this decision should be directed to Kery Fries, Senior Legal Advisor, at (571) 272-7757.

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,434	01/29/2009	6629556	038569/340590	6529

71274 7590 10/27/2009

BORGWARNER INC. C/O PATENT CENTRAL LLC
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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 10/27/2009

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CHARLOTTE, NC 28280-4000

Date:
MAILED
OCT 27 2009
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000434
PATENT NO. : 6629556
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

OCT 27 2009

CENTRAL REEXAMINATION UNIT

ALSTON & BIRD LLP.
101 SOUTH TRYON STREET, SUITE 4000
CHARLOTTE, NC 2820-4000

(For Third Party Requester)

In re *Decker et al.*	:	
Inter partes Reexamination Proceeding	:	**DECISION DENYING**
Control No: 95/000,434	:	**PETITION TO SUSPEND**
Filing Date: January 29, 2009	:	***INTER PARTES* PROCEEDING**
For: U.S. Patent No.: 6,629,556	:	

This is a decision on the patent owner petition filed on August 18, 2009, entitled "Petition To the Director Under 37 C.F.R. § 1.183 and § 1.987." (the "Petition".) In addition, third party requester filed a paper on September 1, 2009, entitled "Requester's Opposition to Patent Owner's Renewed Petition to Suspend *Inter Partes* Reexamination" (the "Opposition").

The Petition, Opposition, and *inter partes* reexamination control number 95/000,434 are before the Office of Patent Legal Administration for consideration as to whether the relief requested by patent owner is to be granted.

The patent owner's petition is **denied** for the reasons below, and reexamination will continue with special dispatch.

This decision is designated as a final agency action under 5 U.S.C. § 704.

BACKGROUND

1. Patent number 6,629,556 (the '556 patent) issued on October 7, 2003, with claims 1-9.

2. The '556 patent is the subject of a concurrent proceeding styled *BorgWarner v. Honeywell International, Case No. 1:07CV184 MR-DLH (W.D.N.C.)*. The complaint was filed on May 30, 2007.

3. On January 29, 2009, a third party, Honeywell International, filed a request for *inter partes* reexamination of claims 1-9 that was assigned control no. 95/000,434(the '434 proceeding).

4. On March 18, 2009, reexamination was ordered in the '434 proceeding for claims 1-9 of the '556 patent.

5. On April 13, 2009, patent owner filed a petition under 37 CFR §§ 1.181, 1.182, and 1.183, to suspend the '434 proceeding.

6. On April 23, 2009, third party requester filed a petition entitled "Requester's Opposition to Patent Owner's Petition to Suspend *Inter Partes* Reexamination."

7. On August 7, 2009, the Office issued a decision dismissing patent owner's April 13, 2009 petition to suspend the '434 proceeding.

8. On August 18, 2009, patent owner filed the instant petition, entitled "Petition To the Director Under 37 C.F.R. § 1.183 and § 1.987."

9. On September 1, 2009, third party requester filed a petition entitled "Requester's Opposition to Patent Owner's Renewed Petition to Suspend *Inter Partes* Reexamination."

DECISION

I. Pertinent Regulations

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 '556 patent, being conducted in the U.S. District Court for the Western District of Northern Carolina. Petitioner patent owner requests that this *inter partes* reexamination proceeding be suspended pending completion of the concurrent proceeding. The action at the district court remains open, with discovery and a Markman hearing completed, and the deadline for pretrial motions having been set at November 2, 2009. Patent owner petition, exhibit B, at 2-3.

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.)*

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 asserts that termination or suspension of this proceeding is proper because the

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[1] *Ethicon v. Quigg, 849 F.2d 1422 (Fed. Cir. 1988)*
[2] *Id. at 1425*

reexamination request was filed nearly twenty months after suit was filed for infringement of the '556 patent. As phrased by patent owner, "Honeywell chose its horse to ride well before filing the Request [for *inter partes* reexamination]." Patent owner petition at 5.

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 trial information set forth in the petition show that the discovery phase has just been completed, and the pretrial motions will be due on November 2, 2009. There has been no decision on the claims, let alone a final decision following exhaustion of all appeals. Even further, any final decision that could be rendered would not bear on all of the claims that are under reexamination in this proceeding, which include claims 1-9 of the '556 patent, since invalidity is contended only for claims 1, 2, 3, 6, and 9 of the '556 patent.[3] Regardless of the outcome of the court proceedings on claims 1, 2, 3, 6, and 9, reexamination will continue for claims 4, 5, 7, and 8.

Good cause for suspension has not been shown. For *inter partes* reexamination, 35 U.S.C. 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 continued with special dispatch in accordance with § 314. The related court proceeding is still in the pretrial motions phase. 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 that would bear on the validity of claims 1, 2, 3, 6, and 9 of the '556 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 the court proceeding, 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, and, in any case, the district court has stated that a previous motion for stay of the lawsuit was denied "without prejudice to refiling it in the event that the USPTO takes action which indicates a high likelihood that the claims . . . will be invalidated or substantially modified." Patent owner's petition, exhibit C, page 6. 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. Unlike this proceeding, in *Sony*, reexamination was limited to the claims that were being litigated. Further, a District Court decision had issued in favor of patent owner, and a final decision on appeal was on the horizon in the *Sony* fact situation, which is far from the case here. As stated in *Sony*, "a party can choose to run horses in both races," and, in the instant case, the race is far from over in the litigation.

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[3] Requester's Amended Invalidity Contentions (redacted), filed with the Information Disclosure Statement of August 31, 2009, at 1.

In view of the above, the petition is denied, and the reexamination proceeding will be continued with special dispatch within the Office.

CONCLUSION

1. The patent owner petition for suspension filed on August 18, 2009 is denied.

2. Jurisdiction over the proceeding is returned to the Central Reexamination Unit to take appropriate action on the proceeding.

3. This decision is designated as a final agency action under 5 U.S.C. § 704.

4. 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

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

10-26-09
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UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,434	01/29/2009	6629556	038569/340590	6529

71274 7590 11/12/2009

BORGWARNER INC. C/O PATENT CENTRAL LLC
1401 HOLLYWOOD BOULEVARD
HOLLYWOOD, FL 33020-5237

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/12/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
ALSTON & BIRD LLP
BANK OF AMERICA PLAZA
101 SOUTH TRYON STREET, SUITE 4000
CHARLOTTE, NC 28280-4000

Date:

MAILED

NOV 12 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000434
PATENT NO. : 6629556
TECHNOLOGY CENTER : 3999
ART UNIT : 3991

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,083	04/18/2008	6629556	038569/340590	6059

71274 7590 11/12/2009

BORGWARNER INC. C/O PATENT CENTRAL LLC
1401 HOLLYWOOD BOULEVARD
HOLLYWOOD, FL 33020-5237

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/12/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
ALSTON & BIRD LLP
BANK OF AMERICA PLAZA
101 SOUTH TRYON STREET, SUITE 4000
CHARLOTTE, NC 28280-4000

Date:

MAILED

NOV 12 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009083
PATENT NO. : 6629556
ART UNIT : 3991

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

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

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NOV 12 2009

CENTRAL REEXAMINATION UNIT

BorgWarner Inc.
c/o Patent Central LLC
1401 Hollywood Boulevard
Hollywood Florida 33020-5237

(For Patent Owner)

Alston & Bird LLP
101 South Tryon Street, Suite 4000
Charlotte, North Carolina 2820-4000

(For Third Party Requester)

Ex parte Reexamination Proceeding
Control No. 90/009,083
Filed: April 18, 2008
For: U.S. Patent No. 6,629,556

Inter Partes Reexamination Proceeding
Control No. 95/000,434
Filing Date: January 29, 2009
For: U.S. Patent No. 6,629,556

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.

BACKGROUND

1. Patent number 6,629,556 (the '556 patent) issued on October 7, 2003, with claims 1-9.

2. The '556 patent is the subject of a concurrent proceeding styled *BorgWarner v. Honeywell International, Case No. 1:07CV184 MR-DLH (W.D.N.C.)*. The complaint was filed on May 30, 2007.

3. On April 18, 2008, a third party, Honeywell International, met the filing date requirements for a request for *ex parte* reexamination of claims 1-9 that was assigned control number 90/009,083 (the '9083 proceeding).

4. On May 28, 2008, reexamination was ordered in the '9083 proceeding for claims 1-9 of the '556 patent.

5. On January 29, 2009, a third party, Honeywell International, filed a request for *inter partes* reexamination of claims 1-9 that was assigned control no. 95/000,434 (the '434 proceeding).

6. On March 30, 2009, reexamination was ordered in the '434 proceeding for claims 1-9 of the '556 patent.

7. On April 13, 2009, patent owner filed a petition under 37 CFR §§ 1.181, 1.182, and 1.183, to suspend the '434 proceeding.

8. On April 23, 2009, third party requester filed a paper entitled "Requester's Opposition to Patent Owner's Petition to Suspend *Inter Partes* Reexamination."

9. On August 7, 2009, the Office issued a decision dismissing patent owner's April 13, 2009 petition to suspend the '434 proceeding.

10. On August 18, 2009, patent owner filed a petition in the '434 proceeding, entitled "Petition To the Director Under 37 C.F.R. § 1.183 and § 1.987.

11. On September 1, 2009, third party requester filed a paper in the '434 proceeding entitled "Requester's Opposition to Patent Owner's Renewed Petition to Suspend *Inter Partes* Reexamination."

12. On October 27, 2009, the Office issued a decision denying patent owner's August 18, 2009 petition for suspension of the '434 proceeding.

DECISION

I. MERGER OF PROCEEDINGS

37 CFR 1.989 provides:

> (a) If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the merged examination will normally result in the issuance of a single reexamination certificate under § 1.997.
>
> (b) An *inter partes* reexamination proceeding filed under § 1.913 which is merged with an *ex parte* reexamination proceeding filed under § 1.510 will result in the merged proceeding being governed by §§ 1.902 through 1.997, except that the rights of any third party requester of the *ex parte* reexamination shall be governed by §§ 1.510 through 1.560.

As evidenced by the above review of facts, both the '9083 and the '434 reexamination proceedings are currently pending. An order granting reexamination of claims 1-9 of the '556 patent has been mailed in each of the reexamination proceedings, and the time for filing a patent

owner's statement has expired in the '9083 *ex parte* proceeding. Therefore, consideration of merger pursuant to 37 CFR 1.989 is appropriate at this time.

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 95/000,434 and 90/009,083 reexamination proceedings would address these considerations. Thus, pursuant to 37 CFR 1.989(a), the 95/000,434 and 90/009,083 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. Patent owner is required to maintain the same claims (and specification) in both files throughout the merged proceeding.

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

The present decision merges an *ex parte* reexamination proceeding with an *inter partes* reexamination proceeding. Pursuant to 37 CFR 1.989(b), the merged proceeding is governed by 37 CFR 1.902 through 1.997, except that the rights of the third party requester of the *ex parte* reexamination are governed by 37 CFR 1.510 through 1.560. In this instance, Honeywell International has full *inter partes* reexamination participation rights. The examiner will conduct reexamination in the merged proceeding for claims 1-9 of the '556 patent.

B. Papers mailed/filed:

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

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

by Mail to: Attn: Mail Stop "*Inter Partes* Reexam"
Central Reexamination Unit

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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

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

By EFS:

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

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

C. Amendments:

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

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

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

D. Fees:

Where a paper is filed that requires payment of a fee (*e.g.*, petition fee, excess claims fee, extension of time fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For

example, only one fee need be paid for any patent owner's appellant brief (or that of the *inter partes* reexamination requester) which may be filed, even though the brief relates to merged multiple proceedings, and copies must be filed (as pointed out above) for each file in the merged proceeding.

E. Citation of Patents and Printed Publications:

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

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/000,434 and *ex parte* Reexamination Control No. 90/009,083 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 Michael Cygan, Legal Advisor, at 571-272-7700.

Pinchus M. Laufer
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.
95/000,434	01/29/2009	6629556	038569/340590	6529

71274 7590 05/18/2010

BORGWARNER INC. C/O PATENT CENTRAL LLC
1401 HOLLYWOOD BOULEVARD
HOLLYWOOD, FL 33020-5237

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 05/18/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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www.uspto.gov

CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/000,434	01/29/09	6629556	

EXAMINER
TILL, TERRENCE

ART UNIT	PAPER
3991	

ALSTON & BIRD LLP
101 SOUTH TRYON STREET
SUITE 4000
CHARLOTTE, NC 28280-4000

DATE MAILED:

05/18/10

INTER PARTES REEXAMINATION COMMUNICATION

BELOW/ATTACHED YOU WILL FIND A COMMUNICATION FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE OFFICIAL(S) IN CHARGE OF THE PRESENT REEXAMINATION PROCEEDING.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/000,434	01/29/09	6629556	

EXAMINER
TILL, TERRENCE

ART UNIT	PAPER
3991	

ALSTON & BIRD LLP
101 SOUTH TRYON STREET
SUITE 4000
CHARLOTTE, NC 28280-4000

DATE MAILED:

INTER PARTES REEXAMINATION COMMUNICATION

BELOW/ATTACHED YOU WILL FIND A COMMUNICATION FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE OFFICIAL(S) IN CHARGE OF THE PRESENT REEXAMINATION PROCEEDING.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
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www.uspto.gov

BorgWarner Inc.
c/o Patent Central LLC
1401 Hollywood Boulevard
Hollywood, Florida 33020-5237

(For Patent owner)

MAILED

MAY 18 2010

CENTRAL REEXAMINATION UNIT

Alston & Bird LLP
101 South Tryon Street, Suite 4000
Charlotte, North Carolina 28280-4000

(For Third Party Requester)

Ex parte Reexamination Proceeding
Control No. 90/009,083
Filed: April 18, 2008
For: U.S. Patent No. 6,629,556

Inter Partes Reexamination Proceeding
Control No. 95/000,434
Filing Date: January 29, 2009
For: U.S. Patent No. 6,629,556

DECISION DISMISSING PETITION

This is a decision on the March 31, 2010 patent owner petition entitled "Petition to Suspend Rule 37 CFR § 1.943 Pursuant to the Provisions of 37 CFR § 1.183."

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

The petition fee of $400.00 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183 has been paid in the March 31, 2010 petition.

The petition is dismissed as moot.

BACKGROUND

1. U.S. Patent No. 6,629,556 (the '556 patent) issued on October 7, 2003, with claims 1-9.

2. On April 18, 2008, a third party requester, Honeywell International Inc., met the filing date requirements for a request for *ex parte* reexamination of claims 1-9 of the '556 patent that was assigned control number 90/009,083 (the '9083 proceeding).

3. On May 28, 2008, reexamination was ordered in the '9083 proceeding for claims 1-9 of the '556 patent.

4. On January 29, 2009, the same third party requester, Honeywell International Inc., filed a request for *inter partes* reexamination of claims 1-9 of the '556 patent that was assigned control no. 95/000,434 (the '434 proceeding).

5. On March 30, 2009, reexamination was ordered in the '434 proceeding for claims 1-9 of the '556 patent.

6. On November 12, 2009, the Office mailed a decision merging, *sua sponte,* the '434 and '9083 reexamination proceedings into a single, merged proceeding.

7. On January 22, 2010, the Office mailed a non-final Office action.

8. On February 16, 2010, patent owner filed a request for a one-month extension of time pursuant to 37 CFR 1.956 for filing a response to the January 22, 2010 non-final Office action.

9. On March 1, 2010, the Office mailed a decision granting the requested one-month extension, setting the response due date to April 22, 2010.

10. On March 31, 2010 patent owner filed a petition entitled "Petition to Suspend Rule 37 CFR § 1.943 Pursuant to the Provisions of 37 C.F.R. § 1.183."

11. On April 22, 2010 patent owner timely filed a response to the January 22, 2010 non-final Office action. On page 4 of the response, patent owner expressly renewed the petition of March 31, 2010, requesting that the 50 page limit pursuant to 37 CFR 1.943(b) be extended to 59 pages.

12. On April 23, 2010, patent owner filed a paper entitled "Submission of Exhibits by Patent Owner," to supplement the April 22, 2010 patent owner 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

I. Patent Owner's Petition

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 January 22, 2010 non-final action, not to exceed 75 pages in length.[1] Pet. at 4. In support of waiver of the rule, patent owner indicates that "The Office Action comprises 45 separate paragraphs on 15 pages with 12 grounds of rejection, relying on many hundreds of pages of prior art, and incorporating by reference a further 15 pages of text from the Request for Reexamination, which for its part comprised a 34 page statement and 123 pages of reference material." Pet. at 2.

Patent owner further states that in order to adequately prepare a response, not only does each reference have to be addressed, but a discussion on the development of the turbocharger technology over time must also be presented since this is a highly specialized technology. Pet. at 3.

Patent owner submitted a response to the Office action on April 22, 2010, with two accompanying declarations under 37 CFR 1.132 by Dr. Baines. On April 23, 2010, patent owner submitted exhibits that were inadvertently omitted from the April 22, 2010 submission. Patent owner included in the remarks section of the April 22, 2010 response a request to renew the petition of the March 31, 2010 petition, which had not been decided yet by the Office. In the renewed petition request, patent owner requests waiver of the 50-page limit to allow a response of 59 pages.[2]

II. Analysis and Findings

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[1] It is noted that on page 4 of the petition, patent owner requests waiver of the 50 page limit of up to 75 pages; however, also on page 4, at the end of the first full paragraph of the petition, patent owner requests 70 pages.

[2] Patent owner response at page 4.

The present petition under 37 CFR 1.183 has been fully considered. 37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. In this instance, the petitioner has made a showing in support of the request for waiver of 37 CFR 1.943(b) by attempting to draft a response in compliance with the 50-page limit, and submitting the response entitled "Response by Patent Owner Pursuant to 37 CFR 1.941" on April 22, 2010.

The April 22, 2010 patent owner response, as supplemented by the exhibits filed on April 23, 2010, is accompanied by the two declarations of Dr. Baines. The response includes a "Remarks" section that consists of 26 pages. The following sections of the "Remarks" section are not included in the page limit: the cover page, the two pages of claim appendices, the signature page, and the certificate of service page.

It is noted that, any portion of an affidavit/declaration that does not strictly adhere to presenting and explaining the evidence is subject to the 50-page limit of 37 CFR 1.943(b). Thus, opinion evidence that goes beyond explaining the evidence - legal arguments, e.g. assertions of obviousness and anticipation, are counted as remarks, and are thus part of the 50-page limit of 37 CFR 1.943(b).

The first declaration by Dr. Baines entitled "Declaration under 37 CFR 1.132, Background" comprises 9 pages that do not count toward the page count as the declaration focuses on technological background and does not include any legal arguments. The second declaration by Dr. Baines, entitled "Declaration under 37 CFR 1.132 Patentability" comprises 34 pages. Of these 34 pages, 20 contain legal argument and thus are counted toward the page limit. Examples of legal arguments in the second declaration, which are not exhaustive, that count toward the page limit are: On page 7, paragraph 26 declarant states: "It is my opinion that this disclosure of Hofmeister would motivate one of ordinary skill in the art against using two or more die inserts per air passage." On page 12, paragraph 45, Dr. Baines states: "Further Fries directs the skilled person away from the claimed features." [3] The April 23, 2010 submission's exhibits comprising only drawing with no legal arguments, do not count toward the page limit. Therefore, a total of 46 pages of the patent owner response are counted toward the page-limit, which is within the 50 page limit of 37 CFR 1.943(b).

Accordingly, patent owner's petition under 37 CFR 1.183 is **dismissed as moot**, as the response of April 22, 2010 (as supplemented on April 23, 2010) to the January 22, 2010 non-final Office action is page-length compliant.

CONCLUSION

1. The patent owner petition under 37 CFR 1.183 is **dismissed as moot**, as patent owner's April 22, 2010 response, as supplemented on April 23, 2010, to the January 22, 2010 non-final Office action is page-length compliant.

---

[3] Other examples of legal arguments are on pages 8, 11, 15-19, 21-30 and 33.

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 Maria Nuzzolillo, Legal Advisor, at 571-272-8150 or Susy Tsang-Foster, Legal Advisor, at 571-272-7711.

Kenneth M. Schor

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

Kenpet8
5-17-10

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,437	02/03/2009	7174661	051291.00218	8842

22908 7590 01/08/2010

BANNER & WITCOFF, LTD.
TEN SOUTH WACKER DRIVE
SUITE 3000
CHICAGO, IL 60606

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 01/08/2010

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
TOWNSEND AND TOWNSEND AND CREW LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

Date:

MAILED

JAN 08 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000437
PATENT NO. : 7174661
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 60606

(For Patent Owner)

MAILED

JAN 08 2010

TOWNSEND AND TOWNSEND AND CREW
TWO EMBARCADERO CENTER
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SAN FRANCISCO, CA 94111-3834

(For Requester)

CENTRAL REEXAMINATION UNIT

In re Briscoe
Inter Partes Reexamination Proceeding
Control No. 95/000,437
Filed: February 3, 2009
For: U.S. Patent No. 7,174,661 B2

DECISION
GRANTING PETITION
TO ENTER MISSING PAGES

This is a decision on the November 25, 2009 patent owner petition entitled "PETITION AS TO A CLERICAL ERROR, TO ACCEPT A CORRECT EXHIBIT A TO THE PATENT OWNER'S SUBMISSION UNDER 37 C.F.R. § 1.951 AND PROPOSED AMENDMENT IN RESPONSE TO THE ACTION CLOSING PROSECUTION DATED OCTOBER 16, 2009." The petition is taken as a petition to accept a replacement paper under 37 CFR 1.182.

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 February 3, 2009, a request for *inter partes* reexamination of claims 1-6, 13-20, 24, 25, 39, 40, 43, and 44 of U.S. Patent Number 7,174,661 B2 was filed by the third party requester; the resulting reexamination proceeding was given a filing date and assigned control number 95/000,437 ("the '437 proceeding").

2. On March 6, 2009, an order granting reexamination of claims 1-6, 13-20, 24, 25, 39, 40, 43, and 44 of the '661 patent was mailed in the '437 proceeding, and a non-final Office action was mailed in the '437 proceeding.

3. Prosecution advanced, until, on November 16, 2009, patent owner filed a submission in response to the outstanding Office action, an action closing prosecution, including a proposed amendment to the claims. However, patent owner failed to submit the even numbered pages of the proposed amendment.

4. On November 25, 2009, the instant petition entitled "PETITION AS TO A CLERICAL ERROR, TO ACCEPT A CORRECT EXHIBIT A TO THE PATENT OWNER'S SUBMISSION UNDER 37 C.F.R. § 1.951 AND PROPOSED AMENDMENT IN RESPONSE TO THE ACTION CLOSING PROSECUTION DATED OCTOBER 16, 2009." was filed seeking entry of the missing (unsubmitted) pages of the November 16, 2009 claim amendments.

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).

37 C.F.R. § 1.951 provides:

(a) After an Office action closing prosecution in an inter partes reexamination, the patent owner may once file comments limited to the issues raised in the Office action closing prosecution. The comments can include a proposed amendment to the claims, which amendment will be subject to the criteria of § 1.116 as to whether or not it shall be admitted. The comments must be filed within the time set for response in the Office action closing prosecution.
(b) When the patent owner does file comments, a third party requester may once file comments responsive to the patent owner's comments within 30 days from the date of service of patent owner's comments on the third party requester.

37 C.F.R. § 1.957(d) provides:

When action by the patent owner is a *bona fide* attempt to respond and to advance the prosecution and is substantially a complete response to the Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, an opportunity to explain and supply the omission may be given.

DECISION

Patent owner's November 16, 2009 response omitted the even numbered pages from the amendments to the claims. Patent owner stated that the omission was unintentional, and first came to the patent owner's attention on the date of the filing of the instant petition, November 25, 2009.

Patent owner's omission was unintentional and was timely brought to the attention of the Office. Pursuant to 37 C.F.R. § 1.957(d), an opportunity to explain and supply the omission may be given. For this reason, patent owner's petition is granted to the extent that the Exhibit A, containing the correct amendment to the claims, submitted on November 25, 2009, will be entered to replace the November 16, 2009 amendment to the claims of Exhibit A in the November 16, 2009 submission that contained only odd numbered pages of the submission. To effectuate 37 C.F.R. § 1.951(b), third party requester will be given 30 days from the mailing date of this decision to file comments responsive to the patent owner's comments.

The November 25, 2009 response will be entered[1] by the Central Reexamination Unit in the reexamination proceeding to replace the amendment to the claims of Exhibit A in the November 16, 2009 submission. 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 then address the November 25, 2009 Amendment and any third party comments that comply with 37 C.F.R. § 1.951(b). The examiner will then issue an Office action treating the patent owner papers as a response and comments received after an action closing prosecution.

CONCLUSION

- The petition is **granted to the extent set forth herein**.
- Since the present decision makes the patent owner response enterable, **third party requester has thirty (30) days from the date of mailing of this decision to submit comments pursuant to 37 C.F.R. § 1.951.**
- The November 25, 2009 amendment to the claims will be entered by the Central Examination Unit (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 to address the November 25, 2009 amendment under 37 C.F.R. § 1.951(a) and any third party requester comments under 37 C.F.R. § 1.951(b).

---

[1] 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.

- 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

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

January 7, 2009
C:\Kiva\Kenpet7\RCR\

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,438	02/06/2009	6421210	044760-5002US	5709

24341 7590 09/25/2009

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/25/2009

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/000,438	02/06/09	6421210	DRE1

EXAMINER
BROWNE,LYNNE HAMBLETON

PERRY CLARK
KIRKLAND & ELLIS, LLP
950 PAGE MILL ROAD,
P O BOX 51827
PALO ALTO, CA 94303

ART UNIT	PAPER
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INTER PARTES REEXAMINATION COMMUNICATION

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

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(For Patent Owner)

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(For Third Party Requester)

In re Higuchi
Inter Partes Reexamination Proceeding
Control No. 95/000,438
Filed: February 6, 2009
For: U.S. Patent No. 6,421,210

: **DECISION**
: **DISMISSING PETITION,**
: ***SUA SPONTE,* SUSPENDING**
: **REEXAMINATION**
: **PROCEEDING**

This is a decision on the June 30, 2009 patent owner petition under 37 CFR 1.182 to terminate the instant *inter partes* reexamination proceeding.

The patent owner petition and the instant 95/000,438 *inter partes* reexamination proceeding are before the Office of Patent Legal Administration for consideration.

The patent owner petition requesting termination of the reexamination proceeding is dismissed for the reasons set forth below.

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.

FEE

The petition fee of $400.00 set forth in 37 CFR 1.17(f) for the patent owner's petition under 37 CFR 1.182 was charged to patent owner's Deposit Account No. 50-0310, as authorized by the patent owner on page one of the patent owner's petition. It is noted that patent owner also requests on page one of the petition that the fee set forth in 37 CFR 1.17(f) required by 37 CFR 1.182 be waived pursuant to 37 CFR 1.183 based upon the fact that the patent owner is providing notification to the Office regarding the prior litigation, as it was required to do pursuant to 37 CFR 1.985(a). In response, petitioner could have submitted a bare notification of the concurrent litigation pursuant to 37 CFR 1.985(a), but instead chose to file a petition to terminate the instant

inter partes reexamination proceeding. Since a petition filed under 37 CFR 1.182 requires a fee of $400 as set forth in 37 CFR 1.17(f), the requested fee relief will not be granted.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,421,210 ("the '210 patent") issued to Takeshi Higuchi on July 16, 2002, and is currently assigned to Funai Electric Co., Ltd. ("Funai").

2. The '210 patent is the subject of litigation styled *Funai Electric Company, Ltd. v. Daewoo Electronics Corporation et al.,* No. 3:04-CV-01830 (JCS) initiated in the United States District Court for the Northern District of California on May 7, 2004 by Funai against Daewoo Electronics Corporation ("Daewoo") and related entities (hereinafter "the litigation"). A copy of Daewoo's Answer to the Complaint alleging invalidity of the '210 patent is attached to the patent owner petition filed on June 30, 2009 as Exhibit A.

3. On March 31, 2005, Daewoo served preliminary invalidity contentions regarding the '210 patent. A copy of Daewoo's Preliminary Invalidity Contentions and relevant exhibits thereto are attached to the patent owner petition filed on June 30, 2009 as Exhibit B.

4. On April 20, 2006, Daewoo served final invalidity contentions regarding the '210 patent. A copy of Daewoo's Final Invalidity Contentions and relevant exhibits thereto are attached to the patent owner petition filed on June 30, 2009 as Exhibit C.

5. On February 6, 2008, a jury returned a verdict finding that Daewoo had not sustained its burden of proving the invalidity of claims 1, 2, 4-7, 9, and 10 of the '210 patent. A copy of the verdict is attached to the patent owner petition filed on June 30, 2009 as Exhibit D.

6. On January 21, 2009, a Final Judgment and Permanent Injunction was entered into the litigation by the district court. A Corrected Final Judgment and Permanent Injunction was entered in the litigation on February 13, 2009. The Corrected Final Judgment and Permanent Injunction contained a holding that Daewoo had infringed the '210 patent and is permanently enjoined from making, using, selling, offering for sale, or importing into the United States any of the products found to infringe one or more claims of Funai's '210 patent. A copy of the Final Judgment and and a copy of the Corrected Final Judgment are attached to the patent owner petition filed on June 30, 2009 as Exhibit E.

7. On February 6, 2009, a request for *inter partes* reexamination of claims 1, 2, 4-7, 9, and 10 of the '210 patent was filed by third party requester Perry Clark, Esq. on behalf of Daewoo which was identified as the real party in interest. The request was assigned control number 95/000,438 ("the '438 reexamination proceeding").

8. On April 27, 2009, the third party requester Daewoo 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 *Funai Electric Company, Ltd. v. Daewoo Electronics Corporation et al.,* Appeal Nos. 2009-1225,-1244 (hereafter "the appeal"). The appeal did not challenge the validity of any claims of the '210 patent.

However, the appeal challenges the district court's claim construction. A copy of Daewoo's Appeal Brief is attached to the patent owner petition filed on June 30, 2009 as Exhibit F.

9. Reexamination was ordered in the '438 proceeding on May 4, 2009. A first Office action was mailed, rejecting claims 1, 2, and 4-7 and confirming claims 9 and 10 of the '210 patent.

10. On June 26, 2009, patent owner filed a petition under 37 CFR 1.956, requesting a one month extension of time to file its response to the outstanding Office action.

11. On June 30, 2009, the patent owner filed the present petition under 37 CFR 1.182 to terminate the instant *inter partes* reexamination proceeding.

12. On July 6, 2009, patent owner timely filed a response to the first Office action pursuant to 37 CFR 1.945, retaining original patent claims 1, 2, 4-7, 9, and 10 as unamended.

13. On August 5, 2009, third party requester timely filed comments pursuant to 37 CFR 1.947.

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 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), Section 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 '438 Proceeding

Patent owner petitioner requests that the present *inter partes* reexamination proceeding be terminated on the grounds that the Office no longer has authority to continue with the present reexamination under 35 U.S.C. § 317(b) and 37 CFR 1.907(b). Petitioner asserts that pursuant to 35 U.S.C. § 317(b), 37 CFR 1.907(b) and MPEP 2686.04(II), the following three criteria have been established and therefore require dismissal of the present reexamination proceeding:

1) 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;
2) The final decision establishes that the party has not sustained its burden of proving the invalidity of any patent claim in suit; and
3) The *inter partes* reexam was based on issues which that party or its privies raised or could have raised in the civil action.

Petitioner contends that the Office must not maintain the present '438 reexamination proceeding because a Final Judgment upholding the validity of the '210 patent was entered in the concurrent litigation and that the third party requester has not challenged the validity of the '210 patent on appeal and therefore has waived its right to appeal that issue. Pet. at page 4.

Patent owner also argues that the request for *inter partes* reexamination of the '210 patent was based on issues that were raised or could have been raised in the district court litigation. Specifically, the request for *inter partes* reexamination alleged a substantial new question of patentability regarding claims 1, 2, 4-7, 9, and 10 of the '210 patent based on U.S. Patent No. 6,147,833 ("the '833 patent"), U.S. Patent No. 3,881,118 ("the '188 patent"), Japanese Laid-open Patent Publication No. P Hei. 5-191958 ("the Sankyo 191958 patent"), Korean Utility Model

1997-010957 ("the Daewoo 10957 reference"), and U.S. Patent No. 5,594,604 ("the Daewoo '604 patent"). Patent owner asserts that the '833 patent and the '188 patent were both cited by the original Examiner during the prosecution of the '210 patent, that the Sankyo 191958 patent and the Daewoo 10957 reference were both raised by Daewoo against the '210 patent in the litigation and that the Daewoo '604 patent, issued on January 14, 1997, is currently assigned to Daewoo. Patent owner urges that, in light of the foregoing circumstances, the present reexamination proceeding should be terminated under 35 U.S.C. § 317(b) and 37 CFR 1.907(b).

B. Analysis and Findings

I. Termination of the '438 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 '438 proceeding both involve the same claims in the '210 patent. There is no concurrent *ex parte* proceeding for the '210 patent.

A review of the Final Judgment and Permanent Injunction (Exhibit E) attached to the present petition does not mention that that Daewoo had not sustained its burden of proving the invalidity of claims 1, 2, 4-7, 9, and 10 of the '210 patent. The injunction enjoins Daewoo from making, using, selling, offering for sale, or importing into the U.S. any of the products found to infringe the '210 patent. However, it is noted that on February 6, 2008, Funai obtained a jury verdict (Civil Action No. 3:04-CV-01830) in the U.S. District Court for the Northern District of California finding that Daewoo had not sustained its burden of proving the invalidity of claims 1, 2, 4-7, 9, and 10 of the '210 patent (See Exhibit D attached to the present petition).

The above factors listed in MPEP 2686.04, subsection V, 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 '438 *inter partes* proceeding, at the present time there is no final nonappealable decision adverse to the requester that has been issued in the litigation. Although the third party requester did not challenge the validity of the '210 patent on appeal, the third party requester is challenging claim construction by the district court on appeal (see Daewoo's Appeal Brief attached to the patent owner petition as Exhibit F). Stated differently, because the litigation is presently involved in a pending appeal at the Federal Circuit, the petitioner's position 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) is not accepted. It is not impossible that a decision from the Federal Circuit may vacate the district court's claim construction with a remand for a new trial. If there is a remand for a new trial, it is entirely possible for the district court to alter its previous decision concerning the validity of the claims at issue in the pending *inter partes reexamination* proceeding, either based on the resolved claim construction or other factors.

II. Suspension of the '438 Reexamination Proceeding is Appropriate

Although the decision in the litigation 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. In this situation, the concurrent litigation is potentially near its final resolution. Daewoo filed its brief on April 27, 2009 (see Attachment F). Funai filed its principal brief on June 8, 2009 and its reply brief on August 3, 2009, and Daewoo filed its reply brief on July 20, 2009 (docket information for the concurrent litigation obtained from LexisNexis Courtlink on September 17, 2009).

The significant facts in this proceeding are:

(1) The present '438 proceeding is in the early reexamination phase (a patent owner response has been filed on July 6, 2009, in response to a non-final first Office action, and third party requester comments have been filed on August 10, 2009), and

(2) The appeal has progressed with both parties having filed their principal appeal briefs and reply 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 U.S.C. § 317(b).

The Office recognizes that, upon completion of the appellate process in the Federal Circuit pertaining to the litigated claims, there are only two possible outcomes for the instant *inter partes* reexamination proceeding: (a) the district court's claim construction is upheld or (b) the district court's claim construction is reversed or vacated, with a remand to grant the third party requester a new trial.[1]

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,

[1] At that point, the suspension would be withdrawn, and the reexamination proceeding may continue or resume.

then the reexamination proceeding will 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 '438 proceeding.

CONCLUSION

1. The patent owner petition under 37 CFR 1.182 is dismissed.

2. The instant *inter partes* reexamination proceeding is suspended, *sua sponte*, until the Court of Appeals for the Federal Circuit issues a decision in the concurrently pending appeal with respect to the '210 patent.

3. The patent owner in the '438 *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. Once the Federal Circuit issues its decision, patent owner may renew its petition as to what further action the Office should take.

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

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

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

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

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

For EFS-Web transmissions, 37 CFR 1.8(a)(1)(i) (C) and (ii) states that correspondence (except for a request for reexamination and a corrected or replacement request for reexamination) will be considered timely filed if (a) it is transmitted via the Office's

electronic filing system in accordance with 37 CFR 1.6(a)(4), and (b) includes a certificate of transmission for each piece of correspondence stating the date of transmission, which is prior to the expiration of the set period of time in the Office action.

6. Telephone inquiries related to the present decision should be directed to the Susy Tsang-Foster, Legal Advisor, at 571-272-7711.

Kenneth Schor

Kenneth Schor
Senior Legal Advisor
Office of Patent Legal Administration

9-24-09
C:\Kiva\Kenpet7\IP\suspend

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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.
95/000,440	03/18/2009	7381804	03369/7001505-000	2649

22852 7590 07/12/2010

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 07/12/2010

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

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Date: JUL 1 2 2010

CENTRAL REEXAMINATION UNIT

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
ROTHWELL, FIGG, ERNST & MANBECK, P.C.
1425 K STREET N.W.
SUITE 800
WASHINGTON, D.C. 20005

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000440
PATENT NO. : 7381804
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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GARRETT & DUNNER LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

(For Patent Owner)

MAILED

JUL 1 2 2010

CENTRAL REEXAMINATION UNIT

DARBY & DARBY P.C.
P.O. BOX 770
CHURCH STREET STATION
NEW YORK, NY 10008-0770

(For *Inter Partes* Requester)

ROTHWELL, FIGG, ERNST & MANBECK, P.C.
SUITE 800, 1425 K STREET, N.W.
WASHINGTON, D.C. 200050

(Courtesy Copy)

Inter Partes Reexamination Proceeding
Control No. 95/000,440
Filed: March 18, 2009
For: U.S. Patent No. 7,381,804

DECISION DISMISSING PETITION

This is a decision addressing patent owner's April 28, 2010 petition paper entitled "PETITION SEEKING WAIVER OF 37 C.F.R. § 1.943."

The petition is before the Office of Patent Legal Administration.

The $400.00 petition fee pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183 was processed on April 29, 2010.

The petition is dismissed for the reasons set forth herein.

REVIEW OF THE RELEVANT FACTS

1. United States Patent Number 7,381,804 ("the '804 patent") issued on June 3, 2008.

2. On February 6, 2009, a request for *inter partes* reexamination of the '804 patent was deposited by a third party requester, which request was assigned Reexamination Control No. 95/000,440 ("the '440 proceeding").

3. On March 18, 2009, a corrected request for *inter partes* reexamination of the '804 patent was filed by the third party requester in the '440 proceeding, and the proceeding was assigned a filing date of March 18, 2009.

4. On May 13, 2009, the Office issued an order granting *inter partes* reexamination in the '440 proceeding, concurrently with a non-final Office action on the merits.

5. On July 13, 2009, patent owner filed a response to the May 13, 2009 Office action.

6. On August 11, 2009, third party requester filed comments after patent owner's July 13, 2009 response.

7. On April 13, 2010, the Office mailed a "NOTICE RE DEFECTIVE PAPER IN INTER PARTES REEXAMINATION" ("the Notice of Defective Paper"), stating that patent owner's July 13, 2009 response exceeded the page limit of 37 CFR 1.943(b) and giving patent owner 15 days to file a re-drafted response that would not exceed the page limit or a redacted supplemental response.

8. On April 28, 2010, patent owner filed the instant petition paper entitled, "PETITION SEEKING WAIVER OF 37 C.F.R. § 1.943" ("the petition under 37 CFR 1.183").

9. Concurrently, on April 28, 2010, patent owner filed a re-drafted response to the May 13, 2009 Office action.

10. On May 28, 2010, third party requester filed comments after patent owner's April 28, 2010 re-drafted response.

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.

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 April 13, 2010, the Office mailed a Notice of Defective Paper, stating that patent owner's July 13, 2009 response exceeds 50 pages and giving patent owner 15 days to file a re-drafted response that would not exceed the page limit or a supplemental response redacted to satisfy the 37 CFR 1.943 page limit requirement. In particular, the Office included in its page count the pages of two declarations ("the Petsko declaration" and "the Levitt declaration"), which were submitted as part of the July 13, 2009 response, and the pages of four exhibits, which were cited in patent owner's July 13, 2009 response and submitted with an information disclosure statement that was also filed on July 13, 2009.[1]

On April 28, 2010, patent owner filed the instant petition under 37 CFR 1.183, concurrently with a re-drafted response. In the petition under 37 CFR 1.183, patent owner asserts that the April 28, 2010 re-drafted response complies with the 37 CFR 1.943 page limit requirement.[2] In particular, patent owner asserts that the re-drafted response contains "32 pages of argument and two declarations containing 18 pages of argument, 33 pages of curriculum vitae, 12 pages of data, and 17 pages of non-patent literature" and that "the 62 pages of curriculum vitae, test data, and non-patent literature included with the declarations should be excluded from the total page count, as indicated in MPEP § 2667."[3] Patent owner further asserts:

> In addition, Patent Owner has revised the Response submitted July 13, 2009, to ensure that all of the information from the patent file history documents relied upon in the Response is provided in the form of direct quotes and explanatory discussion. The information presented in the replacement Response is intended to stand on its own, such that there is no need for the Office to analyze the original source materials filed July 13, 2009. Although the replacement Response cites the sources of the quoted material, which were submitted with the Information Disclosure Statement filed July 13, 2009, Patent Owner submits that these citations should not be interpreted as an attempt to incorporate by reference the entire contents of the source documents.[4]

Nonetheless, patent owner requests that "[i]f the Office continues to view Patent Owner's citation to the public patent file history documents as incorporating those documents by reference into

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[1] See, April 13, 2010 Notice of Defective Paper at the Continuation Sheet.
[2] See, the petition under 37 CFR 1.183 at section II(B).
[3] Id.
[4] Id.

the total page count of the replacement Response, Patent Owner respectfully requests waiver of the 50 page requirement set forth in 37 C.F.R. § 1.943(b)."[5]

In this instance, patent owner's April 28, 2010 re-drafted response, including the Petsko and Levitt declarations, is page-length compliant, because 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 31 pages of arguments,[6] and the Petsko and Levitt declarations include approximately 16 pages of arguments.[7] Thus, the portions of patent owner's April 28, 2010 re-drafted response, including the portions of the Petsko and Levitt 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 April 28, 2010 re-drafted response into the record of the '440 proceeding. Accordingly, patent owner's conditional request for waiver of the 50-page limit of 37 CFR 1.943(b) is dismissed as unnecessary.

ADDITIONAL DISCUSSION

In section II(A) of the instant petition under 37 CFR 1.183, patent owner asserts that the April 13, 2010 Notice of Defective Paper was in error and requests that the determination that patent owner's July 13, 2009 response exceeded the page limit be withdrawn. The resolution of patent owner's request that the April 13, 2010 Notice of Defective Paper be withdrawn,[8] although filed as part of the instant petition under 37 CFR 1.183, is a matter that would be decided by the Central Reexamination Unit (CRU) by way of a petition under 37 CFR 1.181. Patent owner's request for waiver of 37 CFR 1.943(b), on the other hand, is a matter that would be decided by the Office of Patent Legal Administration (OPLA) as a petition under 37 CFR 1.183. When two different forms of relief are being requested in a single petition, such petition would normally be considered improper under 37 CFR 1.4(c).[9] However, in the interest of special dispatch, pursuant to 35 U.S.C. 314, patent owner's petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b) has been considered and addressed in this decision. Accordingly, patent owner's petition under 37 CFR 1.181 is dismissed under 37 CFR 1.4(c), as each distinct subject must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects that are considered by different areas of the Office.

CONCLUSION

1. Patent owner's April 28, 2010 petition under 37 CFR 1.183 for waiver of the page limit requirement of 37 CFR 1.943(b) is **dismissed**.

---

[5] Petition under 37 CFR 1.183 at section II(C).

[6] The cover sheet was excluded from the page count. A review of the remarks portion of the April 28, 2010 re-drafted response indicates that patent owner did not incorporate by reference material from other sources, but rather included such material into the response itself, for example, in the form of direct quotes. See, e.g., the re-drafted response at page 11, second paragraph.

[7] See, e.g., pages 2-6 of the Petsko declaration and pages 2-12 of the Levitt declaration.

[8] See, the petition under 37 CFR 1.183 at section II(A).

[9] 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 paper dealing with different subject."

2. Jurisdiction over the '440 proceeding is being 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

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

Kenpet 8
7-8-10

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,443	03/18/2009	6833252	2000706.00135US1	9804

22852 7590 07/20/2009

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 07/20/2009

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
WILMERHALE/ BOSTON
60 STATE STREET
BOSTON, MA 02109

Date:

RECEIVED
JUL 20 2009
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000443
PATENT NO. : 6833252
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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Kenneth J. Meyers
Finnegan, Henderson, Farabow,
Garrett & Dunner LLP
901 New York Avenue, NW
Washington, DC 20001-4413

For Patent Owner

RECEIVED
JUL 20 2009
CENTRAL REEXAMINATION UNIT

Michael J. Twomey, Esq.
Wilmer Cutler Pickering
Hale and Dorr LLP
60 State Street
Boston, MA 02109

For Requester

Ex Parte Reexamination Proceeding
Control No. 95/000,443
Filed: March 18, 2009
For: US Patent No. 6,833,252

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

This is a decision on the petition filed July 1, 2009 to request a one-month extension of time pursuant to 37 CFR 1.956 for filing a response to the Office action mailed May 27, 2009.

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

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

Decision

The Patent Owner requests an extension of time in which to file a response to the Office action dated May 27, 2009, which set a two-month date for filing a response thereto. The Office action is a non-final Office action. The request is timely filed and includes authorization to debit a deposit account for the $200.00 petition fee as required by 37 CFR 1.17(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 Owners are concurrently filing a similar petition in a related proceeding, CN 95,000,427 involving USPN 7,214,536 which also has a response date of July 27, 2009. The request indicates that Patent Owners are currently preparing a response to the outstanding office actions in both proceedings; however, both patents are involved in a Civil Action captioned Cellectis SA v. Precision BioSciences, Inc. Civil Action No.: 5:08-cv-00119-14, US District Court, Eastern District North Caroline (Western Division). Additional time is necessary to consider the invalidity contentions in the civil action as well as the rejections raised in the reexamination proceedings.

Analysis and Findings

On balance, it is considered that the petition explains the "sufficient cause" for an extension of time. Patent Owner has set forth a factual accounting that is deemed to establish reasonably diligent behavior by all those responsible for preparing a

response within the statutory period. When balanced against the requirement of 35 USC 314(c) that this proceeding be handled with special dispatch, Owner's showing is adequate to justify the grant of a one-month extension of time in which to file a response to the Office action. Accordingly, the response is due August 27, 2009. Patent Owner should expect that future requests for extensions will not be granted absent strong and compelling reasons that establish the existence of an extraordinary situation necessitating the additional time.

Conclusion

1. The Patent Owner's petition for extension of time in which to file a response to the Office action of May 27, 2009 is **granted**.

2. The Patent Owner's response is due August 27, 2009.

3. Response may be submitted as follows:

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

By Mail to: Mail Stop *Ex Parte* Reexam
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By Fax to: (571) 273-9900 (Central Reexamination Unit)

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401 Dulany Street
Alexandria, VA 22314

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

/Deborah Jones/

Deborah Jones
SPE, AU 3991
Central Reexamination Unit

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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.
95/000,443	03/18/2009	6833252	2000706.00135US1	9804

22852 7590 02/17/2010

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/17/2010

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
WILMERHALE/ BOSTON
60 STATE STREET
BOSTON, MA 02109

Date:

MAILED

FEB 17 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000443
PATENT NO. : 6833252
TECHNOLOGY CENTER : 3999
ART UNIT : 3991

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

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

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

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

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CENTRAL REEXAMINATION UNIT

Kenneth J. Meyers
Finnegan, Henderson, Farabow,
Garrett & Dunner LLP
901 New York Avenue, NW
Washington, DC 20001-4413

For Patent Owner

Michael J. Twomey, Esq.
Wilmer Cutler Pickering
Hale and Dorr LLP
60 State Street
Boston, MA 02109

For Requester

Ex Parte Reexamination Proceeding
Control No. 95/000,443
Filed: March 18, 2009
For: US Patent No. 6,833,252

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

This is a decision on the petition filed February 16, 2010 to request a one-week extension of time pursuant to 37 CFR 1.956 for filing a response to the Office action mailed January 28, 2010.

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

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

Decision

The Patent Owner requests an extension of time in which to file a response to the Office action dated January 28, 2010, which set a one-month date for filing a response thereto. The Office action is an action closing prosecution (ACP). 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 Owners are concurrently filing a similar petition in a related proceeding, CN 95,000,427 involving USPN 7,214,536 which also has a response date of February 28, 2010. The request indicates that Patent Owners are currently preparing a response to the outstanding Office action; however, efforts have been severely hampered by the recent severe and adverse weather conditions in Washington DC where counsel and supporting staff are located. Offices for counsel were closed February 8-11, 2010 as was the Patent & Trademark Office. An extension of one week is requested in order to complete the response to the outstanding Office action.

Analysis and Findings

On balance, it is considered that the petition explains the "sufficient cause" for an extension of time. Patent Owner has set forth a factual accounting that is deemed to establish reasonably diligent behavior by all those responsible for preparing a response within the statutory period. When balanced against the requirement of 35 USC 314(c) that this proceeding be handled with special dispatch, Owner's showing is adequate to justify the grant of a one-week extension of time in which to file a response to the Office action. Accordingly, the response is due March 7, 2010. Patent Owner should expect that future requests for extensions will not be granted absent strong and compelling reasons that establish the existence of an extraordinary situation necessitating the additional time.

Conclusion

1. The Patent Owner's petition for extension of time in which to file a response to the Office action of January 28, 2010 is **granted**.

2. The Patent Owner's response is due March 7, 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/
Supervisory Patent Examiner, CRU 3991

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CENTRAL REEXAMINATION UNIT

MARTIN & FERRARO, LLP
1557 LAKE O'PINES STREET, NE
HARTVILLE, OH 44632

(For Patent Owner)

DOROTHY P. WHELAN
FISH & RICHARDSON P.C.
P.O. BOX 1022
MINNEAPOLIS, MN 55440-1022

(For *Inter Partes* Requester)

Inter Partes Reexamination Proceeding
Control No. 95/000,446
Filed: May 20, 2009
For: U.S. Patent No. 6,428,542

DECISION GRANTING PETITION

This is a decision on the October 30, 2009 third party requester "PETITION UNDER 37 C.F.R. § 1.183 TO PERMIT 1.5 LINE SPACING FOR THIRD PARTY COMMENTS, OR IN THE ALTERNATIVE, TO WAIVE THE 50-PAGE LIMIT SET FORTH IN 37 C.F.R. § 1.943." The petition is taken as a petition under 37 CFR 1.182, since it requests waiver of a requirement, rather than waiver of a rule.

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

The petition is **granted**, to the extent set forth below.

REVIEW OF FACTS

1. U.S. Patent No. 6,428,542 issued to Michelson on August 6, 2002 (the '542 patent).

2. On May 20, 2009, a second corrected request for *inter partes* reexamination of the '542 patent was filed by a third party requester, which proceeding was assigned control no. 95/000,446 (the '446 proceeding).

3. On June 30, 2009, the Office mailed an Order granting *inter partes* reexamination in the '446 proceeding, which was accompanied by a non-final Office action on the merits.

4. On August 29, 2009, patent owner filed an amendment in response to the non-final Office action.

5. On September 28, 2009, third party requester filed comments responsive to patent owner's August 29, 2009 submission.

6. On October 15, 2009, the Office mailed a notice, expunging third party requester's September 28, 2009 comments as being non-compliant (the "notice of non-compliance") and setting a time period of 15 days from the mailing date of the notice for third party requester to file corrected comments in compliance with the requirements set forth in the notice.

7. On October 30, 2009, third party requester filed "THIRD PARTY COMMENTS AFTER PATENT OWNER'S RESPONSE AND IN RESPONSE TO THE NOTICE OF OCTOBER 15, 2009" (the "corrected comments").

8. Concurrently, on October 30, 2009, third party requester filed the instant petition paper entitled "PETITION UNDER 37 C.F.R. § 1.183 TO PERMIT 1.5 LINE SPACING FOR THIRD PARTY COMMENTS, OR IN THE ALTERNATIVE, TO WAIVE THE 50-PAGE LIMIT SET FORTH IN 37 C.F.R. § 1.943" (the "petition").

DECISION

37 CFR 1.52(b) provides (in-part):

> (2) The specification (including the abstract and claims) for other than reissue applications and reexamination proceedings, and any amendments for applications (including reissue applications) and reexamination proceedings to the specification, except as provided for in §§ 1.821 through 1.825, must have:
>
> (i) Lines that are 1 1/2 or double spaced;

In the October 30, 2009 petition, third party requester requests waiver of the requirement set forth in the October 15, 2009 notice of non-compliance that third party requester's corrected comments be double spaced.[1] Third party requester asserts that the corrected comments, submitted concurrently with the petition on October 30, 2009, are 50 pages in length with one and a half line spacing.[2] In the alternative, in the event that the double spacing requirement set forth in the notice of non-compliance is not waived to permit third party requester's corrected comments having one and a half line spacing, third party requester requests waiver of the 50-page limit of 37 CFR 1.943(b).

37 CFR 1.52(b)(2)(i) requires amendments to the specification in reexamination proceedings to have lines that are one and a half or double spaced. Likewise, it is reasonable that patent owner responses and third party requester comments in *inter partes* reexamination be permitted to have lines that are one and a half or double spaced. Accordingly, the line spacing requirement set forth in the October 15, 2009 notice of non-compliance that third party requester's corrected

[1] October 30, 2009 petition at page 1.
[2] October 30, 2009 petition at page 1.

comments be double spaced is hereby waived to the extent that third party requester's corrected comments are permitted to have lines that are one and a half or double spaced.

Thus, third party requester's October 30, 2009 petition is **granted** to the extent that third party requester's concurrently-filed corrected comments having one and a half line spacing are deemed to be in compliance with the line spacing requirements set forth in the October 15, 2009 notice of non-compliance.

CONCLUSION

1. Third party requester's October 30, 2009 petition is **granted** to the extent that third party requester's concurrently-filed corrected comments having one and a half line spacing are deemed to be in compliance with the line spacing requirements, in modification of the October 15, 2009 notice of non-compliance.

2. Jurisdiction over the '446 proceeding is returned to the Central Reexamination Unit.

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

United States Patent and Trademark Office

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CENTRAL REEXAMINATION UNIT

MARTIN & FERRARO, LLP
1557 LAKE O'PINES STREET, NE
HARTVILLE OH 44632

(For Patent Owner)

FISH & RICHARDSON P.C.
3200 RBC PLAZA
60 SOUTH SIXTH STREET
MINNEAPOLIS, MN 55402

(For Third Party Requester)

In re Michelson	:
Inter Partes Reexamination Proceeding	: **DECISION**
Control No. 95/000,446	: **GRANTING PETITION**
Filed: May 20, 2009	: **UNDER § 1.183**
For: U.S. Patent No. 6,428,542	:

This is a decision on the May 28, 2010 patent owner petition entitled "PETITION 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 rule waiver and an extension of time is **granted** to the extent specified below.

BACKGROUND

- On May 20, 2009, a corrected request for *inter partes* reexamination was filed by the third party requester in control number 95/000,446 ("the '446 proceeding"), originally deposited on March 9, 2009, and the reexamination proceeding was assigned a filing date.

- Prosecution progressed until, on April 28, 2010, a Right of Appeal Notice was issued by the Office.

- On May 28, 2010, patent owner filed a Notice of appeal and the following petitions:

- A petition entitled "PETITION UNDER 37 C.F.R. §§ 1.182 & 1.183," requesting entry and consideration of an amendment.
- A petition entitled "PETITION UNDER 37 C.F.R. § 1.182," requesting continued reexamination.
- The instant petition entitled "PETITION UNDER 37 CFR § 1.183," requesting a waiver of the prohibition on requesting an extension of time to file an appeal brief.

- On June 7, 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 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 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 June 7, 2010. Therefore, the time for patent owner petitioner to file an Appeal Brief is due to expire on August 7, 2010. The outstanding petitions under 37 C.F.R. § 1.182 and § 1.183 are 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 petitions under § 1.182 and § 1.183. A decision on the § 1.182 and § 1.183 petitions have not yet been rendered. In the event patent owner were to have filed an Appellant's 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 either of the petitions under § 1.182 and § 1.183 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 Appellant's Brief is extended to run 30 days from the due date; i.e., September 6, 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 6, 2010.

If the petitions under § 1.182 and § 1.183 have not yet been decided at the point where the time for patent owner to file an Appellant's Brief becomes less than two weeks prior to the deadline as extended, then petitioner may file a petition for an additional extension of time. In that event, petitioner is advised to contact Michael Cygan at the phone number given below in the contact

information to inform the Office that the petition for an additional extension of time is being filed, in order to expedite its review.

CONCLUSION

1. The patent owner petition for extension of time filed May 28, 2010 for filing an Appellant's Brief is **granted to the extent stated above.**

2. The time for to file both the patent owner and third party requester Appellant's Briefs is extended to run **30 days** from the due date; i.e., through September 6, 2010.

3. Telephone inquiries related to this decision should be directed to the undersigned at (571) 272-7700.

/Michael Cygan/

Michael Cygan
Legal Advisor
Office of Patent Legal Administration

July 26, 2010

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,447	05/18/2009	6592586	101.0056-03REX	9993

22882 7590 09/03/2009

MARTIN & FERRARO, LLP
1557 LAKE O'PINES STREET, NE
HARTVILLE, OH 44632

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/03/2009

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

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/000,447	05/18/09	6592586	101.0056-03REX

EXAMINER
CLARK, JEANNE

ART UNIT	PAPER
3993	

FISH & RICHARDSON PC
P O BOX 1022
MINNEAPOLIS, MN 55440-1022

DATE MAILED:

09/03/09

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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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/000,447 03REX	05/18/09	6592586	101.0056-

FISH & RICHARDSON PC
P O BOX 1022
MINNEAPOLIS, MN 55440-1022

EXAMINER
CLARK, JEANNE

ART UNIT	PAPER
3993	

DATE MAILED:

INTER PARTES REEXAMINATION COMMUNICATION

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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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CENTRAL REEXAMINATION UNIT

MARTIN & FERRARO, LLP
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HARTVILLE, OH 44632

(For Patent Owner)

FISH & RICHARDSON PC
P.O. BOX 1022
MINNEAPOLIS, MN 55440-1022

(For Third Party Requester)

In re Michelson.	:	
Inter Partes Reexamination Proceeding	:	DECISION ON
Control No. 95/000,447	:	PETITION UNDER
Filed: May 18, 2009	:	37 CFR 1.181 & 1.927
For: U.S. Patent No. 6,592,586	:	

The paper filed by requester on July 13, 2009, entitled "Petition to Reconsider Order Denying 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 September 19, 2008.

The Petition is **DENIED**.

REVIEW OF FACTS

1. U.S. Patent No. 6,592,586 (hereinafter, the '586 patent) issued on July 15, 2003.

2. A request for *inter partes* reexamination was filed by a third party requestor, on May 18, 2009. The resulting reexamination proceeding was assigned Control No. 95/000,447 (hereinafter, the '447 proceeding).

3. Reexamination was requested for claims 8, 15, 16, 20, 22-27, 30-34, 43, 50, 51, 55, 57-62, 65-69, 78, 85, 86, 90, 92-97, 100-104, 148, 155, 156, 160, 162-167, 170-174, 183, 190, 191, 195, 197, 198, 202-206, and 209-213 of the '586 patent.

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

5. An order denying the request for reexamination for claims 8, 15, 16, 20, 22-27, 30-34, 43, 50, 51, 55, 57-62, 65-69, 78, 85, 86, 90, 92-97, 100-104, 148, 155, 156, 160, 162-167, 170-174, 183, 190, 191, 195, 197, 198, 202-206, and 209-213 was mailed on June 11, 2009.

6. On July 13, 2009, the third party requester filed the present Petition under 37 CFR §§ 1.181 and 1.927.

Summary of 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 erred in her conclusion as to why the claims were allowed over U.S. Patent No. 5,520,690 to Errico et al. [hereinafter "Errico"] (a reference used in a rejection in the original examination) and this error carried over into her analysis of U.S. Patent No. 5,676,666 to Oxland [hereinafter "Oxland"], leading to the erroneous conclusion that Oxland is cumulative of Errico. Petitioner also argues that the examiner erred in her analysis of U.S. Patent No. 5,013,313 to Surer [hereinafter "Surer"] taken with U.S. Patent No. 5,549,612 to Yapp [hereinafter "Yapp"]. Petitioner argues that since Surer discloses the "single-lock" locking mechanism with respect to bone plating systems generally and Yapp discloses an anterior cervical plating system, the two references taken together raise a substantial new question of patentability (SNQ).

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 1-46 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 1-46 of the '915 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).

III. Analysis of the Request for Reexamination

The Request sets forth the following substantial new question (SNQ) of patentability[2]:

---

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

[2] The numbering system for the SNQs set forth by the examiner in the Order Denying the

B1) Claims 8, 15, 16, 20, 22, 23, 25-27, 31-34, 78, 85, 86, 90, 92, 93, 95-97, and 101-104 of the '586 Patent are anticipated by U.S. Patent No. 5,676,666 to Oxland et al. ("Oxland ") under 35 U.S.C. § 102(a) or (e).

B2) Claims 33, 34, 103, and 104 of the '586 Patent are obvious over Oxland in view of Bohler et al, "Anter Plate Stablization for Fracture-disclocations of the Lower Cervical Spine" article in The Journal of Trauma (Vol. 20, No. 3, 1980) ("Bohler") under 35 U.S.C. § 103(a).

B3) Claims 27 and 97 of the '586 Patent are obvious over Oxland in view of U.S. Patent No. 5,492,442 to Lasner ("Lasner") under 35 U.S.C. § 103(a).

C1) Claims 8, 15, 16, 20, 22, 23, 78, 85, 86, 90, 92, 93, 101-104, 183, 190, 191, 195, 197, 202, and 210-213 of the '586 Patent are anticipated by the U.S. Patent No. 5,520,690 to Errico et al. ("Errico") under 35 U.S.C. § 102(a) or (e).

C2) Claims 33, 34, 103, 104, 212, and 213 of the '586 Patent are obvious over Errico in view of Bohler under 35 U.S.C. § 103(a).

C3) Claims 25, 26, 95, 96, 204, and 205 of the '586 Patent are obvious over Errico in view of Oxland under 35 U.S.C. § 103(a).

C4) Claims 26, 27, 96, 97, 205, and 206 of the '586 Patent are obvious over Errico in view of Lasner under 35 U.S.C. § 103(a).

D1) Claims 8, 15, 16, 20, 22-24, 26, 30-34, 43, 50, 51, 55, 57-59, 61, 65-69, 78, 85, 86, 90, 92-94, 96, 100-104, 148, 155, 156, 160, 162-164, 166, 170-174, 183, 190, 191, 195, 197, 198, 202, 203, 205, and 209-213 of the '586 Patent are obvious over U.S. Patent No. 5,013, 313 to Surer ("Surer") in view of U.S. Patent No. 5,549,612 to Yapp et al. ("Yapp") under 35 U.S.C. § 103(a).

D2) Claims 25, 60, 95, 165, and 204 of the '586 Patent are obvious over Surer in view of Yapp and Oxland under 35 U.S.C. § 103(a).

D3) Claims 27, 62, 97, 167, and 206 of the '586 Patent are obvious over Surer in view of Yapp and Lasner under 35 U.S.C. § 103(a).

The Request was denied in the June 11, 2009 Order Denying Request for *Inter Partes* Reexamination, wherein the examiner maintained that a SNQ was not raised by the references cited in the Request. The examiner determined that the references cited in the request, considered both alone and in combination, failed to raise an SNQ to any of claims 8, 15, 16, 20, 22-27, 30-34, 43, 50, 51, 55, 57-62, 65-69, 78, 85, 86, 90, 92-97, 100-104, 148, 155, 156, 160, 162-167, 170-174, 183, 190, 191, 195, 197, 198, 202-206, and 209-213 of the '586 patent. See pages 7-17 of the Order dated June 11, 2009.

Reexamination Request (mailed June 11, 2009) is adopted in this petition decision to maintain continuity and for ease of explanation.

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 issues raised in the Petition.

Turning to the petition, it is first noted that petitioner's statements that the claims of the '586 patent should never have been allowed by the original examiner (see page 4 of the petition filed July 13, 2009) or that errors were committed with respect to Errico during the original prosecution (see page 13 of the petition filed July 13, 2009) are irrelevant to this petition decision and have not been given any credence. Turning to Oxland (proposed SNQs B1-B3 above), petitioner argues that Oxland meets the "coaxial through-hole" limitation of claims 8 and 78 because the bone/screw locking element "may be positioned anywhere along the length of the slot" (see page 10 of the petition filed June 13, 2009). Accordingly, petitioner argues that Oxland necessarily discloses that, in some cases where the bone screw/locking element is positioned in the center of the slot, the central longitudinal axis of the locking element's through-hole would be coaxial with the central longitudinal axis of the bone screw receiving hole (see page 10 of the petition filed July 13, 2009). The examiner argues that Oxland does not raise an SNQ, stating:

> The requester has interpreted this claim limitation so broadly (e.g., being "adapted to") in order
> to have Oxland's teachings read on this limitation. In other words, the requester states that the
> fact that the central longitudinal axes of the through-hole of the locking element and the hole 34"may" align, depending on how the surgeon inserts the screw, meets the claim limitation. The claim, however, does not use "being adapted to" language in this limitation. The interpretation by the requester is unreasonable because it reads in words not present in the claim. When the claim
> limitation is interpreted as written, it is clear that Oxland does not teach that the central longitudinal
> axis of the through-hole being coaxial (e.g., having a common axis) with the central longitudinal axis
> of the bone screw receiving hole. As Oxland fails to present any new, non-cumulative technical
> teaching, a reasonable examiner would not find the teachings of Oxland to be important in deciding
> whether or not a claim is patentable."

An analysis of Oxland reveals that Oxland does not specifically teach that the central longitudinal axis of the through-hole is coaxial with the central longitudinal axis of the bone screw receiving hole. In actuality, as pointed out by the examiner, the ability to adjust the angle of the bone screw relative to the plate and the locking element is an important feature in Oxland's invention (see, e.g., column 3 line 53 to column 4 line 19). As this feature, rather than coaxial alignment, is clearly brought out by Oxland, Oxland thus teaches away from coaxial alignment. The possibility that the through-hole and the bone screw receiving hole may align

and be coaxial is not enough to raise an SNQ. As Oxland fails to present any new, non-cumulative technical teaching, the examiner correctly determined that a reasonable examiner would not find the teachings of Oxland to be important in deciding whether or not a claim is patentable.

Turning to Errico (proposed SNQs C1-C4 above), petitioner argues that there is a complete lack of transparency in the examination process of the '586 patent and this, the examiner incorrectly determined the reasons for why the original examiner allowed the claims over Errico. Notwithstanding this point, petitioner argues that Errico meets the "coaxial through-hole" claim limitation. The examiner states: "The patent applicant in the prior examination added the limitation to claim 713 that "said locking element contacting said contact surface without penetrating said bone screws." By adding this limitation, this claim was distinguished over the alternative embodiment of Errico that fixed the screw relative to the plate by penetrating the bone screw with protuberances 254 (see, e.g., Figure 9 and column 10 lines 26-36)." The examiner further states: "The requester has interpreted this claim limitation so broadly in order to have Errico's teachings read on this limitation. In other words, the requester states that the fact that the central longitudinal axes of the through-hole of the locking element and the hole "may" align, depending on how the surgeon inserts the screw, meets the claim limitation. The claim, however, does not use "may align" language in this limitation. The interpretation by the requester is unreasonable because it reads in words not present in the claim."

An analysis of Errico reveals that Errico does not specifically teach that the central longitudinal axis of the through-hole is coaxial with the central longitudinal axis of the bone screw receiving hole. In actuality, as pointed out by the examiner, the ability to have a wide range of angles for the bone screw relative to the plate and the locking element is an important feature in Errico's invention (see, e.g., column 4 lines 3-12). As this feature, rather than coaxial alignment, is clearly brought out by Errico, Errico thus teaches away from coaxial alignment. The possibility that the through-hole and the bone screw receiving hole may align and be coaxial is not enough to raise an SNQ. As Errico fails to present any new, non-cumulative technical teaching, the examiner correctly determined that a reasonable examiner would not find the teachings of Errico to be important in deciding whether or not a claim is patentable.

Turning to Surer and Yapp, petitioner argues that although Surer does not disclose any specific orthopedic applications for his bone plating system, Yapp is an example of prior art references that disclose anterior cervical plating systems and one of skill in the art at the time would have looked to known plating designs that are applications to orthopedics generally when designing a system specifically for anterior cervical spine application (see pages 22-23 of the petition filed July 13, 2009). The examiner argues that the prior art does not support adapting the invention of Surer for use in a cervical plating system.

An analysis of Surer and Yapp reveals that Surer and Yapp are not combinable. As noted by the examiner, Yapp teaches of the "unique challenges" associated with plates for the cervical region of the spine (see column 1 lines 25-40) as opposed to other bone fixation systems. Furthermore, Surer's invention clearly includes toe-nailed screws and locking elements that extend beyond the

face of the plate (see Figure 2). The examiner also notes that it is not clear if the thickness of the plate required by Surer could be reduced without destroying the invention so as to be usable in the cervical spine region and that there are anatomical differences between examples given in Surer and the spine, including the different bone structures and different stresses and strains experienced by the plate or anchor systems. As Surer is thus not combinable with Yapp, the request does not present a new technological teaching such that a reasonable examiner would find the teachings of Surer in view of Yapp to be important.

Therefore, the examiner properly determined that request fails to raise an SNQ as to claims 8, 15, 16, 20, 22-27, 30-34, 43, 50, 51, 55, 57-62, 65-69, 78, 85, 86, 90, 92-97, 100-104, 148, 155, 156, 160, 162-167, 170-174, 183, 190, 191, 195, 197, 198, 202-206, and 209-213 of the '586 patent. Accordingly, the Petition is DENIED.

CONCLUSION

1. Given the facts involved in this proceeding, the request for *inter partes* reexamination of claims 8, 15, 16, 20, 22-27, 30-34, 43, 50, 51, 55, 57-62, 65-69, 78, 85, 86, 90, 92-97, 100-104, 148, 155, 156, 160, 162-167, 170-174, 183, 190, 191, 195, 197, 198, 202-206, and 209-213 of the '586 patent is denied.

2. Accordingly, the PETITION is DENIED.

3. A partial refund of the filing fee for the request for reexamination will be made to the third party requester in due course. See 35 U.S.C. 312(c) and 37 CFR 1.26(c).

4. This decision is final and nonappealable. 37 CFR 1.927. No further communication on this matter will be acknowledged or considered.

5. Telephone inquiries related to this decision should be directed to Beverly Flanagan at (571) 272-4766, Andres Kashnikow, Supervisory Patent Examiner, at (571) 272-4361, or in their absence to the undersigned at (571) 272-3838.

Gregory A. Morse
Director
Central Reexamination Unit

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Date: MAILED
SEP 0 9 2009
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000450
PATENT NO. : 6916320
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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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,450	04/06/2009	6916320	101.0056-12REX	5831

22882 7590 09/09/2009

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/09/2009

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

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CENTRAL REEXAMINATION UNIT

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(For Patent Owner)

FISH & RICHARDSON PC
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MINNEAPOLIS, MN 55440-1022

(For Third Party Requester)

In re Michelson.	:	
Inter Partes Reexamination Proceeding	:	DECISION ON
Control No. 95/000,450	:	PETITION UNDER
Filed: April 6, 2009	:	37 CFR 1.181 & 1.927
For: U.S. Patent No. 6,916,320	:	

The paper filed by requester on June 12, 2009, entitled "Petition to Reconsider Order Denying 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 14, 2009.

The Petition is **DENIED**.

REVIEW OF FACTS

1. U.S. Patent No. 6,916,320 (hereinafter, the '320 patent) issued on July 12, 2005.

2. A request for *inter partes* reexamination was filed by a third party requestor, on April 6, 2009. The resulting reexamination proceeding was assigned Control No. 95/000,450 (hereinafter, the '450 proceeding).

3. Reexamination was requested for claims 1-11, 24, 25, 31-33, and 35 of the '320 patent.

4. A Notice of Reexamination Request Filing Date was issued on April 29, 2009.

5. An order denying the request for reexamination for claims 1-11, 24, 25, 31-33, and 35 was mailed on May 14, 2009.

6. On June 12, 2009, the third party requester filed the present Petition under 37 CFR §§ 1.181 and 1.927.

Summary of 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 erred in her conclusion that French Patent No. 2,750,594 to Kehr [hereinafter "Kehr"] does not present a substantial new question of patentability (SNQ) because the "width" and "length" limitations recited in the claims are shown by the Figures in Kehr. Petitioner also argues that the examiner erred in her analysis of U.S. Patent No. 4,955,908 to Frey [hereinafter "Frey"] by incorrectly interpreting the "mid-longitudinal axis" limitation and therefore incorrectly concluding that Frey did not disclose the "width" limitation. Petitioner further argues that the examiner incorrectly interpreted the "end wall" limitation in the claims and thus wrongly concluded that Frey did not disclose the "length" limitation.

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 1-46 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 1-46 of the '915 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).

III. Analysis of the Request for Reexamination

The Request sets forth the following substantial new question (SNQ) of patentability[2]:

> A1) Claims 1, 8-11, 24, 25, 31, 32, and 35 of the '320 Patent are anticipated by French Patent Document No. 2,570,594 to Kehr ("Kehr") under 35 U.S.C. §102(b).
>
> A2) Claims 2-7 of the '320 Patent are obvious over Kehr under 35 U.S.C. §103(a).

---

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

[2] The numbering system for the SNQs set forth by the examiner in the Order Denying the Reexamination Request (mailed June 11, 2009) is adopted in this petition decision to maintain continuity and for ease of explanation.

A3) Claims 2-7 and 33 of the '320 Patent are obvious over Kehr in view of U.S. Patent No. 5,364,399 to Lowery et al. ("Lowery") under 35 U.S.C. §103(a).

B1) Claims 1, 8-11, 24, 25, 31, 32, and 35 of the '320 Patent are anticipated by U.S. Patent No. 4,955,908 to Frey et al. ("Frey") under 35 U.S.C. §102(b).

B2) Claims 2-7 of the '320 Patent are obvious over Frey under 35 U.S.C. §103(a).

B3) Claims 2-7 and 33 of the '320 Patent are obvious over Frey in view of Lowery under 35 U.S.C. §103(a).

The Request was denied in the May 14, 2009 Order Denying Request for *Inter Partes* Reexamination, wherein the examiner maintained that a SNQ was not raised by the references cited in the Request. The examiner determined that the references cited in the request, considered both alone and in combination, failed to raise an SNQ to any of claims 1-11, 24, 25, 31-33, and 35 of the '320 patent. See pages 6-15 of the Order dated May 14, 2009.

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 issues raised in the Petition.

Turning to the petition, petitioner argues that the "length" and "width" limitations in the claims are supported only by the Figures of the '320 patent (see Fig. 5 of the '320 patent and petitioner's marked up copy of Fig. 5 as shown at page 4 of the petition filed June 12, 2009). Petitioner thus argues that his reliance on the prior art figures to teach the "length" and "width" limitations should have been accepted by the examiner and given the same degree of reliance as the original examiner gave the figures of the '320 patent during prosecution. Turning specifically to Kehr, petitioner argues that the "width" and "length" limitations are supported by the Figures in Kehr, such as Fig. 1 (see page 11 of the petition filed June 12, 2009). The examiner states:

> Furthermore, the request does not present any evidence outside of the annotated drawings on page 16 to support the contention that Kehr meets the width limitations of the indentation as cited in claim 1 of the '320 patent. In reviewing Kehr and the request as a whole (especially page 16), it is simply not clear if Kehr does teach the "width" of the indentation as "... having a maximum width transverse to the mid-longitudinal axis that is greater than the minimum distance separating said bone screw receiving holes at said upper surface and along the straight line," as required by claim 1. Furthermore, it is also not clear if Kehr meets the "length" limitation as alleged on pages 15-16 of the request.

An analysis of Kehr reveals that Kehr is silent as to any width or length dimensions on the figures. One is thus left to interpret the figures. It is well settled that drawings can anticipate claim limitations if they clearly show the structure that is claimed, and accordingly, drawings must be evaluated for what they reasonably disclose and suggest to one of ordinary skill in the art. See MPEP 2125. MPEP 2125 further states that:

> "When the reference does not disclose that the drawings are to scale and is silent as to dimensions, arguments based on measurement of the drawing features are of little value. See *Hockerson-Halberstadt, Inc. v. Avia Group Int'l*, 222 F.3d 951, 956, 55 USPQ2d 1487, 1491 (Fed. Cir. 2000) (The disclosure gave no indication that the drawings were drawn to scale. '[I]t is well established that patent drawings do not define the precise proportions of the elements and may not be relied on to show particular sizes if the specification is completely silent on the issue.')."

It is agreed that in this case, Kehr gives no indication that the drawings were drawn to scale. Therefore, Figure 1 must be evaluated for what it reasonably discloses and suggests to one of ordinary skill in the art and it does not suggest any specific width or length dimensions. Accordingly, a reasonable examiner would not find the teachings of Kehr to be important in determining the patentability of claim 1 because Kehr does not clearly teach the limitations pertaining to the indentation dimensions. Therefore, Kehr does not raise a substantial new question of patentability with regard to independent claim 1 and dependent claims 2-11, 24, 25, 31-33, and 35.

Turning to Frey, (proposed SNQs B1-B3 above), petitioner argues that the examiner gave an unduly narrow interpretation of "mid-longitudinal axis", stating that it is the "long axis of the plate located in the middle of the plate". As such, the examiner wrongly found that the indentation width in Frey is not "transverse to the mid-longitudinal axis" of the plate. Petitioner also argues that the examiner incorrectly interpreted claim 1 as requiring that the "lowermost portion of the indentation" must meet the "length" requirement.

An analysis of Frey reveals that Frey, like Kehr, does not describe in the specification about any length or width dimensions of the spacing between of around the bone screw receiving openings. Therefore, only the disclosure of any dimensions is that shown in Figure 3 of Frey. One is thus left to interpret the figures. It is well settled that drawings can anticipate claim limitations if they clearly show the structure that is claimed, and accordingly, drawings must be evaluated for what they reasonably disclose and suggest to one of ordinary skill in the art. See MPEP 2125. MPEP 2125 further states that:

> "When the reference does not disclose that the drawings are to scale and is silent as to dimensions, arguments based on measurement of the drawing features are of little value. See *Hockerson-Halberstadt, Inc. v. Avia Group Int'l*, 222 F.3d 951, 956, 55 USPQ2d 1487, 1491 (Fed. Cir. 2000) (The disclosure gave no indication that the drawings were drawn to scale. '[I]t is well established that patent drawings do not define the precise proportions of

> the elements and may not be relied on to show particular sizes if the specification is completely silent on the issue.')."

It is agreed that, in this case, Frey gives no indication that the drawings were drawn to scale. Therefore, Figure 3 must be evaluated for what it reasonably discloses and suggests to one of ordinary skill in the art and it does not suggest any specific width or length dimensions. Regarding the examiner's interpretation of the "mid-longitudinal axis" claim language, her reasoning below is found to be sound:

> While the specification of the '320 patent does not set forth a clear and explicit definition of the mid-longitudinal axis, one of ordinary skill in the art when reading the specification of the '320 patent would understand the mid-longitudinal axis is the long axis of the plate located in the middle of the plate. For example, see column 13 lines 17-25. This understanding is consistent with the common usage of the term "longitudinal." See definition in the medical dictionary on the Free Dictionary website (e.g., "running in the direction of the long axis of the body" or "pertaining to a measurement in the direction of the long axis of an object ..."). Using this definition, in Frey, the mid-longitudinal axis is center horizontal line shown in Figure 3. Therefore, the "width" as defined by the requester is parallel to (and not transverse to, as required by claim 1) the mid-longitudinal axis.

Regarding the examiner's interpretation of the "end wall" limitation of the claims, her reasoning below is likewise found to be sound:

> Claim 1, however, states that the end wall is proximate to the straight line that connects the centers of the screw receiving holes. Therefore, in Frey, the end wall is the lowermost portion of the indentation that is proximate to the defined straight line. It appears that the "length" as shown in the annotated drawings on page 26 in the request is equal to the distance of the radius of either of the bone screw receiving holes. Specifically, lowermost portion of the indentation (the end wall) appears to be in line with the bottom of the holes. Therefore, Frey does not appear to meet the limitation of the "length" being less than the radius of the holes. Accordingly, the drawings do not clearly show that Frey teaches either the "width" or the "length" limitations.

Accordingly, a reasonable examiner would not find the teachings of Frey to be important in determining the patentability of claim 1 because Frey does not clearly teach the limitations pertaining to the indentation dimensions and the teachings of Frey appear to be cumulative to teachings already considered in the prior examination.

Therefore, the examiner properly determined that request fails to raise an SNQ as to claims 1-11, 24, 25, 31-33, and 35 of the '320 patent. Accordingly, the Petition is DENIED.

CONCLUSION

1. Given the facts involved in this proceeding, the request for *inter partes* reexamination of claims 1-11, 24, 25, 31-33, and 35 of the '320 patent is denied.

2. Accordingly, the PETITION is DENIED.

3. A partial refund of the filing fee for the request for reexamination will be made to the third party requester in due course. See 35 U.S.C. 312(c) and 37 CFR 1.26(c).

4. This decision is final and nonappealable. 37 CFR 1.927. No further communication on this matter will be acknowledged or considered.

5. Telephone inquiries related to this decision should be directed to Beverly Flanagan at (571) 272-4766, Andres Kashnikow, Supervisory Patent Examiner, at (571) 272-4361, or in their absence to the undersigned at (571) 272-3838.

Gregory A. Morse
Director
Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,451	03/12/2009	6,936,050 B2	101.0056-10REX	5200

22882 7590 01/08/2010

MARTIN & FERRARO, LLP
1557 LAKE O'PINES STREET, NE
HARTVILLE, OH 44632

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 01/08/2010

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Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000451
PATENT NO. : 6936050
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)

FISH & RICHARDSON P.C.
P.O. BOX 1022
MINNEAPOLIS, MN 55440-1022

(For *Inter Partes* Requester)

MAILED

JAN 08 2010

CENTRAL REEXAMINATION UNIT

Inter Partes Reexamination Proceeding
Control No. 95/000,451
Filed: March 12, 2009
For: U.S. Patent No. 6,936,050

DECISION GRANTING PETITION

This is a decision on the October 30, 2009 third party requester "PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE THE 50-PAGE LIMIT SET FORTH IN 37 C.F.R. § 1.943 AND TO PERMIT 1.5 LINE SPACING FOR THIRD PARTY COMMENTS." The petition is taken as a petition under 37 CFR 1.182 as to the line spacing, since it requests waiver of a requirement, rather than waiver of a rule. The petition is also taken as a petition under 37 CFR 1.183 as to the page limit, since it requests waiver of a rule.

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

The petition is **granted**, to the extent set forth below.

REVIEW OF FACTS

1. U.S. Patent No. 6,936,050 issued to Michelson on August 30, 2005 (the '050 patent).

2. On March 12, 2009, a request for *inter partes* reexamination of the '050 patent was filed by a third party requester, which proceeding was assigned control no. 95/000,451 (the '451 proceeding).

3. On April 29, 2009, the Office mailed an Order granting *inter partes* reexamination in the '451 proceeding.

4. On June 17, 2009, the Office mailed a non-final Office action on the merits in the '451 proceeding.

5. On August 17, 2009, patent owner filed an amendment in response to the non-final Office action.

6. On September 16, 2009, third party requester filed comments responsive to patent owner's August 17, 2009 submission.

7. On October 15, 2009, the Office mailed a notice, expunging third party requester's September 16, 2009 comments as being non-compliant (the "notice of non-compliance") and setting a time period of 15 days from the mailing date of the notice for third party requester to file corrected comments in compliance with the requirements set forth in the notice.

8. On October 30, 2009, third party requester filed "THIRD PARTY COMMENTS AFTER PATENT OWNER'S RESPONSE AND IN RESPONSE TO THE NOTICE OF OCTOBER 15, 2009" (the "corrected comments").

9. Concurrently, on October 30, 2009, third party requester filed the instant petition paper entitled "PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE THE 50-PAGE LIMIT SET FORTH IN 37 C.F.R. § 1.943 AND TO PERMIT 1.5 LINE SPACING FOR THIRD PARTY COMMENTS" (the "petition").

DECISION

Relevant Statutes, Regulations and Procedures

37 CFR 1.52(b) provides (in-part):

> (2) The specification (including the abstract and claims) for other than reissue applications and reexamination proceedings, and any amendments for applications (including reissue applications) and reexamination proceedings to the specification, except as provided for in §§ 1.821 through 1.825, must have:
>
> (i) Lines that are 1 1/2 or double spaced;

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.

October 15, 2009 Line Spacing Requirement

In the October 30, 2009 petition, third party requester requests waiver of the requirement set forth in the October 15, 2009 notice of non-compliance that third party requester's corrected

comments be double spaced.[1] Third party requester asserts that the corrected comments, submitted concurrently with the petition, on October 30, 2009, use one and a half line spacing.[2]

37 CFR 1.52(b)(2)(i) requires amendments to the specification in reexamination proceedings to have lines that are one and a half or double spaced. Likewise, it is reasonable that patent owner responses and third party requester comments in *inter partes* reexamination be permitted to have lines that are one and a half or double spaced. Accordingly, the line spacing requirement set forth in the October 15, 2009 notice of non-compliance that third party requester's corrected comments be double spaced is hereby waived to the extent that third party requester's corrected comments are permitted to have lines that are one and a half or double spaced.

Thus, third party requester's October 30, 2009 petition is **granted** to the extent that third party requester's concurrently-filed corrected comments having one and a half line spacing are deemed to be in compliance with the line spacing requirements set forth in the October 15, 2009 notice of non-compliance.

Request for Waiver of 37 CFR 1.943(b)

In the October 30, 2009 petition, third party requester requests waiver of the 50-page limit of 37 CFR 1.943(b).[3] Third party requester asserts that the corrected comments, submitted concurrently with the instant petition on October 30, 2009, are 56 pages in length, having text in a 12-point font size and one and a half line spacing.[4]

In support of waiver of the rule, third party requester asserts that patent owner's August 17, 2009 amendment "doubled the number of claim limitations that must be analyzed for the previously reexamined claims" and "more than double[d] the total number of claims in the reexamination."[5] Third party requester asserts that "[i]n order to address all of the new issues raised by the Patent Owner's lengthy claim amendments, this corrected version of the Third Party Comments (in 12-point font) has a length of 56 pages--slightly more than the 50-page limit set forth in 37 C.F.R. § 1.943."[6] Further, third party requester has made a showing in support of its request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft corrected comments in compliance with the 50-page limit and having 12-point font, as required by the notice of non-compliance, and by submitting the resulting corrected comments, which are in excess of 50 pages. Additionally, third party requester asserts that it has "made a good faith effort to remove any redundant textual arguments from this corrected version of the Third Party Comments while still addressing the same issues identified in the originally filed Comments."[7] The corrected comments have one and a half line spacing; however, the requirement for double spacing has been waived herein (see previous section above).

---

[1] October 30, 2009 petition at page 1.
[2] October 30, 2009 petition at page 1.
[3] October 30, 2009 petition at page 3.
[4] October 30, 2009 petition at page 3.
[5] October 30, 2009 petition at page 3 (asserting that the August 17, 2009 amendment more than doubled the length of independent claims 1-20 and added thirty-six new claims numbered 40-75).
[6] October 30, 2009 petition at page 4.
[7] October 30, 2009 petition at page 4.

Based on the specific facts set forth in the instant petition under 37 CFR 1.183, third party requester's showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft corrected comments in compliance with the 50-page limit and the 12-point font size requirement (set forth in the notice of non-compliance) and submitting the resulting corrected comments (which are 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 of permitting third party requester's October 30, 2009 corrected comments, which exceed the 50-page limit by 6 pages.

Accordingly, third party requester'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 6 pages of the portions of third party requester's October 30, 2009 comments, which are included in the regulatory page count, that exceed the 50-page limit.

CONCLUSION

1. Third party requester's October 30, 2009 petition is **granted** to the extent that third party requester's concurrently-filed corrected comments having one and a half line spacing are deemed to be in compliance with the line spacing requirements, in modification of the October 15, 2009 notice of non-compliance.

2. Third party requester's October 30, 2009 petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b) is **granted**. The page limit of 37 CFR 1.943(b) is waived as to 6 pages of the portions of third party requester's October 30, 2009 corrected comments, which are included in the regulatory page count, that exceed the 50-page limit. This makes the October 30, 2009 corrected comments page length compliant.

3. Jurisdiction over the '451 proceeding is returned to the Central Reexamination Unit.

4. 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

Kenpet7/IP/...
1-6-10

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,451	03/12/2009	6,936,050 B2	101.0056-10REX	5200

22882 7590 07/27/2010

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 07/27/2010

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Date:
MAILED

JUL 27 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000451
PATENT NO. : 6936050
TECHNOLOGY CENTER : 3999
ART UNIT : 3993

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

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

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

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

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MAILED

JUL 27 2010

CENTRAL REEXAMINATION UNIT

Inter Partes Reexamination Proceeding
Control No. 95/000,451
Filed: March 12, 2009
For: U.S. Patent No. 6,936,050

DECISION DISMISSING PETITION

This is a decision on *inter partes* requester's May 13, 2010 petition paper entitled "PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE 37 C.F.R. § 1.951 AS TO ITS 'ONE OPPORTUNITY' LIMITATION" (hereinafter "the petition under 37 CFR 1.183").

The petition under 37 CFR 1.183 is before the Office of Patent Legal Administration.

The petition fee of $400 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183 was processed on March 14, 2010.

The petition is **dismissed**, for the reasons set forth herein.

BACKGROUND

1. U.S. Patent No. 6,936,050 issued to Michelson on August 30, 2005 ("the '050 patent").

2. On March 12, 2009, a request for *inter partes* reexamination of the '050 patent was filed by a third party requester (hereinafter "requester"), which proceeding was assigned control no. 95/000,451 ("the '451 proceeding").

3. On April 29, 2009, the Office mailed an Order granting *inter partes* reexamination in the '451 proceeding.

4. The '451 proceeding progressed to the point where, on February 16, 2010, the Office mailed an Action Closing Prosecution ("ACP").

5. On March 16, 2010, patent owner filed a submission under 37 CFR 1.951(a) addressing the February 16, 2010 ACP, which submission included a proposed amendment to the claims.

6. On April 15, 2010, requester filed responsive comments under 37 CFR 1.951(b).

7. On April 28, 2010, the Office mailed a Right of Appeal Notice ("RAN"). In the RAN, the examiner entered patent owner's March 16, 2010 amendment, but the examiner did not enter requester's April 15, 2010 comments, for reasons set forth in the RAN.

8. On May 13, 2010, requester filed the instant petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.951(b) for entry of its concurrently filed submission entitled "CORRECTED THIRD PARTY COMMENTS TO PATENT OWNER'S PROPOSED AMENDMENT AFTER THE CLOSE OF PROSECUTION" ("the May 13, 2010 comments submission").

9. On May 28, 2010, requester filed a Notice of Appeal in the '451 proceeding.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

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 1.181 provides, in pertinent part:

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

37 CFR 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 1.951(b) provides:

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

DECISION

In the April 28, 2010 RAN, the examiner withdrew all of the previous rejections set forth in the February 16, 2010 ACP and confirmed all of the claims subject to reexamination as patentable (*i.e.*, claims 1, 4, 5, 7-9, 11-16, 19-21, 24-27, 29, 31-36, 39, 42-45, 47-50, 52-54, 61-64, 66, 68, 71, 72 and 75).[1]

On page 5 of the RAN, the examiner stated the following reasons for entering patent owner's March 16, 2010 amendment:

> Patent owner responded to the ACP by further amending claims 1, 5, 8, 19, 20, 25, 26, 29, 44, 45, 50,52-54, 63, 68, 71, and 72, and further cancelling claims 6, 40, 41, 46, 51, 55-60, 65, 67, 69, 70, 73 and 74. See the papers dated March 16, 2010. In order to best achieve the statutory mandate of special dispatch, the proposed amendment of March 16, 2010 is entered because it resolves the issues raised in the ACP without being a undue burden on the examiner.

Further, on pages 5-6 of the RAN, the examiner stated the following reasons for not entering requester's April 15, 2010 comments submission, and for not providing requester an opportunity to file corrected comments:

> The comments of April 15, 2010 are not compliant with 37 CFR 1.951(b) because they go beyond the scope of responding to patent owner's March 16, 2010 response and the ACP. ... [T]he amendment of March 16, 2010 that inserted the subject matter of claim 67 into dependent claim 1 does not raise any new issues that gives the requester an additional right for consideration of new proposed rejections. Accordingly, the newly raised proposed rejections of claim 1 under 35 USC 112 and 103 (e.g., proposed rejections identified as III(C)&(D) and IV), based upon the addition of the subject matter of claim 67 into claim 1, go beyond the scope of responding to patent owner's March 16, 2010 amendment. In accordance with MPEP 2672 and 37 CFR 1.951(b), the papers of April 15, 2010 will be returned as improper, and no additional opportunity is given to file corrected comments. The third party requester may address any new finding of patentability in this action at the appeal stage in the same manner that it would address any earlier finding of patentability made during the reexamination proceeding.

---

[1] See April 28, 2010 RAN at page 7.

In the instant petition under 37 CFR 1.183, requester seeks waiver of 37 CFR 1.951(b) to permit entry of the concurrently filed May 13, 2010 comments submission.

Requester asserts in the instant petition that, in the April 15, 2010 comments submission, which was refused entry by the examiner in the RAN, requester "proposed new rejections for claim 20 under §§ 112 and 103 necessitated by the newly modified claim scope for claim 20," and "proposed a new § 112 rejection for dependent claim 8 due to the newly added limitations injected by [patent owner's March 16, 2010] Proposed Amendment."[2] With respect to the proposed rejections of claim 1, requester asserts that, when requester filed the April 15, 2010 comments submission, "the Requester mistakenly believed that the proposed rejections for claim 1 were permissible under 37 CFR 1.951(b)" because "[patent owner's] amendment to claim 1 inserted some new language that was never previously recited in claim 1 or allowed dependent claim 67," and "new questions under 35 U.S.C. § 112 arose due to the unexpectedly different (narrower) interpretation that the Examiner gave to dependent claim 67...."[3]

Requester further asserts in the instant petition that the concurrently filed May 13, 2010 comments submission, for which requester seeks entry, "eliminate any proposed rejections related to claim 1" and "relate only to the new limitations inserted in claims 8 and 20 that were never previously considered before the ACP and thus fully and clearly comply with 37 C.F.R. 1.951(b)."[4] Accordingly, in the instant petition, requester "asks that the Patent Office consider the significant problems raised by the Patent Owner's amendments to claims 8 and 20" and asserts that "[a] refusal to consider these issues for claims 8 and 20 may eventually result in the issuance of a reexamination certificate in which patent claims are invalid over known prior art publications that were refused consideration by the Patent Office due differing interpretations of a technical rule (37 C.F.R. § 1.951(b)). Such an application of 37 C.F.R. § 1.951 would rise to the level of being arbitrary and capricious....."[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 are not sufficient to demonstrate an extraordinary situation in which justice requires suspension of a rule. Rather, in order to obtain a grant of any petition under 37 CFR 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 satisfied that burden in this case. Petitioner's failure to timely file an acceptable comments submission is not an extraordinary situation which, when justice requires, waiver of the rules.

---

[2] The petition under 37 CFR 1.183 at page 3, paragraph 8.
[3] *Id.* at page 4.
[4] *Id.* at page 1
[5] *Id.* at page 5.

As pointed out above, at page 4 of the instant petition, requester asserts that, when requester filed the April 15, 2010 comments submission, "the Requester mistakenly believed that the proposed rejections for claim 1 were permissible under 37 CFR 1.951(b)" because "[patent owner's] amendment to claim 1 inserted some new language that was never previously recited in claim 1 or allowed dependent claim 67," and "new questions under 35 U.S.C. § 112 arose due to the unexpectedly different (narrower) interpretation that the Examiner gave to dependent claim 67...." However, 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). If the petition were to be granted in this case, petitioner's mistaken belief would cause the proceeding to be backed-up (regressed) to the point where the examiner would need to consider patent owner and requester comments after ACP, as opposed to the present status of being ready to be briefed. This would run contrary to the requirement of 35 U.S.C. § 314(c) that reexamination proceedings are to be conducted with special dispatch in the Office.

For the foregoing reasons, the instant petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.951(b) for entry of requester's May 13, 2010 comments submission, **is dismissed**. The May 13, 2010 comments submission will not be entered and will be expunged from the record of the '451 proceeding by marking the papers "closed" and "not public."

CONCLUSION

1. Requester's May 13, 2010 petition under 37 CFR 1.183 is **dismissed**.

2. The May 13, 2010 comments submission will not be entered and will be expunged from the record of the '451 proceeding by marking the papers "closed" and "not public."

3. Jurisdiction over the '451 proceeding is being returned to the Central Reexamination Unit.

4. Any inquiry concerning the instant decision should be directed to Nicole Dretar, Legal Advisor, at (571) 272-7717.

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

7-23-10
Kenpet8/

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,457	05/07/2009	6549970	379922-457RX (105402)	1192

37509 7590 02/22/2010

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/22/2010

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/000,457	05/07/09	6549970	INNL-006/00US

EXAMINER
LEE, CHRISTOPHER E.

ART UNIT	PAPER
3992	

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DATE MAILED: MAILED

FEB 22 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.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,457	05/07/2009	6549970	379922-457RX (105402)	1192

37509 7590 02/22/2010

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/22/2010

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FEB 22 2010

CENTRAL REEXAMINATION UNIT

Inter Partes Reexamination Proceeding : **DECISION**
Control No. 95/000,457 : **GRANTING**
Filed: May 7, 2009 : **PETITION**
For: U.S. Patent No. 6,549,970 : **IN-PART**

This is a decision on the October 9, 2009 patent owner paper entitled "PETITION UNDER 37 CFR §§ 1.182 AND 1.183 TO DISMISS AND EXPUNGE AN IMPERMISSIBLE FILING FROM THE RECORD."

The petition under 37 CFR 1.182/1.183 is before the Office of Patent Legal Administration.

The patent owner petition is **granted in-part**, i.e., granted to the extent that waiver of 37 CFR 1.939 has been considered with respect to third party requester's petition, but is dismissed as to the underlying expungement relief requested therein.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,549,970 issued to Arai et al. on April 15, 2003 ("the '970 patent").

2. On March 24, 2009, a request for *inter partes* reexamination of the '970 patent was deposited by a third party requester, which proceeding was assigned Control No. 95/000,457 ("the '457 proceeding").

3. On May 7, 2009, a corrected request for *inter partes* reexamination of the '970 patent was filed by third party requester in the '457 proceeding.

4. On July 21, 2009, reexamination was ordered in the '457 proceeding.

5. On September 21, 2009, third party requester filed a paper in the '457 proceeding entitled "PETITION UNDER 37 C.F.R. §§ 1.182-1.183 TO RESOLVE CONTRADICTORY EXAMINER FINDINGS IN COPENDING REEXAMINATION PROCEEDINGS" ("the requester petition under 37 CFR 1.182/1.183").

6. On October 2, 2009, the Office mailed the initial Office action on the merits in the '457 proceeding.

7. On October 9, 2009, patent owner filed the instant paper entitled "PETITION UNDER 37 CFR §§ 1.182 AND 1.183 TO DISMISS AND EXPUNGE AN IMPERMISSIBLE FILING FROM THE RECORD" ("the patent owner petition under 37 CFR 1.182/1.183").

DECISION

37 CFR 1.181 provides, 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;

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 2625 provides in-part:

> Pursuant to 37 CFR 1.939, after filing of a request for *inter partes* reexamination, no papers directed to the merits of the reexamination other than (A) citations of patents or printed publications under 37 CFR 1.501 and 1.933, (B) another complete request under 37 CFR 1.510 or 37 CFR 1.915, or (C) notifications pursuant to MPEP § 2686, should be filed with the Office prior to the date of the first Office action in the reexamination proceeding. Any papers directed to the merits of the reexamination, other than those under 37 CFR 1.501, 1.933, 1.510 or 1.915, or under MPEP § 2686, filed prior to the date of the first Office action will be returned to the sender without consideration. If the papers are entered prior to discovery of the impropriety, such papers will be expunged from the record. A copy

> of the letter providing notification of the returned papers or expungement will be made of record in the patent file. However, no copy of the returned/expunged papers will be retained by the Office. If the submission of the returned/expunged papers is appropriate later in the proceedings, they may be filed, and accepted by the Office, at that time.

Because requester's September 21, 2009 petition under 37 CFR 1.182/1.183 was filed prior to the initial Office action on the merits in the '457 proceeding, patent owner requests, in its October 9, 2009 petition under 37 CFR 1.182/1.183, that the requester's petition be dismissed and expunged from the record of the '457 proceeding as an improper paper pursuant to 35 U.S.C. 314(b) and 37 CFR 1.939.[1] 35 U.S.C. 314(b) provides, in part, that each time the patent owner files a response to an Office action on the merits, requester shall have one opportunity to file written comments addressing issues raised by the Office action or the patent owner's response thereto, and 37 CFR 1.939 provides, in part, "[u]nless otherwise authorized, no paper shall be filed prior to the initial Office action on the merits of the *inter partes* reexamination." Patent owner also asserts that requester's September 21, 2009 petition violates 35 U.S.C. 312(c), which states that a determination by the Director under 35 U.S.C. 312(a) regarding whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request shall be final and non-appealable.[2]

Patent owner's petition under 37 CFR 1.182/1.183 has been fully considered, and is granted to the extent that waiver of 37 CFR 1.939 has been considered with respect to authorizing entry of requester's September 21, 2009 petition. Based on the following, however, the requester's September 21, 2009 petition will not be expunged.

In view of the nature of the issues raised in the requester's September 21, 2009 petition under 37 CFR 1.182/1.183 regarding resolution of inconsistencies among co-pending reexamination proceedings, and in furtherance of special dispatch, this decision waives 37 CFR 1.939 to authorize entry of the requester's September 21, 2009 petition for consideration by the Central Reexamination Unit (CRU) as a petition requesting relief under 37 CFR 1.181. 37 CFR 1.181 permits petitions to be taken to the Director from any action or requirement of any examiner in the *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. Director review of requests for relief under 37 CFR 1.181 is not precluded by either 35 U.S.C. 314(b) or 35 U.S.C. 312(c). Thus, patent owner's petition under 37 CFR 1.182/1.183 is dismissed as to the underlying relief requested therein of dismissing and expunging the requester's September 21, 2009 petition under 37 CFR 1.182/1.183.

Because this decision makes the requester's September 21, 2009 petition under 37 CFR 1.182/1.183 an authorized paper in the '457 proceeding, the requester's September 21, 2009 petition will not be expunged from the record. Rather, jurisdiction over the '457 proceeding is remanded to the CRU to address the requester's September 21, 2009 petition pursuant to 37 CFR 1.181 for resolution of the issues raised therein.

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[1] Patent owner's petition under 37 CFR 1.182/1.183 at pages 1-2 and 5-6.
[2] Patent owner's petition under 37 CFR 1.182/1.183 at pages 3-5.

CONCLUSION

1. Patent owner's October 9, 2009 petition paper entitled "PETITION UNDER 37 CFR §§ 1.182 AND 1.183 TO DISMISS AND EXPUNGE AN IMPERMISSIBLE FILING FROM THE RECORD" is granted to the extent that waiver of 37 CFR 1.939 has been considered with respect to third party requester's petition. However, the patent owner petition is dismissed as to the underlying expungement relief requested therein.

2. This decision waives the provisions of 37 CFR 1.939 to authorize entry of the requester's September 21, 2009 petition filed under 37 CFR 1.182/1.183, for consideration by the Central Reexamination Unit (CRU) as a petition requesting relief under 37 CFR 1.181.

3. Jurisdiction over the '457 proceeding is remanded to the CRU to address the requester's September 21, 2009 petition as a petition under 37 CFR 1.181.

4. Telephone inquiries with regard to this decision should be directed to Nicole Dretar, Office of Patent Legal Administration, at (571) 272-7717.

Kenneth M. Schor

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

Kimpropa/IP
2-19-10

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,457	05/07/2009	6549970	379922-457RX (105402)	1192

20457 7590 06/04/2010

ANTONELLI, TERRY, STOUT & KRAUS, LLP
1300 NORTH SEVENTEENTH STREET
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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/04/2010

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

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/000,457	05/07/09	6549970	

EXAMINER
LEE, CHRISTOPHER

ART UNIT	PAPER
3992	

COOLEY GODWARD KRONISH LLP
ATTN: PATENT GROUP
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DATE MAILED:

06/04/10

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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3992	

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06/04/10

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JUN 04 2010

CENTRAL REEXAMINATION UNIT

DECHERT LLP (Courtesy Copy)
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Mountain View, CA 94039

In re Arai *et al.*	: **DECISION DISMISSING**
Inter Partes Reexamination Proceeding	: **REQUESTER PETITIONS**
Control No.: 95/000,457	: **AND *SUA SPONTE***
Filed: May 7, 2009	: **EXPUNGING**
For: U.S. Patent No. 6,549,970	: **IMPROPER PAPERS**

This is a decision on requester's petition filed on February 3, 2010, entitled "PETITION FOR SUSPENSION OF RULE UNDER 37 CFR 1.183," requesting waiver of the requirements of 37 CFR 1.943(b), and on requester's petition filed on February 24, 2010 entitled "PETITION UNDER 37 CFR 1.182 FOR REPLACEMENT OF PAPERS PREVIOUSLY SUBMITTED".

This decision also addresses the January 4, 2010 patent owner response, the February 3, 2010 requester comments, and the October 9, 2009 power of attorney, statement under 3.73(b), and change of correspondence address of the patent owner.

The petition under 37 CFR 1.183, the petition under 37 CFR 1.182, the January 4, 2010 patent owner response, the February 3, 2010 requester comments, the October 9, 2009 power of attorney, statement under 3.73(b), and change of correspondence address of the patent owner, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

A separate petition fee of $400 pursuant to 37 CFR 1.17(f) for the petitions under 37 CFR §§ 1.182 and 1.183 were each charged to requester's Deposit Account No. 50-1283, as authorized by requester's EFS-WEB fee transmittals.

SUMMARY

The February 3, 2010 requester petition under 37 CFR 1.183 is **dismissed as moot**.

The February 24, 2010 requester petition under 37 CFR 1.182 is **dismissed as moot**.

The January 4, 2010 patent owner response is **improper** and **will be expunged**. The Feburary 3, 2010 requester comments submission is **improper** and **will be expunged**. These papers will be expunged by closing the papers in the '457 proceeding's Image File Wrapper (IFW) and by marking the papers "non-public." These papers will not constitute part of the record of the present reexamination proceeding.

The October 9, 2009 power of attorney, statement under 3.73(b), and change of correspondence address of the patent owner is **ineffective**.

REVIEW OF RELEVANT FACTS

- On April 15, 2003, the Office issued U.S. Patent No. 6,549,970 (the '970 patent) to Arai *et al.*
- On May 7, 2009, a request for *inter partes* reexamination of the '970 patent was filed. The request was assigned Control No. 95/000,457 (the '457 proceeding).
- On July 21, 2009, *inter partes* reexamination was ordered for the '457 proceeding indicating that an Office action on the merits would issue in due course.
- On October 2, 2009, the Office issued a non-final Office action on the merits in the '457 proceeding.
- On October 9, 2009, patent owner submitted a paper entitled "Combined Revocation and Power of Attorney and Statements under 37 CFR §§ 3.73(b) & 3.71".
- On January 4, 2010, patent owner timely filed a response to the October 2, 2009 Office action.[1]
- On February 3, 2010, the requester filed comments along with several declarations and exhibits and concurrently filed a petition entitled, "PETITION FOR SUSPENSION OF RULE UNDER 37 CFR 1.183," requesting waiver of the requirements of 37 CFR 1.943(b).
- Also on February 3, 2010, the requester filed a paper entitled "Submission of Corrected Declarations".

[1] Patent owner was granted a thirty day extension of time to respond to the Office action and January 2, 2010 was a Saturday, giving patent owner until January 4, 2010 to respond.

- On February 24, 2010, the requester filed a petition entitled, "PETITION UNDER 37 CFR 1.182 FOR REPLACEMENT OF PAPERS PREVIOUSLY SUBMITTED".

RELEVANT RULES AND GUIDANCE

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.

37 CFR 1.52 states in pertinent part:

> (a) Papers that are to become a part of the permanent United States Patent and Trademark Office records in the file of a patent application or a reexamination proceeding.
>
> > (1) All papers, other than drawings, that are submitted on paper or by facsimile transmission, and are to become a part of the permanent United States Patent and Trademark Office records in the file of a patent application or reexamination proceeding, must be on sheets of paper that are the same size, not permanently bound together, and:
> >
> > *
> >
> > *
> >
> > (v) Presented in a form having sufficient clarity and contrast between the paper and the writing thereon to permit the direct reproduction of readily legible copies in any number by use of photographic, electrostatic, photo-offset, and microfilming processes and electronic capture by use of digital imaging and optical character recognition.

37 CFR 1.183 states:

> In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, sua sponte, or on petition of the interested party, subject to such other

requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.943 states, in pertinent part:

(a) The form of responses, written comments, briefs, appendices, and other papers **must be in accordance with the requirements of § 1.52.** [Emphasis added]

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

37 CFR 1.947 states:

Each time the patent owner files a response to an Office action on the merits pursuant to § 1.945, a third party requester may once file written comments within a period of 30 days from the date of service of the patent owner's response. These comments shall be limited to issues raised by the Office action or the patent owner's response. The time for submitting comments by the third party requester may not be extended. For the purpose of filing the written comments by the third party requester, the comments will be considered as having been received in the Office as of the date of deposit specified in the certificate under § 1.8.

MPEP 2667, subsection I A 2, provides, in pertinent part:

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

page(s) of the exhibit or sheet(s) of drawings that include such argument would be included against the page limit count.

DECISION

I. The January 4, 2010 Patent Owner Response Will Be *Sua Sponte* Expunged

On January 4, 2010, patent owner submitted a response containing a twenty-eight page single-spaced remarks section using a font size of less than 12 points.[2] The declaration of Joseph D. Lamm (Exhibit M) is also single-spaced. Patent owner's response must be in a form that ensures sufficient clarity and contrast for electronic capture and reproducibility without degradation, e.g., a font size of 12 points, one-and-a-half or double-spacing, and text written in a nonscript type font, such as Arial, Times New Roman, or Courier. The current usage of single line spacing with a reduced font size impedes direct reproduction of readily legible copies in any number by use of photographic, electrostatic, photo-offset, and microfilming processes and electronic capture by use of digital imaging and optical character recognition, contrary to 37 CFR 1.52(a)(1)(v). See, generally, 37 CFR 1.943(a) and 37 CFR 1.52.

In addition, the declaration of Joseph D. Lamm (Exhibit M) contains legal arguments, legal analyses, and legal conclusions, which subject the Lamm declaration to the regulatory 50-page limit. For example, the Lamm declaration includes legal arguments and legal conclusions that one of ordinary skill would not have been motivated to combine the references cited in the examiner's rejections (see, e.g., paragraphs 14, 18, 20, 22-24, 26-30, and 32-34). Accordingly, the 16-page Lamm declaration is replete with legal argument and is subject to the regulatory 50-page limit.

Furthermore, the remarks section of the response and the declaration of Joseph D. Lamm (Exhibit M) are both single-spaced, and if formatted for the minimum one and a half line spacing, would be at least fifty percent longer. Currently the remarks section and the Lamm declaration combined are 44 pages in length, single-spaced. Assuming a minimum one and a half line spacing and a 12-point font size, the two documents combined would be at least 66 pages in length, exceeding the 50–page limit established by 37 CFR 1.943(b).

Accordingly, for all the reasons set forth above, patent owner's January 4, 2010 response submission, including the remarks, declarations, and exhibits, is **improper and will be *sua sponte* expunged**. The response submission will be expunged by closing the papers in the '457 proceeding's Image File Wrapper (IFW) and by marking the papers "non-public." The patent owner's January 4, 2010 response submission will not constitute part of the record of the present reexamination proceeding.

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[2] The signature page is not subject to the page count if it does not contain legal argument.

Because the January 4, 2010 patent owner response will not constitute part of the record of the present reexamination proceeding, the February 3, 2010 requester comments will not be considered. The February 3, 2010 requester comments, however, are also improper and will be expunged, for reasons discussed *infra*.

II. The February 3, 2010 Requester Petition under 37 CFR 1.183 to waive 37 CFR 1.943(b)

Third party requester's petition under 37 CFR 1.183 requests waiver of the 50-page limit of 37 CFR 1.943(b) for the concurrently filed comments submission, including supplemental claim charts, appendices, and multiple declarations under 37 CFR 1.132. The February 3, 2010 requester comments submission, however, will not be considered, because the January 4, 2010, patent owner response, to which the February 3, 2010 requester comments are directed, is improper, will be expunged, and will not constitute part of the record of the present reexamination proceeding.

Accordingly, the February 3, 2010 requester petition under 37 CFR 1.183 to waive the provisions of 37 CFR 1.943(b) is **dismissed as moot**.

Even if a proper response to the October 2, 2009 Office action had been submitted by the patent owner, however, the February 3, 2010 requester petition under 37 CFR 1.183 would not have been granted. Third party requester has not made an adequate showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b). Requester has provided no explanation of how the submitted response economizes, excludes extraneous material, and is arranged so as not to repeat information already of record. Requester has not demonstrated that efforts to be as brief as possible were taken to respond to patent owner's response and amendment. Requester only asserts that because patent owner has added fourteen new dependent claims (claims 30-43), it is justified to exceed the fifty (50) page regulatory limit by at least 186 pages if the material were one-and-a-half or double-spaced, for reasons given below. Newly added dependent claims 30-43 claims only cover slightly more than one page. The need for 186 additional pages cannot be justified solely by patent owner's addition of this limited amount of new claim limitations.

Waiver of the rules under 37 CFR 1.183 may be suspended in an ***extraordinary situation when justice requires***. Patent owner's petition only states that newly added claims caused requester to exceed the fifty (50) page limit of 37 CFR 1.943(b). As noted above the requester undertook no effort to economize the response and instead filed unnecessarily voluminous claim charts that are duplicative of the proposed rejections asserted in the remarks section. Furthermore, the newly added claims consist only of slightly more than a page of one-and-a-half or double-spaced dependent claims. Requester provides no other facts to establish an extraordinary situation where justice requires suspension of the rule to such an extreme degree of an additional 186 pages. The failure of requester to comply with the rules, in the form of submitting an economized set of comments in accordance with 37 CFR 1.943(b), does not rise to an ***extraordinary situation*** under 37 CFR

1.183 to justifying suspension of the rules. Therefore, justice would not require suspension of 37 CFR 1.943(b).

III. The February 3, 2010 Requester Comments Submission

The February 3, 2010 requester comments submission is **improper**, and **will be expunged**.

Submission of Corrected Declarations

On February 3, 2010, the requester filed a paper entitled "Submission of Corrected Declarations", accompanied by a declaration of Jake Richter, dated February 1, 2010 ("the corrected Richter declaration"), and a declaration of Tom Ryan, dated February 2, 2010 (collectively, "the corrected declarations"). The requester states that the corrected declarations were filed to address issues under 37 CFR 1.68 raised by the examiner in the first Office action, regarding the declaration of Jake Richter and the declaration of Tom Ryan (collectively, "the original declarations"), which were attached as exhibits to the March 24, 2009 (noncompliant) request for *inter partes* reexamination, and also to the May 7, 2009 corrected request for *inter partes* reexamination. The requester further states that the corrected declarations "differ from the [o]riginal [d]eclarations only in the first and final paragraphs of the declarations" which were added to comply with the requirements of 37 CFR 1.68, that none of the numbered paragraphs in the declarations have been changed, and that the corrected declarations are being submitted without the exhibits to which the corrected declarations, and the original declarations, each separately refer, because the exhibits also have not been changed.[3]

The Ryan and Richter declarations that were submitted with the original, and with the corrected, request for reexamination, however, were not in proper form and thus were not considered by the examiner, as pointed out by the examiner on page 5 of the first Office action. These declarations, in their corrected (proper) form, if filed with a proper requester comments submission as will be discussed *infra*, will be reviewed and addressed by the examiner for the first time in the next Office action. The corrected declaration of Jake Richter includes legal argument, legal analyses, and legal conclusions, as to how a rejection of the claims is supported, causing the declaration to be subject to the 50-page length requirement for requester comments, pursuant to 37 CFR 1.943(b),[4] as will be explained in detail *infra*. See MPEP 2667.

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[3] See the paragraph bridging the first and second pages of the February 3, 2010 paper entitled "Submission of Corrected Declarations".

[4] In determining whether an affidavit or declaration under 37 CFR 1.132 is subject to the 50-page length requirement under 37 CFR 1.943(b), the Office analyzes whether the affidavit or declaration is providing factual evidence, i.e., evidence of *technological* facts, or whether the affidavit or declaration is merely an extension of the arguments of counsel.[4] Factual evidence includes declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results. Where the affidavit or declaration includes arguments containing legal analysis or legal conclusions, including arguments that the claims are patentable

The corrected declaration of Tom Ryan, filed on February 2, 2010, is directed to subject matter that is not subject to the 50-page regulatory limit. However, because the corrected Richter declaration was not submitted in proper form under 37 CFR 1.68 until it was filed with the requester's comments on February 3, 2010, and because the corrected Richter declaration is directed to subject matter that causes the declaration to be subject to the 50-page length requirement, the pages of the corrected Richter declaration, if later submitted with a corrected requester submission, would be counted toward the 50-page limit.

The February 3, 2010 Requester Comments Submission

On February 3, 2010, requester submitted comments that included a thirty-nine (39) page single-spaced remarks section using a font size of less than 12 points.[5] The remarks section of requester's comments and the supplemental claim chart appendices, submitted to address new claims 30-43, exceed the 50-page limit set forth in 37 CFR 1.943(b). Additionally, any declaration containing legal arguments, legal analyses, or legal conclusions will result the declaration being subjected to the regulatory 50-page limit. Accordingly, third party requester's February 3, 2010 comments submission, including declarations within which such arguments appear, is included against the page limit count. See MPEP 2667(I)(A)(2) and MPEP 2667(I)(B)(2).

Requester's February 3, 2010 comments to patent owner's January 4, 2010 response consists of a forty-two (42) page single spaced remarks section, an eighty-seven (87) page claim chart section dedicated solely to newly added claims 30-43 and multiple exhibits which includes four declarations under 37 CFR 1.132, totaling fifty-six (56) double-spaced pages and twelve (12) single-spaced pages, and broken down across the four declarations as follows: (1) Exhibit A13 contains a two-page single-spaced declaration by Frans Tols; (2) Exhibit A14 contains a thirty-seven (37) double-spaced declaration by Jake Richter; (3) Exhibit A16 contains a nineteen (19) page double-spaced declaration by Tom Ryan; and (4) Exhibit A26 contains a 10 page single-spaced declaration also executed by Jake Richter.[6] The A13 and A16 declarations are free of legal argument and are not subject to the 50-page length requirement.

The remarks section is forty-two (42) single-spaced pages in length, using a font size of less than 12 points, and includes a signature page and a two-page appendix listing all the attached exhibits, which are exclusive of argument. Therefore, thirty-nine (39) pages of the remarks section contain substantive argument, which are subject to the regulatory fifty (50) page limit.

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or unpatentable, or are directed to how an outstanding or proposed rejection is overcome, or, in the case of a declaration filed by the requester, how an outstanding or proposed rejection is supported, the affidavit or declaration is subject to the 50-page length requirement. The corrected Richter declaration is replete with such arguments. For this reason, the entire declaration is subject to the 50-page length requirement.

[5] The two-page listing entitled "Attachments" (see pages 41-42 of the February 3, 2010 requester comments) is not considered as part of the substantive portion of the remarks.

[6] All declarations will be referred to by their exhibit number.

The A14 declaration contains legal arguments, legal analyses, and legal conclusions. For example, page 16, paragraph 40, argues that the VDDP document is a printed publication.[7] Page 18, paragraph 46, pages 28 and 34, header no. 2, page 29, paragraph 83, page 30-31, paragraph 90, page 35, paragraph 104, and page 36, paragraph 106 undertake a 35 U.S.C. 112, sixth paragraph analysis of claim language. Page 20, paragraph 55, and page 24, paragraph 67, assert the legal conclusion of obviousness etc. The corrected Richter declaration, dated February 1, 2010, which accompanied the February 3, 2010 paper entitled "Submission of Corrected Declarations", similarly contains legal arguments, legal analyses, and legal conclusions.[8] Accordingly, the A14 declaration and the corrected Richter declaration which accompanied the February 3, 2010 paper entitled "Submission of Corrected Declarations" are replete with legal argument and are subject to the regulatory fifty (50) page limit.

The A26 declaration contains legal arguments, legal analyses and legal conclusions. See, for example, pages 1-2, paragraph 8 (bridging text) in which declarant asserts the current legal standard for obviousness; page 4, paragraphs 24-25, page 5, paragraphs 29-30, page 7-8, paragraph 42, page 8, paragraph 47 and page 9, paragraphs 48-49 where declarant renders multiple legal opinions, legal arguments and legal conclusions that the claimed invention is "obvious" under the "*KSR* standard." Accordingly, the A26 declaration is replete with legal argument and is subject to the regulatory fifty (50) page limit.

The February 3, 2010 response under 37 CFR 1.947 contains eighty-seven (87) pages of supplemental claim chart appendices, which are also replete with legal arguments and legal conclusions, and are subject to the regulatory fifty (50) page count limit, see *e.g.* the obviousness arguments and analysis on pages App. I-1-2, App. I-13-14, and App. I-23-24 regarding claim 20; the arguments and analysis re: indefiniteness on page App. I-5 regarding claim 35; and the obviousness argument and analysis on pages App. I-17-18 and App. I-28-29 regarding claim 23.

Thus, thirty-nine (39) pages of the remarks section, eighty-seven (87) pages of the claim chart section, thirty-seven (37) pages of the A14 declaration, the thirty-seven (37) pages of the corrected Richter declaration that accompanied the paper entitled "Submission of Corrected Declarations", and the (10) pages of the A26 declaration are all subject to the 50-page regulatory limit for the requester's comments, totaling 210 pages, exceeding the 50-page length requirement of 37 CFR 1.943(b) by 160

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[7] Pursuant to MPEP 2667, subsection I A 2, affidavits or declarations solely containing factual evidence directed to establishing the date of a printed publication are not subject to the page limit requirement. In the present case, however, the requester is not presenting factual evidence directed to establishing the date of a printed publication. Rather, the requester is presenting legal argument and legal analyses to postulate a legal conclusion that the VDDP document is a printed publication.

[8] The corrected Richter declaration may or may not be identical to the declaration of Jake Richter submitted in Exhibit A14. The requester has not filed any statement to this effect. Furthermore, the requester states in the paper entitled "Submission of Corrected Declarations" that the corrected Richter declaration is submitted without exhibits. The Richter declaration in Exhibit A14, however, is submitted with exhibits.

pages.

Furthermore, the remarks section and the A26 declaration are both single-spaced, using a font size of less than 12 points. The requester is requesting a waiver of the rules under 37 CFR 1.183. Waiver of the rules is within the discretion of the Office. Submitting comments in single-spaced form, and/or using a font size of less than 12 points, not only impedes electronic reproduction, but defeats the purpose of the rules on page limits and violates the spirit and intent of the petition requesting relief from the 50 page limit. **Any response/comments that exceeds 50 pages and thus requires recourse to a waiver must be in a non-script type font (e.g., Arial, Times New Roman, or Courier), a font size no smaller than 12-point, must be double-spaced, must conform to the margin requirements of 37 CFR 1.52(a)(1)(ii), and must have sufficient clarity and contrast to permit direct reproduction of readily legible copies in any number by use of photographic, electrostatic, photo-offset, and microfilming processes and electronic capture by digital imaging and optical character recognition pursuant to 37 CFR § 1.52(a)(1)(v). See, generally, 37 CFR 1.943(a) and 37 CFR 1.52.**

The remarks section and the A26 declaration are both single-spaced, and if formatted for a minimum of one and a half line spacing, would be at least fifty percent longer. Currently, the remarks section and the A26 declaration combined are 49 pages in length, single-spaced. Assuming one and a half line spacing, the two documents combined would be approximately 75 pages in length. The A14 declaration and the corrected Richter declaration are already in a double or one and a half line spacing format and are each at a length of 37 pages. Therefore, *in toto* requester has submitted substantive comments of 236 pages, exceeding the 50–page limit established by 37 CFR 1.943(b) by a total of 186 pages.

Accordingly, for all the reasons set forth above, requester's February 3, 2010 comments submission, including the remarks, declarations, and exhibits, is **improper and will be expunged**. The comments submission will be expunged by closing the papers in the '457 proceeding's Image File Wrapper (IFW) and by marking the papers "non-public." The requester's February 3, 2010 comments submission will not constitute part of the record of the present reexamination proceeding.

IV. The February 24, 2010 Requester Petition

On February 24, 2010, the requester filed a petition entitled, "PETITION UNDER 37 CFR 1.182 FOR REPLACEMENT OF PAPERS PREVIOUSLY SUBMITTED", requesting that certain exhibits that are included in requester's February 3, 2010 comments submission be closed from the public record, and that replacement versions of these documents, submitted with the February 24, 2010 petition, be added to the public record in their place.

Because the requester's February 3, 2010 petition under 37 CFR 1.183 to waive the

page length requirement of 37 CFR 1.943(b) for requester's February 3, 2010 comments submission is dismissed as moot, and because the entire February 3, 2010 requester comments submission, including the remarks, declarations, and exhibits, will be expunged from the public record for the reasons given above, the February 24, 2010 petition under 37 CFR 1.182, entitled "PETITION UNDER 37 CFR 1.182 FOR REPLACEMENT OF PAPERS PREVIOUSLY SUBMITTED", is **dismissed as moot**.

Both the patent owner and the requester are advised, however, that any future petition under 37 CFR 1.182 requesting the sealing of documents that are subject to a protective order, must include a copy of the protective order and must show that the specific documents at issue are covered by the protective order. See, particularly, MPEP 724.

V. Guidance for Resubmission of Papers

Patent Owner

Any response by patent owner to the outstanding Office action must be filed within **15 days** from the mail date of this decision, and must comply with the provisions of 37 CFR §§ 1.943 and 1.52, also as set forth in this decision. **This 15-day period is not extendable.**

Requester

Any comments by the requester filed in reply to patent owner's response must be filed within **30 days** from the date of service of patent owner's response, and must comply with the provisions of 37 CFR §§ 1.943 and 1.52, also as set forth in this decision. **This 30-day period is not extendable.**

General Comments

Any patent owner response or requester comments submission that exceeds the regulatory 50-page limit must be accompanied by a petition under 37 CFR 1.183 that provides sufficient specificity as to the extraordinary circumstances that justify waiver of the 50-page length requirement.

To obtain a waiver of the 50-page length requirement of 37 CFR 1.943(b), any grantable petition under 37 CFR 1.183 must be accompanied by a patent owner response submission or a requester comments submission that:

1) is double-spaced;
2) is in a non-script type font (e.g., Arial, Times New Roman, or Courier);
3) has a font size no smaller than 12-point;
4) conforms to the margin requirements of 37 CFR 1.52(a)(1)(ii); and

5) has sufficient clarity and contrast to permit direct reproduction of readily legible copies in any number by use of photographic, electrostatic, photo-offset, and microfilming processes and electronic capture by digital imaging and optical character recognition pursuant to 37 CFR § 1.52(a)(1)(v).

See, generally, 37 CFR 1.943(a) and 37 CFR 1.52.

In accordance with 37 CFR 1.903, any paper submitted pursuant to this decision must be served on every other party in the reexamination proceeding.

If no response from the patent owner is received, the reexamination proceeding will be forwarded to the examiner for appropriate action, without entry of any written comments (and attachments) filed by the requester.

In general the parties should avoid the insertion of lengthy block quotes and figures and instead cite to the relevant portion(s) of the document(s) of record that contain the quoted text or figures. The merits of the case does not contain any unique and/or inordinately complex legal issues, but instead consists of common issues of patent law that arise in many patent examination proceedings, e.g. anticipation, obviousness or availability of a reference to serve as prior art, etc. Therefore no need exists for extensive stand alone sections regarding the current state of the law. Citations to the relevant section(s) of the Manual of Patent Examining Procedure (MPEP) along with supplemental citation to the most current case law, if necessary, is sufficient for purposes of a reexamination proceeding. Finally, the parties need not restate the full legal analysis and rationale for each rejection. For purposes of brevity the parties can simply cite to the examiner's rejection or patent owner's response and add comments deemed appropriate to then raise the relevant points of contention, in order to efficiently identify the rejections and present arguments.

VI. The October 9, 2009 Power of Attorney, Statement under 37 CFR 3.73(b), and Change of Correspondence Address is Ineffective

The October 9, 2009 power of attorney, statement under 37 CFR 3.73(b) and change of correspondence address for the patent owner is **ineffective**, because it does not comply with 37 CFR 1.5(a) and 37 CFR 1.4(c). Each paper must separately identify, on the top page in a conspicuous location, the control number of the proceeding. 37 CFR 1.5(a). Furthermore, a power of attorney, statement under 37 CFR 3.73(b), and change of correspondence address must be submitted as a separate paper in each application or reexamination proceeding to which it relates. 37 CFR 1.4(c).

In addition, the official correspondence address for the patent owner in a reexamination proceeding is the correspondence address as recorded in the patent file. See 37 CFR 1.33(c) and MPEP 2622. Office records fail to reveal that a change of correspondence address was received in the patent file, application no. 09/732, 291. In the present case, the official correspondence address of record for the patent owner as recorded in the patent file is that of ANTONELLI, TERRY, STOUT & KRAUS, LLP, 1300 NORTH

SEVENTEENTH STREET, SUITE 1800, ARLINGTON VA 22209-3873.

A courtesy copy of this decision will be mailed to the correspondence address indicated on the October 9, 2009 power of attorney, statement under 37 CFR 3.73(b), and change of correspondence address for the patent owner. In the absence of a proper submission of a change of correspondence address for the patent owner in the patent file, application no., 09/732,291, however, all future correspondence in this reexamination proceeding will be mailed ONLY to the official correspondence address of record for the patent owner, i.e., the address of ANTONELLI, TERRY, STOUT & KRAUS, LLP, 1300 NORTH SEVENTEENTH STREET, SUITE 1800, ARLINGTON VA 22209-3873.

VII. ADDITIONAL COMMENTS

Both parties are on specific notice as to the format and font requirements as set forth in this decision for the submission of responses and comments for an *inter partes* reexamination proceeding when a waiver of the 50-page length requirement of 37 CFR 1.943(b) is sought. Accordingly, any subsequent noncompliant submissions may not be considered, and may be expunged **without** an opportunity for resubmission, because such noncompliant submissions **would not be considered a *bona fide* attempt** to respond and advance prosecution in this *inter partes* reexamination proceeding. . 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.

VIII. CONCLUSION

- Requester's February 3, 2010 petition under 37 CFR 1.183, entitled "PETITION FOR SUSPENSION OF RULE UNDER 37 CFR 1.183," requesting waiver of the requirements of 37 CFR 1.943(b), is **dismissed as moot**.

- Requester's February 24, 2010 petition under 37 CFR 1.182, entitled "PETITION UNDER 37 CFR 1.182 FOR REPLACEMENT OF PAPERS PREVIOUSLY SUBMITTED," is **dismissed as moot**.

- The January 4, 2010 patent owner response submission is **improper** and **will not be considered**. The patent owner response submission **will be expunged** by closing the papers in the '457 proceeding's Image File Wrapper (IFW) and by marking the papers "non-public." The January 4, 2010 patent owner submission will not constitute part of the record of the present reexamination proceeding.

- The requester's February 3, 2010 comments submission is **improper** and will not be considered. The comments submission **will be expunged** by closing the papers in the '457 proceeding's Image File Wrapper (IFW) and by marking the papers "non-public." The requester's February 3, 2010 comments submission

will not constitute part of the record of the present reexamination proceeding.

- If no response from the patent owner is received, the reexamination proceeding will be forwarded to the examiner for appropriate action.

- The October 9, 2009 power of attorney, statement under 37 CFR 3.73(b), and change of correspondence address for the patent owner is **ineffective** A courtesy copy of this decision will be mailed to the address provided in the ineffective October 9, 2009 change of correspondence address.

- In the absence of a proper submission of a change of correspondence address for the patent owner in the patent file, application no. 09/732,291, all future correspondence in this reexamination proceeding will be mailed ONLY to the official correspondence address of record for the patent owner, i.e., the address of ANTONELLI, TERRY, STOUT & KRAUS, LLP, 1300 NORTH SEVENTEENTH STREET, SUITE 1800, ARLINGTON VA 22209-3873.

- Jurisdiction over this proceeding is returned to the Central Reexamination Unit (CRU). After the CRU has processed all party papers, or there are no such papers and the time for filing same has expired, the proceeding will be taken up for appropriate action.

- Telephone inquiries with regard to this decision should be directed to Joseph F. Weiss, Jr., Office of Patent Legal Administration, at (571) 272-7759.

Kenneth M. Schor

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examining Policy

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,459	05/15/2009	6513088	379922-459RX (105402)	3741

37509 7590 02/22/2010

DECHERT LLP
P.O. BOX 390460
MOUNTAIN VIEW, CA 94039-0460

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/22/2010

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COOLEY GODWARD KRONISH LLP
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WASHINGTON, D.C. 20001

Date: MAILED
FEB 22 2010
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000459
PATENT NO. : 6513088
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
FEB 22 2010
CENTRAL REEXAMINATION UNIT

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WASHINGTON, DC 20001

(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/000,459
Filed: May 15, 2009
For: U.S. Patent No. 6,513,088

: **DECISION**
: **GRANTING**
: **PETITION**
: **IN-PART**

This is a decision on the October 9, 2009 patent owner paper entitled "PETITION UNDER 37 CFR §§ 1.182 AND 1.183 TO DISMISS AND EXPUNGE AN IMPERMISSIBLE FILING FROM THE RECORD."

The petition under 37 CFR 1.182/1.183 is before the Office of Patent Legal Administration.

The patent owner petition is **granted in-part**, i.e., granted to the extent that waiver of 37 CFR 1.939 has been considered with respect to third party requester's petition, but is dismissed as to the underlying expungement relief requested therein.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,513,088 issued to Arai et al. on January 28, 2003 ("the '088 patent").

2. On March 24, 2009, a request for *inter partes* reexamination of the '088 patent was deposited by a third party requester, which proceeding was assigned Control No. 95/000,459 ("the '459 proceeding").

3. On May 15, 2009, a corrected request for *inter partes* reexamination of the '088 patent was filed by third party requester in the '459 proceeding.

4. On July 21, 2009, reexamination was ordered in the '459 proceeding.

5. On September 21, 2009, third party requester filed a paper in the '459 proceeding entitled "PETITION UNDER 37 C.F.R. §§ 1.182-1.183 TO RESOLVE CONTRADICTORY EXAMINER FINDINGS IN COPENDING REEXAMINATION PROCEEDINGS" ("the requester petition under 37 CFR 1.182/1.183").

6. On October 6, 2009, the Office mailed the initial Office action on the merits in the '459 proceeding.

7. On October 9, 2009, patent owner filed the instant paper entitled "PETITION UNDER 37 CFR §§ 1.182 AND 1.183 TO DISMISS AND EXPUNGE AN IMPERMISSIBLE FILING FROM THE RECORD" ("the patent owner petition under 37 CFR 1.182/1.183").

DECISION

37 CFR 1.181 provides, 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;

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 2625 provides in-part:

> Pursuant to 37 CFR 1.939, after filing of a request for *inter partes* reexamination, no papers directed to the merits of the reexamination other than (A) citations of patents or printed publications under 37 CFR 1.501 and 1.933, (B) another complete request under 37 CFR 1.510 or 37 CFR 1.915, or (C) notifications pursuant to MPEP § 2686, should be filed with the Office prior to the date of the first Office action in the reexamination proceeding. Any papers directed to the merits of the reexamination, other than those under 37 CFR 1.501, 1.933, 1.510 or 1.915, or under MPEP § 2686, filed prior to the date of the first Office action will be returned to the sender without consideration. If the papers are entered prior to discovery of the impropriety, such papers will be expunged from the record. A copy

> of the letter providing notification of the returned papers or expungement will be made of record in the patent file. However, no copy of the returned/expunged papers will be retained by the Office. If the submission of the returned/expunged papers is appropriate later in the proceedings, they may be filed, and accepted by the Office, at that time.

Because requester's September 21, 2009 petition under 37 CFR 1.182/1.183 was filed prior to the initial Office action on the merits in the '459 proceeding, patent owner requests, in its October 9, 2009 petition under 37 CFR 1.182/1.183, that the requester's petition be dismissed and expunged from the record of the '459 proceeding as an improper paper pursuant to 35 U.S.C. 314(b) and 37 CFR 1.939.[1] 35 U.S.C. 314(b) provides, in part, that each time the patent owner files a response to an Office action on the merits, requester shall have one opportunity to file written comments addressing issues raised by the Office action or the patent owner's response thereto, and 37 CFR 1.939 provides, in part, "[u]nless otherwise authorized, no paper shall be filed prior to the initial Office action on the merits of the *inter partes* reexamination." Patent owner also asserts that requester's September 21, 2009 petition violates 35 U.S.C. 312(c), which states that a determination by the Director under 35 U.S.C. 312(a) regarding whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request shall be final and non-appealable.[2]

Patent owner's petition under 37 CFR 1.182/1.183 has been fully considered, and is granted to the extent that waiver of 37 CFR 1.939 has been considered with respect to authorizing entry of requester's September 21, 2009 petition. Based on the following, however, the requester's September 21, 2009 petition will not be expunged.

In view of the nature of the issues raised in the requester's September 21, 2009 petition under 37 CFR 1.182/1.183 regarding resolution of inconsistencies among co-pending reexamination proceedings, and in furtherance of special dispatch, this decision waives 37 CFR 1.939 to authorize entry of the requester's September 21, 2009 petition for consideration by the Central Reexamination Unit (CRU) as a petition requesting relief under 37 CFR 1.181. 37 CFR 1.181 permits petitions to be taken to the Director from any action or requirement of any examiner in the *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. Director review of requests for relief under 37 CFR 1.181 is not precluded by either 35 U.S.C. 314(b) or 35 U.S.C. 312(c). Thus, patent owner's petition under 37 CFR 1.182/1.183 is dismissed as to the underlying relief requested therein of dismissing and expunging the requester's September 21, 2009 petition under 37 CFR 1.182/1.183.

Because this decision makes the requester's September 21, 2009 petition under 37 CFR 1.182/1.183 an authorized paper in the '459 proceeding, the requester's September 21, 2009 petition will not be expunged from the record. Rather, jurisdiction over the '459 proceeding is remanded to the CRU to address the requester's September 21, 2009 petition pursuant to 37 CFR 1.181 for resolution of the issues raised therein.

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[1] Patent owner's petition under 37 CFR 1.182/1.183 at pages 1-2 and 5-6.
[2] Patent owner's petition under 37 CFR 1.182/1.183 at pages 3-5.

CONCLUSION

1. Patent owner's October 9, 2009 petition paper entitled "PETITION UNDER 37 CFR §§ 1.182 AND 1.183 TO DISMISS AND EXPUNGE AN IMPERMISSIBLE FILING FROM THE RECORD" is granted to the extent that waiver of 37 CFR 1.939 has been considered with respect to third party requester's petition. However, the patent owner petition is dismissed as to the underlying expungement relief requested therein.

2. This decision waives the provisions of 37 CFR 1.939 to authorize entry of the requester's September 21, 2009 petition filed under 37 CFR 1.182/1.183, for consideration by the Central Reexamination Unit (CRU) as a petition requesting relief under 37 CFR 1.181.

3. Jurisdiction over the '459 proceeding is remanded to the CRU to address the requester's September 21, 2009 petition as a petition under 37 CFR 1.181.

4. Telephone inquiries with regard to this decision should be directed to Nicole Dretar, Office of Patent Legal Administration, at (571) 272-7717.

Kenneth M. Schor

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

Kimpropa/IP
2-19-10

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,459	05/15/2009	6513088	379922-459RX (105402)	3741

37509 7590 06/04/2010

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/04/2010

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WASHINGTON, D.C. 20001

Date:

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000459
PATENT NO. : 6513088
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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(For *Inter Partes* Requester)

DECHERT LLP
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Mountain View, CA 94039

(Courtesy Copy)

In re Arai *et al.*
Inter Partes Reexamination Proceeding
Control No.: 95/000,459
Filed: May 15, 2009
For: U.S. Patent No. 6,513,088

: **DECISION**
: **DISMISSING**
: **PETITION AND**
: ***SUA SPONTE***
: **EXPUNGING**
: **IMPROPER PAPERS**

This is a decision on requester's petition filed on February 5, 2010, entitled "PETITION FOR SUSPENSION OF RULE UNDER 37 CFR 1.183," for a concurrently filed response and on requester's petition filed on February 24, 2010, entitled "PETITION UNDER 37 CFR 1.182 FOR REPLACEMENT OF PAPERS PREVIOUSLY SUBMITTED".

This decision also addresses the January 6, 2010 patent owner response submission, the February 4 and February 5, 2010 requester comments submission, and the October 9, 2009 power of attorney, statement under 3.73(b), and change of correspondence address of the patent owner.

The petition under 37 CFR 1.183, the petition under 37 CFR 1.182, the January 6, 2010 patent owner response submission, the February 4 and February 5, 2010 requester comments submission, the October 9, 2009 power of attorney, statement under 3.73(b), and change of correspondence address of the patent owner, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

Two petition fees of $400 each pursuant to 37 CFR 1.17(f) for the petitions under 37 CFR §§ 1.182 and 1.183 were charged to requester's Deposit Account No. 50-1283, as authorized by requester's EFS-WEB fee transmittals.

SUMMARY

The February 5, 2010 requester petition under 37 CFR 1.183 is **dismissed as moot**.

The February 24, 2010 requester petition under 37 CFR 1.182 is **dismissed as moot**.

The January 6, 2010 patent owner response is **improper** and **will be expunged**. The February 4 and February 5, 2010 requester comments submission is **improper** and **will be expunged**. These papers will be expunged by closing the papers in the '459 proceeding's Image File Wrapper (IFW) and by marking the papers "non-public." These papers will not constitute part of the record of the present reexamination proceeding.

The October 9, 2009 power of attorney, statement under 3.73(b), and change of correspondence address of the patent owner is **ineffective**.

REVIEW OF RELEVANT FACTS

1. On January 28, 2003, the Office issued U.S. Patent No. 6,513,088 (the '088 patent) to Arai *et al.*

2. On May 15, 2009, a request for *inter partes* reexamination of the '088 patent was filed. The request was assigned Control No. 95/000,459 (the '459 proceeding).

3. On July 21, 2009, *inter partes* reexamination was ordered for the '459 proceeding and indicating that an Office action on the merits would issue in due course.

4. On October 6, 2009, the Office issued a non-final Office action on the merits in the '459 proceeding.

5. On October 9, 2009, patent owner submitted a change in power of attorney and correspondence address in the '459 proceeding

6. January 6, 2010, patent owner timely filed a response to the October 6, 2009 Office action without amendment to the claims.[1]

7. On February 4, 2010, the requester filed a paper entitled "Submission of Corrected Declarations", with accompanying declarations.

8. On February 5, 2010, the requester filed comments along with several declarations and exhibits and concurrently filed a petition entitled, "PETITION FOR SUSPENSION OF RULE UNDER 37 CFR 1.183," requesting suspension of 37 CFR 1.948.

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[1] Patent owner was granted a thirty day extension of time to respond to the Office action.

9. On February 24, 2010, the requester filed a petition entitled, "PETITION UNDER 37 CFR 1.182 FOR REPLACEMENT OF PAPERS PREVIOUSLY SUBMITTED," to selectively replace papers in the exhibits attached to the declarations filed with the February 5, 2010 comments.

RELEVANT RULES AND GUIDANCE

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.

37 CFR 1.52 states in pertinent part:

> (a) Papers that are to become a part of the permanent United States Patent and Trademark Office records in the file of a patent application or a reexamination proceeding.
>
> > (1) All papers, other than drawings, that are submitted on paper or by facsimile transmission, and are to become a part of the permanent United States Patent and Trademark Office records in the file of a patent application or reexamination proceeding, must be on sheets of paper that are the same size, not permanently bound together, and:
> >
> > *
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> > *
> >
> > (v) Presented in a form having sufficient clarity and contrast between the paper and the writing thereon to permit the direct reproduction of readily legible copies in any number by use of photographic, electrostatic, photo-offset, and microfilming processes and electronic capture by use of digital imaging and optical character recognition.

37 CFR 1.182 states:

> All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Director, subject to such other requirements as may be

imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.183 states:

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

37 CFR 1.943 states in pertinent part:

(a) The form of responses, written comments, briefs, appendices, and other papers **must be in accordance with the requirements of § 1.52.** [Emphasis added]

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

37 CFR 1.947 states:

Each time the patent owner files a response to an Office action on the merits pursuant to § 1.945, a third party requester may once file written comments within a period of 30 days from the date of service of the patent owner's response. These comments shall be limited to issues raised by the Office action or the patent owner's response. The time for submitting comments by the third party requester may not be extended. For the purpose of filing the written comments by the third party requester, the comments will be considered as having been received in the Office as of the date of deposit specified in the certificate under § 1.8.

37 CFR 1.948 states:

(a) After the *inter partes* reexamination order, the third party requester may only cite additional prior art as defined under § 1.501 if it is filed as part of a comments submission under § 1.947 or § 1.951(b) and is limited to prior art:

(1) which is necessary to rebut a finding of fact by the examiner;

(2) which is necessary to rebut a response of the patent owner; or

> (3) which for the first time became known or available to the third party requester after the filing of the request for *inter partes* reexamination proceeding. Prior art submitted under paragraph (a)(3) of this section must be accompanied by a statement as to when the prior art first became known or available to the third party requester and must include a discussion of the pertinency of each reference to the patentability of at least one claim.

MPEP 2666.05 II states in pertinent part:

> New prior art can be submitted with the comments only where the prior art (A) is necessary to rebut a finding of fact by the examiner, (B) is necessary to rebut a response of the patent owner, or (C) for the first time became known or available to the third party requester after the filing of the request for inter partes reexamination.
>
> As to item (A) above, 37 CFR 1.948(a)(1) permits the requester to provide new prior art rebutting the examiner's interpretation/finding of what the art of record shows. However, <u>a statement in an Office action that a particular claimed feature is not shown by the prior art of record (which includes references that were cited by requester) does NOT permit the requester to then cite new art to replace the art originally advanced by requester</u>. Such a substitution of a new art for the art of record is not a rebuttal of the examiner's finding that a feature in question is not taught by the art of record. Rather, such a substitution would amount to a rebuttal of a finding that a feature in question is not taught by any art in existence. A finding that the feature in question is not taught by any art in existence could not realistically be made for the reexamination proceeding, since the proceeding does not include a comprehensive validity search, and such was not envisioned by Congress as evidenced by the 35 U.S.C. 314(c) mandate that reexamination proceedings are to be conducted in the Office with special dispatch. [Emphasis added]
>
> As to item (B) above, 37 CFR 1.948(a)(2) <u>permits the requester to provide a new proposed rejection, where such new proposed rejection is necessitated by patent owner's amendment of the claims.</u> [Emphasis added]
>
> As to item (C) above, prior art submitted under 37 CFR 1.948(a)(3) must be accompanied by a statement that explains the circumstances as to when the prior art first became known or available to the third party requester, including the date and manner that the art became known or available, and why it was not available earlier. The submission must also include a discussion of the pertinency of each reference to the patentability of at least one claim.

MPEP 2667, subsection I A 2, provides, in pertinent part:

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

DECISION

I. The January 6, 2010 Patent Owner Response Will Be *Sua Sponte* Expunged

On January 6, 2010, patent owner submitted a response containing a thirty page remarks section using a font size of less than 12 points.[2] Also, the declaration of Joseph D. Lamm (Exhibit M) is single-spaced. Patent owner's response must be in a form that ensures sufficient clarity and contrast for electronic capture and reproducibility without degradation, e.g., a font size of 12 points, one-and-a-half or double-spacing, and text written in a non-script type font, such as Arial, Times New Roman, or Courier. The current usage of a reduced font size and/or single line spacing impedes direct reproduction of readily legible copies in any number by use of photographic, electrostatic, photo-offset, and microfilming processes and electronic capture by use of digital imaging and optical character recognition, contrary to 37 CFR 1.52(a)(1)(v). See, generally, 37 CFR 1.943(a) and 37 CFR 1.52.

In addition, the declaration of Joseph D. Lamm (Exhibit M) contains legal arguments, legal analyses, and legal conclusions, which subject the Lamm declaration to the regulatory 50-page limit. For example, the Lamm declaration

[2] The signature page is subject to the page count if it contains legal argument.

includes legal arguments and legal conclusions that one of ordinary skill would not have been motivated to combine the references cited in the examiner's rejections (see, e.g., paragraphs 14, 18, 20, 22-24, 26-30, and 32-34). Accordingly, the 16-page Lamm declaration is replete with legal argument and is subject to the regulatory 50-page limit.

Furthermore, the declaration of Joseph D. Lamm (Exhibit M) is single-spaced, and if formatted for double spacing, would be at least fifty percent longer. Currently the remarks section and the Lamm declaration combined are 46 pages in length. Assuming a minimum one and a half line spacing and a 12-point font size, the two documents combined would be at least 69 pages in length, exceeding the 50–page limit established by 37 CFR 1.943(b).

Accordingly, for all the reasons set forth above, patent owner's January 6, 2010 response submission, including the remarks, declarations, and exhibits, is **improper and will be *sua sponte* expunged**. The response submission will be expunged by closing the papers in the '459 proceeding's Image File Wrapper (IFW) and by marking the papers "non-public." The patent owner's January 6, 2010 response submission will not constitute part of the record of the present reexamination proceeding.

Because the January 6, 2010 patent owner response will not constitute part of the record of the present reexamination proceeding, the requester comments submission filed on February 4 and February 5, 2010 will not be considered. The February 4 and February 5, 2010 requester comments submission, however, are also improper and will be expunged, for reasons discussed *infra*.

II. The February 5, 2010 Requester Petition Under 37 CFR 1.183

Third party requester's petition under 37 CFR 1.183 requests waiver of 37 CFR 1.948. The February 4 and February 5, 2010 requester comments submission, however, will not be considered, because the January 6, 2010, patent owner response, to which the February 4 and February 5, 2010 requester comments submission is directed, is improper, will be expunged, and will not constitute part of the record of the present reexamination proceeding.

Accordingly, the February 5, 2010 requester petition under 37 CFR 1.183 to waive the provisions of 37 CFR 1.948 is **dismissed as moot**.

Even if a proper response to the October 9, 2009 Office action had been filed by the patent owner, however, the February 5, 2010 requester petition would not have been granted for the reasons discussed immediately below.

A. The Printed Publication Rebuttal Evidence

The requester argues that justice requires entry of a rebuttal declaration by Jake Richter (exhibit A26) and accompanying exhibits, a declaration by Frans Tol and accompanying exhibit, and an article by Rob McCabe, which are apparently submitted to rebut the patent owner's arguments as to whether certain documents are printed publications. The requester further states the rebuttal declaration by Jake Richter (exhibit A26) and accompanying exhibits are submitted to rebut the patent owner's declaration directed to commercial success.

On October 6, 2009 the examiner rejected the original claims using *inter alia* the AN442 reference in view of Moriconi and the AN442 reference in view of the VDDP reference. On January 6, 2010 patent owner filed, without amendment to the claims, a response that *inter alia* asserted that the AN442 reference and the VDDP reference cannot be used as a basis for rejecting the claims, because the references are not printed publications. On February 5, 2010 the requester filed a response that argues *inter alia* the AN442 reference and the VDDP reference are available for use as prior art because they are printed publications. In support of the assertion, requester submits the above-discussed declarations with exhibits. The documents contained in the exhibits are not used to propose new rejections against the unamended claims, but only as evidence in rebuttal to patent owner's arguments that the references do not qualify as printed publications. Therefore, the documents contained in the exhibits submitted with the declarations do not constitute a submission of prior art that is contrary to the 37 CFR 1.948. For this reason, there would be no need for waiver of the rule under 37 CFR 1.183.

B. The Lack of Motivation Rebuttal Evidence

The requester seeks suspension of 37 CFR 1.948 to permit entry of two articles: (1) "Computer-Controlled Alignment for a 2000-Line Color Monitor," by Suzuki *et al., Society for Information Display International Symposium Digest of Technical Papers,* 1989 ("the alignment article"); and (2) "Advanced Automation Systems Common Console Workstation Perspective," by Ancile Malden, *Society for Information Display International Symposium Digest of Technical Papers,* 1989 ("the workstation article").

On October 6, 2009 the examiner rejected all the original claims using *inter alia* the AN442 reference in view of Moriconi and the AN442 reference in view of the VDDP reference. On January 6, 2010 patent owner filed, without amendment to the claims, a response that *inter alia* asserted that the rejections of the claims using the AN442 reference in view of Moriconi and the AN442 reference in view of the VDDP reference were improper due to a lack of motivation to combine. On February 5, 2010 the requester filed a response that argues *inter alia* the rejections using the AN442 reference in view of Moriconi and the AN442 reference in view of

the VDDP reference are properly motivated. As evidence of proper motivation requester cites to several references which are of record and also cites to two new references, which are not of record. Requester cites (1) the alignment article and (2) the workstation article. Requester alleges that both articles contain the relevant technical features in a single article which are being combined by the examiner in the rejections of AN442 in view of Moriconi and AN422 in view of VDDP. Requester asserts these new references are only being submitted as evidence that a motivation to combine existed in the prior art. The submissions are improper and contrary to 37 CFR 1.948(2) which precludes the submission of prior art for the basis of a new proposed rejection unless necessitated by a patent owner's amendment of the claims.

In order to support requester's contention that the references are only being submitted to rebut patent owner's assertion that there is no motivation to combine AN442 in view of Moriconi and AN422 in view of VDDP the newly submitted references must evidence, verbatim, the motivation to combine used by the examiner. Requester does not cite to the passages in either article that evidence the examiner's motivation to combine as being proper as understood by one of ordinary skill in the art at the time the invention was made. A review of the articles does not yield any passages that would serve as evidence of the examiner's specifically articulated motivation to combine. Therefore, the references are not being submitted to support the examiner's rejections of record, but instead serve as an attempt by requester to submit new prior art of record without a basis for entry under 37 CFR 1.948.

Waiver of the rules under 37 CFR 1.183 may be suspended in an ***extraordinary situation when justice requires***. Patent owner's petition only states that should 37 CFR 1.948(a)(2) preclude submission of the alignment article and the workstation article, third party requester seeks suspension of the rule. As noted above the references have no right of entry under 37 CFR 1.948, e.g. as a basis of a newly proposed rejection necessitated by a patent owner's amendment of the claims. Requester provides no facts to establish an extraordinary situation where justice requires suspension of the rule other than whether the requester believes that the patent owner may have been aware of the references. The failure of requester to comply with the rules, in the form of submitting the references with their request or in accordance with 37 CFR 1.948, does not rise to an ***extraordinary situation*** under 37 CFR 1.183 to justifying suspension of the rules. Therefore, justice would not require suspension of 37 CFR 1.948(a)(2).

If, however, the requester believes that these articles raise a substantial question of patentability as to at least one claim of the patent, which differs from those raised in this proceeding, the requester may file an *ex parte* request for reexamination for consideration of the article(s).

III. The February 4 and February 5, 2010 Requester Comments Submission Will Be *Sua Sponte Expunged*

Submission of Corrected Declarations

On February 4, 2010, the requester filed a paper entitled "Submission of Corrected Declarations", accompanied by a declaration of Jake Richter, dated February 1, 2010 ("the corrected Richter declaration"), and a declaration of Tom Ryan, dated February 2, 2010 (collectively, "the corrected declarations"). The requester states that the corrected declarations were filed to address issues under 37 CFR 1.68 raised by the examiner in the first Office action, regarding the declaration of Jake Richter and the declaration of Tom Ryan (collectively, "the original declarations"), which were attached as exhibits to the March 24, 2009 (noncompliant) request for *inter partes* reexamination, and also to the May 15, 2009 corrected request for *inter partes* reexamination. The requester further states that the corrected declarations "differ from the [o]riginal [d]eclarations only in the first and final paragraphs of the declarations" which were added to comply with the requirements of 37 CFR 1.68, that none of the numbered paragraphs in the declarations have been changed, and that the corrected declarations are being submitted without the exhibits to which the corrected declarations, and the original declarations, each separately refer, because the exhibits also have not been changed.[3]

The Ryan and Richter declarations that were submitted with the original, and with the corrected, request for reexamination, however, were not in proper form and thus were not considered by the examiner, as pointed out by the examiner on page 4 of the first Office action. These declarations, in their corrected (proper) form, if filed with a proper requester comments submission as will be discussed *infra*, will be reviewed and addressed by the examiner for the first time in the next Office action. The corrected declaration of Jake Richter includes legal argument, legal analyses, and legal conclusions, as to how a rejection of the claims is supported, causing the declaration to be subject to the 50-page length requirement for requester comments, pursuant to 37 CFR 1.943(b),[4] as will be explained in detail *infra*. See MPEP 2667. The corrected declaration of Tom Ryan, filed on February 2, 2010, is directed to subject matter that is not subject to the 50-page regulatory limit. However, because

[3] See the paragraph bridging the first and second pages of the February 4, 2010 paper entitled "Submission of Corrected Declarations".

[4] In determining whether an affidavit or declaration under 37 CFR 1.132 is subject to the 50-page length requirement under 37 CFR 1.943(b), the Office analyzes whether the affidavit or declaration is providing factual evidence, i.e., evidence of *technological* facts, or whether the affidavit or declaration is merely an extension of the arguments of counsel.[4] Factual evidence includes declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results. Where the affidavit or declaration includes arguments containing legal analysis or legal conclusions, including arguments that the claims are patentable or unpatentable, or are directed to how an outstanding or proposed rejection is overcome, or, in the case of a declaration filed by the requester, how an outstanding or proposed rejection is supported, the affidavit or declaration is subject to the 50-page length requirement. The corrected Richter declaration is replete with such arguments. For this reason, the entire declaration is subject to the 50-page length requirement.

the corrected Richter declaration was not submitted in proper form under 37 CFR 1.68 until it was filed on February 4, 2010, and because the corrected Richter declaration is directed to subject matter that causes the declaration to be subject to the 50-page length requirement, the pages of the corrected Richter declaration, if later submitted with a corrected requester submission, would be counted toward the 50-page limit.

The February 5, 2010 Requester Comments Submission

On February 5, 2010, requester submitted comments that included a twenty-three (23) page single-spaced remarks section using a font size of less than 12 points.[5] The remarks section of requester's comments is subject to the 50-page limit set forth in 37 CFR 1.943(b). Additionally, any declaration containing legal arguments, legal analyses, or legal conclusions along will result the declaration being subjected to the regulatory 50-page limit. Accordingly, third party requester's February 4 and February 5, 2010 comments submission, including declarations within which such arguments appear is included against the page limit count. See MPEP 2667(I)(A)(2).

Requester's February 5, 2010 comments to patent owner's January 6, 2010 response includes a twenty-three (23) page single spaced remarks section, a fifty (50 page claim chart "L" designated as Exhibit A29, and four declarations under 37 CFR 1.132, totaling fifty-six (56) double-spaced pages and twelve (12) single-spaced pages, and broken down across the four declarations as follows: (1) Exhibit A13 contains a two-page single-spaced declaration by Frans Tols; (2) Exhibit A14 contains a thirty-seven (37) double- spaced declaration by Jake Richter; (3) Exhibit A16 contains a nineteen (19) page double-spaced declaration by Tom Ryan; and (4) Exhibit A26 contains a 10 page single-spaced declaration also executed by Jake Richter.[6] The A13 and A16 declarations are free of legal argument and are not subject to the 50-page length requirement.

The remarks section is twenty-three (23) single-spaced pages in length, using a font size of less than 12 points, and includes a two-page appendix listing all the attached exhibits, which are exclusive of argument. Therefore, twenty-one (21) pages of the remarks section contain substantive argument, which are subject to the regulatory fifty (50) page limit.

The A14 declaration contains legal arguments, legal analyses, and legal conclusions. For example, page 16, paragraph 40, argues that the VDDP document is a printed publication.[7] Page 18, paragraph 46, pages 28 and 34, header no. 2, page 29,

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[5] The two-page listing entitled "Attachments" (see pages 22-23 of the February 5, 2010 requester comments) is not considered as part of the substantive portion of the remarks.

[6] All declarations will be referred to by their exhibit number.

[7] Pursuant to MPEP 2667, subsection I A 2, affidavits or declarations solely containing factual evidence directed to establishing the date of a printed publication are not subject to the page limit requirement. In the present case, however, the requester is not presenting factual evidence directed to establishing the date of a printed publication. Rather, the requester is presenting legal argument and legal analyses to postulate a legal conclusion that the VDDP document is a printed publication.

paragraph 83, page 30-31, paragraph 90, page 35, paragraph 104, and page 36, paragraph 106 undertake a 35 U.S.C. 112, sixth paragraph analysis of claim language. Page 20, paragraph 55, and page 24, paragraph 67, assert the legal conclusion of obviousness etc. The corrected Richter declaration, dated February 1, 2010, which accompanied the February 4, 2010 paper entitled "Submission of Corrected Declarations", similarly contains legal arguments, legal analyses, and legal conclusions.[8] Accordingly, the A14 declaration and the corrected Richter declaration which accompanied the February 4, 2010 paper entitled "Submission of Corrected Declarations" are replete with legal argument and are subject to the regulatory fifty (50) page limit.

The A26 declaration contains legal arguments, legal analyses and legal conclusions. See, for example, pages 1-2, paragraph 8 (bridging text) in which declarant asserts the current legal standard for obviousness; page 4, paragraphs 24-25, page 5, paragraphs 29-30, page 7-8, paragraph 42, page 8, paragraph 47 and page 9, paragraphs 48-49 where declarant renders multiple legal opinions, legal arguments and legal conclusions that the claimed invention is "obvious" under the "*KSR* standard." Accordingly, the A26 declaration is replete with legal argument and is subject to the regulatory fifty (50) page limit.

The fifty (50) page claim chart "L", designated by requester as Exhibit A29, was created by patent owner for litigation in asserting a claim of infringement in civil proceedings. Requester originally submitted claim chart "L" as exhibit 13 to the original request for reexamination of the '088 patent. Claim chart "L" is replete with legal argument, however requester is submitting claim chart "L" as proof of patent owner admissions and not for the substance of the legal argument. Therefore claim chart "L", as exhibit A29, which is submitted with the February 4 and February 5, 2010 comments submission, is not subject to the regulatory 50-page limit.

Thus, twenty-one (21) pages of the remarks section, thirty-seven (37) pages of the A14 declaration, the thirty-seven (37) pages of the corrected Richter declaration that accompanied the paper entitled "Submission of Corrected Declarations", and the (10) pages of the A26 declaration are all subject to the 50-page regulatory limit for the requester's comments, totaling 105 pages, exceeding the 50-page length requirement of 37 CFR 1.943(b) by 55 pages.

Furthermore, the remarks section and the A26 declaration are both single-spaced, using a font size of less than 12 points. The requester is requesting a waiver of the rules under 37 CFR 1.183. Waiver of the rules is within the discretion of the Office. Submitting comments in single-spaced form, and/or using a font size of less than 12 points, not only impedes electronic reproduction, but defeats the purpose of the rules

[8] The corrected Richter declaration may or may not be identical to the declaration of Jake Richter submitted in Exhibit A14. The requester has not filed any statement to this effect. Furthermore, the requester states in the paper entitled "Submission of Corrected Declarations" that the corrected Richter declaration is submitted without exhibits. The Richter declaration in Exhibit A14, however, is submitted with exhibits.

on page limits and violates the spirit and intent of the petition requesting relief from the 50 page limit.

Any response/comments that exceeds 50 pages and thus requires recourse to a waiver must be in a non-script type font (e.g., Arial, Times New Roman, or Courier), a font size no smaller than 12-point, must be double-spaced, must conform to the margin requirements of 37 CFR 1.52(a)(1)(ii), and must have sufficient clarity and contrast to permit direct reproduction of readily legible copies in any number by use of photographic, electrostatic, photo-offset, and microfilming processes and electronic capture by digital imaging and optical character recognition pursuant to 37 CFR § 1.52(a)(1)(v). See, generally, 37 CFR 1.943(a) and 37 CFR 1.52.

The remarks section and the A26 declaration are both single-spaced, and if formatted for a minimum of one and a half line spacing, would be at least fifty percent longer. Currently, the remarks section and the A26 declaration combined are 31 pages in length, single-spaced. Assuming one and a half line spacing, the two documents combined would be approximately 47 pages in length. The A14 declaration and the corrected Richter declaration are already in a double or one and a half line spacing format and are each at a length of 37 pages. Therefore, *in toto* requester has submitted substantive comments of 121 pages, exceeding the 50–page limit established by 37 CFR 1.943(b) by a total of 71 pages.

Accordingly, for all the reasons set forth above, requester's February 4 and February 5, 2010 comments submission, including the remarks, declarations, and exhibits, is **improper and will be expunged.** The comments submission will be expunged by closing the papers in the '459 proceeding's Image File Wrapper (IFW) and by marking the papers "non-public." The requester's February 4 and February 5, 2010 comments submission will not constitute part of the record of the present reexamination proceeding.

IV. The February 24, 2010 Requester Petition

On February 24, 2010, the requester filed a petition entitled, "PETITION UNDER 37 CFR 1.182 FOR REPLACEMENT OF PAPERS PREVIOUSLY SUBMITTED", requesting that certain exhibits that are included in requester's February 5, 2010 comments submission be closed from the public record, and that replacement versions of these documents, submitted with the February 24, 2010 petition, be added to the public record in their place.

Because the requester's February 5, 2010 petition under 37 CFR 1.183 to waive the page length requirement of 37 CFR 1.943(b) for requester's February 4 and February 5, 2010 comments submission is dismissed as moot, and because the entire February 4 and February 5, 2010 requester comments submission, including the remarks, declarations, and exhibits, will be expunged from the public record for the reasons given above, the February 24, 2010 petition under 37 CFR 1.182, entitled "PETITION UNDER 37 CFR 1.182 FOR REPLACEMENT OF PAPERS

PREVIOUSLY SUBMITTED", is **dismissed as moot**.

Both the patent owner and the requester are advised, however, that any future petition under 37 CFR 1.182 requesting the sealing of documents that are subject to a protective order, must include a copy of the protective order and must show that the specific documents at issue are covered by the protective order. See, particularly, MPEP 724.

V. Guidance for Resubmission of Papers

Patent Owner

Any response by patent owner to the outstanding Office action must be filed within **15 days** from the mail date of this decision, and must comply with the provisions of 37 CFR §§ 1.943 and 1.52, also as set forth in this decision. **This 15-day period is not extendable.**

Requester

Any comments by the requester filed in reply to patent owner's response must be filed within **30 days** from the date of service of patent owner's response, and must comply with the provisions of 37 CFR §§ 1.943 and 1.52, also as set forth in this decision. **This 30-day period is not extendable.**

General Comments

Any patent owner response or requester comments submission that exceeds the regulatory 50-page limit must be accompanied by a petition under 37 CFR 1.183 that provides sufficient specificity as to the extraordinary circumstances that justify waiver of the 50-page length requirement.

To obtain a waiver of the 50-page length requirement of 37 CFR 1.943(b), any grantable petition under 37 CFR 1.183 must be accompanied by a patent owner response submission or a requester comments submission that:

1) is double-spaced;[9]
2) is in a non-script type font (e.g., Arial, Times New Roman, or Courier);
3) has a font size no smaller than 12-point;
4) conforms to the margin requirements of 37 CFR 1.52(a)(1)(ii); and
5) has sufficient clarity and contrast to permit direct reproduction of readily legible copies in any number by use of photographic, electrostatic, photo-offset, and microfilming processes and electronic capture by digital imaging and optical character recognition pursuant to 37 CFR § 1.52(a)(1)(v).

See, generally, 37 CFR 1.943(a) and 37 CFR 1.52.

[9] With the exception of claim charts, which need not be double-spaced.

In accordance with 37 CFR 1.903, any paper submitted pursuant to this decision must be served on every other party in the reexamination proceeding.

If no response from the patent owner is received, the reexamination proceeding will be forwarded to the examiner for appropriate action, without entry of any written comments (and attachments) filed by the requester.

In general the parties should avoid the insertion of lengthy block quotes and figures and instead cite to the relevant portion(s) of the document(s) of record that contain the quoted text or figures. The merits of the case does not contain any unique and/or inordinately complex legal issues, but instead consists of common issues of patent law that arise in many patent examination proceedings, e.g. anticipation, obviousness or availability of a reference to serve as prior art, etc. Therefore no need exists for extensive stand alone sections regarding the current state of the law. Citations to the relevant section(s) of the Manual of Patent Examining Procedure (MPEP) along with supplemental citation to the most current on point case law, if necessary, as requester argues the merits of the case is sufficient for purposes of a reexamination proceeding. Finally, the parties need not restate the full legal analysis and rationale for each rejection. For purposes of brevity the parties can simply cite to the examiner's rejection or patent owner's response and add comments deemed appropriate to then raise the relevant points of contention, in order to efficiently identify the rejections and present arguments.

VI. The October 9, 2009 Power of Attorney, Statement under 37 CFR 3.73(b), and Change of Correspondence Address is Ineffective

The October 9, 2009 power of attorney, statement under 37 CFR 3.73(b) and change of correspondence address for the patent owner are **ineffective**, because they do not comply with 37 CFR 1.5(a) and 37 CFR 1.4(c). Each paper must separately identify, on the top page in a conspicuous location, the control number of the proceeding. 37 CFR 1.5(a). Furthermore, a power of attorney, statement under 3.73(b), and change of correspondence address must be submitted as a separate paper in each application or reexamination proceeding to which it relates. 37 CFR 1.4(c).

In addition, the official correspondence address for the patent owner in a reexamination proceeding is the correspondence address as recorded in the patent file. See 37 CFR 1.33(c) and MPEP 2622. Office records fail to reveal that a change of correspondence address was received in the patent file, application no. 09/732, 292. In the present case, the official correspondence address of record for the patent owner as recorded in the patent file is that of ANTONELLI, TERRY, STOUT & KRAUS, LLP, 1300 NORTH SEVENTEENTH STREET, SUITE 1800, ARLINGTON VA 22209-3873.

A courtesy copy of this decision will be mailed to the correspondence address indicated on the October 9, 2009 power of attorney, statement under 37 CFR 3.73(b), and change of correspondence address for the patent owner. In the absence of a proper submission of a change of correspondence address for the patent owner in the patent file, application

no., 09/732,292, however, all future correspondence in this reexamination proceeding will be mailed ONLY to the official correspondence address of record for the patent owner, i.e., the address of ANTONELLI, TERRY, STOUT & KRAUS, LLP, 1300 NORTH SEVENTEENTH STREET, SUITE 1800, ARLINGTON VA 22209-3873.

VII. ADDITIONAL COMMENTS

Both parties are on specific notice as to the format and font requirements as set forth in this decision for the submission of responses and comments for an *inter partes* reexamination proceeding when a waiver of the 50-page length requirement of 37 CFR 1.943(b) is sought. Accordingly, any subsequent noncompliant submissions may not be considered, and may be expunged **without** an opportunity for resubmission, because such noncompliant submissions **would not be considered a *bona fide* attempt** to respond and advance prosecution in this *inter partes* reexamination proceeding. 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.

VIII. CONCLUSION

- Requester's February 5, 2010 petition under 37 CFR 1.183, entitled "PETITION FOR SUSPENSION OF RULE UNDER 37 CFR 1.183," requesting waiver of the requirements of 37 CFR 1.943(b), is **dismissed as moot**.

- Requester's February 24, 2010 petition under 37 CFR 1.182, entitled "PETITION UNDER 37 CFR 1.182 FOR REPLACEMENT OF PAPERS PREVIOUSLY SUBMITTED," is **dismissed as moot**.

- The January 6, 2010 patent owner response submission is **improper** and **will not be considered**. The patent owner response submission **will be expunged** by closing the papers in the '459 proceeding's Image File Wrapper (IFW) and by marking the papers "non-public." The January 6, 2010 patent owner submission will not constitute part of the record of the present reexamination proceeding.

- The requester's February 4 and February 5, 2010 comments submission is **improper** and will not be considered. The comments submission **will be expunged** by closing the papers in the '459 proceeding's Image File Wrapper (IFW) and by marking the papers "non-public." The requester's February 4 and February 5, 2010 comments submission will not constitute part of the record of the present reexamination proceeding.

- If no response from the patent owner is received, the reexamination proceeding will be forwarded to the examiner for appropriate action.

- The October 9, 2009 power of attorney, statement under 37 CFR 3.73(b), and change of correspondence address for the patent owner is **ineffective** A courtesy copy of this decision will be mailed to the address provided in the ineffective October 9, 2009 change of correspondence address.

- In the absence of a proper submission of a change of correspondence address for the patent owner in the patent file, application no. 09/732,292, all future correspondence in this reexamination proceeding will be mailed ONLY to the official correspondence address of record for the patent owner, i.e., the address of ANTONELLI, TERRY, STOUT & KRAUS, LLP, 1300 NORTH SEVENTEENTH STREET, SUITE 1800, ARLINGTON VA 22209-3873.

- Jurisdiction over this proceeding is returned to the Central Reexamination Unit (CRU). After the CRU has processed all party papers, or there are no such papers and the time for filing same has expired, the proceeding will be taken up for appropriate action.

- Telephone inquiries with regard to this decision should be directed to Joseph F. Weiss, Jr., Office of Patent Legal Administration, at (571) 272-7759.

Kenneth M. Schor

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examining Policy

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.
95/000,464	06/15/2009	6624761	080272-0016	8229

1473 7590 12/30/2009

ROPES & GRAY LLP
PATENT DOCKETING 39/361
1211 AVENUE OF THE AMERICAS
NEW YORK, NY 10036-8704

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/30/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
MCDERMOTT WILL & EMERY LLP
600 13TH STREET, N.W.
WASHINGTON, DC 20005-3096

Date:
MAILED
DEC 30 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000464
PATENT NO. : 6624761
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

Jeffrey H Ingerman
ROPES & GRAY LLP
PATENT DOCKETING 39/361
1211 AVENUE OF THE AMERICAS
NEW YORK NY 10036-8704

(For Patent Owner)

MAILED

DEC 30 2009

CENTRAL REEXAMINATION UNIT

Michael A Messina
MCDERMOTT WILL & EMERY LLP
600 13TH STREET, N.W.
WASHINGTON, DC 20005-3096

(For Third Party Requester)

In re: James J Fallon
Inter Partes Reexamination Proceeding
Control No. 95/000,464
Deposited on: 05 May 2009
For: US Patent No. 6,624,761

DECISION
GRANTING-IN-PART
PETITION FOR
EXTENSION OF TIME
[37 CFR §§ 1.956 & 1.181]

This is a decision on the 28 December 2009, patent owner "Petition Under 37 CFR § 1.956 for Extension of Time to Reply to Office Action in Reexamination," requesting that the time for responding to the Office action mailed 15 December 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.

Discussion

The Patent Owner requests an extension of time in which to file a response to the non-final Office action was mailed 15 December 2009. The non-final Office action provides two (2) month period for response. The petition request for a two (2) month extension of time was timely filed on 28 December 2009. The petition request provides electronic payment for the $200 petition fee under 37 CFR §1.17 (g).

There is sufficient cause to grant one (1) month extension of time.

The request is granted-in-part.

> **37 CFR § 1.956. Patent owner extensions of time in inter partes reexamination.** *The time for taking any action by a patent owner in an inter partes reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified. Any request for such extension must be filed on or before the day on which action by the patent owner is due, but in no case will the mere filing of a request effect any extension. Any request for such extension must be accompanied by the petition set forth in § 1.17(g). See § 1.304(a) for extensions of time for filing a notice of appeal to the U.S. Court of Appeals for the Federal Circuit.*

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

> As noted above, a request for extension of time under 37 CFR § 1.956 will be granted only for sufficient cause, ...
>
> Evaluation of whether "sufficient cause" has been shown for an extension must be made by **balancing** the desire to provide the patent owner with a fair opportunity to respond, **against** the requirement of the statute, 35 U.S.C. § 314(c), that the proceedings be conducted with special dispatch. ...

Any petition request must include the required petition fee as set forth according to 37 CFR § 1.17 (g) and 37 CFR § 1.956.

MPEP § 2665 Extension of Time for Patent Owner Response (in-part)

> ...
>
> 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.

...

DECISION

The patent owner's representative petitions under 37 CFR § 1.956 to extend the period for response by adding two (2) months to the period for response. The decision to extend the period for response is evaluated based upon a showing of "sufficient cause." There is always the consideration to balance the need for the patent owner to have a fair opportunity to respond to the Office action between the need for special dispatch.

The petition dated 28 December 2009 notes that there are a number of related proceedings as well as some concurrent due dates for response thereto. Further the patent owner notes that an expert is unavailable until March. It is not clear 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 with respect to the concurrent proceedings. The statement of must provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period. It is unclear why the patent owner does not have adequate representation to respond to the various proceedings in a timely manner. Further while it is unfortunate that Dr. Ligler is unavailable at this time, the granting of one month additional time amply provides the patent owner with time to locate additional experts as needed. Again it is unclear what action has been taken thus far to locate expert help for response in this proceeding as well as a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.

The time for response is extended by one (1) month.

The petition request to extend the response time is hereby granted-in-part.

CONCLUSION

1. The patent owner's petition for extension for time in which to file a response to the non-final Office action dated 15 December 2009 is hereby **granted-in-part.**

2. A one (1) month extension of time is granted.

3. The Patent Owner's response is due **15 March 2010.**

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

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

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

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

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

reexamination proceeding, which offers parties the opportunity to review the content of their submissions after the "soft scanning" process is complete.

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

/Mark Reinhart/

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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JUL 14 2009

CENTRAL REEXAMINATION UNIT

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

Brian Poissant
JONES DAY
222 EAST 41ST STREET
NEW YORK, NY 10017-6702

(For Patent Owner)

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

(For 95/000,465 & 90/009,377 Requester)

David R. Bailey
WOODCOCK WASHBURN LLP
CIRA CENTRE, 12TH FLOOR
2929 ARCH STREET
PHILADELPHIA PA 19104-2891

(Courtesy Copy)

Inter Partes Reexamination Proceeding
Control No. 95/000,465
Filed: May 5, 2009
For: U.S. Patent No. 7,128,744

Ex Parte Reexamination Proceeding
Control No. 90/009,377
Filed: January 8, 2009
For: U.S. Patent No. 7,128,744

DECISION, *SUA SPONTE*, TO MERGE REEXAMINATION PROCEEDINGS

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

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 7,128,744 (the '744 patent) issued to Weaver *et al.* on October 31, 2006.

2. A request for *ex parte* reexamination of claims 1-55 of the '744 patent was filed on January 8, 2009, by third party requester Smith & Nephew, Inc., and the request was assigned control number 90/009,377 (the '9377 *ex parte* proceeding).

3. On February 13, 2009, *ex parte* reexamination was ordered for the '9377 proceeding based on the examiner's determination that the January 8, 2009 request raised a substantial new question of patentability.

4. A request for *inter partes* reexamination of claims 1-55 of the '744 patent was filed on May 5, 2009, by third party requester Smith & Nephew, Inc., and the request was assigned control number 95/000,465 (the '465 *inter partes* proceeding).

5. On June 19, 2009, *inter partes* reexamination was ordered for the '465 proceeding based on the examiner's determination that the May 5, 2009 request raised a substantial new question of patentability.

6. There has been no Office action in the '465 *inter partes* proceeding, and the time for filing a patent owner's statement pursuant to 37 CFR 1.530 expired in the '9377*e x parte* proceeding after April 13, 2009. [1]

DECISION

I. MERGER OF PROCEEDINGS

Reexamination has been ordered in two proceedings for the same claims of the same patent. One of the proceedings (the '465 proceeding) is an *inter partes* proceeding. All of the proceedings are still pending, and have not been terminated. Therefore, consideration of merger pursuant to 37 CFR 1.989 is ripe at this point in time.

37 CFR 1.989 provides:

> (a) If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where 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] 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 (aside from the request).

> §§ 1.902 through 1.997, except that the rights of any third party requester of the *ex parte* reexamination shall be governed by §§ 1.510 through 1.560.

In accordance with 37 CFR 1.989(a), the 95/000,465 & 90/009,377 proceedings are merged. The merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN ALL PROCEEDINGS

Patent owner is required to maintain the same claims (and specification) in all files throughout the merged proceeding. Since the claims are the same in all files, a "housekeeping amendment" is NOT needed in this instance.

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

The present decision merges 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 proceeding are governed by 37 CFR 1.510 through 1.560. In this instance, however, the '9377 *ex parte* reexamination was requested by the same third party that requested the *inter partes* reexamination. And, that third party (Smith & Nephew, Inc.) has full *inter partes* reexamination participation rights.

B. Papers mailed/filed:

All papers mailed by the Office throughout the merged proceeding will take the form of a single action which applies to both proceedings. All papers issued by the Office, or filed by the patent owner and the third party requester, will contain the identifying data for both proceedings and will be 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 proceedings, 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 (or delivery service) 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

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.

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

C. Amendments:

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

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

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

D. Fees:

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

E. Citation of Patents and Printed Publications:

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

PATENT OWNER'S ADDRESS

The patent owner is called upon to coordinate the proper correspondence addresses in (1) the patent, (2) the 95/00,465 proceeding and (3) the 90/009,377 proceeding. Different patent owner counsel and addresses are of record for the two reexamination proceedings. **The current correspondence address of record <u>in the patent file</u> is the proper patent owner address for reexamination mailings pursuant to 37 CFR 1.33(c),** and it is that of JONES DAY, 222 EAST 41ST STREET, NEW YORK, NY 10017-6702. Accordingly, all future correspondence will be directed to JONES DAY, 222 EAST 41ST STREET, NEW YORK, NY 10017-6702, unless patent owner changes the correspondence address of record in the patent (the same address should be explicitly made of record in the reexamination proceedings).

It is further noted that different attorneys are of record for the two reexamination proceedings. In order to permit filing of patent owner papers in the now merged proceeding by one attorney alone, the two proceedings must given a single attorney of record, with appointment being made as appropriate. Patent owner is provided with ONE (1) MONTH from the mailing of this decision to do so. If there is a newly designated attorney, patent owner must supply the designated attorney with the requisite power of attorney in the appropriate files (the patent file and both reexamination proceedings). If this is not rectified, the attorney of record will be taken as the attorney of record in the patent

As a one-time courtesy, this decision is being mailed to both addresses. However, as pointed out above, the address of JONES DAY, 222 EAST 41ST STREET, NEW YORK, NY 10017-6702, will be used in future correspondence, unless the address of record is changed as set forth above.

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/000,465 and *ex parte* Reexamination Control No. 90/009,377 are <u>merged into a single proceeding</u>, to be conducted in accordance with the procedure set forth above.

2. Patent owner is provided with ONE (1) MONTH from the mailing of this decision to file papers to address the correspondence address and attorney of record considerations in both proceedings, as set forth in the last section of this decision.

3. Jurisdiction over the merged reexamination is being forwarded via the Central Reexamination Unit Director to the examiner for the preparation of an Office action, to be issued in due course for the merged proceeding. The examiner should not issue an Office action for the present merged proceeding until after the earlier of:

   (A) The expiration of the one month period set for filing the papers addressing the correspondence address and attorney of record in both proceedings, or

   (B) The receipt of such papers.

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

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

7-13-09

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.
95/000,465	05/05/2009	7128744	SYNT-0711	1725

53443 7590 02/02/2010
WOODCOCK WASHBURN LLP
CIRA CENTRE, 12TH FLOOR
2929 ARCH STREET
PHILADELPHIA, PA 19104-2891

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/02/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patents and Trademark Office
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
Robert A. King
HUNTON & WILLIAMS LLP, INTELLECTUAL PROPERTY DEPT.
1900 K Street, N.W., Suite 1200
Washington, DC 20006-1109

Date:

MAILED

FEB 02 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000465 & 90/009,377
PATENT NO. : 7128744
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

WOODCOCK WASHBURN LLP
CIRA CENTRE, 12TH FLOOR
2929 ARCH STREET
PHILADELPHIA, PA 19104-2891

(For Patent Owner)

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

(For *Inter Partes* & *Ex Parte* Requester)

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CENTRAL REEXAMINATION UNIT

Inter Partes Reexamination Proceeding
Control No. 95/000,465
Filed: May 5, 2009
For: U.S. Patent No. 7,128,744

Ex Partes Reexamination Proceeding
Control No. 90/009,377
Filed: January 8, 2009
For: U.S. Patent No. 7,128,744

DECISION DISMISSING PETITION

This is a decision on the patent owner paper entitled "PETITION FOR INCREASE OF PAGE LIMIT FOR PATENT OWNER'S RESPONSE PURSUANT TO 37 C.F.R. §§1.183 AND 1.943(b)," filed on November 19, 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. 233050.

REVIEW OF THE RELEVANT FACTS

1. On October 31, 2006, United States Patent No. 7,128,744 ("the '744 patent") issued to Weaver *et al.*

2. On January 8, 2009, a request for *ex parte* reexamination of the '744 patent was filed by a third party requester, which request was assigned Reexamination Control No. 90/009,377 ("the '9377 proceeding").

3. On February 13, 2009, the Office mailed an order granting *ex parte* reexamination in the '9377 proceeding.

4. On May 5, 2009, a request for *inter partes* reexamination of the '744 patent was filed by a third party requester, which request was assigned Reexamination Control No. 95/000,465 ("the '465 proceeding").

5. On June 19, 2009, the Office mailed an order granting *inter partes* reexamination in the '465 proceeding.

6. On July 14, 2009, the Office mailed a decision *sua sponte* merging the '9377 *ex parte* and the '465 *inter partes* proceedings ("the merged proceeding").

7. On November 5, 2009, the Office mailed a non-final Office action in the merged proceeding.

8. On November 19, 2009, patent owner filed the instant petition entitled, "PETITION FOR INCREASE OF PAGE LIMIT FOR PATENT OWNER'S RESPONSE PURSUANT TO 37 C.F.R. §§1.183 AND 1.943(b)" ("petition under 37 CFR 1.183").

9. Concurrently, on November 19, 2009, patent owner filed a request for a two-month extension of time to respond to the November 5, 2009 Office action.

10. On November 25, 2009, patent owner's petition for a two-month extension of time was granted for one month only, extending the period for response to the November 5, 2009 Office action to February 5, 2009.

11. On December 30, 2009, patent owner filed a petition for an additional two-week extension of time to respond to the November 5, 2009 Office action.

12. On January 7, 2010, patent owner's petition for an additional two-week extension of time was granted, extending the period for response to the November 5, 2009 Office action to February 19, 2009.

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), which limits patent owner responses to 50 pages in length. In particular, patent owner requests that "[i]n view of the voluminous nature of the Office Action and the numerous and complex issues raised therein" the page limit for patent owner's response to the November 5, 2009 Office action be increased "to an amount equal to the number of pages used by the Examiner for presenting the rejections set forth in the November 5, 2009 Office Action."[1]

In support of its request for waiver of the rule, patent owner asserts that "[t]he outstanding Office Action presents 58 separate grounds of rejection for alleged obviousness that are said to find basis in 17 documents and publications" and that "[t]he Examiner has adopted in their entirety 17 claim charts submitted by the Third Party Requester and 23 pages from one of the Requester's written requests to support the rejections."[2] Patent owner asserts that "[i]n sum, these adopted claim charts and written request documents cited by the Examiner reflect that the Examiner has used approximately 1,263 pages for presenting the rejections set forth in the November 5, 2009 Office Action."[3] Patent owner further asserts that "[a]s a point of reference on the facial insufficiency of the 50-page limit under these circumstances, Patent Owner notes that the Requests for Reexamination (in both the *ex parte* and *inter partes* requests) that appear to have served as a basis for the Office Action span 116 pages (not including the exhibits) and include in addition the aforementioned numerous and lengthy claim charts."[4]

Further in support of its request for waiver of the 50-page limit of 37 CFR 1.943(b), patent owner asserts that "[t]he increase in pages is further necessitated by the fact that the outstanding grounds for rejection are for alleged obviousness" and that "[g]iven the analytical standards set forth in *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727 (2007), Patent Owner needs adequate briefing space to tell the full and complete story of the significant inventions embodied in the patent claims that currently are subject to reexamination."[5] Additionally, patent owner states that it intends support its response with factual expert declarations, in addition to drawings and images of bone plates and the prior art.[6]

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[1] Petition under 37 CFR 1.183 at page 2.
[2] Petition under 37 CFR 1.183 at page 2.
[3] Petition under 37 CFR 1.183 at page 2.
[4] Petition under 37 CFR 1.183 at page 2.
[5] Petition under 37 CFR 1.183 at page 2.
[6] Petition under 37 CFR 1.183 at page 2. *See* MPEP 2667, which provides, in-part: "Any affidavit or declaration (or a clearly defined portion thereof) that contains opinon(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

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 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 length that is equal to the length of the November 5, 2009 Office action, which, patent owner asserts, is effectively 1,263 pages long.[7] It is to be noted, however, that the length of the Examiner's treatment of issues is not a *per se* indication of how many pages patent owner 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. For example, while patent owner states "that 50 pages are plainly insufficient for its response to an Office Action of such magnitude and depth," it is not clear exactly how many pages patent owner would need to develop a response to each of the rejections, or that a maximum of 1,263 pages would be needed to sufficiently to develop a response to all of the rejections.[8] 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 <u>economizing, extraneous material, and arrangement, without repetition of information already of record</u>. 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 exactly how many additional pages are needed to complete the response.

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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. ... Similarly, attached exhibits presenting data or drawings are not included against the page limit count, unless an exhibit or drawing includes argument as to how the outstanding rejection is overcome. Any page(s) of the exhibit or sheet(s) of drawings that include such argument would be included against the page limit count."

[7] On its face, the November 5, 2009 Office action is 23 pages long.

[8] Petition under 37 CFR 1.183 at page 2.

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 requester 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.[9] If the Office does grant such a petition under 37 CFR 1.183, the third party requester 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 November 19, 2009 petition under 37 CFR 1.183 is dismissed.

CONCLUSION

1. The patent owner November 19, 2009 petition under 37 CFR 1.183 is **dismissed**.

2. Jurisdiction for the instant merged 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

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Kenpet7/IP/length

[9] *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."

UNITED STATES PATENT AND TRADEMARK OFFICE

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CENTRAL REEXAMINATION UNIT

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Inter Partes Reexamination Proceeding	:
Control No. 95/000,465	: **DECISION**
Filed: May 5, 2009	: **GRANTING**
For: U.S. Patent No. 7,128,744	: **PATENT OWNER**
	: **PETITION AND**
Ex Partes Reexamination Proceeding	: ***SUA SPONTE***
Control No. 90/009,377	: **WAIVING REQUESTER**
Filed: January 8, 2009	: **PAGE LIMIT**
For: U.S. Patent No. 7,128,744	:

This is a decision on the patent owner paper entitled "RENEWED PETITION FOR INCREASE OF PAGE LIMIT FOR PATENT OWNER'S RESPONSE PURSUANT TO 37 C.F.R. §§1.183 AND 1.943(b)," filed on February 19, 2010.

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

The $400.00 petition fee pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183 was charged to patent owner's deposit account on February 22, 2010.

BACKGROUND

1. On October 31, 2006, United States Patent No. 7,128,744 ("the '744 patent") issued to Weaver *et al.*

2. On January 8, 2009, a request for *ex parte* reexamination of the '744 patent was filed by a third party requester, which request was assigned Reexamination Control No. 90/009,377 ("the '9377 proceeding").

3. On February 13, 2009, the Office mailed an order granting *ex parte* reexamination in the '9377 proceeding.

4. On May 5, 2009, a request for *inter partes* reexamination of the '744 patent was filed by a third party requester, which request was assigned Reexamination Control No. 95/000,465 ("the '465 proceeding").

5. On June 19, 2009, the Office mailed an order granting *inter partes* reexamination in the '465 proceeding.

6. On July 14, 2009, the Office mailed a decision *sua sponte* merging the '9377 *ex parte* and the '465 *inter partes* proceedings ("the merged proceeding").

7. On November 5, 2009, the Office mailed a non-final Office action in the merged proceeding.

8. On November 19, 2009, patent owner filed the instant petition entitled, "PETITION FOR INCREASE OF PAGE LIMIT FOR PATENT OWNER'S RESPONSE PURSUANT TO 37 C.F.R. §§1.183 AND 1.943(b)" ("the petition under 37 CFR 1.183").

9. Concurrently, on November 19, 2009, patent owner filed a request for a two-month extension of time to respond to the November 5, 2009 Office action.

10. On November 25, 2009, patent owner's petition for a two-month extension of time was granted for one month only, extending the period for response to the November 5, 2009 Office action to February 5, 2009.

11. On December 30, 2009, patent owner filed a petition for an additional two-week extension of time to respond to the November 5, 2009 Office action.

12. On January 7, 2010, patent owner's petition for an additional two-week extension of time was granted, extending the period for response to the November 5, 2009 Office action to February 19, 2009.

13. On February 2, 2010, the Office mailed a decision dismissing patent owner's November 19, 2009 petition under 37 CFR 1.183.

14. On February 19, 2010, patent owner filed the instant petition entitled, "RENEWED PETITION FOR INCREASE OF PAGE LIMIT FOR PATENT OWNER'S RESPONSE PURSUANT TO 37 C.F.R. §§1.183 AND 1.943(b)" ("the renewed petition under 37 CFR 1.183").

15. Concurrently, on February 19, 2010, patent owner filed a response to the November 5, 2009 Office action.

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 Renewed Petition under 37 CFR 1.183

On February 2, 2010, the Office mailed a decision dismissing patent owner's November 19, 2009 petition under 37 CFR 1.183 for waiver of the 50-page limit of 37 CFR 1.948(b). In the February 19, 2010 renewed petition under 37 CFR 1.183, patent owner requests waiver of the 50-page limit of 37 CFR 1.943(b) for patent owner's concurrently-filed response, which includes remarks and supporting declarations.[1] In particular, patent owner requests that the 50-page limit of 37 CFR 1.943(b) "be increased to an amount equal to that used in the response and declarations of Dr. Parsons and Mr. Haag as filed February 19, 2010."[2]

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. Patent owner asserts that it "attempted to meet the 50 page limit, but was not able to do so without prejudice to its arguments" and that "Patent Owner has tried to structure the response to limit any repetition, not repeat information already in the record, and arrange the material in a concise fashion."[3] In addition to the showing, patent owner has also substantiated its request for waiver of the 50-page limit of 37 CFR 1.943(b) with specific facts regarding the length of the November 5, 2009 Office action, the number and nature of rejections, and the number of references relied upon therein.[4]

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[1] The renewed petition under 37 CFR 1.183 at pages 1-2.

[2] The renewed petition under 37 CFR 1.183 at page 3. The declarations are subsequently referred to herein as the "Parsons declaration" and the "Haag declaration."

[3] The renewed petition under 37 CFR 1.183 at page 3.

[4] *See* the renewed petition under 37 CFR 1.183 at page 2 (asserting that "The outstanding Office Action presents 58 separate grounds of rejection for alleged obviousness that are said to find basis in 17 documents and publications. The Examiner has adopted in their entirety 17 claim charts submitted by the Third Party Requester and 23 pages from one of the Requester's written requests to support the rejections. In sum, these adopted claim charts and written request documents cited by the Examiner reflect that the Examiner has used approximately 1,263 pages for presenting the rejections set forth in the November 5, 2009 Office Action.")

Based on the specific facts set forth in the renewed petition under 37 CFR 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.[5] Accordingly, the renewed petition under 37 CFR 1.183 is granted to the extent of permitting patent owner's February 19, 2010 response to exceed the page limit by 70 pages as follows. The number of pages of the remarks portion of patent owner's February 19, 2010 response that count toward the page limit is 86 pages and the number of pages of the declarations of patent owner's February 19, 2010 response that count toward the page limit is approximately 34 pages.[6] Thus, the total number of pages of patent owner's response that count toward the page limit is 120 pages, which exceeds the page limit of 37 CFR 1.943(b) by 70 pages. This waiver makes patent owner's February 19, 2010 response page-length compliant.

Time Period and Page Limit for Submission of Third Party Requester Comments

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 120 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.**[7] Requester has 30 days from the mailing date of this decision, granting patent owner's petition under 37 CFR 1.183 and making patent owner's February 19, 2010 response page-length compliant, to file a comments paper pursuant to 37 CFR 1.947. *See* MPEP 2667(I)(A)(2).

CONCLUSION

1. Patent owner's February 19, 2010 petition under 37 CFR 1.183 is granted, and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting patent owner's February 19, 2010 response to the November 5, 2009 Office action to exceed the page limit by 70 pages. This waiver makes patent owner's February 19, 2010 response page-length compliant.

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 after patent owner's February 19, 2010

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[5] It is noted that, on its face, the substantive portion of the November 5, 2009 Office action, setting forth the rejections of the claims that were adopted by the examiner, appears to span only 5 pages but relies exclusively on incorporation by reference of approximately 1200 pages from the request for *inter partes* reexamination in the '465 proceeding to set forth the rejections.

[6] Of the declarations submitted with patent owner's February 19, 2010 response, only the Parsons declaration is replete with pages of arguments (*e.g.*, pages 23-56) that count toward the 50-page limit of 37 CFR 1.943(b). The Haag declaration does not appear to contain any pages of arguments that count toward the 50-page limit of 37 CFR 1.943(b). *See* MPEP 2667(I)(A)(2) (providing that only those pages of the accompanying affidavits/declarations that contain opinon(s) of the affiant/declarant that the art either does or does not anticipate or render obvious the claims, or specific claim elements, of the patent under reexamination are counted toward the 50-page limit.)

[7] Patent owner's February 19, 2010 response and the Parsons declaration appear to use one-and-a-half line spacing.

response shall not exceed 120 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.**

3. Requester has **30 days from the mailing date of this decision** to file a comments paper pursuant to 37 CFR 1.947

4. Jurisdiction for the merged proceeding is returned to the Central Reexamination Unit (CRU).

5. Any questions concerning this communication should be directed to Nicole Dretar, Legal Advisor, Office of Patent Legal Administration, at (571) 272-7717.

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

Kenpet8
5-3-10

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CENTRAL REEXAMINATION UNIT

Jeffrey H Ingerman ROPES & GRAY LLP PATENT DOCKETING 39/361 1211 AVENUE OF THE AMERICAS NEW YORK NY 10036-8704	: : : :	(For Patent Owner)
Michael A Messina MCDERMOTT WILL & EMERY LLP 600 13TH STREET, N.W. WASHINGTON, DC 20005-3096	: : : :	(For Third Party Requester)
In re: James J Fallon *Inter Partes* Reexamination Proceeding Control No. 95/000,466 Deposited on: 07 May 2009 For: US Patent No. 7,321,937	: : : : :	DECISION GRANTING-IN-PART PETITION FOR EXTENSION OF TIME [37 CFR §§ 1.956 & 1.181]

This is a decision on the 28 December 2009, patent owner "Petition Under 37 CFR § 1.956 for Extension of Time to Reply to Office Action in Reexamination," requesting that the time for responding to the Office action mailed 22 December 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.

DISCUSSION

The Patent Owner requests an extension of time in which to file a response to the Action Closing Prosecution that was mailed 22 December 2009. The ACP provides two (2) month period for response. The petition request for a two (2) month extension of time was timely filed on 28 December 2009. The petition request provides electronic payment for the $200 petition fee under 37 CFR §1.17 (g).

There is sufficient cause to grant one (1) month extension of time.

The request is granted-in-part.

> **37 CFR § 1.956. Patent owner extensions of time in inter partes reexamination.** *The time for taking any action by a patent owner in an inter partes reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified. Any request for such extension must be filed on or before the day on which action by the patent owner is due, but in no case will the mere filing of a request effect any extension. Any request for such extension must be accompanied by the petition set forth in § 1.17(g). See § 1.304(a) for extensions of time for filing a notice of appeal to the U.S. Court of Appeals for the Federal Circuit.*

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

> As noted above, a request for extension of time under 37 CFR § 1.956 will be granted only for sufficient cause, ...
>
> Evaluation of whether "sufficient cause" has been shown for an extension must be made by **balancing** the desire to provide the patent owner with a fair opportunity to respond, **against** the requirement of the statute, 35 U.S.C. § 314(c), that the proceedings be conducted with special dispatch. ...

Any petition request must include the required petition fee as set forth according to 37 CFR § 1.17 (g) and 37 CFR § 1.956.

MPEP § 2665 Extension of Time for Patent Owner Response (in-part)

> ...
>
> 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.

...

DECISION

The patent owner's representative petitions under 37 CFR § 1.956 to extend the period for response by adding two (2) months to the period for response. The decision to extend the period for response is evaluated based upon a showing of "sufficient cause." There is always the consideration to balance the need for the patent owner to have a fair opportunity to respond to the Office action between the need for special dispatch.

The petition dated 28 December 2009 notes that there are a number of related proceedings as well as some concurrent due dates for response thereto. Further the patent owner notes that an expert is unavailable until March. It is not clear 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 with respect to the concurrent proceedings. The statement of must provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period. It is unclear why the patent owner does not have adequate representation to respond to the various proceedings in a timely manner. Further while it is unfortunate that Dr. Ligler is unavailable at this time, the granting of one month additional time amply provides the patent owner with time to locate additional experts as needed. Again it is unclear what action has been taken thus far to locate expert help for response in this proceeding as well as a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.

The time for response is extended by one (1) month.

The petition request to extend the response time is hereby granted-in-part.

CONCLUSION

1. The patent owner's petition for extension for time in which to file a response to the Action Closing Prosecution dated 22 December 2009 is hereby **granted-in-part.**

2. A one (1) month extension of time is granted.

3. The Patent Owner's response is due **22 March 2010.**

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

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

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

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

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

reexamination proceeding, which offers parties the opportunity to review the content of their submissions after the "soft scanning" process is complete.

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

/Mark Reinhart/

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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.
95/000,466	05/07/2009	7321937	103532-0004-601	6927

1473 7590 01/12/2010

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 01/12/2010

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

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Jeffrey H Ingerman ROPES & GRAY LLP PATENT DOCKETING 39/361 1211 AVENUE OF THE AMERICAS NEW YORK NY 10036-8704	:	(For Patent Owner)
Michael A Messina MCDERMOTT WILL & EMERY LLP 600 13TH STREET, N.W. WASHINGTON, DC 20005-3096	:	(For Third Party Requester)
In re: James J Fallon *Inter Partes* Reexamination Proceeding Control No. 95/000,466 Deposited on: 07 May 2009 For: US Patent No. 7,321,937	:	DECISION GRANTING-IN-PART PETITION FOR EXTENSION OF TIME [37 CFR §§ 1.956 & 1.181]

MAILED
JAN 12 2010
CENTRAL REEXAMINATION UNIT

This is a corrected decision on the 28 December 2009, patent owner "Petition Under 37 CFR § 1.956 for Extension of Time to Reply to Office Action in Reexamination," requesting that the time for responding to the Office action mailed 22 December 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.

DISCUSSION

The Patent Owner requests an extension of time in which to file a response to the Action Closing Prosecution that was mailed 22 December 2009. The ACP provides one (1) month period for response. The petition request for a two (2) month extension of time was timely filed on 28 December 2009. The petition request provides electronic payment for the $200 petition fee under 37 CFR §1.17 (g).

There is sufficient cause to grant one (1) month extension of time.

The request is granted-in-part.

> **37 CFR § 1.956. Patent owner extensions of time in inter partes reexamination.** *The time for taking any action by a patent owner in an inter partes reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified. Any request for such extension must be filed on or before the day on which action by the patent owner is due, but in no case will the mere filing of a request effect any extension. Any request for such extension must be accompanied by the petition set forth in § 1:17(g). See § 1.304(a) for extensions of time for filing a notice of appeal to the U.S. Court of Appeals for the Federal Circuit.*

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

> As noted above, a request for extension of time under 37 CFR § 1.956 will be granted only for sufficient cause, ...
>
> Evaluation of whether "sufficient cause" has been shown for an extension must be made by **balancing** the desire to provide the patent owner with a fair opportunity to respond, **against** the requirement of the statute, 35 U.S.C. § 314(c), that the proceedings be conducted with special dispatch. ...

Any petition request must include the required petition fee as set forth according to 37 CFR § 1.17 (g) and 37 CFR § 1.956.

MPEP § 2665 Extension of Time for Patent Owner Response (in-part)

...

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.

...

DECISION

The patent owner's representative petitions under 37 CFR § 1.956 to extend the period for response by adding two (2) months to the period for response. The decision to extend the period for response is evaluated based upon a showing of "sufficient cause." There is always the consideration to balance the need for the patent owner to have a fair opportunity to respond to the Office action between the need for special dispatch.

The petition dated 28 December 2009 notes that there are a number of related proceedings as well as some concurrent due dates for response thereto. Further the patent owner notes that an expert is unavailable until March. It is not clear 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 with respect to the concurrent proceedings. The

statement of must provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period. It is unclear why the patent owner does not have adequate representation to respond to the various proceedings in a timely manner. Further while it is unfortunate that Dr. Ligler is unavailable at this time, the granting of one month additional time amply provides the patent owner with time to locate additional experts as needed. Again it is unclear what action has been taken thus far to locate expert help for response in this proceeding as well as a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.

The time for response is extended by one (1) month.

The petition request to extend the response time is hereby granted-in-part.

CONCLUSION

1. The patent owner's petition for extension for time in which to file a response to the Action Closing Prosecution dated 22 December 2009 is hereby **granted-in-part.**

2. A one (1) month extension of time is granted.

3. The corrected Patent Owner's response is due **22 February 2010.**

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

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

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

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

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

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

/Mark Reinhart/

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,468	05/08/2009	6623486	SYNT-0712	2083

53443 7590 05/26/2010

WOODCOCK WASHBURN LLP
CIRA CENTRE, 12TH FLOOR
2929 ARCH STREET
PHILADELPHIA, PA 19104-2891

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 05/26/2010

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
HUNTON & WILLIAMS LLP
INTELLECTUAL PROPERTY DEPARTMENT
1900 K STREET, NW, SUITE 1200
WASHINGTON, DC 20006-1109

Date:

MAILED

MAY 26 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000468 & 90/009,378
PATENT NO. : 6623486
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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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,378	01/08/2009	6623486	SYNT-0703	5757

53443 7590 05/26/2010

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ART UNIT	PAPER NUMBER

DATE MAILED: 05/26/2010

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

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(For Patent Owner)

ROBERT A. KING
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INTELLECTUAL PROPERTY DEPT.
1900 K STREET, N.W., SUITE 1200
WASHINGTON, DC 20006-1109

(For *Inter Partes* & *Ex Parte* Requester)

MAILED

MAY 26 2010

CENTRAL REEXAMINATION UNIT

Inter Partes Reexamination Proceeding
Control No. 95/000,468
Filed: May 8, 2009
For: U.S. Patent No. 6,623,486

Ex Partes Reexamination Proceeding
Control No. 90/009,378
Filed: January 8, 2009
For: U.S. Patent No. 6,623,486

DECISION GRANTING PATENT OWNER AND REQUESTER PETITIONS AND *SUA SPONTE* WAIVING REQUESTER PAGE LIMIT

This is a decision on the patent owner paper entitled "PETITION FOR INCREASE OF PAGE LIMIT FOR PATENT OWNER'S RESPONSE PURSUANT TO 37 C.F.R. §§1.183 AND 1.943(b)," filed on March 22, 2010. This is also a decision on the requester paper entitled "PETITION TO ADOPT A SCHEDULE FOR THIRD-PARTY COMMENT SUBMISSION," filed under 37 CFR 1.182 on March 23, 2010.

The patent owner and requester petitions are before the Office of Patent Legal Administration.

The patent owner and requester petitions are granted to the extent set forth herein.

FEES

The $400.00 petition fee pursuant to 37 CFR 1.17(f) for the patent owner petition under 37 CFR 1.183 was charged to patent owner's deposit account on March 25, 2010.

The $400.00 petition fee pursuant to 37 CFR 1.17(f) for the requester petition under 37 CFR 1.182 is being charged to requester's deposit account pursuant to the authorization on page 5 of the requester March 23, 2010 petition.

BACKGROUND

1. On September 23, 2003, United States Patent No. 6,623,486 ("the '486 patent") issued to Weaver *et al.*

2. On January 8, 2009, a request for *ex parte* reexamination of the '486 patent was filed by third party requester, Smith & Nephew, Inc., which request was assigned Reexamination Control No. 90/009,378 ("the '9378 proceeding").

3. On February 14, 2009, the Office mailed an order granting *ex parte* reexamination in the '9378 proceeding.

4. On May 8, 2009, a request for *inter partes* reexamination of the '486 patent was filed by third party requester, Smith & Nephew, Inc., which request was assigned Reexamination Control No. 95/000,468 ("the '468 proceeding").

5. On June 19, 2009, the Office mailed an order granting *inter partes* reexamination in the '468 proceeding.

6. On July 10, 2009, the Office mailed a decision *sua sponte* merging the '9378 *ex parte* and the '468 *inter partes* proceedings ("the merged proceeding").

7. On November 30, 2009, the Office mailed a non-final Office action in the merged proceeding.

8. On December 30, 2009, patent owner filed a request for a six-week extension of time to respond to the November 30, 2009 Office action.

9. On January 6, 2010, patent owner's petition for a six-week extension of time was granted, extending the period for response to the November 30, 2009 Office action to March 15, 2010.

10. On February 23, 2010, patent owner filed a request for an additional one-week extension of time to respond to the November 30, 2009 Office action.

11. On March 3, 2010, patent owner's petition for a one-week extension of time was granted extending the period for response to the November 30, 2009 Office action to March 22, 2010.

12. On March 22, 2010, patent owner filed the instant petition entitled, "PETITION FOR INCREASE OF PAGE LIMIT FOR PATENT OWNER'S RESPONSE PURSUANT TO 37 C.F.R. §§1.183 AND 1.943(b)" ("the petition under 37 CFR 1.183").

13. Concurrently, on March 22, 2010, patent owner filed a response to the November 30, 2009 Office action.

14. On March 23, 2010, requester filed the instant petition entitled, "PETITION TO ADOPT A SCHEDULE FOR THIRD-PARTY COMMENT SUBMISSION" ("the petition under 37 CFR 1.182").

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 March 22, 2010 petition under 37 CFR 1.183, patent owner requests waiver of the 50-page limit of 37 CFR 1.943(b) for patent owner's concurrently-filed response, which includes remarks and supporting declarations.[1] In particular, patent owner requests that the 50-page limit of 37 CFR 1.943(b) "be increased to an amount equal to that used in the response and declarations of Dr. Truen, Dr. Parsons and Mr. Haag as filed March 22, 2010."[2]

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. Patent owner asserts that it "attempted to meet the 50 page limit, but was not able to do so without prejudice to its arguments" and that "Patent Owner has tried to structure the response to limit any repetition, not repeat information already in the record, and arrange the material in a concise fashion."[3] In addition to the showing, patent owner has also substantiated its request for waiver of the 50-page limit of 37 CFR 1.943(b) with specific facts regarding the length of the November 30, 2009

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[1] The petition under 37 CFR 1.183 at pages 1-2.
[2] The petition under 37 CFR 1.183 at page 3. The declarations are subsequently referred to herein as the "Truen declaration", the "Parsons declaration" and the "Haag declaration."
[3] The petition under 37 CFR 1.183 at page 3.

Office action, the number and nature of rejections, and the number of references relied upon therein.[4]

Based on the specific facts set forth in the renewed petition under 37 CFR 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.[5] Accordingly, the petition under 37 CFR 1.183 is granted to the extent of permitting patent owner's March 22, 2010 response to exceed the page limit by 117 pages as follows. The number of pages of the remarks portion of patent owner's March 22, 2010 response that count toward the page limit is 97 pages and the number of pages of the declarations of patent owner's March 22, 2010 response that count toward the page limit is approximately 70 pages.[6] Thus, the total number of pages of patent owner's response that count toward the page limit is 167 pages, which exceeds the page limit of 37 CFR 1.943(b) by 117 pages. This waiver makes patent owner's March 22, 2010 response page-length compliant.

Time Period and Page Limit for Submission of Third Party Requester Comments

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 167 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.**[7]

In the March 23, 2010 petition under 37 CFR 1.182, requester requests that a schedule be imposed for submission of requester's comments on patent owner's response to the November 30, 2009 Office action, stating that requester's schedule for submission of it comments is unclear as a result of patent owner's concurrent filing in the merged proceeding on March 22, 2010 of

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[4] *See* the petition under 37 CFR 1.183 at page 3 (asserting that "The outstanding Office Action presents ***ninety-three*** (93) separate grounds of rejection for alleged anticipation and obviousness. There are ***eleven*** (11) primary references upon which the anticipation and obviousness rejections are based. The Examiner has adopted in their entirety ***thirty*** (30) claim charts submitted by the Third Party Requester and numerous pages from the Requester's written requests to support the rejections. In sum, these adopted claim charts and written request documents cited by the Examiner reflect that the Examiner has used over 850 pages for presenting the rejections set forth in the November 30, 2009 Office Action.")

[5] It is noted that, on its face, the substantive portion of the November 30, 2009 Office action, setting forth the rejections of the claims that were adopted by the examiner, appears to span only 10 pages but relies exclusively on incorporation by reference of over 850 pages from the request for *inter partes* reexamination in the '468 proceeding and from the request for *ex parte* reexamination in the '9378 proceeding to set forth the rejections.

[6] Of the declarations submitted with patent owner's March 22, 2010 response, only the Truen and Parsons declarations are replete with pages of arguments (*e.g.*, in the Parsons declaration pages 27-62 and in the Truen declaration pages 13-46) that count toward the 50-page limit of 37 CFR 1.943(b). The Haag declaration does not appear to contain any pages of arguments that count toward the 50-page limit of 37 CFR 1.943(b). *See* MPEP 2667(I)(A)(2) (providing that only those pages of the accompanying affidavits/declarations that contain opinion(s) of the affiant/declarant that the art either does or does not anticipate or render obvious the claims, or specific claim elements, of the patent under reexamination are counted toward the 50-page limit.)

[7] Patent owner's March 22, 2010 response and the Parsons and Turen declarations appear to use one-and-a-half line spacing.

the petition under 1.183 with its response in excess of 50 pages.[8] Because this decision makes the patent owner's March 22, 2010 response page-length compliant, the date of service of the patent owner's response pursuant to 37 CFR 1.947 is deemed to be the mailing date of the instant decision. Accordingly, requester's petition under 37 CFR 1.182 is granted to the extent that requester has 30 days from the mailing date of this decision, granting patent owner's petition under 37 CFR 1.183 and making patent owner's March 22, 2010 response page-length compliant, to file a comments paper pursuant to 37 CFR 1.947. *See* MPEP 2667(I)(A)(2).

CONCLUSION

1. Patent owner's March 22, 2010 petition under 37 CFR 1.183 is granted, and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting patent owner's March 22, 2010 response to the November 30, 2009 Office action to exceed the § 1.943(b) page limit by 117 pages. This waiver makes patent owner's March 22, 2010 response page-length compliant.

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 after patent owner's March 22, 2010 response shall not exceed 167 pages in length, excluding reference materials, such as prior art references. **This waiver is conditional on the comments submission being in at least 12 point font and one-and-a-half or double spaced, with appropriate margins.**

3. Requester's March 23, 2010 petition under 37 CFR 1.182 is granted to the extent that requester has **30 days from the mailing date of this decision** to file a comments paper pursuant to 37 CFR 1.947.

4. Jurisdiction for the merged proceeding is returned to the Central Reexamination Unit (CRU).

5. Any questions concerning this communication should be directed to Maria Nuzzolillo at (571) 271-8150 or Nicole Dretar, Legal Advisor, Office of Patent Legal Administration, at (571) 272-7717.

Kenneth M. Schor

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

5-25-10
Pet8

[8] *See* the petition under 37 CFR 1.182 at pages 1 and 3. *See also* the petition under 37 CFR 1.182 at page 2, suggesting that a comments submission schedule similar to that which was set forth in the February 2, 2010 petition decision mailed by the Office in the 95/000,465 proceeding be adopted.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,469	09/03/2009	7389243	535412800100	6472

23694 7590 07/16/2010

Law Office of J. Nicholas Gross, Prof. Corp.
2030 ADDISON ST.
SUITE 610
BERKELEY, CA 94704

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 07/16/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
ROBERT A. SALTZBERG
MORRISON & FOERSTER LLP
425 MARKET STREET
SAN FRANCISCO, CA 94105-2482

Date:

MAILED
JUL 16 2010
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000469
PATENT NO. : 7389243
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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LAW OFFICE OF J. NICHOLAS GROSS, PROF. CORP. (For Patent Owner)
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BERKELEY, CA 94704

ROBERT A. SALTZBERG (For Third Party Requester)
MORRISON & FOERSTER LLP
425 MARKET STREET
SAN FRANCISCO, CA 94105

MAILED

JUL 16 2010

CENTRAL REEXAMINATION UNIT

Inter Partes Reexamination Proceeding : **DECISION GRANTING**
Control No. 95/000,469 : **PETITION AND**
Filed: September 3, 2009 : ***SUA SPONTE***
For: U.S. Patent No. 7,389,243 : **WAIVING PAGE LIMIT**

This is a decision on patent owner's petition under 37 CFR 1.183 to waive the page limit requirement pursuant to 37 C.F.R. 1.943(b), filed on May 13, 2010.

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

The petition fee of $400.00 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183 was charged to patent owner's deposit account.

The patent owner petition under 37 CFR 1.183 is granted, for the reasons set forth herein.

BACKGROUND

- On June 17, 2008, United States Patent No. 7,389,243 (the '243 patent) issued to Gross.
- On September 3, 2009, a request for *inter partes* reexamination of the '243 patent was filed by a third party requester. The request was assigned reexamination control no. 95/000,469 (the '469 proceeding).
- On December 1, 2009, *inter partes* reexamination was ordered in the '469 proceeding.
- On February 3, 2010, a non-final Office action was mailed in the '469 proceeding.
- On April, 1, 2010, the patent owner filed a paper responsive to the February 3, 2010 non-final Office action, including a declaration under 37 CFR 1.132 of J. Nicholas Gross.

- On April 6, 2010, the patent owner filed a paper responsive to the February 3, 2010 non-final Office action.

- On April 28, 2010, the Office mailed a Notice Re Defective Paper in Inter Partes Reexamination, which determined that the April 1 and April 6, 2010 patent owner responses exceeded the page limit provisions of 37 CFR 1.943, and that the amendment accompanying the April 1 and April 6 patent owner responses failed to comply with 37 CFR 1.530(e).

- On May 13, 2010, the patent owner filed a replacement response submission, including a declaration under 37 CFR 1.132 of J. Nicholas Gross, in response to the April 28, 2010 notice.

- Also on May 13, 2010, the patent owner filed the instant petition under 37 CFR 1.183 to waive the provisions of 37 CFR 1.943(b) (the May 13, 2010 petition).

DECISION

I. 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:

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

MPEP 2667(I)(A)(2) provides, in pertinent part:

> Any affidavit or declaration (or a clearly defined portion thereof) that contains opinion(s) of the affiant/declarant, or argument(s) that the art either does or does not anticipate or render obvious the claims, or specific claim elements, of the patent under reexamination, is considered to be part of the comments submitted by the patent owner, or by the third party requester, and is subject to the page limit requirements of 37 CFR 1.943. Affidavits or declarations that are excluded from the page limit requirements include, for example, declarations attempting to swear behind (antedate) the filing date of a reference, or to establish the date of a printed publication, or declarations that provide comparative test data

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

II. Patent Owner Petition Under 37 CFR 1.183

Patent owner's May 13, 2010 petition under 37 CFR 1.183, requesting waiver of the 50-page limit of 37 CFR 1.943(b) for its concurrently-filed response to the February 3, 2010 Office action, 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. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft a patent owner's response in compliance with the 50-page limit, and submission of a 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), 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, petitioner can rely on the proposed response: (1) for justification that more pages are needed to complete the response, and (2) to set forth an accurate determination of exactly how many additional pages are needed to complete the response.

In determining whether an affidavit or declaration under 37 CFR 1.132 is subject to the 50-page length requirement under 37 CFR 1.943(b), the Office analyzes whether the affidavit or declaration is providing factual evidence, i.e., evidence of *technological* facts, or whether the affidavit or declaration is merely an extension of the arguments of counsel. Factual evidence includes declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results. Where the affidavit or declaration includes arguments containing legal argument, including legal analysis and legal conclusions, such as arguments that the claims are patentable or unpatentable, or are directed to how an outstanding or proposed rejection is overcome, or, in the case of a declaration filed by the requester, how an outstanding or proposed rejection is supported, the affidavit or declaration is subject to the 50-page length requirement. The declaration under 37 CFR 1.132 of J. Nicholas Gross is replete with such arguments for the

reasons discussed *infra*. For this reason, the entire declaration is subject to the 50-page length requirement.

In the instant petition under 37 CFR 1.183, patent owner requests that the page limit for patent owner's response to the February 3, 2010 Office action be waived to the extent needed to accommodate the number of pages of patent owner's concurrently-submitted response.[1] In support of the waiver of 37 CFR 1.943(b), patent owner states that the "Office Action issued on February 3, 2010 adopts five (5) of these 14 grounds and consists of 65 pages of analysis under 35 USC § 103 arguing for the combination of no less than 8 of the cited references."[2] Patent owner further asserts that he "has simply resubmitted a replacement Response as requested, and the Remarks section now constitutes a mere 63 pages, which is less than the length of the Office Action."[3] Additionally, patent owner asserts that "the outstanding 65 page Office Action presents 28 separate grounds of rejection . . . for alleged obviousness that are said to find basis in 7 different documents."[4]

Further in support of its request for waiver of 37 CFR 1.943(b), patent owner has submitted, on May 13, 2010, a replacement response that is in excess of 50 pages. Patent owner asserts that it has made every effort to minimize the length of the response and supporting evidence and that it has been able to keep its response to 68 pages.

Based on the individual facts and circumstances of this case including, for example, approximately 40 pages of single line spacing of the February 3, 2010 Office action, as well as the full length of the February 3, 2010 Office action and the number of applied rejections, it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance.

The number of pages of the remarks portion of patent owner's May 13, 2010 replacement response that count toward the page limit is 63 pages, and the number of pages of the declaration under 37 CFR 1.132 of J. Nicholas Gross, also submitted on May 13, 2010, that are subject to the page count is determined to be 30 pages,[5] resulting in a total of 93 pages. As previously stated, a declaration is subject to the 50-page length requirement where it includes arguments containing legal argument, legal analysis, and legal conclusions.[6] The May 13, 2010 declaration under 37 CFR 1.132 is replete with such arguments. Examples of such arguments can be found at page 10, paragraph 34 ("This factor again greatly mitigates against the "motivation" of one skilled in the art to implement the Elston scheme into Hastings, because there would have been no substantial reason to do so in that application"); page 20, paragraph 80 ("On this basis I submit one skilled in the art considering the Hastings reference would not have found it obvious to combine such with a reference such as Elston (or other references) as argued by the Requester. . ."); page 22, paragraph 89 ("The references therefore implicitly (if not explicitly) teach away from the claimed combination"); and page 23, paragraph 92 ("There is simply no identified deficiency in

[1] Petition under 37 CFR 1.183 at page 2.
[2] Petition under 37 CFR 1.183 at page 2.
[3] Petition under 37 CFR 1.183 at page 2.
[4] Petition under 37 CFR 1.183 at page 5.
[5] Sections as indicated in the Table of Contents on page 31 of the May 13, 2010 declaration , and the May 13, 2010 remarks appears to be replete with pages of arguments that count toward the 50-page limit of 37 CFR 1.943(b) pursuant to MPEP 2667(I)(A)(2).
[6] MPEP 2667(I)(A)(2).

Hastings et al in the record that would have led one skilled in the art to add the Elston notification, but for the present disclosure providing a guide to do so"). Additionally, the patent owner admits "that there is almost complete congruence between the content of the Declaration and the content of the April Remarks."[7] Accordingly, since the May 13, 2010 declaration under 37 CFR 1.132 of J. Nicholas Gross is an extension of the arguments of counsel, and is replete with arguments as to how an outstanding/proposed rejection is overcome, the entire 30-page declaration shall be included against the page limit count.

Thus, the total number of pages of patent owner's response submission that count toward the page limit is 93 pages. The substantive portion of the February 3, 2010 Office action has been determined to span approximately 64 pages, of which approximately 40 pages therein is single-spaced. If one-and-a-half or double-spacing had been utilized throughout the Office action, the length of the action would be at least 84 pages. The number of rejections applied by the examiner, which appear to be at least 22 in number, is also noted. Thus, even though patent owner's May 13, 2010 submission, including the remarks section and the declaration under 37 CFR 1.132 of J. Nicholas Gross, exceeds the 50-page limit, it is still deemed equitable in this instance to waive the 50-page limit of 37 CFR 1.943(b) to the extent that patent owner's response to the February 3, 2010 Office action not exceed 93 pages. Accordingly, patent owner's petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting patent owner's response submission to the February 3, 2010 Office action to exceed the page limit by up to 43 pages. This waiver makes patent owner's May 13, 2010 replacement response submission page-length compliant.

III. Time Period and Page Limit for Submission of Third Party Requester Comments

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 93 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 and making patent owner's May 13, 2010 response page-length compliant, to file a comments paper pursuant to 37 CFR 1.947.

IV. Grantable Petition Requirements Under 37 CFR 1.183 to Obtain Waiver

Note that any future grantable petition under 37 CFR 1.183 to obtain a waiver of the 50-page length requirement of 37 CFR 1.943(b), **must** be accompanied by a patent owner response submission or a requester comments submission that:

1) is double-spaced;
2) is in a non-script type font (e.g., Arial, Times New Roman, or Courier);

[7] Petition under 37 CFR 1.183 at page 4.

3) has a font size no smaller than 12-point;
4) conforms to the margin requirements of 37 CFR 1.52(a)(1)(ii); and
5) has sufficient clarity and contrast to permit direct reproduction of readily legible copies in any number by use of photographic, electrostatic, photo-offset, and microfilming processes and electronic capture by digital imaging and optical character recognition pursuant to 37 CFR § 1.52(a)(1)(v).

V. Petition to "Deem Response Compliant with 37 CFR 1.530(e)"

Regarding the petition to "deem the response compliant with 37 CFR 1.530(e)," this petition is dismissed as premature, pending the examiner's determination regarding the compliance of the patent owner's submission with 37 CFR 1.530(e).

CONCLUSION

1. Patent owner's May 13, 2010 petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting patent owner's response submission to the February 3, 2010 Office action, including the remarks section and the declaration under 37 CFR 1.132 of J. Nicholas Gross, to exceed the page limit by up to 43 pages. This waiver makes patent owner's May 13, 2010 replacement response submission page-length compliant.

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 93 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 and making patent owner's May 13, 2010 response page-length compliant, to file a comments paper pursuant to 37 CFR 1.947.

3. Regarding the petition to "deem the response compliant with 37 CFR 1.530(e)," this petition is dismissed as premature, pending the examiner's determination regarding the compliance of the patent owner's submission with 37 CFR 1.530(e).

4. Jurisdiction for the '469 reexamination proceeding is returned to the Central Reexamination Unit (CRU).

5. Any questions concerning this communication should be directed to the undersigned at (571) 272-7724.

Cynthia L. Nessler

Cynthia L. Nessler
Senior Legal Advisor
Office of Patent Legal Administration

6-1510
Kenpet8/IP/length

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,470	05/14/2009	6564281	9278.002.RXUS00	3302

86497 7590 09/24/2009

Paul M. Anderson, PLLC
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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/24/2009

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Date: SEP 24 2009

CENTRAL REEXAMINATION UNIT

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
NOVAK DRUCE & QUIGG, LLP (NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET
FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000470
PATENT NO. : 6564281
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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1000 LOUISIANA STREET
FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date:

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SEP 24 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010540
PATENT NO. : 6564281
ART UNIT : 3992

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

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

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SEP 24 2009
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Paul M. Anderson, PLLC
P.O. Box 160006
Austin, Texas 78716

(For Patent Owner)

Tracy Druce
Novak Druce & Quigg, LLP
1000 Louisiana Avenue, 53rd Floor
Houston, Texas 77002

(For Third Party Requester)

In re Farmwald, et al.	
Inter partes Reexamination Proceeding	
Control No. 95/000,470	
Filed: May 14, 2009	
For: U.S. Patent No. 6,564,281	**DECISION, *SUA SPONTE*, TO MERGE REEXAMINATION PROCEEDINGS**
Ex parte Reexamination Proceeding	
Control No. 90/010,540	
Filed: May 14, 2009	
For: U.S. Patent No. 6,564,281	

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

REVIEW OF FACTS

1. United States Patent Number 6,564,281 (the '281 patent) issued to Farmwald et al., on May 13, 2003.

2. A request for *ex parte* reexamination was filed by third party requester NVIDIA Corporation, on May 14, 2009. The resulting reexamination proceeding was assigned Control No. 90/010,540 (the '540 proceeding). Reexamination was requested for claims 1-46 of the '281 patent.

3. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/000,470 (the '470 proceeding), was filed by third party requester on May 14, 2009. Reexamination was requested for claims 1-46 of the '281 patent. The request identified NVIDIA Corporation as the real party in interest.

4. An order granting reexamination of claims 1-46 in the '281 patent was mailed for the '540 *ex parte* reexamination proceeding on July 6, 2009.

5. An order *granting* the request for *inter partes* reexamination for claims 1-46 in the '470 *inter partes* reexamination proceeding was mailed on July 6, 2009.

DECISION

I. MERGER OF PROCEEDINGS

37 CFR 1.989 provides:

> (a) If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the merged examination will normally result in the issuance of a single reexamination certificate under § 1.997.
>
> (b) An *inter partes* reexamination proceeding filed under § 1.913 which is merged with an *ex parte* reexamination proceeding filed under § 1.510 will result in the merged proceeding being governed by §§ 1.902 through 1.997, except that the rights of any third party requester of the *ex parte* reexamination shall be governed by §§ 1.510 through 1.560.

As evidenced by the above review of facts, both the '470 and the '540 reexamination proceedings are currently pending. An order granting reexamination of claims 1-46 of the '281 patent has been mailed in each of the reexamination proceedings, and a decision under 37 CFR 1.989(a) is timely.

The general policy of the Office is that two reexamination proceedings will not be conducted separately, and at the same time, as to a particular patent. The rationale for this policy is (1) to prevent inconsistent, and possibly conflicting, amendments from being introduced into the two proceedings on behalf of the patent owner, (2) to provide a

comprehensive examination of the patent based on the issues raised in both of the proceedings, and (3) to expedite the prosecution of both proceedings. In the present instance, merger of the 95/000,470 and 90/010,540 reexamination proceedings would address these considerations. Thus, pursuant to 37 CFR 1.989(a), the 95/000,470 and 90/010,540 reexamination proceedings are hereby merged. The merged proceeding will be conducted in accordance with the guidelines and requirements which follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

The claims are identical in both proceedings. The patent owner is required to continue to maintain the same claims (and specification) in both files *throughout the merged proceeding*.

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

The present decision merges an ex *partes* reexamination proceeding with an *inter partes* reexamination proceeding. Pursuant to 37 CFR 1.989(b), the merged proceeding is governed by 37 CFR 1.902 through 1.997, except that the rights of the third party requester of the *ex parte* reexamination proceedings are governed by 37 CFR 1.510 through 1.560. In this instance, however, the '540 *ex parte* reexamination was requested by the same third party that requested the *inter partes* reexamination. And, that third party (NVIDIA Corporation) has full *inter partes* reexamination participation rights.

B. Papers mailed/filed:

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

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

By EFS:

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

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

E. Citation of Patents and Printed Publications:

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

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/000,470 and *ex parte* Reexamination Control No. 90/010,540 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

2. Jurisdiction over the merged reexamination is being forwarded via the Central Reexamination Unit Director to the examiner for the preparation of an Office action, to be issued in due course for the merged proceeding.

3. Any questions concerning this communication should be directed to the Office of Patent Legal Administration, to Maria Nuzzolillo, at (571) 272-8150 or in her absence to the undersigned at (571) 272-7726.

Pinchus M. Laufer
Legal Advisor
Office of Patent Legal Administration

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,470	05/14/2009	6564281	9278.002.RXUS00	3302

86497 7590 12/16/2009

Paul M. Anderson, PLLC
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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/16/2009

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,540	05/14/2009	6564281	9278.002.RX0000	5404

86497 7590 12/16/2009

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/16/2009

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
NOVAK DRUCE & QUIGG, LLP (NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET
FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date:

MAILED
DEC 16 2009
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000470
PATENT NO. : 6564281
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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1000 LOUISIANA STREET
FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date: MAILED
DEC 16 2009
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010540
PATENT NO. : 6564281
ART UNIT : 3992

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

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

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Austin TX 78716

(For Patent Owner)

MAILED

DEC 16 2009

CENTRAL REEXAMINATION UNIT

NOVAK, DRUCE & QUIGG, LLP
(NDQ Reexamination Group)
1000 Louisiana Avenue
Fifty-Third Floor
Houston, TX 77002

(For Third Party Requester)

In re Farmwald *et al.*
Inter partes Reexamination Proceeding
Control No.: 95/000,470
Filed: May 14, 2009
For: U.S. Patent No. 6,564,281

In re Farmwald *et al.*
Ex Parte Reexamination Proceeding
Control No.: 90/010,540
Filed: May 14, 2009
For: U.S. Patent No. 6,564,281

: DECISION
: DISMISSING
: PETITION TO
: RECONSIDER MERGER
: OF REEXAMINATION
: PROCEEDINGS

This is a decision on patent owner's October 13, 2009 petition entitled "PETITION UNDER 37 C.F.R. §§ 1.182 AND 1.183 TO RECONSIDER DECISION, *SUA SPONTE,* TO MERGE REEXAMINATION PROCEEDINGS".

The fee set forth in 37 CFR 1.17(f) for the patent owner petition is $400, and it was charged to Patent Owner's credit card on October 14, 2009 pursuant to the authorization for same in Patent Owner's EFS-WEB fee transmittal.

Patent Owner's petition is before the Office of Patent Legal Administration for consideration.

Patent Owner's petition is dismissed for the reasons set forth below.

REVIEW OF FACTS

1. On April 24, 2007, the Office issued U.S. Patent No. 6,564,281 (the '281 patent) to Farmwald *et al.*

2. On May 15, 2009, a request for *ex parte* reexamination of all the claims (claims 1-46) of

the '281 patent was filed by a third party requester, NVIDIA Corporation. The request was assigned Control No. 90/010,540 (the '10540 proceeding).

3. Also on May 15, 2009, a request for *inter partes* reexamination of all the claims (claims 1-46) of the '281 patent was filed by the same requester (NVIDIA Corporation). The request was assigned Control No. 95/000,470 (the '470 proceeding).

4. The '281 patent is subject to litigation in the United States District Court for the District of Northern California, in *Rambus Inc. v. Nvidia Corp.*, {Civil Action No. 3:08-cv-3343}. The initial complaint was filed July 10, 2008. Based upon the record, patent owner appears to be enforcing at least one of claims 1-46 against the requester in the litigation.

5. On July 6, 2009, the Office issued an order granting the '10540 request for *ex parte* reexamination and setting a two month time period for a Patent Owner's Statement. The order stated that all the claims of the '281 patent, claims 1-46, would be subject to reexamination.

6. Also on July 6, 2009, the Office issued an order granting the '470 request for *inter partes* reexamination and stating that a first action on the merits would be issued in due course. The order stated that all the claims of the '281 patent, claims 1-46, would be subject to reexamination.

7. The time for filing a patent owner's statement pursuant to 37 CFR 1.530 in the '10540 *ex parte* reexamination proceeding expired after September 6, 2009.[1]

8. On September 24, 2009, the Office, *sua sponte,* issued a decision merging the '470 *inter partes* reexamination proceeding with the '10540 *ex parte* reexamination proceeding.

9. On October 13, 2009, patent owner filed the present petition requesting reconsideration of the September 24, 2009 merger decision, citing 35 U.S.C. §§ 305 and 317(a), and requesting waiver of any rule that prevents consideration of the petition.

10. This decision addresses the October 13, 2009 Patent Owner petition requesting reconsideration of the September 24, 2009 decision to merge the '470 *inter partes* and '10540 *ex parte* reexamination proceedings.

11. As of the date of this decision, an Office action on the merits has not issued in either of the two reexamination proceedings.

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[1] There is no provision for filing a patent owner's statement in an *inter partes* reexamination proceeding; instead, an Office action on the merits is issued prior to any input from the parties.

PETITION DECISION TO STAY REEXAMINATION

35 U.S.C. 302 states (in part):

> Any person at any time may file a request for reexamination by the Office of any claim of a patent on the basis of any prior art cited under the provisions of section 301 of this title.

35 U.S.C. 304 states:

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

35 U.S.C. 311(a) states:

> IN GENERAL - Any third-party requester at any time may file a request for *inter partes* reexamination by the Office of a patent on the basis of any prior art cited under the provisions of section 301.

35 U.S.C. 314(c) states:

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

35 U.S.C. 317(a) states:

> (a) ORDER FOR REEXAMINATION.- Notwithstanding any provision of this chapter, once an order for *inter partes* reexamination of a patent has been issued

under section 313, neither the third-party requester nor its privies may file a subsequent request for *inter partes* reexamination of the patent until an *inter partes* reexamination certificate is issued and published under section 316, unless authorized by the Director.

37 CFR 1.33(a) states:

(1) Interviews with examiners concerning applications and other matters pending before the Office must be conducted on Office premises and within Office hours, as the respective examiners may designate. Interviews will not be permitted at any other time or place without the authority of the Director.

(2) An interview for the discussion of the patentability of a pending application will not occur before the first Office action, unless the application is a continuing or substitute application or the examiner determines that such an interview would advance prosecution of the application.

(3) The examiner may require that an interview be scheduled in advance.

37 CFR 1.182 states:

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

37 CFR 1.560 states:

(a) Interviews in *ex parte* reexamination proceedings pending before the Office between examiners and the owners of such patents or their attorneys or agents of record must be conducted in the Office at such times, within Office hours, as the respective examiners may designate. Interviews will not be permitted at any other time or place without the authority of the Director. Interviews for the discussion of the patentability of claims in patents involved in *ex parte* reexamination proceedings will not be conducted prior to the first official action. Interviews should be arranged in advance. Requests that reexamination requesters participate in interviews with examiners will not be granted.

(b) In every instance of an interview with an examiner in an *ex parte*

reexamination proceeding, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the patent owner. An interview does not remove the necessity for response to Office actions as specified in § 1.111. Patent owner's response to an outstanding Office action after the interview does not remove the necessity for filing the written statement. The written statement must be filed as a separate part of a response to an Office action outstanding at the time of the interview, or as a separate paper within one month from the date of the interview, whichever is later.

37 CFR 1.935 states:

The order for *inter partes* reexamination will usually be accompanied by the initial Office action on the merits of the reexamination.

37 CFR 1.937(a) states:

(a) All *inter partes* reexamination proceedings, including any appeals to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office, unless the Director makes a determination that there is good cause for suspending the reexamination proceeding.

37 CFR 1.939 states:

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

(b) Unless otherwise authorized, no paper shall be filed prior to the initial Office action on the merits of the inter partes reexamination.

37 CFR 1.955 states:

There will be no interviews in an *inter partes* reexamination proceeding which discuss the merits of the proceeding.

37 CFR 1.989 states:

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

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

MPEP 2640 II states (in part):

> Where reexamination is granted on a second or subsequent request, but the patent owner can clearly show that the second or subsequent request was filed for purposes of harassment, the patent owner can petition under 37 CFR 1.182 that the second or subsequent request should be suspended.

MPEP 2686.01 states (in part):

> Initially, it is appropriate to point out who can file a second or subsequent request for reexamination while a first reexamination proceeding is pending.
>
> Case (1) - The earlier (pending) reexamination is an *inter partes* reexamination:
>
> (1)(a) The subsequent request is an *inter partes* reexamination request. Pursuant to 35 U.S.C. 317(a), once an order for inter partes reexamination has been issued in a first reexamination proceeding, neither the third party requester, nor its privy, may file a subsequent request for an *inter partes* reexamination of the patent until an *inter partes* reexamination certificate is issued, unless authorized by the Director of the USPTO. In addition, the patent owner is not entitled to file any *inter partes* reexamination request (see MPEP § 2612). Thus, only a third party who is not a party to the earlier pending inter partes reexamination proceeding (nor a privy) can file the subsequent *inter partes* reexamination request.
>
> (1)(b) The subsequent request is an *ex parte* reexamination request. **Any party (including the patent owner) can file the subsequent *ex parte* reexamination request.** (Emphasis added)

MPEP 2686.01 I. WHEN PROCEEDINGS ARE MERGED states (in part):

> Where a second request for reexamination is filed and reexamination is ordered, and a first reexamination proceeding is pending, the proceedings will be merged where the Office (in its discretion) deems it appropriate to do so, to facilitate the orderly handling of the proceedings. However, a decision not to merge is within

the sole discretion of the Office to facilitate/carry out the statutory mandate of 35 U.S.C. 314(c) to conduct reexamination proceedings with "special dispatch."

MPEP 2686.01 IV. PROCEEDINGS NOT MERGED states:

> Pursuant to 35 U.S.C. 314(c), "[u]nless otherwise provided by the Director for good cause, all inter partes reexamination proceedings under this section shall be conducted with special dispatch within the Office." This statutory provision is grounded on the need for certainty and finality as to the question of patentability raised by the request for reexamination. Thus, if a second request for reexamination will unduly delay the first reexamination proceeding, the two proceedings generally will not be merged. If the Office were to merge the two proceedings, the first reexamination proceeding would need to be withdrawn from its place in the process, thus delaying, instead of advancing, prosecution. This would run contrary to the statutory "special dispatch" requirement of 35 U.S.C. 314 and its intent. On the other hand, if the Office does not merge, the first reexamination proceeding can be concluded, and any substantial new question of patentability raised by the second reexamination request can be resolved in the second proceeding, with no delay resulting. The second request is then considered based on the claims in the patent as indicated in the issued reexamination certificate, rather than the original claims of the patent. However, the Office always retains the authority to merge because in some instances, it may be more efficient to merge the two proceedings, which would foster "special dispatch." The instances where the Office may, or may not, merge an ongoing reexamination proceeding with a subsequent reexamination proceeding, are addressed on a case-by-case basis.

DECISION

I. Preliminary Matter: Waiver of 37 CFR 1.939(b)

As noted, *supra*, the *inter partes* request for reexamination of the '281 patent was filed on May 14, 2009, and reexamination was granted on July 6, 2009 and the now merged proceeding is governed by the *inter partes* reexamination rules. The language of 37 CFR 1.935 makes the concurrent sending of an Office action on the merits permissive. As noted above, the Examiner of record has not issue an Office action. In accordance with 37 CFR 1.939(a) unauthorized papers will not be considered in *inter partes* reexamination. Furthermore 37 CFR 1.939(b) does not permit the filing of any papers prior to the filing of the first office action on the merits. Therefore, Patent Owner's petition dated October 13, 2009 is not authorized. However, based upon the unique facts and circumstances of the present proceeding, in the interests of justice and

special dispatch, 37 CFR 1.939 is waived to the extent necessary to permit consideration of the petition presently before the Office of Patent Legal Administration.

II. Findings and Analysis

Patent owner asserts the filing of multiple voluminous requests for reexamination on the same patent, and upon related patents, in a narrow time frame, by the same requester, constitutes harassment. Patent owner further asserts that the reexamination filing pattern of the requester constitutes a gaming of the system that frustrates the Office's statutory mandate of special dispatch. Patent owner also asserts that merging an *inter partes* reexamination proceeding with an *ex parte* reexamination proceeding filed on the same day, when both proceedings were filed by the same third party requester, circumvents the statutory prohibition of 35 U.S.C. 317(a), which prohibits an *inter partes* requester or its privies from filing subsequent *inter partes* reexamination requests on the same patent until an *inter partes* reexamination certificate issues.

Patent owner requests as remedies, in the alternative, of: (1) Dismissal and termination of the reexamination proceeding due to harassment; (2) Dissolution of the merger of the *inter partes* and *ex parte* reexamination proceedings; or (3) Waiver of 37 CFR 1.989(b) to permit interviews, if the *inter partes* and *ex parte* reexamination proceedings remain merged. Granting the first remedy is asserted to preserve the integrity of the Office, by not entertaining requester "gamesmanship" and maintaining Office fidelity to the statutory mandate of special dispatch. Granting the second or third remedies is asserted to "preserve" the patent owner's *ex parte* rights, e.g. a right to an interview, and to prevent the improvident expansion of the third party requester's right to comment upon issues raised solely in the *ex parte* reexamination.

In accordance with 35 U.S.C. 302, any member of the public possesses the right to file a request for *ex parte* reexamination on an issued patent. Specifically the statute states that ANY third party may at ANY time file a request for reexamination based upon ANY prior art. After an *inter partes* reexamination request is ordered, by statute, 35 U.S.C. 317(a), the third party requester in the *inter partes* reexamination is barred from filing another *inter partes* request for reexamination, until an *inter partes* reexamination certificate is issued and published, unless authorized by the USPTO Director. MPEP 2686.01 provides guidance, in accordance with 35 U.S.C. §§ 302 and 317(a) and notes that after the filing of an *inter partes* reexamination request, ANY party may file an *ex parte* reexamination request. The reexamination statutes place no limitation upon a requester, as to the timing of filing a request for *ex parte* reexamination relative to the filing of parallel *inter partes* reexamination. Nor do the statutes place a "volume" limitation on the number of issues that may be raised by a single or multiple reexamination proceedings.

In regard to the asserted derogation of Patent Owner's "*ex parte*" reexamination right to an interview, no statutory or regulatory right to conduct an interview exists. While 37 CFR §§

1.133 and 1.560 provide the guidelines for conducting and making a record of interviews, 37 CFR §§ 1.33(a) and 1.560 do not confer a right to an interview, and 37 CFR 1.955 states that no interviews on the merits are permitted in an *inter partes* reexamination.[2] The relevant sections of the MPEP provide guidance on the conduct of interviews to include denial of an interview.[3] Accordingly, merger cannot divest Patent Owner of a right to an interview in the present *ex parte* reexamination proceeding, because Patent Owner has no such right.

Finally, in order to facilitate the statutory mandate of special dispatch, the relevant rules and MPEP guidance that govern the merger of reexamination proceedings an *inter partes* reexamination proceeding place the public on notice that the *inter partes* reexamination rules control a merged proceeding. Any arrangement to the contrary, e.g. permitting a patent owner to conduct an *ex parte* interview on SNQs[4] presented in the *ex parte* reexamination and only letting the requester comment on SNQs presented in the *inter partes* reexamination request, would be untenable to manage, monitor and control and therefore contrary to the mandate of special dispatch. It would be necessary to exclude all matters bearing any relation to the *inter partes* reexamination proceeding SNQs, in order not to prejudice the *inter partes* reexamination requester's right to respond to patent owner *re* such matters. In each instance of a patent owner point, a "fine" distinction and determination would need to be made, and that determination might be subject to requester challenge.

As reexamination must, by statute, be conducted with special dispatch. Merger of the present concurrent reexamination proceedings is in furtherance of special dispatch. In this instance, merger at the early stage in both the *ex parte* and *inter partes* reexamination proceedings furthers special dispatch by permitting all issues raised in both proceedings, and any overlap of issues, to be resolved at the same time, i.e., a resolution of all SNQs raised in both requests with special dispatch, rather than delaying resolution in one of the proceedings. Patent Owner's "suggestions" to modify the Office's procedure for merging a proceeding that include an *inter partes* reexamination MUST be in accord with, and not contrary to, special dispatch. In the present case, Patent Owner has not established on the record a basis to justify the relief requested. Accordingly, the requested relief will not be granted.

Harassment. Patent Owner alleges the existence of "harassment" to justify dismissal and termination of the '470 *inter partes* reexamination proceeding and the '10540 *ex parte* reexamination proceeding due to the Requester's filing of two allegedly voluminous requests for reexamination on the same day for the '281 patent, in addition to multiple reexamination requests filed against patents related to the '281 patent. The filing of *inter partes* and *ex parte* reexamination requests on other patents, albeit patents related to the '281 patent, is not relevant

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[2] In the extraordinary circumstance where the *inter partes* requester has opted to not participate in the *inter partes* reexamination proceeding, a Patent Owner can petition for a waiver of 37 CFR 1.955 under 37 CFR 1.183 to conduct an interview.
[3] See MPEP §§ 713 *et seq.*, 2281 and 2685
[4] Substantial New Question of Patentability

to the issue of harassment toward the Patent Owner in the reexamination of the '281 patent. Therefore, the issue of harassment focuses upon the actions of the Requester in the reexamination requests with respect to the reexamination of the '281 patent only. MPEP 2640 II states that the procedure for filing a petition based upon harassment calls for the relief of suspension and not dismissal and termination of the second or subsequently filed reexamination proceeding that is allegedly harassing. Petitioner, by filing the petition requesting dismissal and termination has erred.

The allegation of harassment is unsupported. MPEP 2640 II requires that the Patent Owner "clearly show" that the second or subsequent request was filed for purposes of harassment. Patent Owner has stated on the record that the '10540 *ex parte* reexamination request consisted of 150 pages and asserted 15 substantial new questions of patentability (SNQ). Patent owner further stated on the record that the '470 *inter partes* reexamination request consisted of 454 pages and asserted 60 additional SNQs. Patent Owner notes that the 15 SNQs of the '10540 *ex parte* reexamination request was supported by 799 pages of claim charts and the 60 SNQs of the '470 *inter partes* reexamination request was supported by 2,637 pages of claim charts. Patent Owner then speculates that Requester "recognized" that a single request containing 75 SNQs would not be granted by the Office; yet, Patent Owner provides no evidence to support this asserted Requester recognition. Finally, Patent Owner noted that the Office agreed that 59 of the 75 total SNQs asserted by requester did in fact raise a substantial new question of patentability. Patent owner did not present a by reexamination request breakdown of the number of SNQs found to lack merit. Patent Owner points to no authority that sets forth that a single request verses a set of two requests containing 75 SNQs is tantamount to *per se* harassment of the Patent Owner. Patent Owner merely sets forth the conclusory statement that such a filing is not reasonable. Patent Owner then goes on to cite several other reexamination requests for patents related to the '281 patent. However, as noted previously, the reexaminations of other related patents are not relevant to the present proceeding. Finally, Patent Owner alleges that requester has partaken in a form of gamesmanship of the reexamination system at the expense of the Office and Patent Owner that should not be tolerated. However, the degree of burden would be the same if all issues had been presented in one reexamination request, and the employment of multiple SNQs has not been shown to be for the purpose of harassment. To the contrary, estoppel attaches in *inter partes* reexamination to all issues that requester could have raised (35 U.S.C. 315(c) and 35 U.S.C. 317(b)), and bringing all issues to the table could have easily been Requester's motive, as opposed to harassment.

Patent Owner has not made an evidentiary showing that either reexamination request was filed with the intent to harass. The Requester has only filed two reexamination requests on the same day and has not been shown to have had the intent to withhold references at all, let alone for purposes of harassment. Therefore, Patent Owner's arguments are not persuasive, as no evidence of harassment in the filing of the two reexamination requests has been shown. The facts and circumstances surrounding the filing of the *inter partes* and *ex parte* reexamination

proceeding in this instance does not evidence harassment by the Requester of the Patent Owner. Accordingly, Patent Owner's arguments that Requester's filing of two requests for reexamination on the same day for the same patent is not persuasive as a basis for "harassment" dismissal and termination of the reexamination proceedings.

Circumvention of 35 U.S.C. 317(a). Patent Owner alleges that merging the '470 *inter partes* reexamination proceeding with the '10540 *ex parte* reexamination proceeding circumvents the statutory prohibition of 35 U.S.C. 317(a) that precludes the third party requester of an ordered *inter partes* reexamination from filing a subsequent *inter partes* reexamination request until after an *inter partes* reexamination certificate has issued and published, unless authorized by the USPTO Director. Patent Owner's rationale for this violation of the statute is that merger converts the *ex parte* reexamination into an *inter partes* reexamination, as the requester obtains *inter partes* participation rights regarding the SNQs raised in the now merged *ex parte* reexamination request. Patent Owner cites the Office decisions not to merge *ex parte* reexamination proceedings 90/007,844 (the '7844 proceeding) and 90/007843 (the '7843 proceeding) with *inter partes* reexamination proceedings 95/000,093 (the '093 proceeding) and 95/000,094 (the '094 proceeding) (collectively the "Sony cases") as persuasive logic for denying merger between the present proceedings. Patent owner's logic apparently being that the concurrent filing of an *ex parte* reexamination proceedings by the same requester is a "*de facto*" *inter partes* reexamination request, and hence a violation of the statute. However, as Patent Owner concedes, the present proceedings are not under suspension based upon a district court decision adverse to requester, as was the case in the '093 and '094 proceedings.

The statutory prohibition of 35 U.S.C. 317(a) is not implicated by requester's filing of an *ex parte* reexamination request on the same day as an *inter partes* reexamination request. The plain language of the statute states, in part (emphasis added):

> . . . **[O]nce an order for inter partes reexamination of a patent has been issued** under section 313, *neither the third-party requester nor its privies may file a subsequent request for inter partes reexamination* of the patent until an *inter partes* reexamination certificate is issued and published under section 316, unless authorized by the Director.

The requester filed an *ex parte* reexamination request on the same day the requester filed its *inter partes* reexamination request. The statute does not prohibit the filing of *ex parte* reexamination requests by a requester, that concurrently files an *inter partes* reexamination request on the same patent. Furthermore, on the day requester filed the *ex parte* reexamination request, the '470 *inter partes* reexamination had not yet been ordered. Therefore, even if requester's *ex parte* reexamination request were to be taken as a "*de facto*" *inter partes* reexamination request, the statutory prohibition is still not implicated, as the '470 *inter partes* reexamination request was not yet ordered by the Office. The non-merger decisions rendered in the "Sony cases" are not binding on the Office. As a general rule, the merger and suspension of proceedings for the same

patent before the Office are determined on a fact specific, case-by-case basis. Hence, a decision in one proceeding before the Office is not binding upon the Office in other proceedings. Furthermore, the decision to not merge in the "Sony Cases" was based upon the pre-existence of a suspension of the previously filed '093 and '094 *inter partes* reexamination proceedings. (See the Decision Denying Petitions to Merge in the '093 and the '094 proceedings, the text that bridges from the bottom of page 8 to the top of page 9). The statement of denial of the request to merge in the "Sony Cases" appears at an approximate mid-point on page 9 of the decision. After this legal statement of denial, based upon the existence of a suspension of the '093 and '094 *inter partes* proceedings, the decision then goes on to discuss this "*de facto*" *inter partes* filing logic. Therefore, the "*de facto*" *inter partes* filing logic was not part of the decision's rationale that precluded merger. The decision then concludes with a return to the fact that the court affirmed suspension of the '093 and the '094 *inter partes* proceedings was the determinative factor in denying the petition to merge the later filed *ex parte* proceedings with the previously filed *inter partes* proceedings. Accordingly, Patent Owner's argument that merger violates 35 U.S.C. 317(a) is not persuasive.

Demerger or Waiver of 37 CFR 1.989(b). Patent Owner asserts that, based upon the facts and circumstances surrounding the filings of the '470 *inter partes* reexamination proceeding and the '10540 *ex parte* reexamination proceeding, merger should not have been granted. Patent Owner further asserts that, based upon the facts and circumstances surrounding the filings even if merger is maintained, 37 CFR 1.989(b) should be waived to permit Patent Owner's retention of full *ex parte* reexamination patent owner rights. Patent Owner restates the argument that merger under 37 CFR 1.989(a) violates 35 U.S.C. 317(a) and that 37 CFR 1.989(b) has no statutory basis. Patent Owner also states the Office should not reward Requester's conduct. Finally, Patent Owner states that merger burdens the Office, allows the Requester to game the reexamination system and sets a precedent that undermines the integrity of the Office.

Merger of an *inter partes* reexamination and an *ex parte* reexamination, and hence 37 CFR 1.989, does not constitute a statutory violation, as it is grounded in the statutory mandate of special dispatch. 35 U.S.C. 314(c). Title 35 of the United States Code does not contain a statutory right to conduct an interview before the Office in any proceeding, to include *ex parte* reexamination proceedings. Merger of an *inter partes* reexamination proceeding and an *ex parte* reexamination proceeding does not occur until after the time passes for submission of a Patent Owner's statement. Therefore merger does not deny Patent Owner any statutory "*ex parte*" rights. Merger, based upon the statutory mandate of special dispatch, facilitates the timely and efficient disposition of reexamination proceedings, and does not create a burden on the Office as argued by Patent Owner. The very basis of the policy of merger is to reduce the burden upon the Office that separate, concurrent reexamination proceedings on the same patent present. Patent Owner's proposed arrangement of either dissolution of the merger or retention of the merger, but permitting Patent Owner *ex parte* interviews in a merged proceeding, both burden the Office and frustrate the statutory mandate of special dispatch. The conduct of two concurrent proceedings

on the same patent with two disparate sets of procedural rules instead of one will result in a burden on the Office relative to a single merged proceeding. Merging, but permitting Patent Owner *ex parte* interviews on the *ex parte* SNQs will also burden the Office in the form of additional monitoring and administration of interview to protect the rights of all the parties. And, as pointed out above, 37 CFR §§ 1.133(a) and 1.560 provide the guidelines for conducting and making a record of interviews, but 37 CFR §§ 1.33(a) and 1.560 do not confer a right to an interview. The relevant sections of the MPEP provide guidance on the conduct of interviews to include denial of an interview. Accordingly, merger cannot divest Patent Owner of a right to an interview in the present *ex parte* reexamination proceeding, because Patent Owner has no such right. Therefore, Patent Owner's arguments against merger, and for waiver of 37 CFR 1.989(b) if merged, are not persuasive.

Accordingly, the petition to dismiss and terminate, prevent merger or modify any merged proceeding to preserve "*ex parte* rights" is dismissed.

CONCLUSION

1. The October 13, 2009 Patent Owner petition is dismissed.

2. *Inter partes* Reexamination Control No. 95/000,471 and *ex parte* Reexamination Control No. 90/010,542 remain merged as a single proceeding.

3. Jurisdiction over the merged reexamination files is being forwarded via the Director of the Central Reexamination Unit (CRU) to the examiner, for the preparation of an Office action, to be issued in due course.

4. Telephone inquiries related to the present decision should be directed to Joseph F. Weiss, Jr., Reexamination Legal Advisor, at 571-272-7759.

Kenneth M. Schor

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,470	05/14/2009	6564281	9278.002.RXUS00	3302

86497 7590 06/22/2010

Paul M. Anderson, PLLC
P.O. Box 160006
Austin, TX 78716

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/22/2010

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
NOVAK DRUCE & QUIGG, LLP (NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET
FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date:
MAILED

JUN 2 2 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000470
PATENT NO. : 6564281
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,540	05/14/2009	6564281	9278.002.RX0000	5404

86497 7590 06/22/2010

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/22/2010

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Date:
MAILED

JUN 22 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010540
PATENT NO. : 6564281
ART UNIT : 3992

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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MAILED

JUN 22 2010

CENTRAL REEXAMINATION UNIT

In re Farmwald *et al.*
Inter partes Reexamination Proceeding
Control No.: 95/000,470
Filed: May 14, 2009
For: U.S. Patent No. 6,564,281

In re Farmwald *et al.*
Ex Parte Reexamination Proceeding
Control No.: 90/010,540
Filed: May 14, 2009
For: U.S. Patent No. 6,564,281

DECISION DISSOLVING MERGER OF REEXAMINATION PROCEEDINGS

This is a decision on patent owner's January 19, 2010 petition entitled "PETITION FOR RECONSIDERATION OF DECISION DISMISSING RAMBUS'S PETITION REGARDING MERGER OF REEXAMINATION PROCEEDINGS" and on third party requester's January 29, 2010 opposition to patent owner's January 19, 2010 petition.

The fee set forth in 37 CFR 1.17(f) for the patent owner petition is $400, which was charged to Patent Owner's credit card on January 20, 2010 pursuant to the authorization for same in Patent Owner's EFS-WEB fee transmittal.

The Third Party Requester opposition is being taken as a petition under 37 CFR 1.182. The fee set forth in 37 CFR 1.17(f) for this petition is $400, which was charged to Requester's deposit account no. 14-1437 on February 2, 2010, pursuant to the authorization on page two of requester's January 29, 2010 petition.

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

Patent Owner's petition is granted to the extent that the merger of the above-captioned proceedings is dissolved, for the reasons set forth below.

REVIEW OF FACTS

1. On May 13, 2003, the Office issued U.S. Patent No. 6,564,281 (the '281 patent) to Farmwald *et al.*

2. On May 14, 2009, a request for *ex parte* reexamination of all the claims (claims 1-46) of the '281 patent was filed by a third party requester, NVIDIA Corporation. The request was assigned Control No. 90/010,540 (the '10540 proceeding).

3. Also on May 14, 2009, a request for *inter partes* reexamination of all the claims (claims 1-46) of the '281 patent was filed by the same requester (NVIDIA Corporation). The request was assigned Control No. 95/000,470 (the '470 proceeding).

4. The '281 patent is subject to litigation in the United States District Court for the District of Northern California, in *Rambus Inc. v. Nvidia Corp.*, {Civil Action No. 3:08-cv-3343}. The initial complaint was filed July 10, 2008. Based upon the record, patent owner appears to be enforcing at least one of claims 1-46 against the requester in the litigation.

5. On July 6, 2009, the Office issued an order granting the '10540 request for *ex parte* reexamination and setting a two month time period for a Patent Owner's Statement. The order stated that all the claims of the '281 patent, claims 1-46, would be subject to reexamination.

6. Also on July 6, 2009, the Office issued an order granting the '470 request for *inter partes* reexamination and stating that a first action on the merits would be issued in due course. The order stated that all the claims of the '281 patent, claims 1-46, would be subject to reexamination.

7. The time for filing a patent owner's statement pursuant to 37 CFR 1.530 in the '10540 *ex parte* reexamination proceeding expired after September 6, 2009.[1]

8. On September 24, 2009, the Office, *sua sponte,* issued a decision merging the '470 *inter partes* reexamination proceeding with the '10540 *ex parte* reexamination proceeding (the merged proceeding).

9. On October 13, 2009, patent owner filed a petition requesting reconsideration of the September 24, 2009 merger decision, citing 35 U.S.C. §§ 305 and 317(a), and requesting waiver of any rule that would prevent consideration of the petition.

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[1] There is no provision for filing a patent owner's statement in an *inter partes* reexamination proceeding; instead, an Office action on the merits is issued prior to any input from the parties.

10. On December 16, 2009 the Office issued a decision dismissing patent owner's October 13, 2009 petition requesting reconsideration of the September 24, 2009 decision to merge the '470 *inter partes* and '10540 *ex parte* reexamination proceedings.

11. On December 17, 2009, the Office issued a first Office action on the merits in the merged proceeding.

12. On January 19, 2010, patent owner filed the present petition requesting reconsideration of the December 16, 2009 decision dismissing patent owner's October 13, 2009 petition requesting reconsideration of the September 24, 2009 decision to merge the '470 *inter partes* and '10540 *ex parte* reexamination proceedings.

13. On January 29, 2010, third party requester filed an opposition to patent owner's January 19, 2010 petition requesting reconsideration of the December 16, 2009 decision.

DECISION

I. Issues Raised and Relief Requested

Patent owner raises issues, asserting as follows: (1) The Office's manner of merging *ex parte* and *inter partes* reexamination proceedings violates 35 U.S.C. 305 and 37 C.F.R. §§ 1.555 (g) and 1.989(b) when the two proceedings have a common requester; (2) The current merger of *ex parte* and *inter partes* reexamination proceedings violates the statutory prohibition of *ex parte* requester participation and must either be modified or dissolved to remove the violation and facilitate the statutory mandate of special dispatch; (3) Merger of an *ex parte* and *inter partes* reexamination proceeding deprives patent owner of an "expectancy" to conduct an interview on the merits as to issues raised in the *ex parte* proceeding; and (4) Requester's filing of multiple voluminous requests for reexamination on the same patent, and upon related patents, in a narrow time frame, constitutes a harassment of patent owner.

Patent owner requests as remedies in the now merged proceeding that:

(1) The requester be prevented from participating with respect to the issues the requester raised in the *ex parte* proceeding; and patent owner's meaningful opportunity to be heard before the Office pursuant to 37 CFR 1.560 be restored with respect to the issues raised by the requester in the *ex parte* proceeding.

(2) Should the Office not grant the proposed relief (identified in the previous sentence) within the context of the merged proceeding, patent owner requests that the merger of the two proceedings be dissolved and that each proceeding be prosecuted separately.

II. Discussion of Previous Petition and Decision

In the original petition challenging merger, patent owner asserted that: (1) Requester's reexamination filing pattern constituted harassment and a gaming of the system that frustrates the Office's statutory mandate of special dispatch; (2) Merger of *ex parte* and *inter partes* reexamination proceedings frustrates the statutory mandate of special dispatch; (3) Merger of co-pending *ex parte* and *inter partes* reexamination proceedings filed by the same third party requester violates the statutory prohibition against the filing of a second *inter partes* reexamination request on the same patent by the same requester before the first *inter partes* reexamination proceeding concludes; and (4) Merger of *ex parte* and *inter partes* reexamination proceedings denies patent owner the right to conduct an interview regarding the issues raised in the *ex parte* reexamination proceeding.

The Office issued a decision dismissing patent owner's original petition. That decision pointed out that patent owner produced no evidence that the requester's second, subsequent request for reexamination was filed with an "intent to harass" and the finding of a substantial new question of patentability precluded a finding of harassment. Merger of the present concurrent *ex parte* and *inter partes* reexamination proceedings was done as an initial attempt to further special dispatch, as both proceedings were at an early stage and did not, at that time, appear to *per se* frustrate special dispatch as compared to patent owner's suggested alternatives in handling the proceedings. The decision pointed out that the filing of an *ex parte* reexamination proceeding did not violate nor circumvent 35 U.S.C. 317(a), as an *ex parte* reexamination proceeding was not an *inter partes* reexamination proceeding. Furthermore, the decision noted that 35 U.S.C. 302 permits any member of the public the right to file a request for *ex parte* reexamination on an issued patent, even if the member of the public is the requester in an *inter partes* proceeding for the same patent. Finally, the decision noted that no statutory right to interview exists, and therefore, merging *ex parte* and *inter partes* reexamination proceedings could not divest patent owner of a right that did not exist. Accordingly, the decision identified that patent owner had not established on the record a basis to justify the relief requested and the petition was dismissed.

III. Findings and Analysis

Reexamination of the '281 patent has been ordered in the '10540 *ex parte* proceeding and '470 *inter partes* proceeding, and the proceedings have been merged. The issue to be decided is whether the merger of the above-captioned *ex parte* and *inter partes* reexamination proceedings will be retained in this instance, where both requests were filed on the same day by the same party.

As an initial matter, there is no legal requirement for the Office to merge two pending reexamination proceedings. Rather, the determination whether to merge two reexamination proceedings is an act reserved to the discretion of the Office. (See 37 CFR 1.565(c), 37 CFR

1.989(a), MPEP 2686.01 I.,[2] MPEP 2686.01 IV,[3] 2283,[4] MPEP 2286.[5])

First, the statute is silent as to the procedural housekeeping issue of merger. Second, the relevant regulation makes it clear that the Office has discretion when deciding whether or not to merge an *ex parte* reexamination proceeding with an *inter partes* reexamination proceeding. See 37 CFR 1.989(a).[6] Third, while the MPEP does state the Office will "normally" merge two reexaminations, this general policy does not address the various possible permutations that may occur with regard to any specific set of cases eligible for merger. Finally, the MPEP also notes that the decision to merge is within the "sole discretion" of the Office to facilitate/carry out the statutory mandate to conduct reexamination proceedings with special dispatch.[7] Therefore, while the Office retains the authority to merge, it is permissible for the Office to not merge proceedings, where special dispatch can be equally or better served absent merger. Given the complexities and/or particularities that may arise in a proceeding, requester's position that merger in every circumstance where two co-pending reexamination proceedings on the same patent exists would be in accord with special dispatch is not persuasive. In summary, merge/non-merge determinations are made by the Office on a case-by-case basis, so that special dispatch can be achieved in view of the individual facts and circumstances of each proceeding.[8,9]

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[2] "Where a second request for reexamination is filed and reexamination is ordered, and a first reexamination proceeding is pending, the proceedings will be merged where the Office (**in its discretion**) deems it appropriate to do so, to facilitate the orderly handling of the proceedings. However, a decision not to merge is within the sole discretion of the Office to facilitate/carry out the statutory mandate of 35 U.S.C. 314(c) to conduct reexamination proceedings with 'special dispatch.'"

[3] "The instances where the Office may, or may not, merge an ongoing reexamination proceeding with a subsequent reexamination proceeding, are addressed on a case-by-case basis."

[4] "However, a decision not to merge is within the sole discretion of the Office to facilitate/carry out the statutory mandate of 35 U.S.C. 305 to conduct reexamination with 'special dispatch.'"

[5] "[T]he proceedings will be merged where the Office (in its discretion) deems it appropriate to do so, to facilitate the orderly handling of the proceedings. However, a decision not to merge is within the sole discretion of the Office to facilitate/carry out the statutory mandate of 35 U.S.C. 314(c) to conduct reexamination with 'special dispatch.'"

[6] "If any reexamination is ordered while a prior inter partes reexamination proceeding is pending for the same patent and prosecution in the prior inter partes reexamination proceeding has not been terminated, a decision **may** be made to merge the two proceedings or to suspend one of the two proceedings. . . ." (Emphasis added).

[7] Id.

[8] See "Revisions and Technical Corrections Affecting Requirements for *Ex Parte* and *Inter Partes* Reexamination," 72 Fed. Reg. 18892 (April 16, 2007-final rule) at 18901, where it states - "As was pointed out in the Notice of proposed Rule Making, there are instances where the Office does not merge (consolidate) an ongoing ex parte reexamination with a subsequent reexamination or reissue proceeding, which are addressed on a case-by case basis."

[9] "[T]he ability to decide the question of whether to merge/consolidate based on the merits of a particular fact pattern must be, and is, reserved to the Office." *Id.* at 18902.

At this juncture, it is noted that it was requester who chose to file two separate reexamination requests, to institute both *ex parte* and *inter partes* reexamination for all claims of the '281 patent, rather than to present all issues in one proceeding (giving requester the participation rights desired for the various issues identified in each request). Requester did so with full knowledge that the Office retains absolute discretion regarding whether or not to merge.[10] Therefore, requester determined that the issues raised in each request need not be together, and the Office, by doing the same and not merging the proceedings, does not impact upon any rights or expectations of the requester.

It is observed that requester argues that since the *ex parte* requester is the same as the *inter partes* requester, the *quid pro quo* for the requester commenting upon the issues raised in the *ex parte* request a statutory estoppel will occur under 35 U.S.C. 315(c). Requester cites no legal authority for this conclusion; however, it is not relevant to an instance where the Office has decided that, in the best interest of its administrative management of the proceedings and housekeeping, the proceedings will not be merged.

Based upon the specific facts and circumstances of the reexamination proceedings on the '281 patent, the Office has decided that merger would not be the best alternative in this instance.

Accordingly, the merger is dissolved and the two proceedings revert to independent prosecution. However, the Office retains the right to merge the present proceedings or to suspend one (or more) of the proceedings for a limited time at a later date, should circumstances change such that the situation warrants such action.

As an ancillary point, the Office concurs with requester that the act of filing an *ex parte* request is not a forfeiture of a right to file a subsequent *inter partes* request on the same patent as long as it raises a new, non cumulative SNQ and the references were not intentionally withheld with an intent to harass the patent owner. And, the Office also concurs with requester in regard to patent owner's arguments regarding the existence of interview rights. See *infra* section V of this decision.

IV. Procedural Considerations

1. Any Office action issued and responses submitted by the parties during the merged proceeding is hereby vacated by this decision.[11] Reexamination will restart anew from the point of prosecution just prior to the merger of the two proceedings. All Office actions and party responses from the time of merger, to the present, will be expunged from the Image File Wrapper (IFW) of the proceedings by being closed and marked non-public.

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[10] See the rules, MPEP sections, and Office Notice referred to above in the body of the decision and the footnotes.
[11] This does not include the decisions to order reexamination; they are not deemed Office actions in this context.

2. The proceedings will be conducted in a manner that minimizes any overlap of issues between the proceedings by preventing the importation of issues from one proceeding into the other. Specifically, the examiner will not introduce, from one proceeding into the other proceeding, any rejection proposed in the request, requester's reply under 37 CFR 1.535, or requester's comments in the *inter partes* reexamination.

3. All new rejections initiated by the examiner are to be included in the *inter partes* reexamination proceeding so as to permit the Office to have the benefits of third party requester's comments. The authority for inclusion of rejections initiated by the examiner is based upon 35 U.S.C. 314(a) which provides for examination in an *inter partes* reexamination proceeding in accordance with 35 U.S.C. 132 and 133, which permit the examiner's introduction of rejections. It should also be noted, that 35 U.S.C. 312 provides for the Office to *sua sponte* add issues to a reexamination proceeding "with... consideration of other patents or printed publications." Of course any modification of the proposed rejections in the *ex parte* reexamination proceeding to add a new reference to address the prosecution and examination of the *ex parte* reexamination proceeding would be made in that proceeding, and not in the *inter partes* reexamination proceeding, since the *ex parte* reexamination proceeding is the exclusive vehicle to address those proposed rejections.

4. As pointed out above, the Office retains the right to merge the present proceedings or to suspend one (or more) of the proceedings for a limited time at a later time should circumstances change such that the situation warrants such action.

5. If a reexamination certificate issues, concluding one of the two proceedings, patent owner is required pursuant to 37 CFR §§ 1.565(a) and 1.985(a) to file a notice of concurrent proceedings (See MPEP §§ 2282 and 2686) in the still pending proceeding, informing the Office of the issuance and publication of the reexamination certificate. Additionally, patent owner is required to submit an amendment paper, making all necessary amendments to the still pending proceeding, such that the still pending proceeding is consistent with all changes implemented by the issued reexamination certificate in the concluded proceeding.

V. Discussion Regarding "Interview Rights"

Interview and "Right to Request" an Interview. No statutory or regulatory right to conduct an interview exists. While 37 CFR §§ 1.133 and 1.560 provide the guidelines for conducting and making a record of interviews, 37 CFR §§ 1.133(a) and 1.560 do not confer any right to an interview. *Inter partes* reexamination rule 37 CFR 1.955 states that no interviews on the merits are permitted in an *inter partes* reexamination.[12] The relevant sections of the MPEP provide

[12] In the extraordinary circumstance where the *inter partes* requester has opted to not participate in the *inter partes* reexamination proceeding, a Patent Owner can petition for a waiver of 37 CFR 1.955 under 37 CFR 1.183 to conduct an interview, on an as-needed-per-interview basis.

guidance on the conduct of interviews to include denial of an interview.[13] None of the relevant rules or MPEP sections regarding interviews before the Office creates a right for an interview. While a party may request an interview, there is no requirement that the Office grant that request.

CONCLUSION

1. The January 19, 2010 patent owner petition is granted to the extent that the merger of the above-captioned proceedings is dissolved and the proceedings are reconstituted as separate proceedings.

2. Any Office action issued and responses/comments submitted by the parties during the merged proceeding are hereby vacated by this decision.[14]

3. If a reexamination certificate issues, concluding one of the two proceedings, patent owner is required pursuant to 37 CFR §§ 1.565(a) and 1.985(a) to file a notice of concurrent proceedings (See MPEP §§ 2282 and 2686) in the still pending proceeding, informing the Office of the issuance and publication of the reexamination certificate in the still pending proceeding. Additionally, patent owner is required to submit an amendment paper, making all necessary amendments to the still pending proceeding, such that the still pending proceeding is consistent with all changes implemented by the issued reexamination certificate in the concluded proceeding.

4. Jurisdiction over the two reexamination proceeding is forwarded via the Director of the Central Reexamination Unit (CRU) to the examiner, for action in accordance with this decision.

5. Telephone inquiries related to the present decision should be directed to Joseph F. Weiss, Jr., Reexamination Legal Advisor, at 571-272-7759.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration 6-21-10

[13] See MPEP §§ 713 *et seq.*, 2281 and 2685.
[14] As pointed out above, this does not apply to the decisions to order reexamination.

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CENTRAL REEXAMINATION UNIT

In re Farmwald *et al.* *Inter partes* Reexamination Proceeding Control No.: 95/000,471 Filed: May 15, 2009 For: U.S. Patent No. 7,209,997	DECISION DISMISSING PETITION TO RECONSIDER MERGER OF REEXAMINATION PROCEEDINGS
In re Farmwald *et al.* *Ex Parte* Reexamination Proceeding Control No.: 90/010,542 Filed: May 15, 2009 For: U.S. Patent No. 7,209,997	

This is a decision on patent owner's October 13, 2009 petition entitled "PETITION UNDER 37 C.F.R. §§ 1.182 AND 1.183 TO RECONSIDER DECISION, *SUA SPONTE,* TO MERGE REEXAMINATION PROCEEDINGS".

The fee set forth in 37 CFR 1.17(f) for the patent owner petition is $400, and it was charged to Patent Owner's credit card on October 14, 2009 pursuant to the authorization for same in Patent Owner's EFS-WEB fee transmittal.

Patent Owner's petition is before the Office of Patent Legal Administration for consideration.

Patent Owner's petition is dismissed for the reasons set forth below.

REVIEW OF FACTS

1. On April 24, 2007, the Office issued U.S. Patent No. 7,209,997 (the '997 patent) to Farmwald *et al.*

2. On May 15, 2009, a request for *ex parte* reexamination of all the claims (claims 1-38) of

the '997 patent was filed by third party requester, NVIDIA Corporation. The request was assigned Control No. 90/010,542 (the '10542 proceeding).

3. Also on May 15, 2009, a request for *inter partes* reexamination of all the claims (claims 1-38) of the '997 patent was filed by the same requester (NVIDIA Corporation). The request was assigned Control No. 95/000,471 (the '471 proceeding).

4. The '997 patent is subject to litigation in the United States District Court for the District of Northern California, in *Rambus Inc. v. Nvidia Corp.*, {Civil Action No. 3:08-cv-3343}. The initial complaint was filed July 10, 2008. Based upon the record, patent owner appears to be enforcing at least one of claims 1-38 against the requester in the litigation.

5. On July 7, 2009, the Office issued an order granting the '10542 request for *ex parte* reexamination and setting a two month time period for a Patent Owner's Statement. The order stated that all the claims of the '997 patent, claims 1-38, would be subject to reexamination.

6. Also on July 7, 2009, the Office issued an order granting the '471 request for *inter partes* reexamination and stating that a first action on the merits would be issued in due course. The order stated that all the claims of the '997 patent, claims 1-40, would be subject to reexamination.

7. The time for filing a patent owner's statement pursuant to 37 CFR 1.530 in the '10542 *ex parte* reexamination proceeding expired after September 7, 2009.[1]

8. On September 23, 2009, the Office, *sua sponte,* issued a decision merging the '471 *inter partes* reexamination proceeding with the '10542 *ex parte* reexamination proceeding.

9. On October 13, 2009, patent owner filed the present petition requesting reconsideration of the September 23, 2009 merger decision, citing 35 U.S.C. §§ 305 and 317(a), and requesting waiver of any rule that prevents consideration of the petition.

10. This decision addresses the October 13, 2009 Patent Owner petition requesting reconsideration of the September 23, 2009 decision to merge the '471 *inter partes* and '10542 *ex parte* reexamination proceedings.

11. As of the date of this decision, an Office action on the merits has not issued in either of the two reexamination proceedings.

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[1] There is no provision for filing a patent owner's statement in an *inter partes* reexamination proceeding; instead, an Office action on the merits is issued prior to any input from the parties.

PETITION DECISION TO STAY REEXAMINATION

35 U.S.C. 302 states (in part):

> Any person at any time may file a request for reexamination by the Office of any claim of a patent on the basis of any prior art cited under the provisions of section 301 of this title.

35 U.S.C. 304 states:

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

35 U.S.C. 311(a) states:

> IN GENERAL - Any third-party requester at any time may file a request for *inter partes* reexamination by the Office of a patent on the basis of any prior art cited under the provisions of section 301.

35 U.S.C. 314(c) states:

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

35 U.S.C. 317(a) states:

> (a) ORDER FOR REEXAMINATION.- Notwithstanding any provision of this chapter, once an order for *inter partes* reexamination of a patent has been issued

under section 313, neither the third-party requester nor its privies may file a subsequent request for *inter partes* reexamination of the patent until an *inter partes* reexamination certificate is issued and published under section 316, unless authorized by the Director.

37 CFR 1.33(a) states:

(1) Interviews with examiners concerning applications and other matters pending before the Office must be conducted on Office premises and within Office hours, as the respective examiners may designate. Interviews will not be permitted at any other time or place without the authority of the Director.

(2) An interview for the discussion of the patentability of a pending application will not occur before the first Office action, unless the application is a continuing or substitute application or the examiner determines that such an interview would advance prosecution of the application.

(3) The examiner may require that an interview be scheduled in advance.

37 CFR 1.182 states:

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

37 CFR 1.560 states:

(a) Interviews in *ex parte* reexamination proceedings pending before the Office between examiners and the owners of such patents or their attorneys or agents of record must be conducted in the Office at such times, within Office hours, as the respective examiners may designate. Interviews will not be permitted at any other time or place without the authority of the Director. Interviews for the discussion of the patentability of claims in patents involved in *ex parte* reexamination proceedings will not be conducted prior to the first official action. Interviews should be arranged in advance. Requests that reexamination requesters participate in interviews with examiners will not be granted.

(b) In every instance of an interview with an examiner in an *ex parte*

reexamination proceeding, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the patent owner. An interview does not remove the necessity for response to Office actions as specified in § 1.111. Patent owner's response to an outstanding Office action after the interview does not remove the necessity for filing the written statement. The written statement must be filed as a separate part of a response to an Office action outstanding at the time of the interview, or as a separate paper within one month from the date of the interview, whichever is later.

37 CFR 1.935 states:

The order for *inter partes* reexamination will usually be accompanied by the initial Office action on the merits of the reexamination.

37 CFR 1.937(a) states:

(a) All *inter partes* reexamination proceedings, including any appeals to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office, unless the Director makes a determination that there is good cause for suspending the reexamination proceeding.

37 CFR 1.939 states:

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

(b) Unless otherwise authorized, no paper shall be filed prior to the initial Office action on the merits of the inter partes reexamination.

37 CFR 1.955 states:

There will be no interviews in an *inter partes* reexamination proceeding which discuss the merits of the proceeding.

37 CFR 1.989 states:

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

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

MPEP 2640 II states (in part):

Where reexamination is granted on a second or subsequent request, but the patent owner can clearly show that the second or subsequent request was filed for purposes of harassment, the patent owner can petition under 37 CFR 1.182 that the second or subsequent request should be suspended.

MPEP 2686.01 states (in part):

Initially, it is appropriate to point out who can file a second or subsequent request for reexamination while a first reexamination proceeding is pending.

Case (1) - The earlier (pending) reexamination is an *inter partes* reexamination:

(1)(a) The subsequent request is an *inter partes* reexamination request. Pursuant to 35 U.S.C. 317(a), once an order for inter partes reexamination has been issued in a first reexamination proceeding, neither the third party requester, nor its privy, may file a subsequent request for an *inter partes* reexamination of the patent until an *inter partes* reexamination certificate is issued, unless authorized by the Director of the USPTO. In addition, the patent owner is not entitled to file any *inter partes* reexamination request (see MPEP § 2612). Thus, only a third party who is not a party to the earlier pending inter partes reexamination proceeding (nor a privy) can file the subsequent *inter partes* reexamination request.

(1)(b) The subsequent request is an *ex parte* reexamination request. **Any party (including the patent owner) can file the subsequent *ex parte* reexamination request.** (Emphasis added)

MPEP 2686.01 I. WHEN PROCEEDINGS ARE MERGED states (in part):

Where a second request for reexamination is filed and reexamination is ordered, and a first reexamination proceeding is pending, the proceedings will be merged

where the Office (in its discretion) deems it appropriate to do so, to facilitate the orderly handling of the proceedings. However, a decision not to merge is within the sole discretion of the Office to facilitate/carry out the statutory mandate of 35 U.S.C. 314(c) to conduct reexamination proceedings with "special dispatch."

MPEP 2686.01 IV. PROCEEDINGS NOT MERGED states:

> Pursuant to 35 U.S.C. 314(c), "[u]nless otherwise provided by the Director for good cause, all inter partes reexamination proceedings under this section shall be conducted with special dispatch within the Office." This statutory provision is grounded on the need for certainty and finality as to the question of patentability raised by the request for reexamination. Thus, if a second request for reexamination will unduly delay the first reexamination proceeding, the two proceedings generally will not be merged. If the Office were to merge the two proceedings, the first reexamination proceeding would need to be withdrawn from its place in the process, thus delaying, instead of advancing, prosecution. This would run contrary to the statutory "special dispatch" requirement of 35 U.S.C. 314 and its intent. On the other hand, if the Office does not merge, the first reexamination proceeding can be concluded, and any substantial new question of patentability raised by the second reexamination request can be resolved in the second proceeding, with no delay resulting. The second request is then considered based on the claims in the patent as indicated in the issued reexamination certificate, rather than the original claims of the patent. However, the Office always retains the authority to merge because in some instances, it may be more efficient to merge the two proceedings, which would foster "special dispatch." The instances where the Office may, or may not, merge an ongoing reexamination proceeding with a subsequent reexamination proceeding, are addressed on a case-by-case basis.

DECISION

I. Preliminary Matter: Waiver of 37 CFR 1.939(b)

As noted, *supra*, the *inter partes* request for reexamination of the '997 patent was filed on May 15, 2009, and reexamination was granted on July 7, 2009 and the now merged proceeding is governed by the *inter partes* reexamination rules. The language of 37 CFR 1.935 makes the concurrent sending of an Office action on the merits permissive. As noted above, the Examiner of record has not issue an Office action. In accordance with 37 CFR 1.939(a) unauthorized papers will not be considered in *inter partes* reexamination. Furthermore 37 CFR 1.939(b) does not permit the filing of any papers prior to the filing of the first office action on the merits. Therefore, Patent Owner's petition dated October 13, 2009 is not authorized. However, based

upon the unique facts and circumstances of the present proceeding, in the interests of justice and special dispatch, 37 CFR 1.939 is waived to the extent necessary to permit consideration of the petition presently before the Office of Patent Legal Administration.

II. Findings and Analysis

Patent owner asserts the filing of multiple voluminous requests for reexamination on the same patent, and upon related patents, in a narrow time frame, by the same requester, constitutes harassment. Patent owner further asserts that the reexamination filing pattern of the requester constitutes a gaming of the system that frustrates the Office's statutory mandate of special dispatch. Patent owner also asserts that merging an *inter partes* reexamination proceeding with an *ex parte* reexamination proceeding filed on the same day, when both proceedings were filed by the same third party requester, circumvents the statutory prohibition of 35 U.S.C. 317(a), which prohibits an *inter partes* requester or its privies from filing subsequent *inter partes* reexamination requests on the same patent until an *inter partes* reexamination certificate issues.

Patent owner requests as remedies, in the alternative, of: (1) Dismissal and termination of the reexamination proceeding due to harassment; (2) Dissolution of the merger of the *inter partes* and *ex parte* reexamination proceedings; or (3) Waiver of 37 CFR 1.989(b) to permit interviews, if the *inter partes* and *ex parte* reexamination proceedings remain merged. Granting the first remedy is asserted to preserve the integrity of the Office, by not entertaining requester "gamesmanship" and maintaining Office fidelity to the statutory mandate of special dispatch. Granting the second or third remedies is asserted to "preserve" the patent owner's *ex parte* rights, e.g. a right to an interview, and to prevent the improvident expansion of the third party requester's right to comment upon issues raised solely in the *ex parte* reexamination.

In accordance with 35 U.S.C. 302, any member of the public possesses the right to file a request for *ex parte* reexamination on an issued patent. Specifically the statute states that ANY third party may at ANY time file a request for reexamination based upon ANY prior art. After an *inter partes* reexamination request is ordered, by statute, 35 U.S.C. 317(a), the third party requester in the *inter partes* reexamination is barred from filing another *inter partes* request for reexamination, until an *inter partes* reexamination certificate is issued and published, unless authorized by the USPTO Director. MPEP 2686.01 provides guidance, in accordance with 35 U.S.C. §§ 302 and 317(a) and notes that after the filing of an *inter partes* reexamination request, ANY party may file an *ex parte* reexamination request. The reexamination statutes place no limitation upon a requester, as to the timing of filing a request for *ex parte* reexamination relative to the filing of parallel *inter partes* reexamination. Nor do the statutes place a "volume" limitation on the number of issues that may be raised by a single or multiple reexamination proceedings.

In regard to the asserted derogation of Patent Owner's "*ex parte*" reexamination right to an

interview, no statutory or regulatory right to conduct an interview exists. While 37 CFR §§ 1.133 and 1.560 provide the guidelines for conducting and making a record of interviews, 37 CFR §§ 1.33(a) and 1.560 do not confer a right to an interview, and 37 CFR 1.955 states that no interviews on the merits are permitted in an *inter partes* reexamination.[2] The relevant sections of the MPEP provide guidance on the conduct of interviews to include denial of an interview.[3] Accordingly, merger cannot divest Patent Owner of a right to an interview in the present *ex parte* reexamination proceeding, because Patent Owner has no such right.

Finally, in order to facilitate the statutory mandate of special dispatch, the relevant rules and MPEP guidance that govern the merger of reexamination proceedings an *inter partes* reexamination proceeding place the public on notice that the *inter partes* reexamination rules control a merged proceeding. Any arrangement to the contrary, e.g. permitting a patent owner to conduct an *ex parte* interview on the SNQs[4] presented in the *ex parte* reexamination and only letting the requester comment on the SNQs presented in the *inter partes* reexamination request, would be untenable to manage, monitor and control and therefore contrary to the mandate of special dispatch. It would be necessary to exclude all matters bearing any relation to the *inter partes* reexamination proceeding SNQs, in order not to prejudice the *inter partes* reexamination requester's right to respond to patent owner *re* such matters. In each instance of a patent owner point, a "fine" distinction and determination would need to be made, and that determination might be subject to requester challenge.

As reexamination must, by statute, be conducted with special dispatch. Merger of the present concurrent reexamination proceedings is in furtherance of special dispatch. In this instance, merger at the early stage in both the *ex parte* and *inter partes* reexamination proceedings furthers special dispatch by permitting all issues raised in both proceedings, and any overlap of issues, to be resolved at the same time, i.e., a resolution of all SNQs raised in both requests with special dispatch, rather than delaying resolution in one of the proceedings. Patent Owner's "suggestions" to modify the Office's procedure for merging a proceeding that include an *inter partes* reexamination MUST be in accord with, and not contrary to, special dispatch. In the present case, Patent Owner has not established on the record a basis to justify the relief requested. Accordingly, the requested relief will not be granted.

Harassment. Patent Owner alleges the existence of "harassment" to justify dismissal and termination of the '471 *inter partes* reexamination proceeding and the '10542 *ex parte* reexamination proceeding due to the Requester's filing of two allegedly voluminous requests for reexamination on the same day for the '997 patent, in addition to multiple reexamination requests filed against patents related to the '997 patent. The filing of *inter partes* and *ex parte*

---

[2] In the extraordinary circumstance where the *inter partes* requester has opted to not participate in the *inter partes* reexamination proceeding, a Patent Owner can petition for a waiver of 37 CFR 1.955 under 37 CFR 1.183 to conduct an interview.
[3] See MPEP §§ 713 *et seq.*, 2281 and 2685
[4] Substantial New Question of Patentability

reexamination requests on other patents, albeit patents related to the '997 patent, is not relevant to the issue of harassment toward the Patent Owner in the reexamination of the '997 patent. Therefore, the issue of harassment focuses upon the actions of the Requester in the reexamination requests with respect to the reexamination of the '997 patent only. MPEP 2640 II states that the procedure for filing a petition based upon harassment calls for the relief of suspension and not dismissal and termination of the second or subsequently filed reexamination proceeding that is allegedly harassing. Petitioner, by filing the petition requesting dismissal and termination has erred.

The allegation of harassment is unsupported. MPEP 2640 II requires that the Patent Owner "clearly show" that the second or subsequent request was filed for purposes of harassment. Patent Owner has stated on the record that the '10542 *ex parte* reexamination request consisted of 410 pages and asserted 40 substantial new questions of patentability (SNQ). Patent owner further stated on the record that the '471 *inter partes* reexamination request consisted of 641 pages and asserted 80 additional SNQs. Patent Owner notes that the 40 SNQs of the '10542 *ex parte* reexamination request was supported by 3,383 pages of claim charts and the 80 SNQs of the '471 *inter partes* reexamination request was supported by 5,198 pages of claim charts. Patent Owner then speculates that Requester "recognized" that a single request containing 120 SNQs would not be granted by the Office; yet, Patent Owner provides no evidence to support this asserted Requester recognition. Finally, Patent Owner noted that the Office agreed that 90 of the 120 total SNQs asserted by requester did in fact raise a substantial new question of patentability. Patent owner did not present a by reexamination request breakdown of the number of SNQs found to lack merit. Patent Owner points to no authority that sets forth that a single request verses a set of two requests containing 120 SNQs is tantamount to *per se* harassment of the Patent Owner. Patent Owner merely sets forth the conclusory statement that such a filing is not reasonable. Patent Owner then goes on to cite several other reexamination requests for patents related to the '997 patent. However, as noted previously, the reexaminations of other related patents are not relevant to the present proceeding. Finally, Patent Owner alleges that requester has partaken in a form of gamesmanship of the reexamination system at the expense of the Office and Patent Owner that should not be tolerated. However, the degree of burden would be the same if all issues had been presented in one reexamination request, and the employment of multiple SNQs has not been shown to be for the purpose of harassment. To the contrary, estoppel attaches in *inter partes* reexamination to all issues that requester could have raised (35 U.S.C. 315(c) and 35 U.S.C. 317(b)), and bringing all issues to the table could have easily been Requester's motive, as opposed to harassment.

Patent Owner has not made an evidentiary showing that either reexamination request was filed with the intent to harass. The Requester has only filed two reexamination requests on the same day and has not been shown to have had the intent to withhold references at all, let alone for purposes of harassment. Therefore, Patent Owner's arguments are not persuasive, as no evidence of harassment in the filing of the two reexamination requests has been shown. The

facts and circumstances surrounding the filing of the *inter partes* and *ex parte* reexamination proceeding in this instance does not evidence harassment by the Requester of the Patent Owner. Accordingly, Patent Owner's arguments that Requester's filing of two requests for reexamination on the same day for the same patent is not persuasive as a basis for "harassment" dismissal and termination of the reexamination proceedings.

Circumvention of 35 U.S.C. 317(a). Patent Owner alleges that merging the '471 *inter partes* reexamination proceeding with the '10542 *ex parte* reexamination proceeding circumvents the statutory prohibition of 35 U.S.C. 317(a) that precludes the third party requester of an ordered *inter partes* reexamination from filing a subsequent *inter partes* reexamination request until after an *inter partes* reexamination certificate has issued and published, unless authorized by the USPTO Director. Patent Owner's rationale for this violation of the statute is that merger converts the *ex parte* reexamination into an *inter partes* reexamination, as the requester obtains *inter partes* participation rights regarding the SNQs raised in the now merged *ex parte* reexamination request. Patent Owner cites the Office decisions not to merge *ex parte* reexamination proceedings 90/007,844 (the '7844 proceeding) and 90/007843 (the '7843 proceeding) with *inter partes* reexamination proceedings 95/000,093 (the '093 proceeding) and 95/000,094 (the '094 proceeding) (collectively the "Sony cases") as persuasive logic for denying merger between the present proceedings. Patent owner's logic apparently being that the concurrent filing of an *ex parte* reexamination proceedings by the same requester is a "*de facto*" *inter partes* reexamination request, and hence a violation of the statute. However, as Patent Owner concedes, the present proceedings are not under suspension based upon a district court decision adverse to requester, as was the case in the '093 and '094 proceedings.

The statutory prohibition of 35 U.S.C. 317(a) is not implicated by requester's filing of an *ex parte* reexamination request on the same day as an *inter partes* reexamination request. The plain language of the statute states, in part (emphasis added):

> . . . **[O]nce an order for inter partes reexamination of a patent has been issued** under section 313, *neither the third-party requester nor its privies may file a subsequent request for inter partes reexamination* of the patent until an *inter partes* reexamination certificate is issued and published under section 316, unless authorized by the Director.

The requester filed an *ex parte* reexamination request on the same day the requester filed its *inter partes* reexamination request. The statute does not prohibit the filing of *ex parte* reexamination requests by a requester, that concurrently files an *inter partes* reexamination request on the same patent. Furthermore, on the day requester filed the *ex parte* reexamination request, the '471 *inter partes* reexamination had not yet been ordered. Therefore, even if requester's *ex parte* reexamination request were to be taken as a "*de facto*" *inter partes* reexamination request, the statutory prohibition is still not implicated, as the '471 *inter partes* reexamination request was not yet ordered by the Office. The non-merger decisions rendered in the "Sony cases" are not

binding on the Office. As a general rule, the merger and suspension of proceedings for the same patent before the Office are determined on a fact specific, case-by-case basis. Hence, a decision in one proceeding before the Office is not binding upon the Office in other proceedings. Furthermore, the decision to not merge in the "Sony Cases" was based upon the pre-existence of a suspension of the previously filed '093 and '094 *inter partes* reexamination proceedings. (See the Decision Denying Petitions to Merge in the '093 and the '094 proceedings, the text that bridges from the bottom of page 8 to the top of page 9). The statement of denial of the request to merge in the "Sony Cases" appears at an approximate mid-point on page 9 of the decision. After this legal statement of denial, based upon the existence of a suspension of the '093 and '094 *inter partes* proceedings, the decision then goes on to discuss this "*de facto*" *inter partes* filing logic. Therefore, the "*de facto*" *inter partes* filing logic was not part of the decision's rationale that precluded merger. The decision then concludes with a return to the fact that the court affirmed suspension of the '093 and the '094 *inter partes* proceedings was the determinative factor in denying the petition to merge the later filed *ex parte* proceedings with the previously filed *inter partes* proceedings. Accordingly, Patent Owner's argument that merger violates 35 U.S.C. 317(a) is not persuasive.

Demerger or Waiver of 37 CFR 1.989(b). Patent Owner asserts that, based upon the facts and circumstances surrounding the filings of the '471 *inter partes* reexamination proceeding and the '10542 *ex parte* reexamination proceeding, merger should not have been granted. Patent Owner further asserts that, based upon the facts and circumstances surrounding the filings even if merger is maintained, 37 CFR 1.989(b) should be waived to permit Patent Owner's retention of full *ex parte* reexamination patent owner rights. Patent Owner restates the argument that merger under 37 CFR 1.989(a) violates 35 U.S.C. 317(a) and that 37 CFR 1.989(b) has no statutory basis. Patent Owner also states the Office should not reward Requester's conduct. Finally, Patent Owner states that merger burdens the Office, allows the Requester to game the reexamination system and sets a precedent that undermines the integrity of the Office.

Merger of an *inter partes* reexamination and an *ex parte* reexamination, and hence 37 CFR 1.989, does not constitute a statutory violation, as it is grounded in the statutory mandate of special dispatch. 35 U.S.C. 314(c). Title 35 of the United States Code does not contain a statutory right to conduct an interview before the Office in any proceeding, to include *ex parte* reexamination proceedings. Merger of an *inter partes* reexamination proceeding and an *ex parte* reexamination proceeding does not occur until after the time passes for submission of a Patent Owner's statement. Therefore merger does not deny Patent Owner any statutory "*ex parte*" rights. Merger, based upon the statutory mandate of special dispatch, facilitates the timely and efficient disposition of reexamination proceedings, and does not create a burden on the Office as argued by Patent Owner. The very basis of the policy of merger is to reduce the burden upon the Office that separate, concurrent reexamination proceedings on the same patent present. Patent Owner's proposed arrangement of either dissolution of the merger or retention of the merger, but permitting Patent Owner *ex parte* interviews in a merged proceeding, both burden the Office and

frustrate the statutory mandate of special dispatch. The conduct of two concurrent proceedings on the same patent with two disparate sets of procedural rules instead of one will result in a burden on the Office relative to a single merged proceeding. Merging, but permitting Patent Owner *ex parte* interviews on the *ex parte* SNQs will also burden the Office in the form of additional monitoring and administration of interview to protect the rights of all the parties. And, as pointed out above, 37 CFR §§ 1.133(a) and 1.560 provide the guidelines for conducting and making a record of interviews, but 37 CFR §§ 1.33(a) and 1.560 do not confer a right to an interview. The relevant sections of the MPEP provide guidance on the conduct of interviews to include denial of an interview. Accordingly, merger cannot divest Patent Owner of a right to an interview in the present *ex parte* reexamination proceeding, because Patent Owner has no such right. Therefore, Patent Owner's arguments against merger, and for waiver of 37 CFR 1.989(b) if merged, are not persuasive.

Accordingly, the petition to dismiss and terminate, prevent merger or modify any merged proceeding to preserve "*ex parte* rights" is dismissed.

CONCLUSION

1. The October 13, 2009 Patent Owner petition is dismissed.

2. *Inter partes* Reexamination Control No. 95/000,471 and *ex parte* Reexamination Control No. 90/010,542 remain merged as a single proceeding.

3. Jurisdiction over the merged reexamination files is being forwarded via the Director of the Central Reexamination Unit (CRU) to the examiner, for the preparation of an Office action, to be issued in due course.

4. Telephone inquiries related to the present decision should be directed to Joseph F. Weiss, Jr., Reexamination Legal Advisor, at 571-272-7759.

Kenneth M. Schor

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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.
95/000,471 90/010,542	05/15/2009	7,209,997	9278.002.RXUS00	5654

86497 7590 06/22/2010

Paul M. Anderson, PLLC
P.O. Box 160006
Austin, TX 78716

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/22/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
NOVAK DRUCE & QUIGG, LLP
1000 LOUISIANA STREET
FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date:
MAILED

JUN 22 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000471; 90/010,542
PATENT NO. : 7209997
TECHNOLOGY CENTER : 3999
ART UNIT : 3993

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,542 95/000,471	05/15/2009	7,209,997	9278.002.RX0000	7391

86497 7590 06/22/2010

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/22/2010

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UNITED STATES PATENT AND TRADEMARK OFFICE

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(For Patent Owner)

NOVAK, DRUCE & QUIGG, LLP
(NDQ Reexamination Group)
1000 Louisiana Avenue
Fifty-Third Floor
Houston, TX 77002

(For Third Party Requester)

MAILED

JUN 22 2010

CENTRAL REEXAMINATION UNIT

In re Farmwald *et al.*
Inter partes Reexamination Proceeding
Control No.: 95/000,471
Filed: May 15, 2009
For: U.S. Patent No. 7,209,997

In re Farmwald *et al.*
Ex Parte Reexamination Proceeding
Control No.: 90/010,542
Filed: May 15, 2009
For: U.S. Patent No. 7,209,997

: DECISION
: DISSOLVING
: MERGER OF
: REEXAMINATION
: PROCEEDINGS

This is a decision on patent owner's January 19, 2010 petition entitled "PETITION FOR RECONSIDERATION OF DECISION DISMISSING RAMBUS'S PETITION REGARDING MERGER OF REEXAMINATION PROCEEDINGS" and on third party requester's January 29, 2010 opposition to patent owner's January 19, 2010 petition.

The fee set forth in 37 CFR 1.17(f) for the patent owner petition is $400, which was charged to Patent Owner's credit card on January 20, 2010 pursuant to the authorization for same in Patent Owner's EFS-WEB fee transmittal.

The Third Party Requester opposition is being taken as a petition under 37 CFR 1.182. The fee set forth in 37 CFR 1.17(f) for this petition is $400, will be charged to Requester's deposit account no. 14-1437, pursuant to the authorization on page two of requester's January 29, 2010 petition.

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

Patent Owner's petition is granted to the extent that the merger of the above-captioned proceedings is dissolved, for the reasons set forth below.

REVIEW OF FACTS

1. On April 24, 2007, the Office issued U.S. Patent No. 7,209,997 (the '997 patent) to Farmwald *et al.*

2. On May 15, 2009, a request for *ex parte* reexamination of all the claims (claims 1-38) of the '997 patent was filed by third party requester, NVIDIA Corporation. The request was assigned Control No. 90/010,542 (the '10542 proceeding).

3. Also on May 15, 2009, a request for *inter partes* reexamination of all the claims (claims 1-38) of the '997 patent was filed by the same requester (NVIDIA Corporation). The request was assigned Control No. 95/000,471 (the '471 proceeding).

4. The '997 patent is subject to litigation in the United States District Court for the District of Northern California, in *Rambus Inc. v. Nvidia Corp.*, {Civil Action No. 3:08-cv-3343}. The initial complaint was filed July 10, 2008. Based upon the record, patent owner appears to be enforcing at least one of claims 1-38 against the requester in the litigation.

5. On July 7, 2009, the Office issued an order granting the '10542 request for *ex parte* reexamination and setting a two month time period for a Patent Owner's Statement. The order stated that all the claims of the '997 patent, claims 1-38, would be subject to reexamination.

6. Also on July 7, 2009, the Office issued an order granting the '471 request for *inter partes* reexamination and stating that a first action on the merits would be issued in due course. The order stated that all the claims of the '997 patent, claims 1-40, would be subject to reexamination.

7. The time for filing a patent owner's statement pursuant to 37 CFR 1.530 in the '10542 *ex parte* reexamination proceeding expired after September 7, 2009.[1]

8. On September 23, 2009, the Office, *sua sponte,* issued a decision merging the '471 *inter partes* reexamination proceeding with the '10542 *ex parte* reexamination proceeding (the merged proceeding).

9. On October 13, 2009, patent owner filed a petition requesting reconsideration of the September 23, 2009 merger decision, citing 35 U.S.C. §§ 305 and 317(a), and requesting waiver of any rule that prevents consideration of the petition.

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[1] There is no provision for filing a patent owner's statement in an *inter partes* reexamination proceeding; instead, an Office action on the merits is issued prior to any input from the parties.

10. On December 17, 2009 the Office issued a decision dismissing patent owner's October 13, 2009 petition requesting reconsideration of the September 23, 2009 decision to merge the '471 *inter partes* and '10542 *ex parte* reexamination proceedings.

11. On December 18, 2009, the Office issued a first Office action on the merits in the merged proceeding.

12. On January 19, 2010, patent owner filed the present petition requesting reconsideration of the December 17, 2009 decision dismissing patent owner's October 13, 2009 petition requesting reconsideration of the September 23, 2009 decision to merge the '471 *inter partes* and '10542 *ex parte* reexamination proceedings.

13. On January 29, 2010, third party requester filed an opposition to patent owner's January 19, 2010 petition requesting reconsideration of the December 17, 2009 decision.

DECISION

I. Issues Raised and Relief Requested

Patent owner raises issues, asserting as follows: (1) The Office's manner of merging *ex parte* and *inter partes* reexamination proceedings violates 35 U.S.C. 305 and 37 C.F.R. §§ 1.555 (g) and 1.989(b) when the two proceedings have a common requester; (2) The current merger of *ex parte* and *inter partes* reexamination proceedings violates the statutory prohibition of *ex parte* requester participation and must either be modified or dissolved to remove the violation and facilitate the statutory mandate of special dispatch; (3) Merger of an *ex parte* and *inter partes* reexamination proceeding deprives patent owner of an "expectancy" to conduct an interview on the merits as to issues raised in the *ex parte* proceeding; and (4) Requester's filing of multiple voluminous requests for reexamination on the same patent, and upon related patents, in a narrow time frame, constitutes a harassment of patent owner.

Patent owner requests as remedies in the now merged proceeding that:

(1) The requester be prevented from participating with respect to the issues the requester raised in the *ex parte* proceeding; and patent owner's meaningful opportunity to be heard before the Office pursuant to 37 CFR 1.560 be restored with respect to the issues raised by the requester in the *ex parte* proceeding.

(2) Should the Office not grant the proposed relief (identified in the previous sentence) within the context of the merged proceeding, patent owner requests that the merger of the two proceedings be dissolved and that each proceeding be prosecuted separately.

II. Discussion of Previous Petition and Decision

In the original petition challenging merger, patent owner asserted that: (1) Requester's reexamination filing pattern constituted harassment and a gaming of the system that frustrates the Office's statutory mandate of special dispatch; (2) Merger of *ex parte* and *inter partes* reexamination proceedings frustrates the statutory mandate of special dispatch; (3) Merger of co-pending *ex parte* and *inter partes* reexamination proceedings filed by the same third party requester violates the statutory prohibition against the filing of a second *inter partes* reexamination request on the same patent by the same requester before the first *inter partes* reexamination proceeding concludes; and (4) Merger of *ex parte* and *inter partes* reexamination proceedings denies patent owner the right to conduct an interview regarding the issues raised in the *ex parte* reexamination proceeding.

The Office issued a decision dismissing patent owner's original petition. That decision pointed out that patent owner produced no evidence that the requester's second, subsequent request for reexamination was filed with an "intent to harass" and the finding of a substantial new question of patentability precluded a finding of harassment. Merger of the present concurrent *ex parte* and *inter partes* reexamination proceedings was done as an initial attempt to further special dispatch, as both proceedings were at an early stage and did not, at that time, appear to *per se* frustrate special dispatch as compared to patent owner's suggested alternatives in handling the proceedings. The decision pointed out that the filing of an *ex parte* reexamination proceeding did not violate nor circumvent 35 U.S.C. 317(a), as an *ex parte* reexamination proceeding was not an *inter partes* reexamination proceeding. Furthermore, the decision noted that 35 U.S.C. 302 permits any member of the public the right to file a request for *ex parte* reexamination on an issued patent, even if the member of the public is the requester in an *inter partes* proceeding for the same patent. Finally, the decision noted that no statutory right to interview exists, and therefore, merging *ex parte* and *inter partes* reexamination proceedings could not divest patent owner of a right that did not exist. Accordingly, the decision identified that patent owner had not established on the record a basis to justify the relief requested and the petition was dismissed.

III. Findings and Analysis

Reexamination of the '997 patent has been ordered in the '10542 *ex parte* proceeding and '471 *inter partes* proceeding, and the proceedings have been merged. The issue to be decided is whether the merger of the above-captioned *ex parte* and *inter partes* reexamination proceedings will be retained in this instance, where both requests were filed on the same day by the same party.

As an initial matter, there is no legal requirement for the Office to merge two pending reexamination proceedings. Rather, the determination whether to merge two reexamination proceedings is an act reserved to the discretion of the Office. (See 37 CFR 1.565(c), 37 CFR

1.989(a), MPEP 2686.01 I.,[2] MPEP 2686.01 IV,[3] 2283,[4] MPEP 2286.[5])

First, the statute is silent as to the procedural housekeeping issue of merger. Second, the relevant regulation makes it clear that the Office has discretion when deciding whether or not to merge an *ex parte* reexamination proceeding with an *inter partes* reexamination proceeding. See 37 CFR 1.989(a).[6] Third, while the MPEP does state the Office will "normally" merge two reexaminations, this general policy does not address the various possible permutations that may occur with regard to any specific set of cases eligible for merger. Finally, the MPEP also notes that the decision to merge is within the "sole discretion" of the Office to facilitate/carry out the statutory mandate to conduct reexamination proceedings with special dispatch.[7] Therefore, while the Office retains the authority to merge, it is permissible for the Office to not merge proceedings, where special dispatch can be equally or better served absent merger. Given the complexities and/or particularities that may arise in a proceeding, requester's position that merger in every circumstance where two co-pending reexamination proceedings on the same patent exists would be in accord with special dispatch is not persuasive. In summary, merge/non-merge determinations are made by the Office on a case-by-case basis, so that special dispatch can be achieved in view of the individual facts and circumstances of each proceeding.[8,9]

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[2] "Where a second request for reexamination is filed and reexamination is ordered, and a first reexamination proceeding is pending, the proceedings will be merged where the Office (**in its discretion**) deems it appropriate to do so, to facilitate the orderly handling of the proceedings. However, a decision not to merge is within the sole discretion of the Office to facilitate/carry out the statutory mandate of 35 U.S.C. 314(c) to conduct reexamination proceedings with 'special dispatch.'"

[3] "The instances where the Office may, or may not, merge an ongoing reexamination proceeding with a subsequent reexamination proceeding, are addressed on a case-by-case basis."

[4] "However, a decision not to merge is within the sole discretion of the Office to facilitate/carry out the statutory mandate of 35 U.S.C. 305 to conduct reexamination with 'special dispatch.'"

[5] "[T]he proceedings will be merged where the Office (in its discretion) deems it appropriate to do so, to facilitate the orderly handling of the proceedings. However, a decision not to merge is within the sole discretion of the Office to facilitate/carry out the statutory mandate of 35 U.S.C. 314(c) to conduct reexamination with 'special dispatch.'"

[6] "If any reexamination is ordered while a prior inter partes reexamination proceeding is pending for the same patent and prosecution in the prior inter partes reexamination proceeding has not been terminated, a decision **may** be made to merge the two proceedings or to suspend one of the two proceedings. . . ." (Emphasis added).

[7] Id.

[8] See "Revisions and Technical Corrections Affecting Requirements for *Ex Parte* and *Inter Partes* Reexamination," 72 Fed. Reg. 18892 (April 16, 2007-final rule) at 18901, where it states - "As was pointed out in the Notice of proposed Rule Making, there are instances where the Office does not merge (consolidate) an ongoing ex parte reexamination with a subsequent reexamination or reissue proceeding, which are addressed on a case-by case basis."

[9] "[T]he ability to decide the question of whether to merge/consolidate based on the merits of a particular fact pattern must be, and is, reserved to the Office." *Id.* at 18902.

At this juncture, it is noted that it was requester who chose to file two separate reexamination requests, to institute both *ex parte* and *inter partes* reexamination for all claims of the '997 patent, rather than to present all issues in one proceeding (giving requester the participation rights desired for the various issues identified in each request). Requester did so with full knowledge that the Office retains absolute discretion regarding whether or not to merge.[10] Therefore, requester determined that the issues raised in each request need not be together, and the Office, by doing the same and not merging the proceedings, does not impact upon any rights or expectations of the requester.

It is observed that requester argues that since the *ex parte* requester is the same as the *inter partes* requester, the *quid pro quo* for the requester commenting upon the issues raised in the *ex parte* request a statutory estoppel will occur under 35 U.S.C. 315(c). Requester cites no legal authority for this conclusion; however, it is not relevant to an instance where the Office has decided that, in the best interest of its administrative management of the proceedings and housekeeping, the proceedings will not be merged.

Based upon the specific facts and circumstances of the reexamination proceedings on the '997 patent, the Office has decided that merger would not be the best alternative in this instance.

Accordingly, the merger is dissolved and the two proceedings revert to independent prosecution. However, the Office retains the right to merge the present proceedings or to suspend one (or more) of the proceedings for a limited time at a later date, should circumstances change such that the situation warrants such action.

As an ancillary point, the Office concurs with requester that the act of filing an *ex parte* request is not a forfeiture of a right to file a subsequent *inter partes* request on the same patent as long as it raises a new, non cumulative SNQ and the references were not intentionally withheld with an intent to harass the patent owner. And, the Office also concurs with requester in regard to patent owner's arguments regarding the existence of interview rights. See *infra* section V of this decision.

IV. Procedural Considerations

1. Any Office action issued and responses submitted by the parties during the merged proceeding is hereby vacated by this decision.[11] Reexamination will restart anew from the point of prosecution just prior to the merger of the two proceedings. All Office actions and party responses from the time of merger, to the present, will be expunged from the Image File Wrapper (IFW) of the proceedings by being closed and marked non-public.

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[10] See the rules, MPEP sections, and Office Notice referred to above in the body of the decision and the footnotes.
[11] This does not include the decisions to order reexamination; they are not deemed Office actions in this context.

2. The proceedings will be conducted in a manner that minimizes any overlap of issues between the proceedings by preventing the importation of issues from one proceeding into the other. Specifically, the examiner will not introduce, from one proceeding into the other proceeding, any rejection proposed in the request, requester's reply under 37 CFR 1.535, or requester's comments in the *inter partes* reexamination.

3. All new rejections initiated by the examiner are to be included in the *inter partes* reexamination proceeding so as to permit the Office to have the benefits of third party requester's comments. The authority for inclusion of rejections initiated by the examiner is based upon 35 U.S.C. 314(a) which provides for examination in an *inter partes* reexamination proceeding in accordance with 35 U.S.C. 132 and 133, which permit the examiner's introduction of rejections. It should also be noted, that 35 U.S.C. 312 provides for the Office to *sua sponte* add issues to a reexamination proceeding "with... consideration of other patents or printed publications." Of course any modification of the proposed rejections in the *ex parte* reexamination proceeding to add a new reference to address the prosecution and examination of the *ex parte* reexamination proceeding would be made in that proceeding, and not in the *inter partes* reexamination proceeding, since the *ex parte* reexamination proceeding is the exclusive vehicle to address those proposed rejections.

4. As pointed out above, the Office retains the right to merge the present proceedings or to suspend one (or more) of the proceedings for a limited time at a later time should circumstances change such that the situation warrants such action.

5. If a reexamination certificate issues, concluding one of the two proceedings, patent owner is required pursuant to 37 CFR §§ 1.565(a) and 1.985(a) to file a notice of concurrent proceedings (See MPEP §§ 2282 and 2686) in the still pending proceeding, informing the Office of the issuance and publication of the reexamination certificate. Additionally, patent owner is required to submit an amendment paper, making all necessary amendments to the still pending proceeding, such that the still pending proceeding is consistent with all changes implemented by the issued reexamination certificate in the concluded proceeding.

V. Discussion Regarding "Interview Rights"

Interview and "Right to Request" an Interview. No statutory or regulatory right to conduct an interview exists. While 37 CFR §§ 1.133 and 1.560 provide the guidelines for conducting and making a record of interviews, 37 CFR §§ 1.133(a) and 1.560 do not confer any right to an interview. *Inter partes* reexamination rule 37 CFR 1.955 states that no interviews on the merits are permitted in an *inter partes* reexamination.[12] The relevant sections of the MPEP provide

[12] In the extraordinary circumstance where the *inter partes* requester has opted to not participate in the *inter partes* reexamination proceeding, a Patent Owner can petition for a waiver of 37 CFR 1.955 under 37 CFR 1.183 to conduct an interview, on an as-needed-per-interview basis.

guidance on the conduct of interviews to include denial of an interview.[13] None of the relevant rules or MPEP sections regarding interviews before the Office creates a right for an interview. While a party may request an interview, there is no requirement that the Office grant that request.

CONCLUSION

1. The January 19, 2010 patent owner petition is granted to the extent that the merger of the above-captioned proceedings is dissolved and the proceedings are reconstituted as separate proceedings.

2. Any Office action issued and responses/comments submitted by the parties during the merged proceeding are hereby vacated by this decision.[14]

3. If a reexamination certificate issues, concluding one of the two proceedings, patent owner is required pursuant to 37 CFR §§ 1.565(a) and 1.985(a) to file a notice of concurrent proceedings (See MPEP §§ 2282 and 2686) in the still pending proceeding, informing the Office of the issuance and publication of the reexamination certificate in the still pending proceeding. Additionally, patent owner is required to submit an amendment paper, making all necessary amendments to the still pending proceeding, such that the still pending proceeding is consistent with all changes implemented by the issued reexamination certificate in the concluded proceeding.

4. Jurisdiction over the two reexamination proceeding is forwarded via the Director of the Central Reexamination Unit (CRU) to the examiner, for action in accordance with this decision.

5. Telephone inquiries related to the present decision should be directed to Joseph F. Weiss, Jr., Reexamination Legal Advisor, at 571-272-7759.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration 6-21-10

[13] See MPEP §§ 713 *et seq.*, 2281 and 2685.
[14] As pointed out above, this does not apply to the decisions to order reexamination.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,472	07/08/2009	6,596,944	M0506-702150	1514

37462 7590 12/10/2009

LANDO & ANASTASI, LLP
ONE MAIN STREET, SUITE 1100
CAMBRIDGE, MA 02142

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/10/2009

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/000,472	07/08/09	6596944	

KING & SPALDING
1180 PEACHTREE STREET, NE
ATLANTA, GA 30309-3521

EXAMINER
NGUYEN, MINH

ART UNIT	PAPER
3992	

DATE MAILED:

12/10/09

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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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/000,472	07/08/09	6596944	

EXAMINER
NGUYEN, MINH

ART UNIT	PAPER
3992	

KING & SPALDING
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ATLANTA, GA 30309-3521

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INTER PARTES REEXAMINATION COMMUNICATION

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(For Patent Owner)

KING & SPALDING
1180 PEACHTREE STREET, NE
ATLANTA, GA 30309-3521

(For Third Party Requester)

MAILED

DEC 10 2009

CENTRAL REEXAMINATION UNIT

Inter Partes Reexamination Proceeding
Control No. 95/000,472
Filed: July 8, 2009
For: U.S. Patent No. 6,596,944

DECISION GRANTING PETITIONS

This is a decision on patent owner's petition paper entitled "PETITION TO SUSPEND RULE 37 C.F.R. § 1.943(b) PURSUANT TO THE PROVISIONS OF 37 C.F.R. § 1.183," filed on October 14, 2009, as supplemented by the petition paper entitled "PETITION TO SUSPEND RULE 37 C.F.R. § 1.943(b) PURSUANT TO THE PROVISIONS OF 37 C.F.R. § 1.183," filed on November 19, 2009.

The patent owner petitions under 37 CFR 1.183 are before the Office of Patent Legal Administration for consideration.

The petition fee of $400.00 pursuant to 37 CFR 1.17(f) for each petition under 37 CFR 1.183 was charged to patent owner's Deposit Account No. 502762.

The petitions under 37 CFR 1.183 are granted.

REVIEW OF THE RELEVANT FACTS

1. United States Patent Number 6,596,944 ("the '944 patent") issued on July 22, 2003.

2. On May 19, 2009, a request for *inter partes* reexamination of the '944 patent was deposited by a third party requester, which request was assigned Reexamination Control Number 95/000,472 ("the '472 proceeding").

3. On July 8, 2009, a corrected request for *inter partes* reexamination of the '944 patent was filed by the third party requester in the '472 proceeding.

4. On August 19, 2009, the Office mailed an order granting *inter partes* reexamination in the '472 proceeding, with an accompanying Office action on the merits.

5. On October 5, 2009, patent owner filed a request for one-month extension of time to respond to the August 19, 2009 Office action.

6. On October 8, 2009, patent owner's petition for a one-month extension of time was granted, extending the period for response to the August 19, 2009 Office action to November 19, 2009.

7. On October 14, 2009, patent owner filed a petition paper entitled "PETITION TO SUSPEND RULE 37 C.F.R. § 1.943(b) PURSUANT TO THE PROVISIONS OF 37 C.F.R. § 1.183" ("petition under 37 CFR 1.183").

8. On November 19, 2009, patent owner filed a petition paper entitled "PETITION TO SUSPEND RULE 37 C.F.R. § 1.943(b) PURSUANT TO THE PROVISIONS OF 37 C.F.R. § 1.183," as a supplement to the October 14, 2009 petition under 37 CFR 1.183 ("supplemental petition under 37 CFR 1.183").

9. Concurrently, on November 19, 2009, patent owner filed an "AMENDMENT AND RESPONSE TO OFFICE ACTION IN *INTER PARTES* REEXAMINATION."

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.

Discussion

Patent owner's October 14, 2009 petition under 37 CFR 1.183, as supplemented by patent owner's November 19, 2009 petition under 37 CFR 1.183, have been fully considered. On November 19, 2009, concurrently with the supplemental petition under 37 CFR 1.183, patent owner filed an amendment and response to the August 19, 2009 Office action. Patent owner asserts that the November 19, 2009 response is 57 pages long, excluding the listing of claims (showing the amendments to the claims), which is not 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 November 19, 2009 response to the extent that patent owner "be granted 57 pages to respond to the Office Action," and states that "[u]ltimately, the Patent Owner seeks a number of pages in which the Patent Owner can reasonably respond to the Office Action and which is substantially fewer than the number of pages of the Office Action itself."[2]

In support of waiver of the rule, patent owner asserts that "the Office Action contains 36 separate grounds of rejection. The rejections are grounded in 11 prior art references, and cover original claims 1-12."[3] Patent Owner states, "[b]y way of example, the 50 page limit allows on average fewer than one and a half pages to develop a response to each of the rejections."[4] The patent owner further asserts that the Office action is 74 pages in length and expressly references 94 pages of the request and that patent owner cannot to respond to all of that material if it only has 50 pages to do so.[5]

Additionally, patent owner has made a showing in support of its 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. Patent owner asserts that it "has made every effort to condense the Response and to avoid any unnecessary duplication of arguments; however, the Response is 57 pages in length.... Thus, it is apparent that the requirement of 37 C.F.R. § 1.943(b), stating that the Patent Owner's response cannot exceed 50 pages in length, places a severe burden and restraint on the Patent Owner's ability to fairly and fully address all 36 grounds of rejection."[6]

Based on the specific facts set forth in the petition under 37 CFR 1.183 and the supplemental petition under 37 CFR 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 of permitting patent owner's November 19, 2009 response, which exceeds the 50-page limit by 7 pages.

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[1] Supplemental petition under 1.183 at page 3. 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] Supplemental petition under 1.183 at page 3.
[3] Petition under 37 CFR 1.183 and supplemental petition under 37 CFR 1.183 at page 3.
[4] Petition under 37 CFR 1.183 and supplemental petition under 37 CFR 1.183 at page 3.
[5] See petition under 37 CFR 1.183 and supplemental petition under 37 CFR 1.183 at page 3.
[6] Supplemental petition under 37 CFR 1.183 at page 3.

Accordingly, patent owner's October 14, 2009 petition under 37 CFR 1.183, as supplemented by patent owner's November 19, 2009 petition under 37 CFR 1.183, are **granted** to the extent that the page limit of 37 CFR 1.943(b) is waived as to **7 pages** of the portions of patent owner's November 19, 2009 response, which are included in the regulatory page count, that 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 57 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.[7]

CONCLUSION

1. Patent owner's October 14, 2009 petition under 37 CFR 1.183, as supplemented by patent owner's November 19, 2009 petition under 37 CFR 1.183, are granted to the extent that the page length of the November 19, 2009 patent owner "AMENDMENT AND RESPONSE TO OFFICE ACTION IN *INTER PARTES* REEXAMINATION" 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 57 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.

3. Jurisdiction for the '472 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

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

[7] *See* MPEP 2666.05(I).

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,474	07/06/2009	6570095	M0506-702350	5251

37462 7590 10/28/2009

LANDO & ANASTASI, LLP
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CAMBRIDGE, MA 02142

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 10/28/2009

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Date:

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OCT 28 2009
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000474
PATENT NO. : 6570095
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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Sarah M. Gates
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Cambridge, MA 02142

(For Patent Owner)

MAILED

OCT 28 2009

CENTRAL REEXAMINATION UNIT

W. Scott Petty
King & Spalding
1180 Peachtree Street, NE
Atlanta, GA 30309

(For Requester)

In re Clark et al.
Inter partes Reexamination Proceeding
Control No.: 95/000,474
Filed: May 19, 2009
For: U.S. Patent No. 6,570,095

: 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 October 13, 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 permission to file a response of a maximum length of 100 pages to respond to the Office action mailed on Sept. 10, 2009.

The petition, and the proceeding, are before the Office of Patent Legal Administration 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 502762 on October 14, 2009.

The petition is dismissed.

REVIEW OF FACTS

1. U.S. Patent No. 6,570,095 (the '095 patent) issued on May 27, 2003 with 33 claims.

2. An *inter partes* request for reexamination of claims 1-33 of the '095 patent was filed on May 19, 2009. The request was assigned control No. 95/000,474 (the '474 proceeding).

3. A copending litigation styled *Belden Technologies, Inc. et al. v. Superior Essex, Inc. et al.*, Civil Action No. 08-063-SLR, is pending in the District of Delaware.

4. Reexamination was ordered for claims 1-33 in the '474 proceeding on Sept. 10, 2009. 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.

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 was filed Oct. 13, 2009, and is the subject of this 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

Patent owner requests suspension of the 50 page limit rule because the examiner has issued an Office Action containing 31 separate grounds of rejection, relied on 12 prior art references, and referenced 152 pages of the reexamination request. Patent owner asserts that it cannot respond in 50 pages and requests that permission be grated for a reasonable number of pages in which to respond.

The record reveals that the original Office action, mailed on Sept. 10, 2009, contained ninety three (93) pages, approximately eighty (80) of which address the merits of the proceeding. The reexamination request contained one hundred and sixteen (116) pages. The Sept. 10, 2009 Office action repeats the proposed rejections from the request and reproduces many of the claims.

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 a "reasonable number of pages" or a maximum length of 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 *substantive* discussion 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.

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, 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]

---

[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.

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 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.

3. A response to the Sept. 10, 2009, Office Action remains due by Nov. 10, 2009.

4. Telephone inquiries with regard to this decision should be directed to Caroline Dennison, Acting Deputy Director, Office of Patent Legal Administration, at (571) 272-7729.

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

10-25-09

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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,474	07/06/2009	6570095	M0506-702350	5251

37462 7590 03/03/2010

LANDO & ANASTASI, LLP
ONE MAIN STREET, SUITE 1100
CAMBRIDGE, MA 02142

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/03/2010

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
KING & SPALDING
1180 PEACHTREE STREET, NE
ATLANTA, GA 30309-3521

Date:
MAILED
MAR 03 2010
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000474
PATENT NO. : 6570095
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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COMMISSIONER FOR PATENTS
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LANDO & ANASTASI, LLP
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CAMBRIDGE, MA 02142

(For Patent Owner)

KING & SPALDING
1180 PEACHTREE STREET, NE
ATLANTA, GA 30309-3521

(For *Inter Partes* Requester)

MAILED

MAR 03 2010

CENTRAL REEXAMINATION UNIT

Inter Partes Reexamination Proceeding	:	
Control No. 95/000,474	:	**DECISION**
Filed: July 6, 2009	:	**DISMISSING**
For: U.S. Patent No. 6,570,095	:	**PETITION**

This is a decision addressing patent owner's December 10, 2009 petition paper entitled "PETITION TO SUSPEND RULE 37 C.F.R. § 1.943(b) PURSUANT TO THE PROVISIONS OF 37 C.F.R. § 1.183."

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

The petition is dismissed for the reasons set forth herein.

REVIEW OF THE RELEVANT FACTS

1. United States Patent Number 6,570,095 ("the '095 patent") issued on May 27, 2003.

2. On May 19, 2009, a request for *inter partes* reexamination of the '095 patent was deposited by a third party requester, and assigned Reexamination Control No. 95/000,474 ("the '474 proceeding").

3. On July 6, 2009, a corrected request for *inter partes* reexamination of the '095 patent was filed by the third party requester in the '474 proceeding.

4. On September 10, 2009, the Office issued an order granting *inter partes* reexamination in the '474 proceeding, accompanied by a non-final Office action on the merits.

5. On October 13, 2009, patent owner filed a petition paper entitled, "PETITION TO SUSPEND RULE 37 C.F.R. § 1.943(b) PURSUANT TO THE PROVISIONS OF 37 C.F.R. § 1.183" in the '474 proceeding.

6. On October 28, 2009, the Office mailed a decision dismissing patent owner's October 13, 2009 petition.

7. On October 29, 2009, patent owner filed a "PETITION FOR ONE-MONTH EXTENSION OF TIME UNDER 37 C.F.R. §1.550(c)," requesting that the time period for responding to the September 10, 2009 Office action be extended by one month.

8. On November 4, 2009, the Office mailed a decision granting patent owner's October 29, 2009 petition and extending the time period for responding to the September 10, 2009 Office action to December 10, 2009.

9. On December 10, 2009, patent owner filed the instant petition paper entitled, "PETITION TO SUSPEND RULE 37 C.F.R. § 1.943(b) PURSUANT TO THE PROVISIONS OF 37 C.F.R. § 1.183" in the '474 proceeding.

10. Concurrently on December 10, 2009, patent owner filed an "AMENDMENT AND RESPONSE TO OFFICE ACTION" in the '474 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.

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.

On December 10, 2009, patent owner filed an "AMENDMENT AND RESPONSE TO OFFICE ACTION" ("the response"), accompanied by a claims appendix and two declarations.[1] Concurrently, on December 10, 2009, patent owner filed the instant "PETITION TO SUSPEND RULE 37 C.F.R. § 1.943(b) PURSUANT TO THE PROVISIONS OF 37 C.F.R. § 1.183" ("the petition under 1.183"). In the petition under 1.183, patent owner asserts that its December 10, 2009 response "is 47 pages in length, including only 43 pages of argument addressing the merits of the proceeding."[2] Further, patent owner asserts that the accompanying claims appendix "does not include any argument addressing any of the rejections of the claims, and therefore also should not be counted against the 50 page limit for the Patent Owner's Response."[3] With respect to the two accompanying declarations, patent owner asserts that "these Declarations, or at least portions thereof, should not be counted against the 50 page limit set for the Patent Owner's Response because the Declarations, or at least several paragraphs thereof, do not contain 'opinon(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,' nor 'any argument as to how an outstanding/proposed rejection is overcome....'"[4]

Nonetheless, in the petition under 37 CFR 1.183, patent owner requests suspension of 37 CFR 1.943(b) to the extent "that the Commissioner determines that any portion of the Declarations under 37 C.F.R. 1.132 that accompany the Patent Owner's Response includes argument as to how a proposed rejection is overcome, and therefore should be counted against the 50 page limit."[5] Moreover, patent owner requests waiver of 37 CFR 1.943(b) "to allow the Patent Owner to exceed the 50 page limit of the rule and present a response of a maximum of 57 pages, or such other maximum length as the Commissioner may determine reasonable."[6] To this end, patent owner asserts that "[c]ounting the entirety of the Patent Owner's Response and all 10 pages of the two accompanying Declarations, the Response totals only 57 pages in length" and that "[c]ounting only the pages of argument in the Patent Owner's Response, and the portions of the accompanying Declarations which might be considered to include 'argument,' the Response totals only a <u>maximum</u> of 52 pages in length (the range being approximately 43-52 pages depending on the interpretation given to the two Declarations)."[7]

The necessity of patent owner's requests for relief is conditioned on the Office first determining that patent owner's December 10, 2009 response in fact exceeds the 50-page limit of 37 CFR 1.943(b). Facially, patent owner's December 10, 2009 response appears to be compliant, and currently there is no official notice of non-compliance from the Office of record in the '474 proceeding, which would be in need of waiver.[8] Accordingly, patent owner's conditional request for waiver of the 50-page limit of 37 CFR 1.943(b) is <u>dismissed</u> as premature at this time.

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[1] *See* Appendix A, Declaration of Galen Gareis under 37 C.F.R. 1.132, and Declaration of Gregory Niemiera under 37 C.F.R. 1.132.
[2] Petition under 1.183 at page 2.
[3] Petition under 1.183 at page 3.
[4] Petition under 1.183 at page 3.
[5] Petition under 1.183 at page 3.
[6] Petition under 1.183 at page 4.
[7] Petition under 1.183 at page 4.
[8] Patent owner asserts that the remarks/arguments section of patent owner's December 10, 2009 response is only 43 pages long, which is in compliance with the rule.

CONCLUSION

1. Patent owner's December 10, 2009 petition to waive the page limit requirement of 37 CFR 1.943(b) under 37 CFR 1.183 is **dismissed**.

2. 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
Office of the Deputy Commissioner
for Patent Examining Policy

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,475	05/19/2009	7179999	M0506-702651	1283

37462 7590 09/15/2009

LANDO & ANASTASI, LLP
ONE MAIN STREET, SUITE 1100
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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/15/2009

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
Scott Petty
KING & SPALDING
1180 Peachtree Street
Atlanta, GA 30309

Date:
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SEP 1 5 2009
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000475
PATENT NO. : 7179999
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

SEP 15 2009

CENTRAL REEXAMINATION UNIT

W. Scott Petty
KING & SPALDING
1180 PEACHTREE STREET , NE
ATLANTA, GA 30309-3521

(For Third Party Requester)

In re: William T Clark *et alia*
Inter Partes Reexamination Proceeding
Control No. 95/000,475
Deposited on: 19 May 2009
For: US Patent No. 7,179,999

DECISION
GRANTING
PETITION FOR EXTENSION
OF TIME
[37 CFR §§ 1.956 & 1.181]

This is a decision on the 11 September 2009, "Petition for Extension of Time Under 37 CFR § 1.550(c)" requesting that the time for responding to the non-Final Office action mailed 17 July 2009, be extended by one (1) month. The petition was filed under 37 CFR § 1.550(c) which pertains to *Ex Parte* reexamination. The proper authority for *Inter Partes* Reexamination extensions of time may be found in 37 CFR § 1.956. The petition submitted 11 September 2009 will be addressed pursuant to 37 CFR 1.956. 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 extended in which to file a response to the non-final Office action mailed 17 July 2009, which set two (2) months time for filing a response thereto. The petition for extension of time was timely filed on 11 September 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.

> **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 17 August 2009. The patent owner submitted a timely filed the petition on 11 September 2009 with the appropriate fee and certificate of service.

The petition dated 11 September 2009 cites the need for additional time to prepare affidavits under 37 CFR § 1.132. As noted by the patent owner the additional time is needed due to the number and complexity of the affidavits the patent owner's representatives are pursuing in view of the number of combinations of references being asserted. On balance, the petitioner has demonstrated "sufficient cause" to grant a one (1) month extension of time based upon the length, complexity of the Office action.

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

CONCLUSION

1. The patent owner's petition for extension for one (1) month time in which to file a response to the non-final Office action dated 17 July 2009 is hereby **granted.**

2. The period for response is extended by one (1) month.

3. The response is extended to **17 October 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

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MAR 17 2010

CENTRAL REEXAMINATION UNIT

Sarah M. Gates
Lando & Anastasi, LLP
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Cambridge, MA 02142

(For Patent Owner)

King & Spalding, LLP
1180 Peachtree St., NE
Atlanta, GA 30309-4530

(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/000,475
Filed: May 19, 2009
For: U.S. Patent No. 7,179,999

: **DECISION**
: **DISMISSING**
: **PETITION AS MOOT 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) PURSUANT TO THE PROVISIONS OF 37 CFR 1.183" (hereinafter "the petition under 37 CFR 1.183"), filed on February 24, 2010.

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

Patent owner's account number was charged with the petition fee of $400.00 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183 on February 24, 2010.

REVIEW OF THE RELEVANT FACTS

1. On February 20, 2007, United States Patent Number 7,179,999 (the '999 patent) issued.

2. On May 19, 2009, a request for *inter partes* reexamination of the '999 patent, assigned Reexamination Control No. 95/000,475 (the '475 proceeding), was filed by third party requesters Superior Essex Inc. and Superior Essex Communications LP.

3. On July 17, 2009, the Office issued an order granting *inter partes* reexamination in the '475 proceeding, with an accompanying Office action on the merits.

4. On September 11, 2009, patent owner filed a "PETITION FOR ONE-MONTH EXTENSION OF TIME UNDER 37 C.F.R. §1.550(c)" to respond to the July 17, 2009 Office action.

5. On September 15, 2009, the Office granted patent owner's September 11, 2009 petition for a one-month extension of time to respond to the July 17, 2009 Office action.

6. On October 19, 2009, patent owner filed a response to the Office action of July 17, 2009.

7. On November 18, 2009, the third party requester filed comments after the patent owner's October 19, 2009 response.

8. Concurrently, on November 18, 2009, the third party requester filed a paper entitled "PETITION TO STRIKE PATENT OWNER'S RESPONSE UNDER 1.182."

9. On February 5, 2010, the Office issued a "Notice of Defective Paper in *Inter Partes* Reexamination Proceeding" stating that the patent owner's October 19, 2009 response is defective under 37 CFR 1.943(b).

10. On February 24, 2010, the patent owner filed the instant petition under 37 CFR 1.183, concurrently with a corrected response to the July 17, 2009 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.

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 of February 24, 2010

On February 24, 2010, in response to the February 5, 2010 "NOTICE OF DEFECTIVE PAPER IN THE INTER PARTES REEXAMINATION PROCEEDING," patent owner filed the instant petition under 37 CFR 1.183 concurrently with a corrected response to the July 17, 2009 Office action (hereinafter "the corrected response"). The corrected response includes 39 pages of remarks and four exhibits, including a 5-page "Declaration of Galen Gareis under 37 C.F.R. 1.132" (Appendix A), a 5-page "Declaration of Gregory Niemiera under 37 C.F.R. 1.132" (Appendix B), a 41-page "Appendix to Niemiera Declaration" (Appendix C), and a 5-page "Support for New Claims" chart (Appendix D).

In the instant petition under 37 CFR 1.183, 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 July 17, 2009 Office Action. *Pet. at* 2. In support of waiver of the rule, patent owner asserts that the 84-page July 17, 2009 Office action includes 74 pages of substantive rejections, incorporates by reference "dozens of pages" from the 153-page reexamination request, and contains at least 13 separate grounds of rejections, each on one or more of claims 1-20. *Pet at* 2. Patent owner further asserts that it has made efforts to provide a concise response and filed the petition under 37 CFR 1.183 as a "precautionary measure in case the Office determines that the Response exceeds the 50 page limit." *Pet. at* 2.

Patent owner further asserts that the 50 page limit has not been surpassed, as the substantive portion of the corrected response includes "only 38 pages of argument addressing the merits of the proceeding" and that the two 37 CFR 1.132 declarations filed total 10 pages. *Pet. at* 3. Specifically, patent owner asserts:

> These Declarations, or at least portions thereof, should not be counted against the 50 page limit set for the Patent Owner's Response because the Declarations, or at least several paragraphs thereof, do not contain

> "opinon(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," nor "any argument as to how an outstanding/proposed rejection is overcome," as specified in MPEP § 2667. *Pet. at 3.*

Patent owner also asserts:

> In addition, the Appendix to the Declaration by Gregory Niemiera (Appendix C) submitted with the Patent Owner's Response) contains technical data and no argument regarding the patentability of any claim, and is therefore reference material which should not be counted against the 50 page limit for the Patent Owner's Response. The Patent O has also submitted an Appendix (Appendix D) that identifies support in the specification of U.S. Patent No. 7,179,999 for each of the newly added claims, as required under 37 C.F.R. 1.530(e). Appendix D does not include any argument addressing any of the rejections of the claims, and therefore also should not be counted against the 50 page limit. *Pet. at 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. In this instance, petitioner has requested a waiver of the 50-page limit of 37 CFR 1.943(b) as a precautionary measure in case the Commissioner determines that any portion of the Declarations under 37 CFR 1.132 or Appendices that accompany the patent owner's corrected response includes argument as to how a proposed rejection is overcome, and therefore should be counted against the 50 page limit. In that event, to the extent this determination results in the patent owner's corrected response exceeding the 50 page limit, the patent owner requests suspension of the provisions of 37 CFR 1.943(b).

Facially, patent owner's February 24, 2010 corrected response appears to be page-length compliant. Pursuant to MPEP 2667(I)(A)(2), the relief requested is unnecessary as only those pages of the remarks and declaration portions of patent owner's corrected response upon which any argument as to how an outstanding/proposed rejection is overcome, would be included against the page limit count of 37 CFR 1.943. Similarly, attached exhibits presenting data or drawings are not included in the page limit count, unless an exhibit or drawing includes argument as to how the outstanding rejection is

overcome. Any page(s) of the exhibit or sheet(s) of drawings that include such argument would be included in the page limit count.

In this instance, the accompanying exhibits (Appendix C and D) are not counted toward the page limit. Further, even if all of the pages of patent owner's corrected remarks and accompanying decorations are counted, the total page count does not exceed 50 pages. Thus, the remarks and exhibit portions of patent owner's February 24, 2010 corrected response does not exceed 50 pages and accordingly, does not require waiver of 37 CFR 1.943(b). Patent owner's February 24, 2010 petition under 37 CFR 1.183 is therefore dismissed as moot.

ADDITIONAL DISCUSSION ON REQUESTER'S COMMENTS

Any previously submitted third party comments in response to patent owner's improper October 19, 2009 submission will not be considered, as being moot, since the patent owner did not in fact respond to the July 17, 2009 Office action in accordance with the rules. Because patent owner responded to the February 5, 2010 Notice of Defective Paper by filing the February 24, 2010 page-length compliant corrected response, under 37 CFR 1.947, the third party requester may once file written comments, limited to issues raised by the August 17, 2009 Office action or the patent owner's February 24, 2010 corrected response, within 30 days from the date of service of the patent owner's corrected response.

CONCLUSION

1. The patent owner petition under 37 CFR 1.183 is **dismissed as moot** as patent owner's February 24, 2010 corrected response to the July 17, 2009 is page-length compliant.

2. Any previously submitted third party comments in response to patent owner's improper October 19, 2009 submission will not be considered, as being moot, since the patent owner did not in fact respond to the July 17, 2009 Office action within the meaning of the rules. Because patent owner responded to the February 5, 2010 Notice of Defective Paper by filing the February 24, 2010 page-length compliant corrected response, under 37 CFR 1.947, the **third party requester may once file written comments**, limited to issues raised by the August 17, 2009 Office action or the patent owner's February 24, 2010 corrected response. **Any such third party requester written comments must be filed within 30 days from the date of service of the patent owner's corrected response.**

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/

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

Kenpet8
3-16-10

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DEC 09 2009

CENTRAL REEXAMINATION UNIT

LANDO & ANASTASI, LLP
ONE MAIN STREET, SUITE 1100
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(For Patent Owner)

KING & SPALDING
1180 PEACHTREE STREET, NE
ATLANTA, GA 30309-3521

(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/000,476
Filed: July 13, 2009
For: U.S. Patent No. 6,998,537

DECISION DISMISSING PETITION

This is a decision on the patent owner paper entitled "PETITION TO SUSPEND RULE 37 C.F.R. § 1.943(b) PURSUANT TO THE PROVISIONS OF 37 C.F.R. § 1.183," filed on October 14, 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. 502762.

REVIEW OF THE RELEVANT FACTS

1. On February 14, 2006, United States Patent No. 6,998,537 (the '537 patent) issued to Clark *et al.*

2. On May 19, 2009, a request for *inter partes* reexamination of the '537 patent was deposited by a third party requester, which request was assigned Reexamination Control No. 95/000,476 (the '476 proceeding).

3. On July 13, 2009, a corrected request for *inter partes* reexamination of the '537 patent was filed by the third party requester in the '476 proceeding.

4. On September 28, 2009, the Office mailed an order granting *inter partes* reexamination in the '476 proceeding, accompanied by an Office action on the merits.

5. On October 14, 2009, patent owner filed the instant petition entitled, "PETITION TO SUSPEND RULE 37 C.F.R. § 1.943(b) PURSUANT TO THE PROVISIONS OF 37 C.F.R. § 1.183" ("petition under 37 CFR 1.183").

6. On November 11, 2009, patent owner filed a request for one-month extension of time to respond to the September 28, 2009 Office action.

7. On November 25, 2009, patent owner's petition for a one-month extension of time was granted, extending the period for response to the September 28, 2009 Office action to December 28, 2009.

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, patent owner requests suspension of 37 CFR 1.943(b), which limits patent owner responses to 50 pages in length, "because the Examiner has issued a multiplicity of rejections that results in a 76 page Office Action that is based on a reexamination request of 338 pages, including claim charts, dozens of pages of which are expressly incorporated by reference into the Office Action."[1] In support of waiver of the rule, patent owner asserts that the Office action contains 37 separate grounds of rejection, which are grounded in 19 prior art references and which cover original claims 1-22.[2] Patent owner states that "[t]here can be no question that

[1] Petition under 37 CFR 1.183 at page 2.
[2] Petition under 37 CFR 1.183 at page 3.

the Patent Owner's burden to address each and every rejection on one or more of claims 1-22 in a 50 page response is simply not practical. By way of example, the 50 page limit allows an average of fewer than one and a half pages to develop a response to each of the rejections...."[3] Patent owner further states that "when one counts the pages of the reexamination request incorporated by reference into the Office Action, the vast majority of the 37 grounds of rejection exceed one and a half pages in length," and that patent owner cannot respond to all of that material if it only has 50 pages to do so.[4] Thus, patent owner asserts that "the requirement of 37 C.F.R. § 1.943(b), stating that the Patent Owner's response cannot exceed 50 pages in length, places a severe burden and restraint on the Patent Owner's ability to fairly and fully address all 37 grounds of rejection."[5]

Accordingly, patent owner asserts that "the interest of justice requires that the 50 page limit requirement of 37 C.F.R. § 1.943(b) be suspended or waived and the Patent Owner be granted a reasonable number of pages to respond to the Office Action."[6] Patent owner suggests that "[o]ne measure of a reasonable number of pages is the text of the Office Action, including the pages of the Request incorporated by reference into the Office Action," and that, in this instance, the Office action is itself 76 pages long and incorporates by reference an additional 55 pages.[7] Accordingly, patent owner requests that the "rule of a 50 page response length be suspended and leave be granted to file a response of a maximum length of 100 pages, or such other length as may be determined by the Commissioner."[8]

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.

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 100 pages or such other length as may be determined by the Commissioner. 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, patent owner has requested that the page limit for patent owner's response to the outstanding Office action be increased to an amount (a maximum of 100 pages) that is roughly three-fourths the number of pages of the Office action (76 pages) plus the number of pages of the request which patent owner asserts are

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[3] Petition under 37 CFR 1.183 at page 3.
[4] Petition under 37 CFR 1.183 at page 3 (stating that the Office action "specifically incorporates by reference 55 pages of the reexamination request").
[5] Petition under 37 CFR 1.183 at page 3.
[6] Petition under 37 CFR 1.183 at page 3.
[7] Petition under 37 CFR 1.183 at page 3.
[8] Petition under 37 CFR 1.183 at page 4.

incorporated by reference by the Office action (55 pages). However, petitioner has not set forth with specificity the facts upon which petitioner based its determination that approximately 50 extra pages are necessary for patent owner to adequately respond to the outstanding Office action. For example, while patent owner suggests, as indicated above, that one and a half pages to develop a response to each of the rejections (or 50 pages total) would not be practical, it is not clear exactly how many pages patent owner would need to develop a response to each of the rejections, or that a maximum of 100 pages would be sufficient to develop a response to all of the rejections.

A showing which patent owner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft a patent owner's response in compliance with the 50-page limit, and submission of a 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), 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 estimates that patent owner needs a maximum of 100 pages to develop a response, or that addressing all of the rejections in a 50-page response "is simply not practical," patent owner can rely on the proposed response (1) for justification that more pages are needed to complete the response and (2) 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 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. *See* MPEP 2667(I)(A)(2).

Further note that third party requester 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 to file a comments paper pursuant to 37 CFR 1.947, or 30 days from the date of service of any patent owner's rule-compliant response submitted in accordance with the page limit set forth in a decision dismissing patent owner's petition under 37 CFR 1.183 to file a comments paper pursuant to 37 CFR 1.947.[9]

---

[9] *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.

Accordingly, 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 October 14, 2009 petition under 37 CFR 1.183 is dismissed.

CONCLUSION

1. The patent owner October 14, 2009 petition under 37 CFR 1.183 is **dismissed**.

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

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

Kenneth M. Schor

Kenneth M. Schor
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Office of Patent Legal Administration

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12-8-09

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,477	06/16/2009	7283340	26166-186902	8889

44564 7590 03/16/2010

BOND, SCHOENECK & KING, PLLC
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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/16/2010

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

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/000,477	06/16/09	7283340	26166-186902

EXAMINER
NGUYEN, LINH

ART UNIT	PAPER
3992	

ANDREWS KURTH, LLP
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DATE MAILED:

03/16/10

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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NGUYEN, LINH

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CENTRAL REEXAMINATION UNIT

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(For Third Party Requester)

In re Finlay, Sr. et al.
Inter Partes Reexamination Proceeding
Control No. 95/000,477
Filed: June 16, 2009
For: U.S. Patent No. 7,283,340

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

This is a decision on the October 27, 2009 patent owner petition entitled "PETITION TO SUSPEND *INTER PARTES* REEXAMINATION PROCEEDING CONTROL NO. 95/000,477 UNDER 37 C.F.R. §§ 1.182 and 1.987."

On January 20, 2010, patent owner timely filed a response to the November 20, 2009 non-final Office action pursuant to 37 CFR 1.945.

The patent owner petition and *inter partes* reexamination control number 95/000,477 are before the Office of Patent Legal Administration for consideration.

The patent owner petition requesting suspension of the instant reexamination proceeding is dismissed for the reasons set forth below.

For the reasons set forth below, the January 20, 2010 patent owner response is being expunged from the record without consideration by the examiner. Since the January 20, 2010 patent owner paper has been scanned into the Image File Wrapper (IFW) of the 95/000,477 *inter partes* reexamination proceeding, the January 20, 2010 paper is being expunged from the record by closing it and marking it "not public" in the IFW of the 95/000,477 *inter partes* reexamination proceeding.

Patent owner has **fifteen (15) days** from the mailing date of this decision to file a redacted response that is strictly limited to and must not go beyond the response in the original (expunged) response submission.

FEE

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 Deposit Account No. 50-1546 on October 28, 2009.

REVIEW OF THE RELEVANT FACTS

1. U.S. Patent No. 7,283,340 ("the '340 patent") issued to Finlay, Sr. et al. on October 16, 2007, and is currently assigned to Pass & Seymour, Inc. ("P & S").

2. The '340 patent is the subject of litigation styled *In the Matter of Certain Ground Fault Circuit Interrupters and Products Containing the Same*, Inv. No. 337-TA-615, initiated at the U.S. International Trade Commission ("ITC") on August 16, 2007 by P&S against Shanghai Meihao Electric, Inc. ("Meihao") and other co-respondent ground fault circuit interrupter ("GFCI") manufacturers including Wenzhou Trimone Company ("Trimone"), General Protecht Group, Inc. ("GPG"), and Shanghai ELE Manufacturing Corporation ("ELE").[1] A copy of the Amended Complaint of P&S under Section 337 of the Tariff Act of 1930 is attached as Exhibit 2 of the *Inter Partes* Reexamination Proceeding Request of the '340 patent initially deposited on May 21, 2009.

3. On September 24, 2008, the presiding administrative law judge ("ALJ") issued his final initial determination ("ID") in the ITC Proceeding. The ALJ found that the asserted claims of the '340 patent (claims 14, 18, and 30) were not invalid, and that Meihao's 2003 and 2006 GFCIs infringed claims 14 and 18 of the '340 patent. The ALJ also found that GFCIs manufactured by co-respondents Trimone, GPG, and ELE infringed claims 14 and 18 of the '340 patent. A copy of the Public Version of the ID is attached as Exhibit 3 of the *Inter Partes* Reexamination Proceeding Request of the '340 patent initially deposited on May 21, 2009.

4. On March 9, 2009, the ITC Commission issued a Commission Opinion/Final Determination affirming the ALJ's ruling that all asserted claims (claims 14, 18, and 30) of the '340 patent were not invalid. A copy of the Public Version of the Commission Opinion dated March 26, 2009 is attached as Exhibit 4 to the *Inter Partes* Reexamination Proceeding Request of the '340 patent initially deposited on May 21, 2009.

5. On May 21, 2009, a request for *inter partes* reexamination of claims 1, 8-9, 11-16, 18, 21-24, 28, 29, and 36 of the '340 patent, assigned control No. 95/000,477 ("the '477 reexamination proceeding"), was deposited by a third party requester on behalf of real party in interest Meihao ("the third party requester").

---

[1] Patent owner mistakenly states in footnote 1 of the present petition that a parallel stayed district court lawsuit is against third party requester. The parallel district court lawsuit is against GPG, not Meihao (third party requester), as evidenced by the caption of the civil action in the footnote.

6. On June 16, 2009 a corrected request for *inter partes* reexamination of the '340 patent was filed by third party requester in the '477 reexamination proceeding.

7. In June 2009, co-respondents Trimone, GPG, and ELE each filed an appeal to the U.S. Court of Appeals for the Federal Circuit seeking review of the Commission's Final Determination. The three appeals have been consolidated. Third party requester did not appeal the Commission's Final Determination. The Federal Circuit appeal is styled *General Protecht Group, Inc. and Wenzhou Trimone Science & Technology Electric Co., Ltd., and Shanghai ELE Manufacturing Corporation. v. International Trade Commission and Pass & Seymour, Inc.,* Appeal Nos. 2009-1378, -1387,-1434 (hereafter "the appeal"). The appeal challenges the Commission's claim construction of claims 14, 18, and 30 of the '340 patent and the Commission's determination of validity of claims 14 and 18. Copies of the Statement of the Issues to be Presented for Review, filed by Trimone, GPG, and ELE, are attached as Exhibit 1 to the present patent owner petition filed on October 27, 2009.

8. On July 24, 2009, the Office issued an order granting the request for *inter partes* reexamination for claims 1, 8-9, 11-16, 18, 21-24, 28, 29 and 36 of the '340 patent.

9. On October 27, 2009, patent owner filed the present petition entitled "PETITION TO SUSPEND *INTER PARTES* REEXAMINATION PROCEEDING CONTROL NO. 95/000,477 UNDER 37 C.F.R. §§ 1.182 and 1.987 ."

10. On November 20, 2009, the Office mailed a non-final Office action rejecting claims 1, 8-9, 11-16, 18, 21-24, 28, 29 and 36 of the '340 patent.

11. On January 20, 2010, patent owner timely filed a response to the non-final Office action pursuant to 37 CFR 1.945.

I. DECISION DISMISSING PATENT OWNER PETITION UNDER 37 CFR 1.182

A. Patent Owner Petition Requesting Suspension of the Present Proceeding

Patent owner petitioner requests that the present *inter partes* reexamination proceeding be suspended in view of the concurrent litigation at the Federal Circuit. Pet. at page 5. Patent owner asserts that good cause exists for the USPTO to suspend the instant *inter partes* reexamination proceeding based on common issues involved in the more advanced Federal Circuit appeal. Pet. at page 5. Specifically, patent owner argues that the issue of construction and validity of claims 14 and 18 of the '340 patent are common to both the instant *inter partes* reexamination proceeding and the concurrent litigation at the Federal Circuit that is well under way and can be best decided at the Federal Circuit. Pet. at page 5. Patent owner further argues that overlapping validity issues exist since the claims at issue in the instant reexamination proceeding, other than claims 14 and 18, share common claim terms with claims 14 and 18, and at least one prior art reference is being relied on in both the Federal Circuit appeal and the instant reexamination proceeding. Pet. at pages 5-6. Patent owner believes that the Federal Circuit decision regarding the litigated claims (claims 14 and 18) will necessarily cast light on the

appropriate disposition of the other claims in the instant reexamination proceeding. Pet. at page 6 f.n.5. The pending appeal was filed by co-respondents Trimone, GPG, and ELE seeking review of the Commission's Final Determination. Pet. at page 3. The appeal challenges the Commission's claim construction of claims 14, 18, and 30 of the '340 patent and the Commission's determination of validity of claims 14 and 18 of the '340 patent.[2] Patent owner states that the ITC's Commission Opinion became final as to Third Party Requester because Third Party Requester did not file an appeal. Pet. at page 3 f.n.3.

B. Analysis and Findings

The statute 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). In this instance, the ITC proceeding is not an action arising under 28 U.S.C. § 1338, which gives the district courts the original jurisdiction.[3] Thus, a finding by the ITC has no bearing on the third party requester's submission of the present *inter partes* reexamination - the estoppel provisions of 35 U.S.C. § 317(b) do not attach to the present *inter partes* reexamination proceedings. The ITC's holding of validity for claims 14 and 18, even if upheld by the Federal Circuit, is not a final decision within the meaning of 35 U.S.C. § 317(b) because the litigation did not arise under 28 USC § 1338. Since there is no potential termination of the '477 reexamination proceeding under 35 U.S.C. § 317(b), good cause does not exists to suspend the instant reexamination proceeding.

In response to patent owner's argument that overlapping validity issues exist between the instant proceeding and the appeal, the issuance of the Federal Circuit decision **upholding validity** of claims 14 and 18 will have no binding effect on the examination of instant reexamination since the estoppel provisions of 35 U.S.C. § 317(b) do not attach to the instant proceeding for the reasons given above. Furthermore, the Court noted in *Ethicon v. Quigg*, 849 F.2d 1422, 1428, 7 USPQ2d 1152, 1157 (Fed. Cir. 1988) that the District Courts and the Office use different standards of proof in determining invalidity, and thus, on the same evidence, could quite correctly come to different conclusions. Specifically, invalidity in a District Court must be shown by "clear and convincing" evidence (based on a presumption of validity of a patent, 35 U.S.C. § 282), whereas in the Office it is sufficient to show non-patentability by a "preponderance" of the evidence. The ITC's determination of patent invalidity is made with the same "clear and convincing" evidence standard.[4] Since the "clear and convincing" standard is harder to satisfy than the "preponderance standard," a court's holding of patent validity is not controlling. Deference will, however, ordinarily be accorded to the factual findings of the court, where the evidence before the Office and the court is the same. If sufficient reasons are present, claims held valid by the court may be rejected in reexamination.

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[2] See Statement of the Issues to be Presented for Review, filed by Trimone, GPG, and ELE, attached as Exhibit 1 to the present patent owner petition filed on October 27, 2009.

[3] An ITC action arises under 19 U.S.C. § 1337.

[4] See page 35 of ITC's September 24, 2008 Initial Determination ("ID") for discussion of the "clear and convincing" evidence standard to determine patent invalidity.

Therefore, continuing the instant *inter partes* reexamination proceeding is not barred by statute, and there is public interest in resolving the substantial new question of patentability (SNQ) raised in this reexamination proceeding with special dispatch. Accordingly, there is no reason to suspend the instant *inter partes* reexamination proceeding.

C. Appendix

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 final decision in an inter partes reexamination proceeding instituted by a third-party requester is favorable to the patentability of any original or proposed amended or new claim of the patent, then neither that party nor its privies may thereafter request an inter partes reexamination of any such patent claim on the basis of issues which that party or its privies raised or could have raised in such civil action or inter partes reexamination proceeding, and an inter partes reexamination requested by that party or its privies on the basis of such issues may not thereafter be maintained by the Office, notwithstanding any other provision of this chapter. This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the inter partes reexamination proceedings.[Emphasis Added]

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. [Emphasis Added]

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), Section 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.

II. DECISION, *SUA SPONTE*, EXPUNGING THE JANUARY 20, 2010 PATENT OWNER RESPONSE

Patent owner's response filed on January 20, 2010 is improper because it is not limited to issues permitted in the reexamination proceeding.

Patent owner's January 20, 2010 response contains certain allegations, such as starting on page 3, regarding third party requester's conduct in the concurrent litigation and in the present proceeding, and such allegations are improper and are not permitted in the reexamination statute or rules. Conduct allegations are improper in a reexamination proceeding, since they are not directed to the merits of the proceeding. Discussion of conduct has no bearing on how patents or printed publications relate to the patentability of the claims. There is simply no statutory authority for entry of conduct information into the patent by way of reexamination. [5] As such, the response filed on January 20, 2010, which would become part of the patent's record if retained, does not have an entry right, in accordance with 35 U.S.C. §§ 301 and 311.

It is understood that patent owner may properly provide certain information pertaining to litigation involving the patent for which reexamination is being requested under policy set forth in the Office's rules and procedures. In an *inter partes* reexamination proceeding, parties may

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

provide notice to the Office of prior or concurrent proceedings in which the patent (for which reexamination was requested) is or was involved, including interferences, reissues, reexamination, or litigations, and results of such proceedings. However, parties must comply with the requirements for such notice by the parties, as set forth in MPEP § 2686 and 37 CFR 1.985(b). A discussion of litigation, including allegations of misconduct on the part of the third party requester goes well beyond what is permitted, and thus, is not entitled to entry right in the reexamination proceeding.

Accordingly, the January 20, 2010 patent owner response is an improper paper and will not be made part of the record of the present proceeding. The patent owner paper is being expunged from the record. As the improper paper has been scanned into the electronic Image File Wrapper (IFW), the paper is being expunged by closing the submission in the IFW file of the '477 reexamination proceeding and marking the document "not public." The document will not constitute part of the record of the present reexamination proceeding.

As to any replacement response, patent owner **should review the entire replacement response** prior to filing the response for inappropriate comments. Any replacement response must be strictly limited to and must not go beyond the response in the original (expunged) response submission.

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

ADVISORY

MPEP § 2609 states in part:

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

APPENDIX

RELEVANT REGULATIONS AND EXAMINING PROCEDURE

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 1.985(b) states:

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

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

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

III. CONCLUSION

1. The patent owner petition under 37 CFR 1.182 is dismissed. Patent owner's January 20, 2010 response is an improper paper, and therefore will NOT be made a part of the record of the '477 proceeding.

2. Since the January 20, 2010 patent owner response was scanned into the electronic Image File Wrapper (IFW) of the '477 proceeding, the paper is expunged by closing it in the '477 reexamination proceeding's IFW file and marking it as "non-public."

3. Patent owner has **fifteen (15) days** from the mailing date of this decision to file a redacted response that is strictly limited to and must not go beyond the response in the original (expunged) response submission. The patent owner's responsive submission must be clearly labeled as either a redacted or re-drafted patent owner response pursuant to 37 CFR 1.945(a).

4, No copy of the January 20, 2010 patent owner response will be maintained in the record, or elsewhere in the Office.

5. The patent owner in the '477 *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.

6. **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.

7. Telephone inquiries related to the present decision should be directed to the Susy Tsang-Foster, Legal Advisor, at 571-272-7711.

Hiram H. Bernstein
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
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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,477	06/16/2009	7283340	26166-186902	8889

44564 7590 06/10/2010
BOND, SCHOENECK & KING, PLLC
10 BROWN ROAD, SUITE 201
ITHACA, NY 14850-1248

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/10/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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EXAMINER
NGUYEN, LINH

ART UNIT	PAPER
3992	

ANDREWS KURTH, LLP
1350 I STREET, NW
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WASHINGTON, DC 20005

DATE MAILED:
MAILED

JUN 10 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.

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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NGUYEN, LINH

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ANDREWS KURTH, LLP
1350 I STREET, NW
SUITE 1100
WASHINGTON, DC 20005

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INTER PARTES REEXAMINATION COMMUNICATION

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Bond, Schoeneck & King, PLLC
10 Brown Road, Suite 201
Ithaca, New York 14850-1248

(For patent owner)

Andrews Kurth, LLP
1350 I Street NW
Suite 1100
Washington, DC 20005

(For the '477 requester)

Malvern U. Griffin III
Sutherland, Asbill & Brennan, LLP
999 Peachtree Street, NE
Atlanta, Georgia 30309

(For the '1224 requester)

MAILED

JUN 10 2010

CENTRAL REEXAMINATION UNIT

In re Finlay, Sr. *et al.*
Inter Partes Reexamination
Control No. 95/000,477
Filed: June 16, 2009
For: U.S. Patent No. 7,283,340

In re Finlay, Sr. *et al.*
Inter Partes Reexamination Proceeding
Control No. 95/001,224
Filed: October 22, 2009
For: U.S. Patent No. 7,283,340

: 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 October 16, 2007 the Office issued U.S. Patent No. 7,283,340 (the '340 patent) to Finlay, Sr. *et al.*

2. On June 16, 2009, a first request for *inter partes* reexamination of claims 1, 8-9, 11-16, 18, 21-24, 28-29, and 36 of the '340 patent, assigned control No. 95/000,477 ("the '477

proceeding"), was filed by a third party requester on behalf of real party in interest Shanghai Meihao Electric, Inc. ("the '477 requester").[1]

3. On July 24, 2009, *inter partes* reexamination was ordered for claims 1, 8-9, 11-16, 18, 21-24, 28-29 and 36 of the '340 patent in the '477 proceeding based upon the examiner's determination that the June 19, 2009 request raised substantial new questions of patentability. An Office action was not concurrently issued. The order indicated that an Office action would issue in due course.

4. On October 22, 2009, a second request for *inter partes* reexamination of claims 14-16, 18, 21-24, and 28-29 of the '340 patent, assigned control No. 95/001,224 ("the '1224 proceeding"), was filed by a third party requester on behalf of real party in interest General Protecht Group, Inc. ("the '1224 requester").[2]

5. On November 19, 2009, *inter partes* reexamination was ordered for claims 14-16, 18, 21-24, and 28-29 of the '340 patent in the '1224 proceeding based upon the examiner's determination that the October 22, 2009 request raised substantial new questions of patentability. An Office action was not concurrently issued. The order indicated that an Office action would issue in due course.

6. On November 20, 2009, the Office issued a non-final Office action in the '477 proceeding rejecting claims 1, 8-9, 11-16, 18, 21-24, 28-29 and 36 of the '340 patent.

7. To date, no Office action has issued in the '1224 *inter partes* proceeding.

8. On March 30, 2010, patent owner timely filed responsive comments to the November 20, 2009 Office action in the '477 proceeding.[3] The response did not include an amendment to the specification or the claims.

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

---

[1] Requester initially deposited a non-compliant request for reexamination on May 21, 2009, failing to secure a filing date. On June 16, 2009 requester perfected the initial request with a supplemental submission, securing the filing date of June 16, 2009.

[2] Requester initially deposited a non-compliant request for reexamination on August 21, 2009, failing to secure a filing date. On October 22, 2009 requester perfected the initial requester with a supplemental submission, securing the filing date of October 22, 2009.

[3] Patent owner comments are timely. Patent owner originally filed responsive comments to the '477 proceeding on January 20, 2010. The January 20, 2010 comments were expunged from the record by an Office decision issued on March 16, 2010 in the '477 proceeding. The March 16, 2010 Office decision gave patent owner fifteen days to refile redacted or redrafted comments responsive to the November 20, 2009 Office action.

> proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the merged examination will normally result in the issuance and publication of a single reexamination certificate under § 1.997.

As evidenced by the above review of facts, both the '477 and '1224 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 reason 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 95/000,477 and 95/001,224 reexamination proceedings would address these considerations. Thus, pursuant to 37 CFR 1.989(a), the 95/000,477 and 95/001,224 reexamination proceedings are hereby merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

The claims are identical in both proceedings. The patent owner is required to continue to maintain the same claims (and specification) in both files *throughout the merged proceeding.*

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

The present decision merges an *inter partes* reexamination proceeding with another *inter partes* reexamination proceeding. Pursuant to 37 CFR 1.989(b), the merged proceeding is governed by 37 CFR 1.902 through 1.997.

B. Papers mailed/filed:

All papers mailed by the Office throughout the merged proceeding will take the form of a single action which applies to both proceedings. All papers issued by the Office or filed by the patent owner and the third party requesters will contain the identifying data for <u>both</u> 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 <u>both</u> proceedings, for entry into the file for each proceeding.

All papers that are filed by the patent owner and the third party requesters should be directed:

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

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.

By U.S. Postal Service Mail:

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

By FAX to:

(571) 273-9900
Central Reexamination Unit

By hand (or delivery service):

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

The patent owner and the requesters are reminded that every paper filed in the merged proceeding subsequent to this Decision must be served on the other parties, including papers filed *via* facsimile transmission, 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 specification, claims, and drawings 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 a reexamination proceeding. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments

are to be presented via markings pursuant to 37 CFR 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

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

D. Fees:

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

E. Citation of Patents and Printed Publications:

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

F. Appeal Procedure Reminders for *Inter Partes* Reexamination

The parties are reminded of the procedures for taking appeal in an *inter partes* reexamination as explained in MPEP 2674 and 2675. The appeal must only be taken from (1) the rejection(s) of the claims in the Right of Appeal Notice (RAN) that the *patent owner* proposes to contest, or (2) the finding(s) of patentability of claims in the RAN that the *third party requester* proposes to contest. Therefore, in the notice of appeal, the patent owner must identify each claim rejected by examiner that the patent owner intends to contest and the third party requester must identify each rejection *that was previously proposed by that third party requester* that the third party requester intends to contest. (37 CFR 41.61) The appellant's brief shall present a concise statement of each issue. Further, no new ground of rejection can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection. (37 CFR 41.67(c)(1)(vi))

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/001,224 and *inter partes* Reexamination Control No. 95/000,477 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

2. Jurisdiction over the merged reexamination is being forwarded via the Central Reexamination Unit Director to the examiner for the preparation of an Office action, to be issued in due course for the merged proceeding.

3. Any questions concerning this communication should be directed to Joseph F. Weiss in the Office of Patent Legal Administration, at (571) 272-7759.

Pinchus M. Laufer
Legal Advisor
Office of Patent Legal Administration

June 9, 2010

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,477	06/16/2009	7283340	26166-186902	8889

44564 7590 06/15/2010

BOND, SCHOENECK & KING, PLLC
10 BROWN ROAD, SUITE 201
ITHACA, NY 14850-1248

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/15/2010

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

CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/000,477	06/16/09	7283340	26166-186902

EXAMINER
NGUYEN, LINH

ART UNIT	PAPER
3992	

ANDREWS KURTH, LLP
1350 I STREET, NW
SUITE 1100
WASHINGTON, DC 20005

DATE MAILED:

MAILED

JUN 15 2010

CENTRAL REEXAMINATION UNIT

INTER PARTES REEXAMINATION COMMUNICATION

BELOW/ATTACHED YOU WILL FIND A COMMUNICATION FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE OFFICIAL(S) IN CHARGE OF THE PRESENT REEXAMINATION PROCEEDING.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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ANDREWS KURTH, LLP
1350 I STREET, NW
SUITE 1100
WASHINGTON, DC 20005

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UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

BOND, SCHOENECK & KING, PLLC 10 BROWN ROAD, SUITE 201 ITHACA NY 14850-1248	: : :	(For Patent Owner)
ANDREWS KURTH LLP 1350 I STREET, N.W. SUITE 1100 WASHINGTON, DC 20005	: : : :	(For Third Party Requester)

MAILED

JUN 15 2010

CENTRAL REEXAMINATION UNIT

In re: Finlay, Sr. *et alia* *Ex Parte* Reexamination Proceeding Control No. 95/000,477 Deposited: 16 June 2009 For: US Patent No. 7,283,340 B1	: : : : : :	DECISION DISMISSING PETITION AND *SUA SPONTE* EXPUNGING IMPROPER PAPER 37 CFR §§ 1.181, 1.182, 1.987

This is a decision on the 30 March 2010, "Petition to Suspend Inter Partes Reexamination Proceeding Control No. 95/000,477 Under 37 CFR §§ 1.182, 1.987" requesting that the Office reconsider its earlier decision and petition to suspend.

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

The petition is dismissed and the paper is expunged for the reasons set forth below.

REVIEW OF RELEVANT FACTS

- U.S. Patent No. 7,283,340 B1 issued on 16 October 2007.
- A request for *inter partes* reexamination was filed concerning the '340 patent and assigned control no. 95/000,477 on 16 June 2009.
- *Inter partes* reexamination was ordered in the above named proceeding.
- On 27 October 2009 the patent owner filed a petition entitled, "Petition to Suspend *Inter Partes* Reexamination Proceeding Control No. 95/000,477 Under 37 CFR § 1.182 & 1.987."
- The petition dated 27 October 2009was dismissed in a decision dated 16 March 2010. In the 16 March 2010 decision the petition was dismissed and the paper *sua sponte* expunged. The patent owner was given "fifteen (15) days to file a redacted response that is strictly limited to and must not go beyond the response in the original (expunged) response submission."
- On 30 March 2010, the instant petition was filed in response to the 16 March 2010 decision.

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 § 1.987 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.

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 <u>dismissed</u> 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.

Since this is an improper paper it is hereby expunged from the record. Where an inappropriate (unauthorized, improper) paper has already been scanned into the Image File Wrapper (IFW) of the reexamination proceeding before discovery of the inappropriate nature of the paper, the paper cannot be physically returned to the party that submitted it. Instead, the paper will be "returned" by expunging it, i.e., by marking the paper as "non-public" and "closed" so that it does not appear in the active IFW record with the other active papers that comprise the public record of the reexamination proceeding.

CONCLUSION

1. The petition dated 30 March 2010 is hereby dismissed.

2. The petition dated 30 March 2010 is *sua sponte* expunged from the record as improper.

3. Telephone inquiries related to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner, at (571) 272-1611 or in his absence to the undersigned at (571) 272-3838.

Gregory A. Morse
Director, Central Reexamination Unit

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.
95/000,478	05/21/2009	7378992	080272-0019	7980

1473 7590 12/30/2009

ROPES & GRAY LLP
PATENT DOCKETING 39/361
1211 AVENUE OF THE AMERICAS
NEW YORK, NY 10036-8704

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/30/2009

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

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United States Patents and Trademark Office
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
MCDERMOTT WILL & EMERY LLP
600 13th STREET NW
WASHINGTON, DC 20006-3096

Date MAILED

DEC 30 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000478
PATENT NO. : 7378992
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

Jeffrey H Ingerman ROPES & GRAY LLP PATENT DOCKETING 39/361 1211 AVENUE OF THE AMERICAS NEW YORK NY 10036-8704	:	(For Patent Owner)
Michael A Messina MCDERMOTT WILL & EMERY LLP 600 13TH STREET, N.W. WASHINGTON, DC 20005-3096	:	(For Third Party Requester)
In re: James J Fallon *Inter Partes* Reexamination Proceeding Control No. 95/000,478 Deposited on: 21 May 2009 For: US Patent No. 7,378,992	:	DECISION GRANTING-IN-PART PETITION FOR EXTENSION OF TIME [37 CFR §§ 1.956 & 1.181]

MAILED

DEC 30 2009

CENTRAL REEXAMINATION UNIT

This is a decision on the 28 December 2009, patent owner "Petition Under 37 CFR § 1.956 for Extension of Time to Reply to Office Action in Reexamination," requesting that the time for responding to the Office action mailed 15 December 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.

DISCUSSION

The Patent Owner requests an extension of time in which to file a response to the non-final Office action was mailed 15 December 2009. The non-final Office action provides two (2) month period for response. The petition request for a two (2) month extension of time was timely filed on 28 December 2009. The petition request provides electronic payment for the $200 petition fee under 37 CFR §1.17 (g).

There is sufficient cause to grant one (1) month extension of time.

The request is granted-in-part.

> **37 CFR § 1.956. Patent owner extensions of time in inter partes reexamination.** *The time for taking any action by a patent owner in an inter partes reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified. Any request for such extension must be filed on or before the day on which action by the patent owner is due, but in no case will the mere filing of a request effect any extension. Any request for such extension must be accompanied by the petition set forth in § 1.17(g). See § 1.304(a) for extensions of time for filing a notice of appeal to the U.S. Court of Appeals for the Federal Circuit.*

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

> As noted above, a request for extension of time under 37 CFR § 1.956 will be granted only for sufficient cause, ...
>
> Evaluation of whether "sufficient cause" has been shown for an extension must be made by **balancing** the desire to provide the patent owner with a fair opportunity to respond, **against** the requirement of the statute, 35 U.S.C. § 314(c), that the proceedings be conducted with special dispatch. ...

Any petition request must include the required petition fee as set forth according to 37 CFR § 1.17 (g) and 37 CFR § 1.956.

MPEP § 2665 Extension of Time for Patent Owner Response (in-part)

...

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.

...

DECISION

The patent owner's representative petitions under 37 CFR § 1.956 to extend the period for response by adding two (2) months to the period for response. The decision to extend the period for response is evaluated based upon a showing of "sufficient cause." There is always the consideration to balance the need for the patent owner to have a fair opportunity to respond to the Office action between the need for special dispatch.

The petition dated 28 December 2009 notes that there are a number of related proceedings as well as some concurrent due dates for response thereto. Further the patent owner notes that an expert is unavailable until March. It is not clear 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 with respect to the concurrent proceedings. The

statement of must provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period. It is unclear why the patent owner does not have adequate representation to respond to the various proceedings in a timely manner. Further while it is unfortunate that Dr. Ligler is unavailable at this time, the granting of one month additional time amply provides the patent owner with time to locate additional experts as needed. Again it is unclear what action has been taken thus far to locate expert help for response in this proceeding as well as a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.

The time for response is extended by one (1) month.

The petition request to extend the response time is hereby granted-in-part.

CONCLUSION

1. The patent owner's petition for extension for time in which to file a response to the non-final Office action dated 15 December 2009 is hereby **granted-in-part.**

2. A one (1) month extension of time is granted.

3. The Patent Owner's response is due **15 March 2010.**

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

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

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

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

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

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

/Mark Reinhart/

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

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,479	05/28/2009	7161506	080272-0012	2572

1473 7590 12/30/2009

ROPES & GRAY LLP
PATENT DOCKETING 39/361
1211 AVENUE OF THE AMERICAS
NEW YORK, NY 10036-8704

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/30/2009

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MCDERMOTT WILL & EMERY LLP
600 13TH STREET N.W.
WASHINGTON, D.C. 20005-3096

Date:

MAILED

DEC 30 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000479
PATENT NO. : 7161506
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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Alexandria, VA 22313-1450
www.uspto.gov

Jeffrey H Ingerman ROPES & GRAY LLP PATENT DOCKETING 39/361 1211 AVENUE OF THE AMERICAS NEW YORK NY 10036-8704	: : : : :	(For Patent Owner)
Kenneth L Cage MCDERMOTT WILL & EMERY LLP 600 13TH STREET, N.W. WASHINGTON, DC 20005-3096	: : : :	(For Third Party Requester)
In re: James J Fallon *Inter Partes* Reexamination Proceeding Control No. 95/000,479 Deposited on: 28 May 2009 For: US Patent No. 7,161,506	: : : : :	DECISION GRANTING-IN-PART PETITION FOR EXTENSION OF TIME [37 CFR §§ 1.956 & 1.181]

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DEC 30 2009

CENTRAL REEXAMINATION UNIT

This is a decision on the 28 December 2009, patent owner "Petition Under 37 CFR § 1.956 for Extension of Time to Reply to Office Action in Reexamination," requesting that the time for responding to the Office action mailed 15 December 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.

DISCUSSION

The Patent Owner requests an extension of time in which to file a response to the non-final Office action was mailed 15 December 2009. The non-final Office action provides two (2) month period for response. The petition request for a two (2) month extension of time was timely filed on 28 December 2009. The petition request provides electronic payment for the $200 petition fee under 37 CFR §1.17 (g).

There is sufficient cause to grant one (1) month extension of time.

The request is granted-in-part.

> **37 CFR § 1.956. Patent owner extensions of time in inter partes reexamination.** *The time for taking any action by a patent owner in an inter partes reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified. Any request for such extension must be filed on or before the day on which action by the patent owner is due, but in no case will the mere filing of a request effect any extension. Any request for such extension must be accompanied by the petition set forth in § 1.17(g). See § 1.304(a) for extensions of time for filing a notice of appeal to the U.S. Court of Appeals for the Federal Circuit.*

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

> As noted above, a request for extension of time under 37 CFR § 1.956 will be granted only for sufficient cause, ...
>
> Evaluation of whether "sufficient cause" has been shown for an extension must be made by **balancing** the desire to provide the patent owner with a fair opportunity to respond, **against** the requirement of the statute, 35 U.S.C. § 314(c), that the proceedings be conducted with special dispatch. ...

Any petition request must include the required petition fee as set forth according to 37 CFR § 1.17 (g) and 37 CFR § 1.956.

MPEP § 2665 Extension of Time for Patent Owner Response (in-part)

> ...
>
> 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.

...

DECISION

The patent owner's representative petitions under 37 CFR § 1.956 to extend the period for response by adding two (2) months to the period for response. The decision to extend the period for response is evaluated based upon a showing of "sufficient cause." There is always the consideration to balance the need for the patent owner to have a fair opportunity to respond to the Office action between the need for special dispatch.

The petition dated 28 December 2009 notes that there are a number of related proceedings as well as some concurrent due dates for response thereto. Further the patent owner notes that an expert is unavailable until March. It is not clear 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 with respect to the concurrent proceedings. The statement of must provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period. It is unclear why the patent owner does not have adequate representation to respond to the various proceedings in a timely manner. Further while it is unfortunate that Dr. Ligler is unavailable at this time, the granting of one month additional time amply provides the patent owner with time to locate additional experts as needed. Again it is unclear what action has been taken thus far to locate expert help for response in this proceeding as well as a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.

The time for response is extended by one (1) month.

The petition request to extend the response time is hereby granted-in-part.

CONCLUSION

1. The patent owner's petition for extension for time in which to file a response to the non-final Office action dated 15 December 2009 is hereby **granted-in-part.**

2. A one (1) month extension of time is granted.

3. The Patent Owner's response is due **15 March 2010.**

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

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

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

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

By EFS: Registered users of EFS-Web may alternatively submit such correspondence via the electronic filing system EFS-Web, at https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html. EFS-Web offers the benefit of quick submission to the particular area of the Office that needs to act on the correspondence. Also, EFS-Web submissions are "soft

scanned" (i.e., electronically uploaded) directly into the official file for the reexamination proceeding, which offers parties the opportunity to review the content of their submissions after the "soft scanning" process is complete.

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

/Mark Reinhart/

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

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United States 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.
95/000,480	06/04/2009	7475180	INNL-009-00US	4857

37509 7590 11/18/2009
DECHERT LLP
P.O. BOX 390460
MOUNTAIN VIEW, CA 94039-0460

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/18/2009

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

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COOLEY GODWARD KRONISH LLP
ATTN: PATENT GROUP SUITE 1100
777 6TH STREET N.W.
WASHINGTON, D.C. 20001

Date:

MAILED

NOV 1 2 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000480
PATENT NO. : 7475180
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

DECHERT LLP
P.O. Box 390460
Mountain View CA 94039-0460

: (For Patent Owner)

COOLEY GODWARD KRONISH LLP
Attn: Patent Group Suite 1100
777 6th Street N. W.
Washington, DC 20001

: (For Third Party Requester)

MAILED

NOV 18 2009

CENTRAL REEXAMINATION UNIT

In re: ARAI *et alia*
Inter partes Reexamination Proceeding
Control No. 95/000,480
Deposited: June 4, 2009
For: U.S. Patent No. 7,475,180

: DECISION
: GRANTING PETITION
: FOR EXTENSION OF TIME
: (37 CFR § 1.956)

This is a decision on the November 16, 2009 patent owner's petition titled "Petition for Extension of Time for Respond Under 37 CFR § 1.956." Owner seeks one month additional time for response. 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 petitions the director of the Central Reexamination Unit for a one (1) month extension of time. The petition is filed, together with 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. This is the first request for a one-month extension of time.

CITATION OF PERTINENT PROCEDURE

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.)

37 CFR 1.903. Service of papers on parties in inter partes reexamination.

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

DISCUSSION

The Patent owner has set forth that preparation of a response to the October 6, 2009 office action is ongoing and patent owner requests additional time to prepare Affidavits/Declarations regarding the status of an applied prior art printed publication, and well as other technical experts. Details are set forth on pages 2-3 of owner's petition.

On balance, there is always a question whether to grant an extension of time when balancing the need for special dispatch with the need for the patent owner to have a fair opportunity for which to properly respond to the outstanding Office action. In this situation it is considered that the petition provides "sufficient cause" as to why an extension of time should be granted.

The extension of time of one-month is hereby 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 October 6, 2009 is hereby **granted**.

2. The period for response is hereby extended to **January 6, 2010.**

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

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

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

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

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

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, at (571) 272-4929 or Jessica Harrison at (571) 272-4449, Supervisory Patent Examiners, Art Unit 3992, may be contacted.

/J. Harrison/

Jessica J Harrison
SPE AU 3992
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,480	06/04/2009	7475180	INNL-009-00US	4857

37509 7590 04/21/2010

DECHERT LLP
P.O. BOX 390460
MOUNTAIN VIEW, CA 94039-0460

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/21/2010

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
COOLEY GODWARD KRONISH LLP
ATTN: PATENT GROUP SUITE 1100
777 6TH STREET N.W.
WASHINGTON, D.C. 20001

Date:

MAILED
APR 21 2010
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000480
PATENT NO. : 7475180
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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MAILED
APR 21 2010
CENTRAL REEXAMINATION UNIT

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MOUNTAIN VIEW, CA 94040-1499

Inter Partes Reexamination Proceeding	: **DECISION**
Control No. 95/000,480	: **GRANTING**
Filed: June 4, 2009	: **PETITION**
For: U.S. Patent No. 7,475,180	: **IN-PART**

This is a decision on the October 9, 2009 patent owner paper entitled "PETITION UNDER 37 CFR §§ 1.182 AND 1.183 TO DISMISS AND EXPUNGE AN IMPERMISSIBLE FILING FROM THE RECORD."

The petition under 37 CFR 1.182/1.183 is before the Office of Patent Legal Administration.

The patent owner petition is **granted in-part**, i.e., granted to the extent that waiver of 37 CFR 1.939 has been considered with respect to third party requester's petition, but is dismissed as to the underlying expungement relief requested therein.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 7,475,180 issued to Arai *et al.* on January 6, 2009 ("the '180 patent").

2. On June 4, 2009, a request for *inter partes* reexamination of the '180 patent was filed by a third party requester, which proceeding was assigned Control No. 95/000,480 ("the '480 proceeding").

3. On July 24, 2009, reexamination was ordered in the '480 proceeding.

4. On September 24, 2009, third party requester filed a paper in the '480 proceeding entitled "PETITION UNDER 37 C.F.R. §§ 1.182-1.183 TO RESOLVE CONTRADICTORY EXAMINER FINDINGS IN COPENDING REEXAMINATION PROCEEDINGS" ("the requester petition under 37 CFR 1.182/1.183").

5. On October 6, 2009, the Office mailed the initial Office action on the merits in the '480 proceeding.

6. On October 9, 2009, patent owner filed the instant paper entitled "PETITION UNDER 37 CFR §§ 1.182 AND 1.183 TO DISMISS AND EXPUNGE AN IMPERMISSIBLE FILING FROM THE RECORD" ("the patent owner petition under 37 CFR 1.182/1.183").

DECISION

37 CFR 1.181 provides, 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;

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 2625 provides in-part:

> Pursuant to 37 CFR 1.939, after filing of a request for *inter partes* reexamination, no papers directed to the merits of the reexamination other than (A) citations of patents or printed publications under 37 CFR 1.501 and 1.933, (B) another complete request under 37 CFR 1.510 or 37 CFR 1.915, or (C) notifications pursuant to MPEP § 2686, should be filed with the Office prior to the date of the first Office action in the reexamination proceeding. Any papers directed to the merits of the reexamination, other than those under 37 CFR 1.501, 1.933, 1.510 or 1.915, or under MPEP § 2686, filed prior to the date of the first Office action will be returned to the

> sender without consideration. If the papers are entered prior to discovery of the impropriety, such papers will be expunged from the record. A copy of the letter providing notification of the returned papers or expungement will be made of record in the patent file. However, no copy of the returned/expunged papers will be retained by the Office. If the submission of the returned/expunged papers is appropriate later in the proceedings, they may be filed, and accepted by the Office, at that time.

Because requester's September 24, 2009 petition under 37 CFR 1.182/1.183 was filed prior to the initial Office action on the merits in the '480 proceeding, patent owner requests, in its October 9, 2009 petition under 37 CFR 1.182/1.183, that the requester's petition be dismissed and expunged from the record of the '480 proceeding as an improper paper pursuant to 35 U.S.C. 314(b) and 37 CFR 1.939.[1] 35 U.S.C. 314(b) provides, in part, that each time the patent owner files a response to an Office action on the merits, requester shall have one opportunity to file written comments addressing issues raised by the Office action or the patent owner's response thereto, and 37 CFR 1.939 provides, in part, "[u]nless otherwise authorized, no paper shall be filed prior to the initial Office action on the merits of the *inter partes* reexamination." Patent owner also asserts that requester's September 24, 2009 petition violates 35 U.S.C. 312(c), which states that a determination by the Director under 35 U.S.C. 312(a) regarding whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request shall be final and non-appealable.[2]

Patent owner's petition under 37 CFR 1.182/1.183 has been fully considered, and is granted to the extent that waiver of 37 CFR 1.939 has been considered with respect to authorizing entry of requester's September 24, 2009 petition. Based on the following, however, the requester's September 24, 2009 petition will not be expunged.

In view of the nature of the issues raised in the requester's September 24, 2009 petition under 37 CFR 1.182/1.183 regarding resolution of inconsistencies among co-pending reexamination proceedings, and in furtherance of special dispatch, this decision waives 37 CFR 1.939 to authorize entry of the requester's September 24, 2009 petition for consideration by the Central Reexamination Unit (CRU) as a petition requesting relief under 37 CFR 1.181. 37 CFR 1.181 permits petitions to be taken to the Director from any action or requirement of any examiner in the *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. Director review of requests for relief under 37 CFR 1.181 is not precluded by either 35 U.S.C. 314(b) or 35 U.S.C. 312(c). Thus, patent owner's petition under 37 CFR 1.182/1.183 is dismissed as to the underlying relief requested therein of dismissing and expunging the requester's September 24, 2009 petition under 37 CFR 1.182/1.183.

Because this decision makes the requester's September 24, 2009 petition under 37 CFR 1.182/1.183 an authorized paper in the '480 proceeding, the requester's September 24, 2009 petition will not be expunged from the record. Rather, jurisdiction over the '480 proceeding is

---

[1] Patent owner's petition under 37 CFR 1.182/1.183 at pages 1-2 and 5-6.
[2] Patent owner's petition under 37 CFR 1.182/1.183 at pages 3-5.

remanded to the CRU to address the requester's September 24, 2009 petition pursuant to 37 CFR 1.181 for resolution of the issues raised therein.

PATENT OWNER'S ADDRESS

The patent owner is called upon to coordinate the proper correspondence addresses in the patent and the reexamination proceedings. Different patent owner addresses are of record for the '180 patent file and for the '480 reexamination proceeding. The current correspondence address of record for the patent file is the proper patent owner address for reexamination mailings pursuant to 37 CFR 1.33(c), and it is that of ANTONELLI, TERRY, STOUT & KRAUS, LLP, 1300 NORTH SEVENTEENTH STREET, SUITE 1800, ARLINGTON, VA 22209-3873. Accordingly, all future correspondence will be directed to ANTONELLI, TERRY, STOUT & KRAUS, LLP, 1300 NORTH SEVENTEENTH STREET, SUITE 1800, ARLINGTON, VA 22209-3873, unless, within **ONE (1) MONTH** of this decision, patent owner changes the correspondence address of record in the patent, using form PTO/SB/123.

CONCLUSION

1. Patent owner's October 9, 2009 petition paper entitled "PETITION UNDER 37 CFR §§ 1.182 AND 1.183 TO DISMISS AND EXPUNGE AN IMPERMISSIBLE FILING FROM THE RECORD" is granted to the extent that waiver of 37 CFR 1.939 has been considered with respect to third party requester's petition. However, the patent owner petition is dismissed as to the underlying expungement relief requested therein.

2. This decision waives the provisions of 37 CFR 1.939 to authorize entry of the requester's September 24, 2009 petition filed under 37 CFR 1.182/1.183, for consideration by the Central Reexamination Unit (CRU) as a petition requesting relief under 37 CFR 1.181.

3. Jurisdiction over the '480 proceeding is remanded to the CRU to address the requester's September 24, 2009 petition as a petition under 37 CFR 1.181.

4. 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

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

4-20-10

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,480	06/04/2009	7475180	INNL-009-00US	4857

37509 7590 06/04/2010

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/04/2010

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Date: MAILED
JUN 0 4 2010
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000480
PATENT NO. : 7475180
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

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In re Arai *et al.*
Inter Partes Reexamination Proceeding
Control No.: 95/000,480
Filed: June 4, 2009
For: U.S. Patent No. 7,475,180

: **DECISION**
: **DISMISSING**
: **PETITION AND**
: ***SUA SPONTE***
: **EXPUNGING**
: **IMPROPER PAPERS**

This is a decision on requester's petition filed on February 5, 2010, entitled "PETITION FOR SUSPENSION OF RULE UNDER 37 CFR 1.183," for a concurrently filed response and on requester's petition filed on February 24, 2010, entitled "PETITION UNDER 37 CFR 1.182 FOR REPLACEMENT OF PAPERS PREVIOUSLY SUBMITTED".

This decision also addresses the January 6, 2010 patent owner response, the February 4 and February 5, 2010 requester comments, and the October 9, 2009 power of attorney, statement under 3.73(b), and change of correspondence address of the patent owner.

The petition under 37 CFR 1.183, the petition under 37 CFR 1.182, the January 6, 2010 patent owner response, the February 4 and February 5, 2010 requester comments, the October 9, 2009 power of attorney, statement under 3.73(b), and change of correspondence address of the patent owner, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

Two petition fees of $400 each pursuant to 37 CFR 1.17(f) for the petitions under 37 CFR §§ 1.182 and 1.183 were charged to requester's Deposit Account No. 50-1283, as authorized by requester's EFS-WEB fee transmittals.

SUMMARY

The February 5, 2010 requester petition under 37 CFR 1.183 is **dismissed as moot**.

The February 24, 2010 requester petition under 37 CFR 1.182 is **dismissed as moot**.

The January 6, 2010 patent owner response is **improper** and **will be expunged**. The February 4 and February 5, 2010 requester comments submission is **improper** and **will be expunged**. These papers will be expunged by closing the papers in the '480 proceeding's Image File Wrapper (IFW) and by marking the papers "non-public." These papers will not constitute part of the record of the present reexamination proceeding.

REVIEW OF RELEVANT FACTS

1. On January 6, 2009, the Office issued U.S. Patent No. 7,475,180 (the '180 patent) to Arai *et al.*

2. On June 4, 2009, a request for *inter partes* reexamination of the '180 patent was filed. The request was assigned Control No. 95/000,480 (the '480 proceeding).

3. On July 24, 2009, *inter partes* reexamination was ordered for the '480 proceeding and indicating that an Office action on the merits would issue in due course.

4. On October 6, 2009, the Office issued a non-final Office action on the merits in the '480 proceeding.

5. On October 9, 2009, patent owner submitted a change in power of attorney and correspondence address in the '480 proceeding.

6. January 6, 2010, patent owner timely filed a response to the October 6, 2009 Office action without amendment to the claims.[1]

7. On February 4, 2010, the requester filed a paper entitled "Submission of Corrected Declarations", with accompanying declarations.

8. On February 5, 2010, the requester filed comments along with several declarations and exhibits and concurrently filed a petition entitled, "PETITION FOR SUSPENSION OF RULE UNDER 37 CFR 1.183," requesting suspension of 37 CFR §§ 1.948 and 1.943(b).

9. On February 24, 2010, the requester filed a petition entitled, "PETITION UNDER 37 CFR 1.182 FOR REPLACEMENT OF PAPERS PREVIOUSLY

[1] Patent owner was granted a thirty day extension of time to respond to the Office action.

SUBMITTED," to selectively replace papers in the exhibits attached to the declarations filed with the February 5, 2010 comments.

RELEVANT RULES AND GUIDANCE

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.

37 CFR 1.52 states in pertinent part:

> (a) Papers that are to become a part of the permanent United States Patent and Trademark Office records in the file of a patent application or a reexamination proceeding.
>
> > (1) All papers, other than drawings, that are submitted on paper or by facsimile transmission, and are to become a part of the permanent United States Patent and Trademark Office records in the file of a patent application or reexamination proceeding, must be on sheets of paper that are the same size, not permanently bound together, and:
> >
> > *
> >
> > *
> >
> > (v) Presented in a form having sufficient clarity and contrast between the paper and the writing thereon to permit the direct reproduction of readily legible copies in any number by use of photographic, electrostatic, photo-offset, and microfilming processes and electronic capture by use of digital imaging and optical character recognition.

37 CFR 1.182 states:

> All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Director, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties

> in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.183 states:

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

37 CFR 1.943 states in pertinent part:

> (a) The form of responses, written comments, briefs, appendices, and other papers **must be in accordance with the requirements of § 1.52.** [Emphasis added]
>
> (b) Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

37 CFR 1.947 states:

> Each time the patent owner files a response to an Office action on the merits pursuant to § 1.945, a third party requester may once file written comments within a period of 30 days from the date of service of the patent owner's response. These comments shall be limited to issues raised by the Office action or the patent owner's response. The time for submitting comments by the third party requester may not be extended. For the purpose of filing the written comments by the third party requester, the comments will be considered as having been received in the Office as of the date of deposit specified in the certificate under § 1.8.

37 CFR 1.948 states:

> (a) After the *inter partes* reexamination order, the third party requester may only cite additional prior art as defined under § 1.501 if it is filed as part of a comments submission under § 1.947 or § 1.951(b) and is limited to prior art:
>
> (1) which is necessary to rebut a finding of fact by the examiner;
>
> (2) which is necessary to rebut a response of the patent owner; or

> (3) which for the first time became known or available to the third party requester after the filing of the request for *inter partes* reexamination proceeding. Prior art submitted under paragraph (a)(3) of this section must be accompanied by a statement as to when the prior art first became known or available to the third party requester and must include a discussion of the pertinency of each reference to the patentability of at least one claim.

MPEP 2666.05 II states in pertinent part:

> New prior art can be submitted with the comments only where the prior art (A) is necessary to rebut a finding of fact by the examiner, (B) is necessary to rebut a response of the patent owner, or (C) for the first time became known or available to the third party requester after the filing of the request for inter partes reexamination.
>
> As to item (A) above, 37 CFR 1.948(a)(1) permits the requester to provide new prior art rebutting the examiner's interpretation/finding of what the art of record shows. However, a statement in an Office action that a particular claimed feature is not shown by the prior art of record (which includes references that were cited by requester) does NOT permit the requester to then cite new art to replace the art originally advanced by requester. Such a substitution of a new art for the art of record is not a rebuttal of the examiner's finding that a feature in question is not taught by the art of record. Rather, such a substitution would amount to a rebuttal of a finding that a feature in question is not taught by any art in existence. A finding that the feature in question is not taught by any art in existence could not realistically be made for the reexamination proceeding, since the proceeding does not include a comprehensive validity search, and such was not envisioned by Congress as evidenced by the 35 U.S.C. 314(c) mandate that reexamination proceedings are to be conducted in the Office with special dispatch.[Emphasis added]
>
> As to item (B) above, 37 CFR 1.948(a)(2) permits the requester to provide a new proposed rejection, where such new proposed rejection is necessitated by patent owner's amendment of the claims. [Emphasis added]
>
> As to item (C) above, prior art submitted under 37 CFR 1.948(a)(3) must be accompanied by a statement that explains the circumstances as to when the prior art first became known or available to the third party requester, including the date and manner that the art became known or available, and why it was not available earlier. The submission must also include a discussion of the pertinency of each reference to the patentability of at least one claim.

MPEP 2667, subsection I A 2, provides, in pertinent part:

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

DECISION

I. The January 6, 2010 Patent Owner Response Will Be *Sua Sponte* Expunged

On January 6, 2010, patent owner submitted a response containing a twenty-eight page single-spaced remarks section using a font size of less than 12 points.[2] The declaration of Joseph D. Lamm (Exhibit M) is also single-spaced. Patent owner's response must be in a form that ensures sufficient clarity and contrast for electronic capture and reproducibility without degradation, e.g., a font size of 12 points, one-and-a-half or double-spacing, and text written in a non-script type font, such as Arial, Times New Roman, or Courier. The current usage of single line spacing with a reduced font size impedes direct reproduction of readily legible copies in any number by use of photographic, electrostatic, photo-offset, and microfilming processes and electronic capture by use of digital imaging and optical character recognition, contrary to 37 CFR 1.52(a)(1)(v). See, generally, 37 CFR 1.943(a) and 37 CFR 1.52.

In addition, the declaration of Joseph D. Lamm (Exhibit M) contains legal arguments, legal analyses, and legal conclusions, which subject the Lamm declaration to the regulatory 50-page limit. For example, the Lamm declaration includes legal arguments and legal conclusions that one of ordinary skill would not

[2] The signature page is not subject to the page count if it does not contain legal argument.

have been motivated to combine the references cited in the examiner's rejections (see, e.g., paragraphs 14, 18, 20, 22-24, 26-30, and 32-34). Accordingly, the 16-page Lamm declaration is replete with legal argument and is subject to the regulatory 50-page limit.

Furthermore, the remarks section of the response and the declaration of Joseph D. Lamm (Exhibit M) are both single-spaced, and if formatted for the minimum one and a half line spacing, would be at least fifty percent longer. Currently the remarks section and the Lamm declaration combined are 44 pages in length, single-spaced. Assuming the minimum one and a half line spacing and a 12-point font size, the two documents combined would be at least 66 pages in length, exceeding the 50–page limit established by 37 CFR 1.943(b).

Accordingly, for all the reasons set forth above, patent owner's January 6, 2010 response submission, including the remarks, declarations, and exhibits, is **improper and will be *sua sponte* expunged**. The response submission will be expunged by closing the papers in the '480 proceeding's Image File Wrapper (IFW) and by marking the papers "non-public." The patent owner's January 6, 2010 response submission will not constitute part of the record of the present reexamination proceeding.

Because the January 6, 2010 patent owner response will not constitute part of the record of the present reexamination proceeding, the February 4 and February 5, 2010 requester comments submission will not be considered. The February 4 and February 5, 2010 requester comments submission, however, are also improper and will be expunged, for reasons discussed *infra*.

II. The February 5, 2010 Requester Petition Under 37 CFR 1.183

Third party requester's petition under 37 CFR 1.183 requests waiver of 37 CFR 1.948(a) and 37 CFR 1.943(b). The February 4 and February 5, 2010 requester comments submission, however, will not be considered, because the January 6, 2010, patent owner response, to which the February 4 and February 5, 2010 requester comments submission are directed, is improper, will be expunged, and will not constitute part of the record of the present reexamination proceeding.

Accordingly, the February 5, 2010 requester petition under 37 CFR 1.183 to waive the provisions of 37 CFR 1.948(a) and 37 CFR 1.943(b) is **dismissed as moot**.

Even if a proper response to the October 6, 2009 Office action had been filed by the patent owner, however, the February 5, 2010 requester petition would not have been granted for the reasons discussed immediately below.

A. Waiver of 37 CFR 1.948 to present Printed Publication Rebuttal Evidence

The requester argues that justice requires entry of the Lesh declaration and its, exhibits, a rebuttal declaration by Jake Richter (exhibit A26) and accompanying exhibits, a declaration by Frans Tol and accompanying exhibit, and an article by Rob McCabe, which are apparently submitted to rebut the patent owner's arguments as to whether certain documents are printed publications. The requester further states the rebuttal declaration by Jake Richter (exhibit A26) and accompanying exhibits are submitted to rebut the patent owner's declaration directed to commercial success.

On October 6, 2009 the examiner rejected the original claims using *inter alia* the AN442 reference in view of Moriconi, the AN442 reference in view of the VDDP reference and the Sony DDM reference in view of Moriconi. On January 6, 2010 patent owner filed, without amendment to the claims, a response that *inter alia* asserted that the AN442 reference, the VDDP reference and the Sony DDM reference cannot be used as a basis for rejecting the claims, because the references are not printed publications. On February 5, 2010 the requester filed a response that argues *inter alia* the AN442 reference, the VDDP reference and the Sony DDM reference are all available for use as prior art because they are printed publications. In support of the assertion, requester submits the above-discussed declarations with exhibits which are stated to contain support of the facts asserted in the declarations. The documents contained in the exhibits are not used to propose new rejections against the unamended claims, but only as evidence in rebuttal to patent owner's arguments that the references do not qualify as printed publications. Therefore, the documents contained in the exhibits submitted with the declarations do not constitute a submission of prior art that is contrary to the 37 CFR 1.948. For this reason, there would be no need for waiver of the rule under 37 CFR 1.183.

B. Waiver of 37 CFR 1.943(b)

Third party requester's petition under 37 CFR 1.183 requests waiver of the 50-page limit of 37 CFR 1.943(b) for the concurrently filed comments submission, including multiple declarations under 37 CFR 1.132. The February 4 and February 5, 2010 requester comments submission, however, will not be considered, because the January 6, 2010, patent owner response, to which the February 4 and February 5, 2010 requester comments are directed, is improper, will be expunged, and will not constitute part of the record of the present reexamination proceeding. Accordingly, the February 5, 2010 requester petition under 37 CFR 1.183 to waive the provisions of 37 CFR 1.943(b) is **dismissed as moot**.

Even if a proper response to the October 6, 2009 Office action had been submitted by the patent owner, however, the February 5, 2010 requester petition under 37 CFR 1.183 would not have been granted. Third party requester has not made an adequate showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b). Requester has provided no explanation of how the submitted response

economizes, excludes extraneous material, and is arranged so as not to repeat information already of record. Requester has not demonstrated that efforts to be as brief as possible were taken to respond to patent owner's response and amendment. Even if one corrects for patent owner's single spaced twenty-eight page remarks section and 16-page single-spaced declaration of Joseph Lamm, submitted on January 6, 2010, the patent owner response submission is at least 66 pages in length, if the text were double spaced, and thus cannot provide justification for the requester to submit 233 pages as a comments submission (assuming the minimum one and a half line spacing, as discussed below).

Waiver of the rules under 37 CFR 1.183 may be suspended in an ***extraordinary situation when justice requires***. As noted above the requester undertook no effort to economize the response. Requester provides no other facts to establish an extraordinary situation where justice requires suspension of the rule to such an extreme degree of an additional 183 pages, if the text were double spaced. The failure of requester to comply with the rules, in the form of submitting an economized set of comments in accordance with 37 CFR 1.943(b), does not rise to an ***extraordinary situation*** under 37 CFR 1.183 to justifying suspension of the rules. Therefore, justice would not require suspension of 37 CFR 1.943(b).

III. The February 4 and February 5, 2010 Requester Comments Submission

The February 4 and February 5, 2010 requester comments are **improper**, and **will be expunged**.

Submission of Corrected Declarations

On February 4, 2010, the requester filed a paper entitled "Submission of Corrected Declarations", accompanied by a declaration of Jake Richter, dated February 1, 2010 ("the corrected Richter declaration"), and a declaration of Tom Ryan, dated February 2, 2010 (collectively, "the corrected declarations"). The requester states that the corrected declarations were filed to address issues under 37 CFR 1.68 raised by the examiner in the first Office action, regarding the declaration of Jake Richter and the declaration of Tom Ryan (collectively, "the original declarations"), which were attached as exhibits to the June 4, 2009 request for *inter partes* reexamination. The requester further states that the corrected declarations "differ from the [o]riginal [d]eclarations only in the first and final paragraphs of the declarations" which were added to comply with the requirements of 37 CFR 1.68, that none of the numbered paragraphs in the declarations have been changed, and that the corrected declarations are being submitted without the exhibits to which the corrected declarations, and the original declarations, each separately refer, because the exhibits also have not been changed.[3]

The Ryan and Richter declarations that were submitted with the original, and with

[3] See the paragraph bridging the first and second pages of the February 4, 2010 paper entitled "Submission of Corrected Declarations".

the corrected, request for reexamination, however, were not in proper form and thus were not considered by the examiner, as pointed out by the examiner on page 5 of the first Office action. These declarations, in their corrected (proper) form, if filed with a proper requester comments submission as will be discussed *infra*, will be reviewed and addressed by the examiner for the first time in the next Office action. The corrected declaration of Jake Richter includes legal argument, legal analyses, and legal conclusions, as to how a rejection of the claims is supported, causing the declaration to be subject to the 50-page length requirement for requester comments, pursuant to 37 CFR 1.943(b),[4] as will be explained in detail *infra*. See MPEP 2667. The corrected declaration of Tom Ryan, filed on February 2, 2010, is directed to subject matter that is not subject to the 50-page regulatory limit. However, because the corrected Richter declaration was not submitted in proper form under 37 CFR 1.68 until it was filed on February 4, 2010, and because the corrected Richter declaration is directed to subject matter that causes the declaration to be subject to the 50-page length requirement, the pages of the corrected Richter declaration, if later submitted with a corrected requester submission, would be counted toward the 50-page limit.

The February 5, 2010 Requester Comments Submission

On February 5, 2010, requester submitted comments that included a thirty-eight (38) page single-spaced remarks section, apparently using a font size of less than 12 points.[5] The remarks section of requester's comments is subject to the 50-page limit set forth in 37 CFR 1.943(b). Additionally, any declaration containing legal arguments, legal analyses, or legal conclusions will result the declaration being subject to the regulatory 50-page limit. Accordingly, third party requester's February 5, 2010 comments submission, including declarations within which such arguments appear, exceeds the 50-page limit set forth in 37 CFR 1.943(b). See MPEP 2667(I)(A)(2).

Requester's February 5, 2010 response to patent owner's January 6, 2010 comments consists of a forty (40) pages single-spaced remarks section, a forty-five (45) page

[4] In determining whether an affidavit or declaration under 37 CFR 1.132 is subject to the 50-page length requirement under 37 CFR 1.943(b), the Office analyzes whether the affidavit or declaration is providing factual evidence, i.e., evidence of *technological* facts, or whether the affidavit or declaration is merely an extension of the arguments of counsel.[4] Factual evidence includes declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results. Where the affidavit or declaration includes arguments containing legal analysis or legal conclusions, including arguments that the claims are patentable or unpatentable, or are directed to how an outstanding or proposed rejection is overcome, or, in the case of a declaration filed by the requester, how an outstanding or proposed rejection is supported, the affidavit or declaration is subject to the 50-page length requirement. The corrected Richter declaration is replete with such arguments. For this reason, the entire declaration is subject to the 50-page length requirement.

[5] The two-page listing entitled "Attachments" (see pages 39-40 of the February 5, 2010 requester comments) is not considered as part of the substantive portion of the remarks.

claim chart "AG" designated as Exhibit A30, and multiple exhibits,[6] which includes five declarations under 37 CFR 1.132, totally sixty-seven (67) double spaced pages and twelve (12) singe spaced pages, and broken down across the five declarations as follows: (1) Exhibit A13 contains a two-page single-spaced declaration by Frans Tols; (2) Exhibit A14 contains a thirty-seven (37) double spaced declaration by Jake Richter; (3) Exhibit A16 contains a nineteen (19) page double-spaced declaration by Tom Ryan; (4) Exhibit A26 contains a ten (10) page single spaced declaration also executed by Jake Richter; and (5) Exhibit A27 contains an eleven (11) page double spaced declaration executed by David Lesh.[7] The A13, A16 and A27 declarations were determined to be free of legal argument and are not subject to the 50-page length requirement.

The remarks section is forty (40) single-spaced pages in length and includes a two page appendix listing all the attached exhibits, which are exclusive of argument. Therefore, thirty-eight (38) pages of the remarks section contain substantive argument, which are subject to the regulatory fifty (50) page limit.

The A14 declaration contains legal arguments, legal analyses, and legal conclusions. For example, page 16, paragraph 40, argues that the VDDP document is a printed publication.[8] Page 18, paragraph 46, pages 28 and 34, header no. 2, page 29, paragraph 83, page 30-31, paragraph 90, page 35, paragraph 104, and page 36, paragraph 106 undertake a 35 U.S.C. 112, sixth paragraph analysis of claim language. Page 20, paragraph 55, and page 24, paragraph 67, assert the legal conclusion of obviousness etc. The corrected Richter declaration, dated February 1, 2010, which accompanied the February 4, 2010 paper entitled "Submission of Corrected Declarations", similarly contains legal arguments, legal analyses, and legal conclusions.[9] Accordingly, the A14 declaration and the corrected Richter declaration which accompanied the February 4, 2010 paper entitled "Submission of Corrected Declarations" are replete with legal argument and are subject to the regulatory fifty (50) page limit.

The A26 declaration contains legal arguments, legal analyses and legal conclusions. See, for example, pages 1-2, paragraph 8 (bridging text) in which declarant asserts the current legal standard for obviousness; page 4, paragraphs 24-25, page 5, paragraphs 29-30, page 7-8, paragraph 42, page 8, paragraph 47 and page 9,

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[6] Several of the exhibits containing declarations possessed secondary exhibits providing support documents for the facts asserted in the declarations.

[7] All declarations will be referred to by their exhibit number.

[8] Pursuant to MPEP 2667, subsection I A 2, affidavits or declarations solely containing factual evidence directed to establishing the date of a printed publication are not subject to the page limit requirement. In the present case, however, the requester is not presenting factual evidence directed to establishing the date of a printed publication. Rather, the requester is presenting legal argument and legal analyses to postulate a legal conclusion that the VDDP document is a printed publication.

[9] The corrected Richter declaration may or may not be identical to the declaration of Jake Richter submitted in Exhibit A14. The requester has not filed any statement to this effect. Furthermore, the requester states in the paper entitled "Submission of Corrected Declarations" that the corrected Richter declaration is submitted without exhibits. The Richter declaration in Exhibit A14, however, is submitted with exhibits.

paragraphs 48-49 where declarant renders multiple legal opinions, legal arguments and legal conclusions that the claimed invention is "obvious" under the "*KSR* standard." Accordingly, the A26 declaration is replete with legal argument and is subject to the regulatory fifty (50) page limit.

The forty-five (45) page claim chart "AG", designated by requester as Exhibit A30, was created by patent owner for litigation in asserting a claim of infringement in civil proceedings. Requester originally submitted claim chart "AG" as part of exhibit 13 to the original request for reexamination of the '180 patent. Claim chart "AG" is replete with legal argument, however requester is submitting claim chart "AG" as proof of patent owner admissions and not for the substance of the legal argument. Therefore claim chart "AG" as exhibit A30, which is submitted with the February 4 and February 5, 2010 comments submission, is not subject to the regulatory 50-page limit.

Thus, thirty-eight (38) pages of the remarks section, the thirty-seven (37) pages of the A14 declaration, the thirty-seven (37) pages of the corrected Richter declaration that accompanied the paper entitled "Submission of Corrected Declarations," and the (10) pages of the A26 declaration are all subjected to the 50-page regulatory limit for the requester's response. The remarks section and the A26 declaration are both single spaced and if formatted for the minimum requirement of one and one-half line spacing they would be at least fifty percent longer. Currently the remarks section and the A26 declaration combined are 48 pages in length, single spaced. Assuming the minimum one and a half line spacing, the two documents combined would be at least 72 pages in length. The A14 declaration and the corrected Richter declaration are already in a proper line spacing format and at a length of 37 pages. Therefore, *in toto* requester has submitted substantive comments of 156 pages, exceeding the 50–page limit established by 37 CFR 1.943(b) by a total of 106 pages.

Accordingly, for all the reasons set forth above, requester's February 4 and February 5, 2010 comments submission, including the remarks, declarations, and exhibits, is **improper and will be expunged**. The comments submission will be expunged by closing the papers in the '480 proceeding's Image File Wrapper (IFW) and by marking the papers "non-public." The requester's February 4 and February 5, 2010 comments submission will not constitute part of the record of the present reexamination proceeding.

IV. The February 24, 2010 Requester Petition

On February 24, 2010, the requester filed a petition entitled, "PETITION UNDER 37 CFR 1.182 FOR REPLACEMENT OF PAPERS PREVIOUSLY SUBMITTED", requesting that certain exhibits that are included in requester's February 5, 2010 comments submission be closed from the public record, and that replacement versions of these documents, submitted with the February 24, 2010 petition, be added to the public record in their place.

Because the requester's February 5, 2010 petition under 37 CFR 1.183 to waive the provisions of 37 CFR 1.148(a) and 37 CFR 1.943(b) for requester's February 5, 2010 comments submission is dismissed as moot, and because the entire February 5, 2010 requester comments submission, including the remarks, declarations, and exhibits, will be expunged from the public record for the reasons given above, the February 24, 2010 petition under 37 CFR 1.182, entitled "PETITION UNDER 37 CFR 1.182 FOR REPLACEMENT OF PAPERS PREVIOUSLY SUBMITTED", is **dismissed as moot**.

Both the patent owner and the requester are advised, however, that any future petition under 37 CFR 1.182 requesting the sealing of documents that are subject to a protective order, must include a copy of the protective order and must show that the specific documents at issue are covered by the protective order. See, particularly, MPEP 724.

V. Guidance for Resubmission of Papers

Patent Owner

Any response by patent owner to the outstanding Office action must be filed within **15 days** from the mail date of this decision, and must comply with the provisions of 37 CFR §§ 1.943 and 1.52, also as set forth in this decision. **This 15-day period is not extendable.**

Requester

Any comments by the requester filed in reply to patent owner's response must be filed within **30 days** from the date of service of patent owner's response, and must comply with the provisions of 37 CFR §§ 1.943 and 1.52, also as set forth in this decision. **This 30-day period is not extendable.**

General Comments

Any patent owner response or requester comments submission that exceeds the regulatory 50-page limit must be accompanied by a petition under 37 CFR 1.183 that provides sufficient specificity as to the extraordinary circumstances that justify waiver of the 50-page length requirement.

To obtain a waiver of the 50-page length requirement of 37 CFR 1.943(b), any grantable petition under 37 CFR 1.183 must be accompanied by a patent owner response submission or a requester comments submission that:

1) is double-spaced;
2) is in a non-script type font (e.g., Arial, Times New Roman, or Courier);
3) has a font size no smaller than 12-point;
4) conforms to the margin requirements of 37 CFR 1.52(a)(1)(ii); and

5) has sufficient clarity and contrast to permit direct reproduction of readily legible copies in any number by use of photographic, electrostatic, photo-offset, and microfilming processes and electronic capture by digital imaging and optical character recognition pursuant to 37 CFR § 1.52(a)(1)(v).

See, generally, 37 CFR 1.943(a) and 37 CFR 1.52.

In accordance with 37 CFR 1.903, any paper submitted pursuant to this decision must be served on every other party in the reexamination proceeding.

If no response from the patent owner is received, the reexamination proceeding will be forwarded to the examiner for appropriate action, without entry of any written comments (and attachments) filed by the requester.

In general the parties should avoid the insertion of lengthy block quotes and figures and instead cite to the relevant portion(s) of the document(s) of record that contain the quoted text or figures. The merits of the case does not contain any unique and/or inordinately complex legal issues, but instead consists of common issues of patent law that arise in many patent examination proceedings, e.g. anticipation, obviousness or availability of a reference to serve as prior art, etc. Therefore no need exists for extensive stand alone sections regarding the current state of the law. Citations to the relevant section(s) of the Manual of Patent Examining Procedure (MPEP) along with supplemental citation to the most current on point case law, if necessary, as requester argues the merits of the case is sufficient for purposes of a reexamination proceeding. Finally, the parties need not restate the full legal analysis and rationale for each rejection. For purposes of brevity the parties can simply cite to the examiner's rejection or patent owner's response and add comments deemed appropriate to then raise the relevant points of contention, in order to efficiently identify the rejections and present arguments.

VI. The October 9, 2009 Power of Attorney, Statement under 37 CFR 3.73(b), and Change of Correspondence Address is Ineffective

The October 9, 2009 power of attorney, statement under 37 CFR 3.73(b) and change of correspondence address for patent owner are all **ineffective**, because they do not comply with 37 CFR §§ 1.5(a) and 37 CFR 1.4(c). Each paper must separately identify, on the top page in a conspicuous location, the control number of the proceeding. 37 CFR 1.5(a). Furthermore, a power of attorney, statement under 3.73(b), and change of correspondence address must be submitted as a separate paper in each application or reexamination proceeding to which it relates. 37 CFR 1.4(c).

In addition, the official correspondence address for the patent owner in a reexamination proceeding is the correspondence address as recorded in the patent file. See 37 CFR 1.33(c) and MPEP 2622. Office records fail to reveal that a change of correspondence address was received in the patent file, application no. 10/160,022. In the present case, the official correspondence address of record for the patent owner as recorded in the

patent file is that of ANTONELLI, TERRY, STOUT & KRAUS, LLP, 1300 NORTH SEVENTEENTH STREET, SUITE 1800, ARLINGTON VA 22209-3873.

A courtesy copy of this decision will be mailed to the correspondence address indicated on the October 9, 2009 power of attorney, statement under 37 CFR 3.73(b), and change of correspondence address for the patent owner. In the absence of a proper submission of a change of correspondence address for the patent owner in the patent file, application no., 10/160,022, however, all future correspondence in this reexamination proceeding will be mailed ONLY to the official correspondence address of record for the patent owner, i.e., the address of ANTONELLI, TERRY, STOUT & KRAUS, LLP, 1300 NORTH SEVENTEENTH STREET, SUITE 1800, ARLINGTON VA 22209-3873.

VII. ADDITIONAL COMMENTS

Both parties are on specific notice as to the format and font requirements as set forth in this decision for the submission of responses and comments for an *inter partes* reexamination proceeding when a waiver of the 50-page length requirement of 37 CFR 1.943(b) is sought. Accordingly, any subsequent noncompliant submissions may not be considered, and may be expunged **without** an opportunity for resubmission, because such noncompliant submissions **would not be considered a *bona fide* attempt** to respond and advance prosecution in this *inter partes* reexamination proceeding. 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.

VIII. CONCLUSION

- Requester's February 5, 2010 petition under 37 CFR 1.183, entitled "PETITION FOR SUSPENSION OF RULE UNDER 37 CFR 1.183," requesting waiver of the requirements of 37 CFR 1.943(b), is **dismissed as moot**.

- Requester's February 24, 2010 petition under 37 CFR 1.182, entitled "PETITION UNDER 37 CFR 1.182 FOR REPLACEMENT OF PAPERS PREVIOUSLY SUBMITTED," is **dismissed as moot**.

- The January 6, 2010 patent owner response submission is **improper** and **will not be considered**. The patent owner response submission **will be expunged** by closing the papers in the '480 proceeding's Image File Wrapper (IFW) and by marking the papers "non-public." The January 6, 2010 patent owner submission will not constitute part of the record of the present reexamination proceeding.

- The requester's February 4 and February 5, 2010 comments submission is **improper** and will not be considered. The comments submission **will be expunged** by closing the papers in the '480 proceeding's Image File Wrapper

(IFW) and by marking the papers "non-public." The requester's February 4 and February 5, 2010 comments submission will not constitute part of the record of the present reexamination proceeding.

- If no response from the patent owner is received, the reexamination proceeding will be forwarded to the examiner for appropriate action.

- The October 9, 2009 power of attorney, statement under 37 CFR 3.73(b), and change of correspondence address for the patent owner is **ineffective.** A courtesy copy of this decision will be mailed to the address provided in the ineffective October 9, 2009 change of correspondence address.

- In the absence of a proper submission of a change of correspondence address for the patent owner in the patent file, application no. 10/160,022, all future correspondence in this reexamination proceeding will be mailed ONLY to the official correspondence address of record for the patent owner, i.e., the address of ANTONELLI, TERRY, STOUT & KRAUS, LLP, 1300 NORTH SEVENTEENTH STREET, SUITE 1800, ARLINGTON VA 22209-3873.

- Jurisdiction over this proceeding is returned to the Central Reexamination Unit (CRU). After the CRU has processed all party papers, or there are no such papers and the time for filing same has expired, the proceeding will be taken up for appropriate action.

- Telephone inquiries with regard to this decision should be directed to Joseph F. Weiss, Jr., Office of Patent Legal Administration, at (571) 272-7759.

Kenneth M. Schor

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration
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for Patent Examining Policy

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MAILED
FEB 22 2010
CENTRAL REEXAMINATION UNIT

Inter Partes Reexamination Proceeding	: **DECISION**
Control No. 95/000,481	: **GRANTING**
Filed: June 4, 2009	: **PETITION**
For: U.S. Patent No. 7,475,181	: **IN-PART**

This is a decision on the October 9, 2009 patent owner paper entitled "PETITION UNDER 37 CFR §§ 1.182 AND 1.183 TO DISMISS AND EXPUNGE AN IMPERMISSIBLE FILING FROM THE RECORD."

The petition under 37 CFR 1.182/1.183 is before the Office of Patent Legal Administration.

The patent owner petition is **granted in-part**, i.e., granted to the extent that waiver of 37 CFR 1.939 has been considered with respect to third party requester's petition, but is dismissed as to the underlying expungement relief requested therein.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 7,475,181 issued to Arai et al. on January 6, 2009 ("the '181 patent").

2. On June 4, 2009, a request for *inter partes* reexamination of the '181 patent was filed by a third party requester, which proceeding was assigned Control No. 95/000,481 ("the '481 proceeding").

3. On July 27, 2009, reexamination was ordered in the '481 proceeding.

4. On September 25, 2009, third party requester filed a paper in the '481 proceeding entitled "PETITION UNDER 37 C.F.R. §§ 1.182-1.183 TO RESOLVE CONTRADICTORY

EXAMINER FINDINGS IN COPENDING REEXAMINATION PROCEEDINGS" ("the requester petition under 37 CFR 1.182/1.183").

5. On October 9, 2009, the Office mailed the initial Office action on the merits in the '481 proceeding.

6. On October 9, 2009, patent owner filed the instant paper entitled "PETITION UNDER 37 CFR §§ 1.182 AND 1.183 TO DISMISS AND EXPUNGE AN IMPERMISSIBLE FILING FROM THE RECORD" ("the patent owner petition under 37 CFR 1.182/1.183").

DECISION

37 CFR 1.181 provides, 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;

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 2625 provides in-part:

> Pursuant to 37 CFR 1.939, after filing of a request for *inter partes* reexamination, no papers directed to the merits of the reexamination other than (A) citations of patents or printed publications under 37 CFR 1.501 and 1.933, (B) another complete request under 37 CFR 1.510 or 37 CFR 1.915, or (C) notifications pursuant to MPEP § 2686, should be filed with the Office prior to the date of the first Office action in the reexamination proceeding. Any papers directed to the merits of the reexamination, other than those under 37 CFR 1.501, 1.933, 1.510 or 1.915, or under MPEP § 2686, filed prior to the date of the first Office action will be returned to the sender without consideration. If the papers are entered prior to discovery of the impropriety, such papers will be expunged from the record. A copy of the letter providing notification of the returned papers or expungement will be made of record in the patent file. However, no copy of the returned/expunged papers will be retained by the Office. If the submission

> of the returned/expunged papers is appropriate later in the proceedings, they may be filed, and accepted by the Office, at that time.

Because requester's September 25, 2009 petition under 37 CFR 1.182/1.183 was filed prior to the initial Office action on the merits in the '481 proceeding, patent owner requests, in its October 9, 2009 petition under 37 CFR 1.182/1.183, that the requester's petition be dismissed and expunged from the record of the '481 proceeding as an improper paper pursuant to 35 U.S.C. 314(b) and 37 CFR 1.939.[1] 35 U.S.C. 314(b) provides, in part, that each time the patent owner files a response to an Office action on the merits, requester shall have one opportunity to file written comments addressing issues raised by the Office action or the patent owner's response thereto, and 37 CFR 1.939 provides, in part, "[u]nless otherwise authorized, no paper shall be filed prior to the initial Office action on the merits of the *inter partes* reexamination." Patent owner also asserts that requester's September 25, 2009 petition violates 35 U.S.C. 312(c), which states that a determination by the Director under 35 U.S.C. 312(a) regarding whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request shall be final and non-appealable.[2]

Patent owner's petition under 37 CFR 1.182/1.183 has been fully considered, and is granted to the extent that waiver of 37 CFR 1.939 has been considered with respect to authorizing entry of requester's September 25, 2009 petition. Based on the following, however, the requester's September 25, 2009 petition will not be expunged.

In view of the nature of the issues raised in the requester's September 25, 2009 petition under 37 CFR 1.182/1.183 regarding resolution of inconsistencies among co-pending reexamination proceedings, and in furtherance of special dispatch, this decision waives 37 CFR 1.939 to authorize entry of the requester's September 25, 2009 petition for consideration by the Central Reexamination Unit (CRU) as a petition requesting relief under 37 CFR 1.181. 37 CFR 1.181 permits petitions to be taken to the Director from any action or requirement of any examiner in the *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. Director review of requests for relief under 37 CFR 1.181 is not precluded by either 35 U.S.C. 314(b) or 35 U.S.C. 312(c). Thus, patent owner's petition under 37 CFR 1.182/1.183 is dismissed as to the underlying relief requested therein of dismissing and expunging the requester's September 25, 2009 petition under 37 CFR 1.182/1.183.

Because this decision makes the requester's September 25, 2009 petition under 37 CFR 1.182/1.183 an authorized paper in the '481 proceeding, the requester's September 25, 2009 petition will not be expunged from the record. Rather, jurisdiction over the '481 proceeding is remanded to the CRU to address the requester's September 25, 2009 petition pursuant to 37 CFR 1.181 for resolution of the issues raised therein.

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[1] Patent owner's petition under 37 CFR 1.182/1.183 at pages 1-2 and 5-6.
[2] Patent owner's petition under 37 CFR 1.182/1.183 at pages 3-5.

CONCLUSION

1. Patent owner's October 9, 2009 petition paper entitled "PETITION UNDER 37 CFR §§ 1.182 AND 1.183 TO DISMISS AND EXPUNGE AN IMPERMISSIBLE FILING FROM THE RECORD" is granted to the extent that waiver of 37 CFR 1.939 has been considered with respect to third party requester's petition. However, the patent owner petition is dismissed as to the underlying expungement relief requested therein.

2. This decision waives the provisions of 37 CFR 1.939 to authorize entry of the requester's September 25, 2009 petition filed under 37 CFR 1.182/1.183, for consideration by the Central Reexamination Unit (CRU) as a petition requesting relief under 37 CFR 1.181.

3. Jurisdiction over the '481 proceeding is remanded to the CRU to address the requester's September 25, 2009 petition as a petition under 37 CFR 1.181.

4. Telephone inquiries with regard to this decision should be directed to Nicole Dretar, Office of Patent Legal Administration, at (571) 272-7717.

Kenneth M. Schor

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

Kimpropa/IP
2-19-10

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,481	06/04/2009	7,475,181	379922-481RX (105402)	2075

37509 7590 06/04/2010

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/04/2010

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CENTRAL REEXAMINATION UNIT

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In re Arai *et al.*
Inter Partes Reexamination Proceeding
Control No.: 95/000,481
Filed: June 4, 2009
For: U.S. Patent No. 7,475,181

: **DECISION**
: **DISMISSING**
: **PETITION AND**
: ***SUA SPONTE***
: **EXPUNGING**
: **IMPROPER PAPERS**

This is a decision on requester's petition filed on February 10, 2010, entitled "PETITION FOR SUSPENSION OF RULE UNDER 37 CFR 1.183," for a concurrently filed response.

This decision also addresses the January 11, 2010 patent owner response, the February 4 and February 10, 2010 requester comments, and the October 9, 2009 power of attorney, statement under 3.73(b), and change of correspondence address of the patent owner.

The petition under 37 CFR 1.183, the January 11, 2010 patent owner response, the February 10, 2010 requester comments, the October 9, 2009 power of attorney, statement under 3.73(b), and change of correspondence address of the patent owner, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

A petition fee of $400 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR § 1.183 was charged to requester's Deposit Account No. 50-1283, as authorized by requester's EFS-WEB fee transmittal.

SUMMARY

The February 10, 2010 requester petition under 37 CFR 1.183 is **dismissed as moot**.

The January 11, 2010 patent owner response is **improper** and **will be expunged**. The February 4 and February 10, 2010 requester comments submission is **improper** and **will be expunged**. These papers will be expunged by closing the papers in the '481 proceeding's Image File Wrapper (IFW) and by marking the papers "non-public." These papers will not constitute part of the record of the present reexamination proceeding.

The October 9, 2009 power of attorney, statement under 3.73(b), and change of correspondence address of the patent owner is **ineffective**.

REVIEW OF RELEVANT FACTS

1. On January 6, 2009, the Office issued U.S. Patent No. 7,475,181 (the '181 patent) to Arai *et al.*

2. On June 4, 2009, a request for *inter partes* reexamination of the '181 patent was filed. The request was assigned Control No. 95/000,481 (the '481 proceeding).

3. On July 27, 2009, *inter partes* reexamination was ordered for the '481 proceeding and indicating that an Office action on the merits would issue in due course.

4. On October 9, 2009, the Office issued a non-final Office action on the merits in the '481 proceeding.

5. Also on October 9, 2009, patent owner submitted a paper entitled "Combined Revocation and Power of Attorney and Statements under 37 CFR §§ 3.73(b) & 3.71".

6. January 11, 2010, patent owner timely filed a response to the October 9, 2009 Office action without amendment to the claims.[1]

7. On February 4, 2010, the requester filed a paper entitled "Submission of Corrected Declarations", with accompanying declarations.

8. On February 10, 2010, the requester filed comments along with several declarations and exhibits and concurrently filed a petition entitled, "PETITION FOR SUSPENSION OF RULE UNDER 37 CFR 1.183," requesting suspension of 37 CFR § 1.948 and 1.943(b).

RELEVANT RULES AND GUIDANCE

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

[1] Patent owner was granted a thirty day extension of time to respond to the Office action.

> 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 1.52 states in pertinent part:

> (a) Papers that are to become a part of the permanent United States Patent and Trademark Office records in the file of a patent application or a reexamination proceeding.
>
> > (1) All papers, other than drawings, that are submitted on paper or by facsimile transmission, and are to become a part of the permanent United States Patent and Trademark Office records in the file of a patent application or reexamination proceeding, must be on sheets of paper that are the same size, not permanently bound together, and:
> >
> > *
> >
> > *.
> >
> > (v) Presented in a form having sufficient clarity and contrast between the paper and the writing thereon to permit the direct reproduction of readily legible copies in any number by use of photographic, electrostatic, photo-offset, and microfilming processes and electronic capture by use of digital imaging and optical character recognition.

37 CFR 1.182 states:

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

37 CFR 1.183 states:

> In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, sua sponte, or on petition of the interested party, subject to such other

requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.943 states in pertinent part:

(a) The form of responses, written comments, briefs, appendices, and other papers **must be in accordance with the requirements of § 1.52.** [Emphasis added]

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

37 CFR 1.947 states:

Each time the patent owner files a response to an Office action on the merits pursuant to § 1.945, a third party requester may once file written comments within a period of 30 days from the date of service of the patent owner's response. These comments shall be limited to issues raised by the Office action or the patent owner's response. The time for submitting comments by the third party requester may not be extended. For the purpose of filing the written comments by the third party requester, the comments will be considered as having been received in the Office as of the date of deposit specified in the certificate under § 1.8.

37 CFR 1.948 states:

(a) After the *inter partes* reexamination order, the third party requester may only cite additional prior art as defined under § 1.501 if it is filed as part of a comments submission under § 1.947 or § 1.951(b) and is limited to prior art:

(1) which is necessary to rebut a finding of fact by the examiner;

(2) which is necessary to rebut a response of the patent owner; or

(3) which for the first time became known or available to the third party requester after the filing of the request for *inter partes* reexamination proceeding. Prior art submitted under paragraph (a)(3) of this section must be accompanied by a statement as to when the prior art first became known or available to the third party requester and must include a discussion of the pertinency of each reference to the patentability of at least one claim.

MPEP 2666.05 II states in pertinent part:

> New prior art can be submitted with the comments only where the prior art (A) is necessary to rebut a finding of fact by the examiner, (B) is necessary to rebut a response of the patent owner, or (C) for the first time became known or available to the third party requester after the filing of the request for inter partes reexamination.
>
> As to item (A) above, 37 CFR 1.948(a)(1) permits the requester to provide new prior art rebutting the examiner's interpretation/finding of what the art of record shows. However, a statement in an Office action that a particular claimed feature is not shown by the prior art of record (which includes references that were cited by requester) does NOT permit the requester to then cite new art to replace the art originally advanced by requester. Such a substitution of a new art for the art of record is not a rebuttal of the examiner's finding that a feature in question is not taught by the art of record. Rather, such a substitution would amount to a rebuttal of a finding that a feature in question is not taught by any art in existence. A finding that the feature in question is not taught by any art in existence could not realistically be made for the reexamination proceeding, since the proceeding does not include a comprehensive validity search, and such was not envisioned by Congress as evidenced by the 35 U.S.C. 314(c) mandate that reexamination proceedings are to be conducted in the Office with special dispatch.[Emphasis added]
>
> As to item (B) above, 37 CFR 1.948(a)(2) permits the requester to provide a new proposed rejection, where such new proposed rejection is necessitated by patent owner's amendment of the claims. [Emphasis added]
>
> As to item (C) above, prior art submitted under 37 CFR 1.948(a)(3) must be accompanied by a statement that explains the circumstances as to when the prior art first became known or available to the third party requester, including the date and manner that the art became known or available, and why it was not available earlier. The submission must also include a discussion of the pertinency of each reference to the patentability of at least one claim.

MPEP 2667, subsection I A 2, provides, in pertinent part:

> Any affidavit or declaration (or a clearly defined portion thereof) that contains opinon(s) of the affiant/declarant, or argument(s) that the art either does or does not anticipate or render obvious the claims, or specific claim elements, of the patent under reexamination, is considered to be part of the comments submitted by the patent owner, or by the third party requester, and is subject to the page limit requirements of 37 CFR 1.943. Affidavits or declarations that are excluded from the

page limit requirements include, for example, declarations attempting to swear behind (antedate) the filing date of a reference, or to establish the date of a printed publication, or declarations that provide comparative test data and an analysis of same. However, if the patent owner's affidavit or declaration includes any argument as to how an outstanding/proposed rejection is overcome, then the page(s) of the affidavit or declaration upon which the argument appears would be included against of the page limit count. Likewise, if a third party requester affidavit or declaration includes any argument as to how a rejection is supported, then the page(s) of the affidavit or declaration upon which the argument appears would be included against of the page limit count. Similarly, attached exhibits presenting data or drawings are not included against the page limit count, unless an exhibit or drawing includes argument as to how the outstanding rejection is overcome. Any page(s) of the exhibit or sheet(s) of drawings that include such argument would be included against the page limit count.

DECISION

I. The January 11, 2010 Patent Owner Response Will Be *Sua Sponte* Expunged

On January 11, 2010, patent owner submitted a response containing a twenty-eight page single-spaced remarks section using a font size of less than 12 points.[2] Also, the declaration of Joseph D. Lamm (Exhibit N) is single-spaced. Patent owner's response must be in a form that ensures sufficient clarity and contrast for electronic capture and reproducibility without degradation, e.g., a font size of 12 points, one-and-a-half or double-spacing, and text written in a non-script type font, such as Arial, Times New Roman, or Courier. The current usage of a reduced font size and/or single line spacing impedes direct reproduction of readily legible copies in any number by use of photographic, electrostatic, photo-offset, and microfilming processes and electronic capture by use of digital imaging and optical character recognition, contrary to 37 CFR 1.52(a)(1)(v). See, generally, 37 CFR 1.943(a) and 37 CFR 1.52.

In addition, the declaration of Joseph D. Lamm (Exhibit N) contains legal arguments, legal analyses, and legal conclusions, which subject the Lamm declaration to the regulatory 50-page limit. For example, the Lamm declaration includes legal arguments and legal conclusions that one of ordinary skill would not have been motivated to combine the references cited in the examiner's rejections (see, e.g., paragraphs 14, 18, 20, 22-24, 26-30, and 32-34). Accordingly, the 16-page Lamm declaration is replete with legal argument and is subject to the regulatory 50-page limit.

Furthermore, the declaration of Joseph D. Lamm (Exhibit N) is single-spaced, and if formatted for the minimum one and a half line spacing, would be at least fifty percent longer. Currently the remarks section and the Lamm declaration combined

[2] The signature page is subject to the page count if it contains legal argument.

are 44 pages in length. Assuming a minimum one and a half line spacing and a 12-point font size, the two documents combined would be at least 66 pages in length, exceeding the 50–page limit established by 37 CFR 1.943(b).

Accordingly, for all the reasons set forth above, patent owner's January 11 2010 response submission, including the remarks, declarations, and exhibits, is **improper and will be *sua sponte* expunged.** The response submission will be expunged by closing the papers in the '481 proceeding's Image File Wrapper (IFW) and by marking the papers "non-public." The patent owner's January 11, 2010 response submission will not constitute part of the record of the present reexamination proceeding.

Because the January 11, 2010 patent owner response will not constitute part of the record of the present reexamination proceeding, the requester comments submission filed on February 4 and February 10, 2010 will not be considered. The February 4 and February 10, 2010 requester comments submission, however, is also improper and will be expunged, for reasons discussed *infra*.

II. The February 10, 2010 Requester Petition Under 37 CFR 1.183

Third party requester's petition under 37 CFR 1.183 requests waiver of 37 CFR 1.948(a) and 37 CFR 1.943(b). The February 4 and February 10, 2010 requester comments submission, however, will not be considered, because the January 11, 2010, patent owner response, to which the February 4 and February 10, 2010 requester comments submission are directed, is improper, will be expunged, and will not constitute part of the record of the present reexamination proceeding.

Accordingly, the February 10, 2010 requester petition under 37 CFR 1.183 to waive the provisions of 37 CFR 1.948(a) and 37 CFR 1.943(b) is **dismissed as moot**.

Even if a proper response to the October 9, 2009 Office action had been filed by the patent owner, however, the February 10, 2010 requester petition would not have been granted for the reasons discussed immediately below.

A. Waiver of 37 CFR 1.948 to present Printed Publication Rebuttal Evidence

The requester argues that justice requires entry of the Lesh declaration and accompanying exhibits, a rebuttal declaration by Jake Richter (exhibit A26) and accompanying exhibits, a declaration by Frans Tol and accompanying exhibit, and an article by Rob McCabe, which are apparently submitted to rebut the patent owner's arguments as to whether certain documents are printed publications. The requester further states that the rebuttal declaration by Jake Richter (exhibit A26), and accompanying exhibits are submitted to rebut the patent owner's declaration directed to commercial success.

On October 9, 2009 the examiner rejected the original claims using *inter alia* the AN442 reference in view of Moriconi, the AN442 reference in view of the VDDP reference and the Sony DDM reference in view of Moriconi. On January 11, 2010 patent owner filed, without amendment to the claims, a response that *inter alia* asserted that the AN442 reference, the VDDP reference and the Sony DDM reference cannot be used as a basis for rejecting the claims, because the references are not printed publications. On February 10, 2010 the requester filed a response that argues *inter alia* the AN442 reference, the VDDP reference and the Sony DDM reference are all available for use as prior art because they are printed publications. In support of the assertion, requester submits the above-discussed declarations with exhibits which are stated to contain support of the facts asserted within the declarations. The requester states that the documents are not being used to propose new rejections against the unamended claims, but only as evidence in rebuttal to patent owner's arguments that the references do not qualify as printed publications. Therefore, the references submitted with the declarations do not appear to constitute a submission of prior art that is contrary to the 37 CFR 1.948. For this reason, there would be no need for waiver of the rule under 37 CFR 1.183.

B. Waiver of 37 CFR 1.943(b)

Third party requester's petition under 37 CFR 1.183 requests waiver of the 50-page limit of 37 CFR 1.943(b) for the concurrently filed comments submission, including multiple declarations under 37 CFR 1.132. The February 4 and February 10, 2010 requester comments submission, however, will not be considered, because the January 11, 2010, patent owner response, to which the February 4 and February 10, 2010 requester comments are directed, is improper, will be expunged, and will not constitute part of the record of the present reexamination proceeding. Accordingly, the February 10, 2010 requester petition under 37 CFR 1.183 to waive the provisions of 37 CFR 1.943(b) is **dismissed as moot**.

Even if a proper response to the October 9, 2009 Office action had been submitted by the patent owner, however, the February 10, 2010 requester petition under 37 CFR 1.183 would not have been granted. Third party requester has not made an adequate showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b). Requester has provided no explanation of how the submitted response economizes, excludes extraneous material, and is arranged so as not to repeat information already of record. Requester has not demonstrated that efforts to be as brief as possible were taken to respond to patent owner's response and amendment. Even if one corrects for patent owner's single spaced twenty-eight page remarks section and 16-page single-spaced declaration of Joseph Lamm, submitted on January 11, 2010, the patent owner response submission is at most 66 pages in length, if the text were double spaced, and thus cannot provide justification for the requester to submit 145 pages as a comments submission (assuming the minimum one and a half line spacing, as discussed below).

Waiver of the rules under 37 CFR 1.183 may be suspended in an ***extraordinary situation when justice requires***. As noted above the requester undertook no effort to economize the response. Requester provides no other facts to establish an extraordinary situation where justice requires suspension of the rule to such an extreme degree of an additional 145 pages. The failure of requester to comply with the rules, in the form of submitting an economized set of comments in accordance with 37 CFR 1.943(b), does not rise to an ***extraordinary situation*** under 37 CFR 1.183 to justifying suspension of the rules. Therefore, justice would not require suspension of 37 CFR 1.943(b).

III. The February 4 and February 10, 2010 Requester Comments Submission

The February 4 and February 10, 2010 requester comments are **improper**, and **will be expunged**.

Submission of Corrected Declarations

On February 4, 2010, the requester filed a paper entitled "Submission of Corrected Declarations", accompanied by a declaration of Jake Richter, dated February 1, 2010 ("the corrected Richter declaration"), and a declaration of Tom Ryan, dated February 2, 2010 (collectively, "the corrected declarations"). The requester states that the corrected declarations were filed to address issues under 37 CFR 1.68 raised by the examiner in the first Office action, regarding the declaration of Jake Richter and the declaration of Tom Ryan (collectively, "the original declarations"), which were attached as exhibits to the June 4, 2009 request for *inter partes* reexamination. The requester further states that the corrected declarations "differ from the [o]riginal [d]eclarations only in the first and final paragraphs of the declarations" which were added to comply with the requirements of 37 CFR 1.68, that none of the numbered paragraphs in the declarations have been changed, and that the corrected declarations are being submitted without the exhibits to which the corrected declarations, and the original declarations, each separately refer, because the exhibits also have not been changed.[3]

The Ryan and Richter declarations that were submitted with the original, and with the corrected, request for reexamination, however, were not in proper form and thus were not considered by the examiner, as pointed out by the examiner on pages 4-5 of the first Office action. These declarations, in their corrected (proper) form, if filed with a proper requester comments submission as will be discussed *infra*, will be reviewed and addressed by the examiner for the first time in the next Office action. The corrected declaration of Jake Richter includes legal argument, legal analyses, and legal conclusions, as to how a rejection of the claims is supported, causing the declaration to be subject to the 50-page length requirement for requester comments,

[3] See the paragraph bridging the first and second pages of the February 4, 2010 paper entitled "Submission of Corrected Declarations".

pursuant to 37 CFR 1.943(b),[4] as will be explained in detail *infra*. See MPEP 2667. The corrected declaration of Tom Ryan, filed on February 2, 2010, is directed to subject matter that is not subject to the 50-page regulatory limit. However, because the corrected Richter declaration was not submitted in proper form under 37 CFR 1.68 until it was filed on February 4, 2010, and because the corrected Richter declaration is directed to subject matter that causes the declaration to be subject to the 50-page length requirement, the pages of the corrected Richter declaration, if later submitted with a corrected requester submission, would be counted toward the 50-page limit.

The February 10, 2010 Requester Comments Submission

On February 10, 2010, requester submitted comments that included a thirty-seven (37) page single-spaced remarks section, apparently using a font size of less than 12 points.[5] The remarks section of requester's comments is subject to the 50-page limit set forth in 37 CFR 1.943(b). Additionally, any declaration containing legal arguments, legal analyses, or legal conclusions will result the declaration being subjected to the regulatory 50-page limit. Accordingly, third party requester's February 10, 2010 comments submission, including declarations within which such arguments appear, exceeds the 50-page limit set forth in 37 CFR 1.943(b), for the reasons discussed *infra*. See MPEP 2667(I)(A)(2).

Requester's February 10, 2010 response to patent owner's January 11, 2010 comments consists of a total of forty-one (41) pages of a single spaced remarks section, an eight (8) page claim chart "AJ" designated as Exhibit A33, and multiple exhibits[6] which includes five declarations under 37 CFR 1.132, totaling sixty-seven (67) double spaced pages and twelve (12) singe spaced pages, and broken down across the five declarations as follows: (1) Exhibit A13 contains a two page single spaced declaration by Frans Tols; (2) Exhibit A14 contains a thirty-seven (37) double spaced declaration by Jake Richter; (3) Exhibit A16 contains a nineteen (19) page double spaced declaration by Tom Ryan; (4) Exhibit A26 contains a ten (10)

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[4] In determining whether an affidavit or declaration under 37 CFR 1.132 is subject to the 50-page length requirement under 37 CFR 1.943(b), the Office analyzes whether the affidavit or declaration is providing factual evidence, i.e., evidence of *technological* facts, or whether the affidavit or declaration is merely an extension of the arguments of counsel.[4] Factual evidence includes declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results. Where the affidavit or declaration includes arguments containing legal analysis or legal conclusions, including arguments that the claims are patentable or unpatentable, or are directed to how an outstanding or proposed rejection is overcome, or, in the case of a declaration filed by the requester, how an outstanding or proposed rejection is supported, the affidavit or declaration is subject to the 50-page length requirement. The corrected Richter declaration is replete with such arguments. For this reason, the entire declaration is subject to the 50-page length requirement.

[5] The three-page listing entitled "Attachments" (see pages 39-41 of the February 10, 2010 requester comments) is not considered as part of the substantive portion of the remarks. The signature page, if it does not contain legal argument, is also not subject to the page count.

[6] Several of the exhibits containing declarations included secondary exhibits providing documents which were stated to be submitted as support for the facts asserted in the declarations.

page single spaced declaration also executed by Jake Richter; and (5) Exhibit A27 contains an eleven (11) page double spaced declaration executed by David Lesh.[7] The A13, A16 and A27 declarations were reviewed and found free of improper legal argument.

The remarks section is forty-one (41) single spaced pages in length and includes a signature page and a three page appendix listing all the attached exhibits, which are exclusive of argument. Therefore, thirty-seven (37) pages of the remarks section contain substantive argument, which are subject to the regulatory fifty (50) page limit.

The A14 declaration contains legal arguments, legal analyses, and legal conclusions. For example, page 16, paragraph 40, argues that the VDDP document is a printed publication.[8] Page 18, paragraph 46, pages 28 and 34, header no. 2, page 29, paragraph 83, page 30-31, paragraph 90, page 35, paragraph 104, and page 36, paragraph 106 undertake a 35 U.S.C. 112, sixth paragraph analysis of claim language. Page 20, paragraph 55, and page 24, paragraph 67, assert the legal conclusion of obviousness etc. The corrected Richter declaration, dated February 1, 2010, which accompanied the February 4, 2010 paper entitled "Submission of Corrected Declarations", similarly contains legal arguments, legal analyses, and legal conclusions.[9] Accordingly, the A14 declaration and the corrected Richter declaration which accompanied the February 4, 2010 paper entitled "Submission of Corrected Declarations" are replete with legal argument and are subject to the regulatory fifty (50) page limit.

The A26 declaration contains legal arguments, legal analyses and legal conclusions. See, for example, pages 1-2, paragraph 8 (bridging text) in which declarant asserts the current legal standard for obviousness; page 4, paragraphs 24-25, page 5, paragraphs 29-30, page 7-8, paragraph 42, page 8, paragraph 47 and page 9, paragraphs 48-49 where declarant renders multiple legal opinions, legal arguments and legal conclusions that the claimed invention is "obvious" under the "*KSR* standard." Accordingly, the A26 declaration is replete with legal argument and is subject to the regulatory fifty (50) page limit.

The eight (8) page claim chart "AJ", designated by requester as Exhibit A33, was created by patent owner for litigation in asserting a claim of infringement in civil proceedings. Requester originally submitted claim chart "AJ" as exhibit 13 to the

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[7] All declarations will be referred to by their exhibit number.

[8] Pursuant to MPEP 2667, subsection I A 2, affidavits or declarations solely containing factual evidence directed to establishing the date of a printed publication are not subject to the page limit requirement. In the present case, however, the requester is not presenting factual evidence directed to establishing the date of a printed publication. Rather, the requester is presenting legal argument and legal analyses to postulate a legal conclusion that the VDDP document is a printed publication.

[9] The corrected Richter declaration may or may not be identical to the declaration of Jake Richter submitted in Exhibit A14. The requester has not filed any statement to this effect. Furthermore, the requester states in the paper entitled "Submission of Corrected Declarations" that the corrected Richter declaration is submitted without exhibits. The Richter declaration in Exhibit A14, however, is submitted with exhibits.

original request for reexamination of the '181 patent. Claim chart "AJ" is replete with legal argument, however requester is submitting claim chart "AJ" as proof of patent owner admissions and not for the substance of the legal argument. Therefore claim chart "AJ" as exhibit A33, which is submitted with the February 4 and February 10, 2010 comments submission, is not subject to the regulatory 50-page limit.

Thus, thirty-seven (37) pages of the remarks section, thirty-seven (37) pages of the A14 declaration, 37 pages of the corrected Richter declaration, and the (10) pages of the A26 declaration are all subject to the 50-page regulatory limit for the requester's response. The remarks section and the A26 declaration are both single spaced and if formatted for the minimum requirement of one and one-half line spacing they would be at least fifty percent longer. Currently the remarks section and the A26 declaration combined are 47 pages in length, single spaced. Assuming one and a half line spacing the two documents combined would be at least 71 pages in length. The A14 declaration and the corrected Richter declaration are already in a proper line spacing format and at a length of 74 pages. Therefore, *in toto* requester's has submitted substantive comments of 145 pages, exceeding the 50–page limit established by 37 CFR 1.943(b) by a total of 95 pages.

Accordingly, for all the reasons set forth above, requester's February 4 and February 10, 2010 comments submission, including the remarks, declarations, and exhibits, is **improper and will be expunged**. The comments submission will be expunged by closing the papers in the '481 proceeding's Image File Wrapper (IFW) and by marking the papers "non-public." The requester's February 4 and February 10, 2010 comments submission will not constitute part of the record of the present reexamination proceeding.

IV. Guidance for Resubmission of Papers

Patent Owner

Any response by patent owner to the outstanding Office action must be filed within **15 days** from the mail date of this decision, and must comply with the provisions of 37 CFR §§ 1.943 and 1.52, also as set forth in this decision. **This 15-day period is not extendable.**

Requester

Any comments by the requester filed in reply to patent owner's response must be filed within **30 days** from the date of service of patent owner's response, and must comply with the provisions of 37 CFR §§ 1.943 and 1.52, also as set forth in this decision. **This 30-day period is not extendable.**

General Comments

Any patent owner response or requester comments submission that exceeds the regulatory 50-page limit must be accompanied by a petition under 37 CFR 1.183 that

provides sufficient specificity as to the extraordinary circumstances that justify waiver of the 50-page length requirement.

To obtain a waiver of the 50-page length requirement of 37 CFR 1.943(b), any grantable petition under 37 CFR 1.183 must be accompanied by a patent owner response submission or a requester comments submission that:

1) is double-spaced;
2) is in a non-script type font (e.g., Arial, Times New Roman, or Courier);
3) has a font size no smaller than 12-point;
4) conforms to the margin requirements of 37 CFR 1.52(a)(1)(ii); and
5) has sufficient clarity and contrast to permit direct reproduction of readily legible copies in any number by use of photographic, electrostatic, photo-offset, and microfilming processes and electronic capture by digital imaging and optical character recognition pursuant to 37 CFR § 1.52(a)(1)(v).

See, generally, 37 CFR 1.943(a) and 37 CFR 1.52.

In accordance with 37 CFR 1.903, any paper submitted pursuant to this decision must be served on every other party in the reexamination proceeding.

If no response from the patent owner is received, the reexamination proceeding will be forwarded to the examiner for appropriate action, without entry of any written comments (and attachments) filed by the requester.

In general the parties should avoid the insertion of lengthy block quotes and figures and instead cite to the relevant portion(s) of the document(s) of record that contain the quoted text or figures. The merits of the case does not contain any unique and/or inordinately complex legal issues, but instead consists of common issues of patent law that arise in many patent examination proceedings, e.g. anticipation, obviousness or availability of a reference to serve as prior art, etc. Therefore no need exists for extensive stand alone sections regarding the current state of the law. Citations to the relevant section(s) of the Manual of Patent Examining Procedure (MPEP) along with supplemental citation to the most current on point case law, if necessary, as requester argues the merits of the case is sufficient for purposes of a reexamination proceeding. Finally, the parties need not restate the full legal analysis and rationale for each rejection. For purposes of brevity the parties can simply cite to the examiner's rejection or patent owner's response and add comments deemed appropriate to then raise the relevant points of contention, in order to efficiently identify the rejections and present arguments.

V. The October 9, 2009 Power of Attorney, Statement under 37 CFR 3.73(b), and Change of Correspondence Address is Ineffective

The October 9, 2009 power of attorney, statement under 37 CFR 3.73(b) and change of correspondence address for the patent owner are **ineffective**, because they do not comply

with 37 CFR 1.5(a) and 37 CFR 1.4(c). Each paper must separately identify, on the top page in a conspicuous location, the control number of the proceeding. 37 CFR 1.5(a). Furthermore, a power of attorney, statement under 3.73(b), and change of correspondence address must be submitted as a separate paper in each application or reexamination proceeding to which it relates. 37 CFR 1.4(c).

In addition, the official correspondence address for the patent owner in a reexamination proceeding is the correspondence address as recorded in the patent file. See 37 CFR 1.33(c) and MPEP 2622. Office records fail to reveal that a change of correspondence address was received in the patent file, application no. 10/160,056. In the present case, the official correspondence address of record for the patent owner as recorded in the patent file is that of ANTONELLI, TERRY, STOUT & KRAUS, LLP, 1300 NORTH SEVENTEENTH STREET, SUITE 1800, ARLINGTON VA 22209-3873.

A courtesy copy of this decision will be mailed to the correspondence address indicated on the October 9, 2009 power of attorney, statement under 37 CFR 3.73(b), and change of correspondence address for the patent owner. In the absence of a proper submission of a change of correspondence address for the patent owner in the patent file, application no., 10/160,056, however, all future correspondence in this reexamination proceeding will be mailed ONLY to the official correspondence address of record for the patent owner, i.e., the address of ANTONELLI, TERRY, STOUT & KRAUS, LLP, 1300 NORTH SEVENTEENTH STREET, SUITE 1800, ARLINGTON VA 22209-3873.

VI. ADDITIONAL COMMENTS

Both parties are on specific notice as to the format and font requirements as set forth in this decision for the submission of responses and comments for an *inter partes* reexamination proceeding when a waiver of the 50-page length requirement of 37 CFR 1.943(b) is sought. Accordingly, any subsequent noncompliant submissions may not be considered, and may be expunged **without** an opportunity for resubmission, because such noncompliant submissions **would not be considered a *bona fide* attempt** to respond and advance prosecution in this *inter partes* reexamination proceeding. 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.

VII. CONCLUSION

- Requester's February 5, 2010 petition under 37 CFR 1.183, entitled "PETITION FOR SUSPENSION OF RULE UNDER 37 CFR 1.183," requesting waiver of the requirements of 37 CFR 1.948(a) and 1.943(b), is **dismissed as moot**.

- The January 11, 2010 patent owner response submission is **improper** and **will not be considered**. The patent owner response submission **will be expunged** by

closing the papers in the '481 proceeding's Image File Wrapper (IFW) and by marking the papers "non-public." The January 11, 2010 patent owner submission will not constitute part of the record of the present reexamination proceeding.

- The requester's February 4 and February 10, 2010 comments submission is **improper** and will not be considered. The comments submission **will be expunged** by closing the papers in the '481 proceeding's Image File Wrapper (IFW) and by marking the papers "non-public." The requester's February 4 and 10, 2010 comments submission will not constitute part of the record of the present reexamination proceeding.

- If no response from the patent owner is received, the reexamination proceeding will be forwarded to the examiner for appropriate action.

- The October 9, 2009 power of attorney, statement under 37 CFR 3.73(b), and change of correspondence address for the patent owner is **ineffective** A courtesy copy of this decision will be mailed to the address provided in the ineffective October 9, 2009 change of correspondence address.

- In the absence of a proper submission of a change of correspondence address for the patent owner in the patent file, application no. 10/160,056, all future correspondence in this reexamination proceeding will be mailed ONLY to the official correspondence address of record for the patent owner, i.e., the address of ANTONELLI, TERRY, STOUT & KRAUS, LLP, 1300 NORTH SEVENTEENTH STREET, SUITE 1800, ARLINGTON VA 22209-3873.

- Jurisdiction over this proceeding is returned to the Central Reexamination Unit (CRU). After the CRU has processed all party papers, or there are no such papers and the time for filing same has expired, the proceeding will be taken up for appropriate action.

- Telephone inquiries with regard to this decision should be directed to Joseph F. Weiss, Jr., Office of Patent Legal Administration, at (571) 272-7759.

Kenneth M. Schor

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examining Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,482	06/09/2009	7,176,489	160151-0008	6380

30827 7590 11/03/2009

MCKENNA LONG & ALDRIDGE LLP
1900 K STREET, NW
WASHINGTON, DC 20006

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/03/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

DO NOT USE IN PALM PRINTER

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
BABAK REDJAIAN
840 NEWPORT CENTER DR.
SUITE 400
NEWPORT BEACH, CA 92660

Date:

MAILED

NOV 03 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000482
PATENT NO. : 7176489
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,483	06/08/2009	7176489	160151-0006	9949

30827 7590 11/03/2009

MCKENNA LONG & ALDRIDGE LLP
1900 K STREET, NW
WASHINGTON, DC 20006

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/03/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
BABAK REDJAIAN, IRELL & MANELLA LLP
840 NEWPORT CENTER DRIVE
SUITE 400
NEWPORT BEACH, CA 92660

Date: MAILED

NOV 0 3 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009483
PATENT NO. : 7176489
ART UNIT : 3992

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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NOV 03 2009

CENTRAL REEXAMINATION UNIT

Birch Stewart Kolasch & Birch
P.O. Box 747
Falls Church, VA 22040-0747

(For Patent Owner)

Babak Redjaian
IRELL & MANELLA LLP
840 Newport Center Drive
Suite 400
Newport Beach, CA 92660

(For *Ex Parte & Inter Partes* Requester)

McKenna Long & Aldridge LLP
1900 K Street, N.W.
Washington, D.C. 20006

(Courtesy Copy)

Ex parte Reexamination Proceeding
Control No. 90/009,483
Filed: June 8, 2009
For: U.S. Patent No. 7,176,489

Inter Partes Reexamination Proceeding
Control No. 95/000,482
Filed: June 9, 2009
For: U.S. Patent No. 7,176,489

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. 7,176,489 (the '489 patent) issued to Ahn *et al.* on February 13, 2007.

2. A request for *ex parte* reexamination of claims 1-3 of the '489 patent was filed on June 8, 2009 by Chi Mei Optoelectronics, and the request was assigned control number 90/009,483 (the '9483 *ex parte* proceeding).

3. A request for *inter partes* reexamination of claims 1-3 of the '489 patent was filed on June 9, 2009, in which Chi Mei Optoelectronics Corporation was identified as the real party in interest, and the request was assigned control number 95/000,482 (the '482 *inter partes* proceeding).

4. On August 7, 2009, *ex parte* reexamination was ordered for claims 1-3 of the '489 patent based on the examiner's determination that the June 8, 2009 request raised a substantial new question of patentability affecting these claims.

5. Also on August 7, 2009, *inter partes* reexamination was ordered for claims 1-3 of the '489 patent based on the examiner's determination that the June 9, 2009 request raised a substantial new question of patentability affecting these claims.

6. On September 4, 2009, patent owner filed a "Reexamination – Patent Owner Power of Attorney or Revocation of Power of Attorney With a New Power of Attorney and Change of Correspondence Address" in both the '9483 *ex parte* proceeding and the '482 *inter partes* proceeding.

7. On September 18, 2009, the Office mailed a "Notice of Acceptance of Power of Attorney" in the '9483 *ex parte* proceeding.

DECISION

I. MERGER OF PROCEEDINGS

37 CFR 1.989 provides:

> (a) If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the merged examination will normally result in the issuance of a single reexamination certificate under § 1.997.
>
> (b) An *inter partes* reexamination proceeding filed under § 1.913 which is merged with an *ex parte* reexamination proceeding filed under § 1.510 will result in the merged proceeding being governed by §§ 1.902 through 1.997, except that the rights of any third party requester of the *ex parte* reexamination shall be governed by §§ 1.510 through 1.560.

As evidenced by the above review of the facts, both the '9483 and the '482 reexamination proceedings are currently pending. An order granting reexamination of claims 1-3 of the '489 patent has been mailed in each of the reexamination proceedings, and a decision under 37 CFR 1.989 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, (1) to provide a comprehensive examination of the patent based on the issues raised in both proceedings, and (3) to expedite prosecution of both proceedings. In the present instance, merger of the '9483 and the '482 reexamination proceedings would address these considerations. Thus, pursuant to 37 CFR 1.989, the 90/009,483 and 95/000,482 proceedings are hereby 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 both proceedings. The patent owner is required to maintain the same claims (and specification) in both files *throughout the merged proceeding*.

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

The present decision merges an *ex parte* reexamination proceeding with an *inter partes* reexamination proceeding. Pursuant to 37 CFR 1.989(b), the merged proceeding is governed by 37 CFR 1.902 through 1.997, except that the rights of the third party requester of the *ex parte* reexamination are governed by 37 CFR 1.510 through 1.560. In this instance, however, the '9483 *ex parte* reexamination proceeding was requested by the same third party that requested the *inter partes* reexamination, and that third party (Chi Mei Optoelectronics Corporation) has full *inter partes* reexamination participation rights.

B. Papers mailed/filed:

All papers mailed by the Office throughout the merged proceeding will take the form of a single action which applies to both proceedings. All papers issued by the Office, or filed by the patent owner and the third party requester(s), will contain the identifying data for both proceedings 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 proceedings, for entry into each file.

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

By EFS-Web: Registered users may submit the response via the electronic filing system EFS-Web.

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

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

C. Amendments:

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

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

Pursuant to 37 CFR 1.530(i), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the request for reexamination. *Amendments are not to be made relative to previous 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.

PATENT OWNER'S ADDRESS

The patent owner is called upon to coordinate the proper correspondence addresses in (1) the patent, (2) the '9483 proceeding and (3) the '482 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 Birch, Stewart, Kolasch & Birch, P.O. Box 747, Falls Church, VA 22040-0747. Accordingly, all future correspondence will be directed to Birch, Stewart, Kolasch & Birch, P.O. Box 747, Falls Church, VA 22040-0747, unless, within ONE (1) MONTH of this decision, patent owner changes the correspondence address of record in the patent (the same address should be made of record in the reexamination proceedings).

The "Notice of Acceptance of Power of Attorney" mailed on September 18, 2009, in the '9483 proceeding was in error to the extent it indicated that correspondence would be mailed to McKenna Long & Aldridge LLP, 1900 K Street, N.W., Washington, D.C. This is because the patent owner did not change the correspondence address of the patent file (U.S. Patent No. 7,176,489, Application No. 10/872,527) to the correspondence address provided in the paper filed September 4, 2009. Patent owner may wish to consider filing form PTO/SB123A, **filed in duplicate** (with identifying data for both proceedings as discussed above in section III.B.), together with form PTO/SB/123 in the patent file.

As a courtesy, this decision is being mailed to both addresses. However, as pointed out above, the address of Birch, Stewart, Kolasch & Birch, P.O. Box 747, Falls Church, VA 22040-0747, will be used in future correspondence, unless the address of record is changed as set forth above.

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/000,482 and *ex parte* Reexamination Control No. 90/009,483 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

2. Patent owner is provided with **ONE (1) MONTH** from the mailing of this decision to file papers to address the correspondence address considerations in both proceedings, as set forth in the last section of this decision.

3. Jurisdiction over the merged reexamination files is being forwarded via the Director of the Central Reexamination Unit (CRU) to the examiner for preparation of an Office action, to be issued in due course for the merged proceeding. The examiner should not issue an Office action for the present merged proceeding until after the earlier of:

   (A) The expiration of the one month period set for filing the papers addressing the correspondence address in both proceedings, or

   (B) The receipt of such papers.

4. Any questions concerning this communication should be directed to Eugenia A. Jones, Senior Legal Advisor, at 571-272-7727.

Pinchus M. Laufer
Legal Advisor
Office of Patent Legal Administration

11-3-09

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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Birch Stewart Kolasch & Birch
P.O. Box 747
Falls Church, VA 22040-0747

(For Patent Owner)

Babak Redjaian
IRELL & MANELLA LLP
840 Newport Center Drive
Suite 400
Newport Beach, CA 92660

(For *Ex Parte* & *Inter Partes* Requester)

MAILED
NOV 04 2009
CENTRAL REEXAMINATION UNIT

McKenna Long & Aldridge LLP
1900 K Street, N.W.
Washington, D.C. 20006

(Courtesy Copy)

Ex parte Reexamination Proceeding
Control No. 90/009,482
Filed: June 8, 2009
For: U.S. Patent No. 6,815,321

Inter Partes Reexamination Proceeding
Control No. 95/000,483
Filed: June 9, 2009
For: U.S. Patent No. 6,815,321

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. 6,815,321 (the '321 patent) issued to Ahn *et al.* on November 9, 2004.

2. A request for *ex parte* reexamination of claims 7-10, 12, 14, 16-20 and 22 of the '321 patent was filed on June 8, 2009 by Chi Mei Optoelectronics, and the request was assigned control number 90/009,482 (the '9482 *ex parte* proceeding).

3. A request for *inter partes* reexamination of claims 7-10, 12, 14, 16-20 and 22 of the '321 patent was filed on June 9, 2009, in which Chi Mei Optoelectronics Corporation was identified as the real party in interest, and the request was assigned control number 95/000,483 (the '483 *inter partes* proceeding).

4. On August 7, 2009, *ex parte* reexamination was ordered for claims 7-10, 12, 14, 16-20 and 22 of the '321 patent based on the examiner's determination that the June 8, 2009 request raised a substantial new question of patentability affecting these claims.

5. Also on August 7, 2009, *inter partes* reexamination was ordered for claims 7-10, 12, 14, 16-20 and 22 of the '321 patent based on the examiner's determination that the June 9, 2009 request raised a substantial new question of patentability affecting these claims.

6. On September 4, 2009, patent owner filed a "Reexamination – Patent Owner Power of Attorney or Revocation of Power of Attorney With a New Power of Attorney and Change of Correspondence Address" in both the '9482 *ex parte* proceeding and the '483 *inter partes* proceeding.

7. On September 18, 2009, the Office mailed a "Notice of Acceptance of Power of Attorney" in the '483 *inter partes* proceeding.

DECISION

I. MERGER OF PROCEEDINGS

37 CFR 1.989 provides:

> (a) If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the merged examination will normally result in the issuance of a single reexamination certificate under § 1.997.
>
> (b) An *inter partes* reexamination proceeding filed under § 1.913 which is merged with an *ex parte* reexamination proceeding filed under § 1.510 will result in the merged proceeding being governed by §§ 1.902 through 1.997, except that the rights of any third party requester of the *ex parte* reexamination shall be governed by §§ 1.510 through 1.560.

As evidenced by the above review of the facts, both the '9482 and the '483 reexamination proceedings are currently pending. An order granting reexamination of claims 7-10, 12, 14, 16-20 and 22 of the '321 patent has been mailed in each of the reexamination proceedings, and a decision under 37 CFR 1.989 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, (1) to provide a comprehensive examination of the patent based on the issues raised in both proceedings, and (3) to expedite prosecution of both proceedings. In the present instance, merger of the '9482 and the '483 reexamination proceedings would address these considerations. Thus, pursuant to 37 CFR 1.989, the 90/009,482 and 95/000,483 proceedings are hereby 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 both proceedings. The patent owner is required to maintain the same claims (and specification) in both files *throughout the merged proceeding*.

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

The present decision merges an *ex parte* reexamination proceeding with an *inter partes* reexamination proceeding. Pursuant to 37 CFR 1.989(b), the merged proceeding is governed by 37 CFR 1.902 through 1.997, except that the rights of the third party requester of the *ex parte* reexamination are governed by 37 CFR 1.510 through 1.560. In this instance, however, the '9482 *ex parte* reexamination proceeding was requested by the same third party that requested the *inter partes* reexamination, and that third party (Chi Mei Optoelectronics Corporation) has full *inter partes* reexamination participation rights.

B. Papers mailed/filed:

All papers mailed by the Office throughout the merged proceeding will take the form of a single action which applies to both proceedings. All papers issued by the Office, or filed by the patent owner and the third party requester(s), will contain the identifying data for both proceedings 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 proceedings, for entry into each file.

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

By EFS-Web: Registered users may submit the response via the electronic filing system EFS-Web.

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

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

C. Amendments:

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

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

Pursuant to 37 CFR 1.530(i), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the request for reexamination. *Amendments are not to be made relative to previous 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.

PATENT OWNER'S ADDRESS

The patent owner is called upon to coordinate the proper correspondence addresses in (1) the patent, (2) the '9482 proceeding and (3) the '483 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 Birch, Stewart, Kolasch & Birch, P.O. Box 747, Falls Church, VA 22040-0747. Accordingly, all future correspondence will be directed to Birch, Stewart, Kolasch & Birch, P.O. Box 747, Falls Church, VA 22040-0747, unless, within ONE (1) MONTH of this decision, patent owner changes the correspondence address of record in the patent (the same address should be made of record in the reexamination proceedings).

The "Notice of Acceptance of Power of Attorney" mailed on September 18, 2009, in the '483 proceeding was in error to the extent it indicated that correspondence would be mailed to McKenna Long & Aldridge LLP, 1900 K Street, N.W., Washington, D.C. This is because the patent owner did not change the correspondence address of the patent file (U.S. Patent No. 6,815,321, Application No. 10/377,732) to the correspondence address provided in the paper filed September 4, 2009. Patent owner may wish to consider filing form PTO/SB123A, **filed in duplicate** (with identifying data for both proceedings as discussed above in section III.B.), together with form PTO/SB/123 in the patent file.

As a courtesy, this decision is being mailed to both addresses. However, as pointed out above, the address of Birch, Stewart, Kolasch & Birch, P.O. Box 747, Falls Church, VA 22040-0747, will be used in future correspondence, unless the address of record is changed as set forth above.

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/000,483 and *ex parte* Reexamination Control No. 90/009,482 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

2. Patent owner is provided with **ONE (1) MONTH** from the mailing of this decision to file papers to address the correspondence address considerations in both proceedings, as set forth in the last section of this decision.

3. Jurisdiction over the merged reexamination files is being forwarded via the Director of the Central Reexamination Unit (CRU) to the examiner for preparation of an Office action, to be issued in due course for the merged proceeding. The examiner should not issue an Office action for the present merged proceeding until after the earlier of:

   (A) The expiration of the one month period set for filing the papers addressing the correspondence address in both proceedings, or

   (B) The receipt of such papers.

4. Any questions concerning this communication should be directed to Eugenia A. Jones, Senior Legal Advisor, at 571-272-7727.

Pinchus M. Laufer
Legal Advisor
Office of Patent Legal Administration

11-3-09

UNITED STATES PATENT AND TRADEMARK OFFICE

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JUN 11 2010

CENTRAL REEXAMINATION UNIT

COMMISSIONER FOR PATENTS
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FITZPATRICK CELLA HARPER & SCINTO (For Patent Owner)
1290 Avenue of the Americas
NEW YORK NY 10104-3800

ORRICK, HERRINGTON & SUTCLIFFE, LLP (For Third Party Requester)
IP PROSECUTION DEPT.
4 Park Plaza, Suite 1600
Irvine, CA 92614-2558

In re Gerstel *et al.*
Inter Partes Reexamination Proceeding
Control No.: 95/000,485
Filed: July 6, 2009
For: U.S. Patent No.: 7,369,772 B2

DECISION GRANTING PETITION

This is a decision on third party requester's March 17, 2010 paper filed as a petition under 37 CFR 1.182, (the "petition").[1]

The petition and the 95/000,485 *inter partes* reexamination proceeding are before the Office of Patent Legal Administration for consideration.

The petition is GRANTED.

FEES

A petition fee of $ 400.00 (37 CFR 1.17(f)) was charged to Deposit Account No. 50-0665 as authorized in the last paragraph of the one page petition filed on March 17, 2010.

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).

[1] Requester filed a cover letter to a second filing (corrected copy) of responsive comments on the same day explaining the need for a corrected copy and at the end of the letter stated that if necessary the cover letter could be taken as a petition invoking 37 CFR 1.182. The present petition is a principal petition seeking relief, and is addressing neither patent owner's March 31, 2010 petition nor requester's April 8, 2010 opposition to patent owner's petition.

II. Relief Requested by Third Party Requester

A review of the record shows that the Office mailed a first Office action addressing claim patentability on September 25, 2009. On November 25, 2009, patent owner filed a timely response to the September 25, 2009 Office action. On December 29, 2009, third party requester filed written comments after the Office action and patent owner's response. On March 2, 2010, the Office issued a notice of defective third party comments noting that the comments introduced new prior art, and proposed rejections thereon, contrary to the regulatory requirements of 37 CFR 1.948. Third party requester was given a non-extendable time period of 15 days to submit redrafted comments, compliant with all relevant regulations.[2]

On March 17, 2010, third party requester filed redrafted first set of comments, as a response to the March 2, 2010 Office notice. Also on March 17, 2010 third party requester submitted a second set of redrafted comments as a response to the March 2, 2010 Office notice, the submission being denominated as "corrected comments." Concurrently with the submission of the "corrected comments," third party requester submitted the present petition to support the requested relief of accepting the "corrected comments" as responsive comments of record and requesting that the first set of comments be expunged from the record. Third party requester asserts in the petition the "corrected comment" submission is substantively identical to the first set of comments, and the "corrected comment" submission is merely resolving typographical errors. Patent owner, on March 31, 2010, filed a petition under 37 CFR 1.181 requesting denial of entry of third party requester's March 17, 2010 comments, both the first set of comments and the "corrected comments." On April 8, 2010, third party requester filed an opposition to patent owner's March 31, 2010 petition.

The relief requested by third party requester in the present petition is to correct the record in the Image File Wrapper (IFW) of the '485 *inter partes* reexamination proceeding by substituting "corrected comments" for the first set of comments filed on March 17, 2010, that also appear in the IFW of the '485 *inter partes* reexamination proceeding.

III. Analysis and Findings

Upon a review of the "corrected comments" and the "first set" of comments filed by third party requester on March 17, 2010, the two comment sets appear substantially identical. Third party requester has stated the "corrected comments" rectify typographical errors when referencing figures, *etc., e.g.* page 15 first line referencing figure 7, which is corrected to reference figure 5 in the "corrected comments." It is agreed that the "corrected comments" rectify deficiencies in the first set of comments; further, the record of the '485 proceeding benefits, in terms of accuracy, with the "corrected comments" replacing the first set of comments filed on March 17, 2010.

Requester also states in the present petition that the "corrected comments" are substantively identical to the first set of comments filed on March 17, 2010, *i.e.* the corrected comments would not constitute an improvident additional opportunity to comment. In light of the provisions of 37 CFR 10.18, the Office accepts third party request's statements. Accordingly, the Office accepts the "corrected comments" as being requester's comments after the Office notice of March 17,

[2] The March 2, 2010 notice cited 37 CFR 1.948 regarding the proper submission of prior art by a third party requester and voiced concerns regarding compliance with the regulatory page limit requirements of 37 CFR 1.943.

2010, and the first set of March 17, 2010 comments is being expunged from the record by being marked closed and non-public in the Image File Wrapper (IFW).

CONCLUSION

1. The third party requester petition is granted. The first set of March 17, 2010 third party comments is being expunged from the record by marking them closed and non-public in the '485 proceeding's IFW. The first set of comments filed by third party requester on March 17, 2010 will not constitute part of the record for the '485 proceeding. The "corrected comments" filed on March 17, 2010 will constitute the record comments for third party requester in response to the March 2, 2010 Office notice.

2. Jurisdiction of the '485 *inter partes* reexamination proceeding is being forwarded to the Central Reexamination Unit for decision upon patent owner's March 31, 2010 petition challenging entry of third party requester comments and third party requester's April 8, 2010 opposition, both filed under 37 CFR 1.181.

3. Telephone inquiries related to this decision should be directed to Joseph F. Weiss, Jr., Legal Advisor, at (571) 272-7759.

Kenneth M. Schor

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

6-10-10
Kenpet8/IP

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,485	07/06/2009	7369772	02495.000001.36	7173

5514 7590 06/24/2010

FITZPATRICK CELLA HARPER & SCINTO
1290 Avenue of the Americas
NEW YORK, NY 10104-3800

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/24/2010

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
ORRICK HERRINGTON & SUTCLIFFE, LLP
IP PROSECUTION DEPT.
4 Park Plaza, Suite 1600
Irvine, CA 92614-2558

Date:
MAILED

JUN 24 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000485
PATENT NO. : 7369772
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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JUN 24 2010

(For Requester)

CENTRAL REEXAMINATION UNIT

FITZPATRICK CELLA HARPER & SCINTO
1290 Avenue of the Americas
NEW YORK NY 10104-3800

ORRICK, HERRINGTON & SUTCLIFFE, LLP
IP PROSECUTION DEPARTMENT
4 PARK PLAZA
SUITE 1600
IRVINE, CA 92614-2558

In re: Gerstel *et alia*
Reexamination Proceeding
Control No. 95/000,485
Request Deposited: July 6, 2009
For: U.S. Patent No. 7,369,772

: **DECISION DISMISSING**
: **PETITION TO**
: **DENY ENTRY OF**
: **THIRD-PARTY COMMENTS**
:

The *inter partes* reexamination proceeding is before the Central Reexamination Unit to address the patent owner paper filed March 31, 2010 entitled "PETITION UNDER 37 C.F.R. §1.181 TO DENY ENTRY OF THIRD PARTY REQUESTER COMMENTS" and a third-party paper filed April 8, 2010 opposing the March 31, 2010 paper.

The patent owner petition to deny entry of (or expunge) comments is timely filed. No fee is required.

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

The third-party paper is **refused entry** into the record and will not be considered on the merits for the reasons set forth below.

DECISION

Petitioner argues that if the rectified comments of March 17, 2010 are viewed in combination with the comments submitted earlier on March 17, 2010, then the comments are improper. However, the rectified comments should not be viewed in combination with the comments

submitted earlier on March 17, 2010, per the decision of June 11, 2010. The relevant portions of the June 11, 2010 decision are incorporated into the present decision.

With the rectified comments constituting the third party comments, Petitioner also argues that the comments are not strictly limited to the comments appearing in requester's initial comments. Petitioner cites footnote 5 on page 7 and footnote 17 on page 14. However, these two comments are not deemed to go beyond the comments in the original submission.

Therefore, the petition to deny entry of the comments and expunge them from the file is **dismissed**.

Regarding the third-party paper filed April 8, 2010, the present opposition petition is non-statutory, and is being **expunged** as will now be explained.

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.

With respect to the April 8, 2010 requester paper opposing patent owner's petition under 37 CFR 1.181, neither 35 U.S.C. § 314(b)(2) nor the regulations provide any right for the third party requester to file an opposition to, or comment on, the patent owner's petition requesting the 3PR response not be entered. Such a petition is not a response to an "Office action on the merits." Rather, it goes to an issue that goes to formal requirements and is a matter within the discretion of the Office in balancing the requirement of "special dispatch" against the needs of a specific situation. Stated differently, as pointed out above, the requester is not responding to comment on a patent owner response to an Office action, but is instead commenting on the issue of whether the Office should grant a petition to the USPTO Director to provide relief from an action of an examiner. The latter is clearly a matter within the discretion of the USPTO Director, for which requesters were not granted a comment right by statute.

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 that requests relief. No mechanism has been provided for the third party requester to file a paper, such as the April 8, 2010 paper, that is in response to an event other than a patent owner response to an Office action. 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 requesting relief is a paper that is not permitted by the statute governing *inter partes* reexamination proceedings, and accordingly it was not provided for (i.e., was not permitted) in the regulations that implemented the *inter partes* reexamination statute. The paper is not a submission of written comments to a patent owner's response to an Office action; such third party written comments are the subject of a separate paper. Third party requester's opposition to patent owner's petition is therefore not enterable into the record.

It is to be noted that, while the requester may oppose a patent owner challenge to jurisdiction over a proceeding by the Office, the consideration of a request for entry of an amendment is clearly within the Office's jurisdiction, and the Office may exercise its discretion in appropriate instances to grant such relief. Note 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) and compare to the discussion in MPEP § 2667 regarding improper opposition petitions to challenge procedural issues (such as extensions of time, revival of terminated prosecution, withdrawal of finality, and the like). Therefore, the requester's opposition to patent owner's request to deny entry of 3PR's comments is not enterable into the record as a paper addressing the jurisdiction of the Office to act on the patent owner's request.

In view of the above, the opposition will be refused entry as an improper paper.

Pursuant to 37 CFR 1.939(a), "[i]f an unauthorized paper is filed by any party at any time during the *inter partes* reexamination proceeding it will not be considered and may be returned." For the reasons discussed above, the requester's April 8, 2010 opposition to the patent owner's March 31, 2010 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 request is being expunged from the record by closing the paper in the IFW and marking it "non-public." A copy of the present decision will be made of record in the IFW.

CONCLUSION

1. Petitioner's request to deny entry of the 3PR's comments is **dismissed**.

2. The April 8, 2010 requester opposition paper petition is refused entry and **expunged** from the file.

3. Inquiries regarding this decision may be directed to Eric Keasel, Supervisory Patent Examiner, at (571) 272-4929.

4. This decision is not a final agency decision and is without prejudice to request reconsideration or higher-level review.

Eric Keasel
SPE, AU 3992, Central Reexamination Unit

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CENTRAL REEXAMINATION UNIT

Jeffrey H Ingerman ROPES & GRAY LLP PATENT DOCKETING 39/361 1211 AVENUE OF THE AMERICAS NEW YORK NY 10036-8704	:	(For Patent Owner)
Michael A Messina MCDERMOTT WILL & EMERY LLP 600 13TH STREET, N.W. WASHINGTON, DC 20005-3096	:	(For Third Party Requester)
In re: James J Fallon *Inter Partes* Reexamination Proceeding Control No. 95/000,486 Deposited on: 08 July 2009 For: US Patent No. 6,604,158	:	DECISION GRANTING PETITION FOR EXTENSION OF TIME [37 CFR §§ 1.956 & 1.181]

This is a decision on the 20 November 2009, "Petition under 37 CFR § 1.956 for Extension of Time to Reply to Office Action in Reexamination," requesting that the time for responding to the non-Final Office action mailed 12 November 2009, be further extended by two (2) months. 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 12 November 2009, which set one (1) month time for filing a response thereto. The petition for extension of time was timely filed on 20 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 two (2) months to the period for response. The decision to extend the period for response is evaluated based upon a showing of "sufficient cause." There is always the consideration to balance the need for the patent owner to have a fair opportunity to respond to the Office action between the need for special dispatch.

The non-final Office action was mailed 12 November 2009. The patent owner submitted a timely filed the petition on 20 November 2009 with the appropriate fee and certificate of service.

The petition dated 20 November 2009 cites several reasons for the need for additional time. It should be noted that while the reasons for extending the time for response generally support a one (1) month extension of time, the petition noted the error in the time for response given on the non-final Office action dated 12 November 2009 which correctly should have been two (2) months time for response thereto. On balance, the petitioner has demonstrated "sufficient cause" to grant a one (1) month extension of time based upon the length and complexity of the Office action plus the correction of response time also adding one month for a total to two (2) months extension of time.

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

CONCLUSION

1. The patent owner's petition for further extension for two (2) months time in which to file a response to the non-final Office action dated 12 November 2009 is hereby **granted.**

2. The period for response is further extended by two (2) month.

3. The response is extended to **12 February 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.
95/000,486	07/08/2009	6604158	103532-0009-602	6777

1473 7590 02/03/2010

ROPES & GRAY LLP
PATENT DOCKETING 39/361
1211 AVENUE OF THE AMERICAS
NEW YORK, NY 10036-8704

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/03/2010

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
Kenneth L. Cage
MCDERMOTT WILL & EMERY, LLP
600 13th Street, N.W.
Washington, DC 20005-3096

Date:
MAILED

FEB 03 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000486
PATENT NO. : 6604158
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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NEW YORK, NY 10036-8704

(For Patent Owner)

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CENTRAL REEXAMINATION UNIT

KENNETH L. CAGE
MCDERMOTT, WILL & EMERY LLP
600 13TH STREET, NW
WASHINGTON, DC 20005

(For Third Party Requester)

Inter Partes Reexamination Proceeding Control No. 95/000,486 Filed: July 8, 2009 For: U.S. Patent No. 6,604,158	**DECISION** **DISMISSING** **PETITION**

This is a decision on the patent owner paper entitled "PETITION UNDER 37 C.F.R. § 1.183 FOR WAIVER OF 37 C.F.R. § 1.943(b) IN CONNECTION WITH REPLY TO OFFICE ACTION IN REEXAMINATION," filed on November 20, 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. 016075.

REVIEW OF THE RELEVANT FACTS

1. On August 5, 2003, United States Patent No. 6,604,158 (the '158 patent) issued to Fallon.

2. On July 8, 2009, a request for *inter partes* reexamination of the '158 patent was filed by a third party requester, which request was assigned Reexamination Control No. 95/000,486 ("the '486 proceeding").

3. On August 14, 2009, the Office mailed an order granting *inter partes* reexamination in the '486 proceeding.

4. On November 12, 2009, the Office mailed a non-final Office action in the '486 proceeding.

5. On November 20, 2009, patent owner filed the instant petition entitled, "PETITION UNDER 37 C.F.R. § 1.183 FOR WAIVER OF 37 C.F.R. § 1.943(b) IN CONNECTION WITH REPLY TO OFFICE ACTION IN REEXAMINATION" ("petition under 37 CFR 1.183").

6. Concurrently, on November 20, 2009, patent owner filed a request for a two-month extension of time to respond to the November 12, 2009 Office action.

7. On December 2, 2009, patent owner's petition for a two-month extension of time was granted, extending the period for response to the November 12, 2009 Office action to February 12, 2009.

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), which limits patent owner responses to 50 pages in length. In particular, patent owner "requests a new page limit of 194 pages, equal in length to the Office Action." [1] Patent owner further requests that "[i]n the interest of fairness ... Requester be given a page limit for its response to Patent Owner's reply equal to the number of pages in the reply ultimately filed by Patent Owner (but not less than the 50 pages permitted by 37 C.F.R. § 1.943 in the unlikely event that Patent Owner's reply is shorter than 50 pages)."[2]

In support of its request for waiver of the rule, patent owner asserts that "in view of the length of the Office Action and the large number of separate rejections, justice requires that the page limit

[1] Petition under 37 CFR 1.183 at page 2.
[2] Petition under 37 CFR 1.183 at page 2.

of 37 C.F.R. § 1.943(b) be waived as requested above."[3] In particular, patent owner states that "[t]he Detailed Action portion of the Office Action is 194 pages long, encompassing 63 separate rejections based on various combinations of thirteen references."[4] Patent owner further asserts that "[i]n the experience of the undersigned [representative for patent owner], it will not be possible to address 63 rejections adequately in 50 pages. Indeed, experience shows that replies to office actions are more commonly longer than the office actions to which they reply."[5] Patent owner also asserts that "[it] is not in a position at this time to predict how long its reply to the Office Action will be. However, Patent Owner does not expect an open-ended waiver of the page limit."[6] Accordingly, patent owner requests waiver of 37 CFR 1.943(b) to permit a response of up to 194 pages, which is equal in length to the November 12, 2009 Office action.

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 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 194 pages, which is equal to the length of the November 12, 2009 Office action. It is to be noted, however, that the length of the Examiner's treatment of issues is not a *per se* indication of how many pages patent owner 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. For example, while patent owner suggests, as indicated above, that 50 pages in which to respond to the 63 rejections would be inadequate, it is not clear exactly how many pages patent owner would need to develop a response to each of the 63 rejections, or that a maximum of 194 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 <u>economizing, extraneous material, and arrangement, without repetition of information already of record</u>. In this way, petitioner could have relied on the

[3] Petition under 37 CFR 1.183 at page 2.
[4] Petition under 37 CFR 1.183 at page 1.
[5] Petition under 37 CFR 1.183 at page 2.
[6] Petition under 37 CFR 1.183 at page 2.

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 requester 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 requester 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 November 20, 2009 petition under 37 CFR 1.183 is dismissed.

CONCLUSION

1. The patent owner November 20, 2009 petition under 37 CFR 1.183 is **dismissed**.

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

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

Kenneth M. Schor

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

[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."

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(For Patent Owner)

KENNETH L. CAGE
MCDERMOTT, WILL & EMERY LLP
600 13TH STREET, NW
WASHINGTON, DC 20005

(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/000,486
Filed: July 8, 2009
For: U.S. Patent No. 6,604,158

: **DECISION**
: **GRANTING**
: **PATENT OWNER**
: **PETITION AND**
: ***SUA SPONTE* WAIVING**
: **REQUESTER PAGE LIMIT**

This is a decision on the patent owner paper entitled "RENEWED PETITION UNDER 37 C.F.R. § 1.183 FOR WAIVER OF 37 C.F.R. § 1.943(b) IN CONNECTION WITH REPLY TO OFFICE ACTION IN REEXAMINATION," filed on February 12, 2010.

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

The $400.00 petition fee pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183 was charged to patent owner's deposit account on February 16, 2010.

BACKGROUND

1. On August 5, 2003, United States Patent No. 6,604,158 ("the '158 patent") issued to James J. Fallon.

2. On July 8, 2009, a request for *inter partes* reexamination of the '158 patent was filed by a third party requester, which request was assigned Reexamination Control No. 95/000,486 ("the '486 proceeding").

3. On August 14, 2009, the Office mailed an order granting *inter partes* reexamination in the '486 proceeding.

4. On November 12, 2009, the Office mailed a non-final Office action in the '486 proceeding.

5. On November 20, 2009, patent owner filed a petition entitled, "PETITION UNDER 37 C.F.R. § 1.183 FOR WAIVER OF 37 C.F.R. § 1.943(b) IN CONNECTION WITH REPLY TO OFFICE ACTION IN REEXAMINATION" ("the petition under 37 CFR 1.183").

6. Concurrently, on November 20, 2009, patent owner filed a request for a two-month extension of time to respond to the November 12, 2009 Office action.

7. On December 2, 2009, patent owner's petition for a two-month extension of time was granted, extending the period for response to the November 12, 2009 Office action to February 12, 2009.

8. On February 3, 2010, the Office mailed a decision dismissing patent owner's November 20, 2009 petition under 37 CFR 1.183.

9. On February 12, 2010, patent owner filed the instant petition entitled, "RENEWED PETITION UNDER 37 C.F.R. § 1.183 FOR WAIVER OF 37 C.F.R. § 1.943(b) IN CONNECTION WITH REPLY TO OFFICE ACTION IN REEXAMINATION" ("the renewed petition under 37 CFR 1.183").

10. Concurrently, on February 12, 2010, patent owner filed a response to the November 12, 2009 Office action.

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 Renewed Petition under 37 CFR 1.183

On February 3, 2010, the Office mailed a decision dismissing patent owner's November 20, 2009 petition under 37 CFR 1.183 for waiver of the 50-page limit of 37 CFR 1.948(b). In the present renewed petition under 37 CFR 1.183, patent owner requests waiver of the 50-page limit

of 37 CFR 1.943(b) for patent owner's concurrently-filed response.[1] Patent owner asserts that the response is 87 pages long and is accompanied by a declaration under 37 CFR 1.132 ("the Ligler Declaration"), which patent owner asserts is 18 pages long, exclusive of exhibits.[2] Thus, patent owner requests that the 50-page limit of 37 CFR 1.943(b) be waived to permit a response that is 105 pages long.[3]

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. Patent owner asserts that it "has attempted to economize, avoid extraneous material, and avoid repetition of information already of record" and "has attempted to arrange the Reply to present its arguments efficiently."[4] In addition to the showing, patent owner has also substantiated its request for waiver of the 50-page limit of 37 CFR 1.943(b) with specific facts regarding the length of the November 12, 2009 Office action and the number of rejections and references relied upon therein.[5]

Based on the specific facts set forth in the renewed petition under 37 CFR 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. Accordingly, the renewed petition under 37 CFR 1.183 is <u>granted</u> to the extent of permitting patent owner's February 12, 2010 response to exceed the page limit by 50 pages as follows. The number of pages of the remarks portion of patent owner's February 12, 2010 response that count toward the page limit is 82 pages,[6] and the number of pages of the declarations portion of patent owner's February 12, 2010 response that count toward the page limit is approximately 18 pages.[7] Thus, the total number of pages of patent owner's response that count toward the page limit is 100 pages, which exceeds the page limit of 37 CFR 1.943(b) by 50 pages. <u>This waiver makes patent owner's February 12, 2010 response page-length compliant</u>.

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[1] The renewed petition under 37 CFR 1.183 at page 1.
[2] The renewed petition under 37 CFR 1.183 at page 2.
[3] The renewed petition under 37 CFR 1.183 at page 2.
[4] The renewed petition under 37 CFR 1.183 at page 3 (stating that "For example, the various rejections in the Office Action rely on various combinations of thirteen references, and also make similar arguments as to different combinations of references. Therefore, in the Reply, Patent Owner presents common arguments as to each reference, as well as common arguments in response to various of the Examiner's arguments. Patent Owner then addresses the individual rejections, referring back, wherever possible, to the common arguments.)
[5] *See* the renewed petition under 37 CFR 1.183 at page 2 (asserting that the Detailed Action portion of the November 12, 2009 Office action is 194 pages long, encompassing 63 rejections based on various combinations of thirteen references.)
[6] Only those pages of the remarks portion of the response that contain 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 are counted toward the 50-page limit. Likewise, only those pages of the accompanying affidavits/declarations that contain opinon(s) of the affiant/declarant that the art either does or does not anticipate or render obvious the claims, or specific claim elements, of the patent under reexamination are counted toward the 50-page limit. *See* MPEP 2667(I)(A)(2).
[7] Of the declarations submitted with patent owner's February 12, 2010 response, only the Ligler declaration is replete with pages of arguments that count toward the 50-page limit of 37 CFR 1.943(b).

Time Period and Page Limit for Submission of Third Party Requester Comments

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 100 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.**[8] Requester has 30 days from the mailing date of this decision, granting patent owner's petition under 37 CFR 1.183 and making patent owner's February 12, 2010 response page-length compliant, to file a comments paper pursuant to 37 CFR 1.947. *See* MPEP 2667(I)(A)(2).

CONCLUSION

1. Patent owner's February 12, 2010 petition under 37 CFR 1.183 is granted, and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting patent owner's February 12, 2010 response to the November 12, 2009 Office action to exceed the page limit by 50 pages. This waiver makes patent owner's February 12, 2010 response page-length compliant.

2. This decision, *sua sponte*, waives the provisions of 37 CFR 1.943(b) to the extent that any written comments to patent owner's response (addressed by this decision) filed by third party requester shall not exceed 100 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 and making patent owner's February 12, 2010 response page-length compliant, to file a comments paper pursuant to 37 CFR 1.947

3. Jurisdiction for the '489 proceeding is returned to the Central Reexamination Unit (CRU).

4. Any questions concerning this communication should be directed to Nicole Dretar, Legal Advisor, Office of Patent Legal Administration, at 571-272-7717.

Kenneth M. Schor

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

Kenpet8
4-2910

[8] Patent owner's February 12, 2010 response appears to use one-and-a-half line spacing.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,487	08/21/2009	6505172	54848-5016-US	8473

70813 7590 04/30/2010

GOODWIN PROCTER LLP
901 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20001

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/30/2010

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

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/000,487 US	08/21/09	6505172	54848-5016-

EXAMINER
POKRZYWA, JOSEPH

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ART UNIT	PAPER
3992	

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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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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/000,487 US	08/21/09	6505172	54848-5016-

EXAMINER
POKRZYWA, JOSEPH

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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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(For Third Party Requester)

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APR 5 0 2010

CENTRAL REEXAMINATION UNIT

Inter Partes Reexamination Proceeding	:	**DECISION**
Control No. 95/000,487	:	**GRANTING**
Filed: August 21, 2009	:	**PETITION**
For: U.S. Patent No. 6,505,172	:	**UNDER 37 CFR 1.183**

This is a decision on the patent owner paper entitled "PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE PAGE LIMIT OF 37 C.F.R. § 1.943," filed on February 19, 2010.

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

The $400.00 petition fee pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183 was charged to patent owner's deposit account on February 22, 2010.

BACKGROUND

1. On January 7, 2003, United States Patent No. 6,505,172 ("the '172 patent") issued to Johnson *et al.*

2. On July 10, 2009, a request for *inter partes* reexamination of the '172 patent was filed by a third party requester, which request was assigned Reexamination Control No. 95/000,487 ("the '487 proceeding").

3. On August 21, 2009, a corrected request for *inter partes* reexamination of the '172 patent was filed by the third party requester in the '487 proceeding, and the proceeding was assigned a filing date.

4. On October 23, 2009, the Office mailed an order granting *inter partes* reexamination in the '487 proceeding, concurrently with a non-final Office action on the merits.

5. On December 16, 2009, patent owner filed a request for extension of time to respond to the October 23, 2009 Office action.

6. On December 23, 2009, the Office mailed a decision granting the patent owner's December 16, 2009 request for extension of time, extending the time period for responding to the October 23, 2009 office action by one month.

7. On January 25, 2010, patent owner filed a response to the October 23, 2009 Office action. The response included a "DECLARATION UNDER 37 C.F.R. § 1.132 OF BROOKS L. HILLIARD SUPPORTING PATENTABILITY OF U.S. PATENT NO. 6,505,172 AND TRAVERSING REJECTIONS IN OFFICE ACTION DATED OCTOBER 23, 2009" ("the Hilliard declaration").

8. 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 January 25, 2010 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.

9. On February 19, 2010, patent owner filed a "SUBSTITUTE RESPONSE TO NON-FINAL OFFICE ACTION" ("the re-drafted response"), concurrently with the instant petition paper, "PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE PAGE LIMIT OF 37 C.F.R. § 1.943" ("the petition under 1.183") and a redacted version of the Hilliard declaration.

10. On March 22, 2010, third party requester filed comments after patent owner's February 19, 2010 re-drafted response.

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

On February 4, 2010, the Central Reexamination Unit (CRU) mailed a notice of defective paper, stating that patent owner's January 25, 2010 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 the re-drafted response (also referred to by patent owner as the "Substitute Response"). In the petition under 37 CFR 1.183, patent owner requests "that the 50-page limit of 37 C.F.R. § 1.943(b) be waived to the extent necessary to permit entry of the material submitted by the Patent Owner on January 25, 2010, in response to the October 23, 2009 Office Action."[1] Patent owner also requests "that the 50-page limit of 37 C.F.R. § 1.943(b) be waived to allow entry of the Substitute Response together with the complete Hilliard Declaration."[2]

Patent owner asserts that the January 25, 2010 response includes 47 pages of remarks and an additional 190 pages of material submitted in eight exhibits, including three declarations.[3] One of the declarations, the Hilliard declaration (Exhibit 1), is a declaration of an expert in the field, and the other two are declarations from two of the named inventors.[4] Patent owner asserts that the Hilliard declaration includes nine sections and "that the only defined portions of the Hilliard Declaration that arguably may be considered to contain opinions or argument that the art does not anticipate or render obvious the claims, or specific claim elements, of the '172 Patent are sections seven and eight. These sections span pages 23 to 58, for a total of 36 pages."[5] Patent owner further asserts that the remaining exhibits do not count against the page limit, "[a]s these Exhibits 2-8 are limited to evidence establishing whether asserted references qualify as prior art and do not include opinions or argument that the applied art either does or does not anticipate or render obvious the claims of the ' 172 Patent...."[6]

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 re-draft a response in compliance with the 50-page limit, and submitting the resulting re-drafted response, which is in excess of 50 pages, but which contains fewer pages than the earlier-filed January 25, 2010 response deemed defective by the CRU. Patent owner asserts that the re-drafted response "includes a maximum of 33 pages of

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[1] Petition under 37 CFR 1.183 at page 1.
[2] Id. at page 3.
[3] Id. at page 1.
[4] Id.
[5] Id. at page 2.
[6] Id. at pages 2-3. (stating that "Exhibits 2 ant 3 are declarations by inventors James M. Johnson and Douglas A. Momyer establishing that these inventors conceived and invented the subject matter disclosed in U.S. Patent 5,712,989. These declarations serve to remove the '989 Patent as available prior art. These declarations are akin to declarations attempting to swear behind a filing date of a reference and are thus not counted against the page limit. ... Exhibits 4-6 are excerpts of trial transcripts in which Ms. Fielder addresses the confidentiality and availability of the P.O. Writer Manual asserted against claims 1-5. These trial transcripts are evidence that establishes that the P.O. Writer Manual does not qualify as a printed publication. Exhibit 7 is a sample P.O. Writer License Agreement that shows that the P.O. Writer Manuals were not publically accessible. Exhibit 8 is a TSA Gateway 2000 License Agreement that shows that the Gateway Manuals were not publically accessible.")

argument" and that "the 33 pages of Substitute Response and the 36 pages of sections 7-8 of the Hilliard Declaration, totaling 69 pages are necessary to completely and concisely respond to the October 23, 2009, Office Action."[7]

In addition to the showing, patent owner has also substantiated its request for waiver of the 50-page limit of 37 CFR 1.943(b) with specific facts regarding the nature of the rejections set forth in the October 23, 2009 Office action and the nature of the response required by patent owner. Specifically, patent owner asserts that some of the rejections are based on references that patent owner believes do not qualify as prior art and "that the limited additional 19 pages is necessary to fully explain why the asserted references fail to render the claims of the '172 Patent unpatentable and also to explain why four of the references fail to qualify as prior art."[8]

Based on the specific facts set forth in the petition under 37 CFR 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 re-draft a response in compliance with the 50-page limit and submitting the resulting re-drafted 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.

Accordingly, the petition under 37 CFR 1.183 is granted to the extent of (1) permitting entry of patent owner's un-redacted January 25, 2010 version of the Hilliard declaration, and (2) waiving the page limit of 37 CFR 1.943(b) to permit patent owner's February 19, 2010 re-drafted response, including the un-redacted January 25, 2010 version of the Hilliard declaration, to exceed the page limit by 19 pages. The number of pages of the remarks portion of patent owner's February 19, 2010 re-drafted response that count toward the page limit is 33 pages, and the number of pages of the declarations portion of patent owner's response that count toward the page limit is approximately 36 pages.[9] Thus, the total number of pages of patent owner's response that count toward the page limit is 69 pages, which exceeds the page limit of 37 CFR 1.943(b) by 19 pages. This waiver makes patent owner's February 19, 2010 re-drafted response, including the un-redacted January 25, 2010 version of the Hilliard declaration, page-length compliant.

CONCLUSION

1. Patent owner's February 19, 2010 petition under 37 CFR 1.183 is granted to the extent of (1) permitting entry of patent owner's un-redacted January 25, 2010 version of the Hilliard declaration, and (2) waiving the page limit of 37 CFR 1.943(b) to permit patent owner's February 19, 2010 re-drafted response, including the un-redacted January 25, 2010 version of the Hilliard declaration, to exceed the page limit by 19 pages. This waiver makes patent owner's February 19, 2010 re-drafted response including the un-redacted January 25, 2010 version of the Hilliard declaration, page-length compliant.

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[7] Id. at page 3.
[8] Id. at page 3.
[9] Of the declarations, only the un-redacted January 25, 2010 version of the Hilliard declaration is replete with pages of arguments that count toward the 50-page limit of 37 CFR 1.943(b).

2. Jurisdiction for the '487 proceeding is returned to the Central Reexamination Unit (CRU).

3. Any questions concerning this communication should be directed to Nicole Dretar, Legal Advisor, Office of Patent Legal Administration, at 571-272-7717.

Kenneth M. Schor

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

Kenpet8
4-2910

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,489	07/20/2009	6304975	159291-0011(975)	8274

6449 7590 04/15/2010

ROTHWELL, FIGG, ERNST & MANBECK, P.C.
1425 K STREET, N.W.
SUITE 800
WASHINGTON, DC 20005

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/15/2010

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Date: MAILED
APR 15 2010
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000489
PATENT NO. : 6304975
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

APR 15 2010

CENTRAL REEXAMINATION UNIT

IRELL & MANELLA LLP
1800 AVENUE OF THE STARS SUITE 900
LOS ANGELES, CA 90067

(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/000,489
Filed: July 20, 2009
For: U.S. Patent No. 6,304,975

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

This is a decision on third party requester's February 5, 2010 petition paper entitled "PETITION REGARDING ESR'S SUBMISSION IN VIOLATION OF 37 C.F.R. § 1.943" (the petition under 37 CFR 1.182/1.183).

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

A petition fee of $400.00 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.182/1.183 is being charged to requester's deposit account, as authorized on page 6 of requester's petition.

The third party requester petition under 37 CFR 1.182/1.183 is dismissed, for the reasons set forth herein.

BACKGROUND

1. On October 15, 2001, United States Patent No. 6,304,975 (the '975 patent) issued to Shipley.

2. On July 20, 2009, a request for *inter partes* reexamination of the '975 patent was filed by a third party requester. The request was assigned Reexamination Control No. 95/000,489 (the '489 proceeding).

3. On August 28, 2009, *inter partes* reexamination was ordered in the '489 proceeding.

4. On September 29, 2009, a non-final Office action was mailed in the '489 proceeding.

5. On January 29, 2010, patent owner filed a petition entitled "PETITION FOR WAIVER OF PAGE LIMIT UNDER 37 C.F.R. § 1.183" (petition under 37 CFR 1.183), concurrently with a patent owner response to the September 29, 2009 Office Action.[1] This petition is being decided by a separate decision being issued concurrently with the present decision.

6. On February 5, 2010, requester filed a petition entitled "PETITION REGARDING ESR'S SUBMISSION IN VIOLATION OF 37 C.F.R. § 1.943" (petition under 37 CFR 1.182/1.183). This petition is the subject of the present decision.

DECISION

I. Relevant Authority

37 CFR 1.4 provides (in-part):

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

37 CFR 1.181 provides (in-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 1.182 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).

[1] The Office granted a 1-month extension of time for patent owner's response on October 30, 2009 and another 1-month extension of time for patent owner's response on December 2, 2009.

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.

35 U.S.C. § 314(b)(2) provides:

> Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.

37 CFR 1.947 provides:

> Each time the patent owner files a response to an Office action on the merits pursuant to § 1.945, a third party requester may once file written comments within a period of 30 days from the date of service of the patent owner's response. These comments shall be limited to issues raised by the Office action or the patent owner's response. The time for submitting comments by the third party requester may not be extended. For the purpose of filing the written comments by the third party requester, the comments will be considered as having been received in the Office as of the date of deposit specified in the certificate under § 1.8.

II. Third Party Requester Petition Under 37 CFR 1.182/1.183

In the February 5, 2010 petition under 37 CFR 1.182/1.183, third party requester petitions for the following relief: (1) that patent owner's January 29, 2010 response be denied entry for failure to comply with 37 CFR 1.943(b), (2) that patent owner's January 29, 2010 petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b) be denied, and (3) waiver under 37 CFR 1.183 "to the extent deemed necessary" to provide an entry right for its petition under 37 CFR 1.182.[2]

[2] Petition under 37 CFR 1.182/1.183 at page 1.

A. Requester's February 5, 2010 Petition Under 37 CFR 1.182/1.183

Third party requester's request that patent owner's January 29, 2010 response be denied entry for failure to comply with 37 CFR 1.943(b), although it is filed as part of the petition under 37 CFR 1.182, is a petition under 37 CFR 1.181 from the Central Reexamination Unit (CRU) posting of the response in the electronic Image File Wrapper (IFW) for the present proceeding; this is a matter that would be decided by the Central Reexamination Unit (CRU). Third party requester's request that patent owner's January 29, 2010 petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b) be denied is considered a petition under 37 CFR 1.182, which is a matter that would ordinarily be decided by the Office of Patent Legal Administration (OPLA). Accordingly, third party requester's February 5, 2010 petition under 37 CFR 1.182/1.183 is dismissed under 37 CFR 1.4(c), as each distinct subject must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects that are considered by different areas of the Office.

B. Requester Comments Not Permitted for Procedural Matters in *Inter Partes* Reexamination

Additionally, for the reasons set forth below, the February 5, 2010 third party requester petition under 37 CFR 1.182, requesting that patent owner's January 29, 2010 petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b) be denied, does not have a right of entry in the '489 proceeding.

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 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. Patent owner's January 29, 2010 petition under 37 CFR 1.183, requesting suspension of 37 CFR 1.943(b) for waiver of page limit, however, 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 comments on a patent owner's petition under 37 CFR 1.183 for suspension of the rules.

A third party requester's opposition paper in response to a patent owner's petition for waiver of the page limit set out in 37 CFR 1.943(b) is not a paper that is permitted by the statute governing *inter partes* reexamination proceedings, and accordingly was not provided for (i.e., was not permitted) in the regulations that implemented the *inter partes* reexamination statute. Furthermore, third party requester's petition under 37 CFR 1.183 requesting entry of the concurrently filed petition under 37 CFR 1.182 has not been granted as detailed below. Third party requester's February 5, 2010 petition under 37 CFR 1.182 filed in opposition to patent owner's petition under 37 CFR 1.183, therefore, is not enterable into the record.

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, third party requester's February 5, 2010 petition under 37 CFR

1.182 filed in opposition to patent owner's January 29, 2010 petition under 37 CFR 1.183 does not have a right of entry into the record of the '489 proceeding and, as such, is not an authorized paper. Because third party requester's February 5, 2010 petition under 37 CFR 1.182 has been scanned into the electronic Image File Wrapper (IFW), the paper is being expunged by marking it "closed" and "non-public" in the IFW, and will not constitute part of the record of the '489 proceeding. *See* MPEP 2267.

C. The Office Lacks Statutory Authority to Consider the Substance of Requester's Petition

As noted above, on February 5, 2010, third party requester filed a petition under 37 CFR 1.183 requesting waiver of the rules for entry of its petition under 37 CFR 1.182 filed in opposition to patent owner's January 29, 2010 petition under 37 CFR 1.183. However, the rules cannot be waived to provide the third party requester the right to file a paper at the present stage in the '489 proceeding.

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.

Whether a patent owner's petition under 37 CFR 1.183 for suspension of the rules is grantable is an issue that goes to procedure and a showing of 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 1.183 for suspension of the rules in an *inter partes* reexamination proceeding. Such a right was 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 a right was ever contemplated by Congress.

37 CFR 1.183 permits waiver of the regulations in an extraordinary situation when justice requires. Requester's February 5, 2010 petition, however, seeks to waive a requirement set forth in 35 U.S.C. § 314(b)(2), which allows requester comments only in response to a patent owner's response on the merits. Accordingly, the Office is without statutory authority to consider the substance of third party requester's February 5, 2010 petition paper. In this respect, third party requester stands on a footing no different from any other member of the public who wishes to challenge a procedural action taken by the Office in a proceeding. The patent statute simply does not provide for such intervention.

CONCLUSION

1. Third party requester's February 5, 2010 petition under 37 CFR 1.182/183 is dismissed.

2. Third party requester's February 5, 2010 petition under 37 CFR 1.182 filed in opposition to patent owner's January 29, 2010 petition under 37 CFR 1.183 does not have a right of entry

into the record of the '489 proceeding and, as such, is not an authorized paper. Because third party requester's February 5, 2010 petition under 37 CFR 1.182 has been scanned into the electronic Image File Wrapper (IFW), the paper is being expunged by marking it "closed" and "non-public" in the IFW, and will not constitute part of the record of the '489 proceeding.

3. Jurisdiction for the '489 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

4-14-10
Kimprop/opposition

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,489	07/20/2009	6304975	159291-0011(975)	8274

6449 7590 04/15/2010

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/15/2010

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Date:

MAILED
APR 15 2010
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000489
PATENT NO. : 6304975
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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WASHINGTON, DC 20005

(For Patent Owner)

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APR 15 2010

CENTRAL REEXAMINATION UNIT

IRELL & MANELLA LLP
1800 AVENUE OF THE STARS SUITE 900
LOS ANGELES, CA 90067

(For Third Party Requester)

Inter Partes Reexamination Proceeding	: **DECISION GRANTING**
Control No. 95/000,489	: **PETITION AND**
Filed: July 20, 2009	: ***SUA SPONTE***
For: U.S. Patent No. 6,304,975	: **WAIVING PAGE LIMIT**

This is a decision on patent owner's petition paper entitled "PETITION FOR WAIVER OF PAGE LIMIT UNDER 37 C.F.R. § 1.183," filed on January 29, 2010.

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

The petition fee of $400.00 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183 was charged to patent owner's deposit account on February 1, 2010.

The patent owner petition under 37 CFR 1.183 is granted, for the reasons set forth herein.

BACKGROUND

1. On October 15, 2001, United States Patent No. 6,304,975 (the '975 patent) issued to Shipley.

2. On July 20, 2009, a request for *inter partes* reexamination of the '975 patent was filed by a third party requester. The request was assigned Reexamination Control No. 95/000,489 (the '489 proceeding).

3. On August 28, 2009, *inter partes* reexamination was ordered in the '489 proceeding.

4. On September 29, 2009, a non-final Office action was mailed in the '489 proceeding.

5. On January 29, 2010, patent owner filed the instant petition entitled "PETITION FOR WAIVER OF PAGE LIMIT UNDER 37 C.F.R. § 1.183" (petition under 37 CFR 1.183),

concurrently with a patent owner response to the September 29, 2009 Office Action.[1] This petition is the subject of the present decision.

6. On February 5, 2010, requester filed a petition entitled "PETITION REGARDING ESR'S SUBMISSION IN VIOLATION OF 37 C.F.R. § 1.943" (petition under 37 CFR 1.182/1.183). This petition is being decided by a separate decision being issued concurrently with the present decision.

DECISION

I. 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:

> 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. Patent Owner Petition Under 37 CFR 1.183

Patent owner's January 29, 2010 petition under 37 CFR 1.183, requesting waiver of the 50-page limit of 37 CFR 1.943(b) for its concurrently-filed response to the September 29, 2009 Office action, 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. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft a patent owner's response in compliance with the 50-page limit, and submission of a 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), requesting entry of the submitted

[1] On October 30, 2009, the Office granted a 1-month extension of time for patent owner's response to the September 29, 2009 Office action, and on December 2, 2009, the Office granted another 1-month extension of time for patent owner's response to the September 29, 2009 Office action.

response. Such a response can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed response: (1) for justification that more pages are needed to complete the response, and (2) to set forth an accurate determination of exactly how many additional pages are needed to complete the response.

In the instant petition under 37 CFR 1.183, patent owner requests that the page limit for patent owner's response to the September 29, 2009 Office action be "waived to the extent needed to accommodate" the number of pages of patent owner's concurrently-submitted response.[2] In support of waiver of 37 CFR 1.943(b), patent owner states that the "Office Action is 133 pages and incorporates over 200 pages from the third party's request," "contains 39 rejections," and "relies of 31 different pieces of alleged prior art."[3] Patent owner further asserts that "due to the questionable nature of many of the references as 'printed publications' (including an incomplete primary reference), and the citation of references admittedly having publication dates after the '975 patent's priority date of October 7, 1996, [patent owner] believed it necessary to address these deficiencies," and that "[g]iven the length and number of the rejections, it was not possible to fully respond in 50 pages, in spite of much effort to do so."[4]

Further in support of its request for waiver of 37 CFR 1.943(b), patent owner attempted to draft a patent owner's response in compliance with the 50-page limit and submitted the resulting response that is in excess of 50 pages.[5] Patent owner asserts that it "has made every effort to minimize the length of the Response and supporting evidence" and that it "has been able to keep its Response to 53 pages."[6] Patent owner states that "several of the supporting declarations unavoidably include portions that could be characterized as 'argument'" and "understands that these portions of the declarations will be included in the page count under MPEP § 2667."[7]

Based on the individual facts and circumstances of this case including, for example, the size of the September 29, 2009 Office action, including the number of rejections and incorporation by reference of pages from the request, it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance.

The number of pages of the remarks portion of patent owner's January 29, 2010 response that count toward the page limit is 53 pages, and the number of pages of the declarations portion of patent owner's January 29, 2010 response that count toward the page limit is approximately 76

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[2] Petition under 37 CFR 1.183 at page 1.
[3] Petition under 37 CFR 1.183 at page 1.
[4] Petition under 37 CFR 1.183 at pages 1-2.
[5] Petition under 37 CFR 1.183 at page 2.
[6] Petition under 37 CFR 1.183 at page 1.
[7] Petition under 37 CFR 1.183 at page 1. Per MPEP 2667(I)(A)(2), only those pages of the remarks portion of the response that contain 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 are counted toward the 50-page limit. Likewise, only those pages of accompanying affidavits/declarations that contain opinion(s) of the affiant/declarant that the art either does or does not anticipate or render obvious the claims, or specific claim elements, of the patent under reexamination are counted toward the 50-page limit.

pages.[8] Thus, the total number of pages of patent owner's response that count toward the page limit is 129 pages. The substantive portion of the September 29, 2009 Office action has been determined to span approximately 130 pages, not including pages of material from the request that are incorporated by reference. Thus, it is deemed equitable in this instance to waive the 50-page limit of 37 CFR 1.943(b) to the extent that patent owner's response to the September 29, 2009 Office action not exceed 129 pages. Accordingly, patent owner's petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting patent owner's response to the September 29, 2009 Office action to exceed the page limit by up to 79 pages. This waiver makes patent owner's January 29, 2010 response page-length compliant.

III. Time Period and Page Limit for Submission of Third Party Requester Comments

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 129 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 and making patent owner's January 29, 2010 response page-length compliant, to file a comments paper pursuant to 37 CFR 1.947.

CONCLUSION

1. Patent owner's January 29, 2010 petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting patent owner's response to the September 29, 2009 Office action to exceed the page limit by up to 79 pages. This waiver makes patent owner's January 29, 2010 response page-length compliant.

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 129 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 and making patent owner's January 29, 2010 response page-length compliant, to file a comments paper pursuant to 37 CFR 1.947.

3. Jurisdiction for the '489 reexamination proceeding is returned to the Central Reexamination Unit (CRU).

[8] Only the Appendix A declaration of Bruce Weber appears to be replete with pages of arguments that count toward the 50-page limit of 37 CFR 1.943(b) pursuant to MPEP 2667(I)(A)(2).

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

4-14-10
Kenpet8/IP/length

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,497	08/21/2009	7138061	12100.1001	7795

25099 7590 11/20/2009

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/20/2009

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

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United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/000,497	08/21/09	7138061	12100.1001

EXAMINER
STEIN, STEPHEN

ART UNIT	PAPER
3991	

GEORGE C. BECK, ESQ.
FOLEY & LARDNER LLP
3000 K STREET NW
SUITE 600
WASHINGTON, DC 20007

DATE MAILED:

11/20/09

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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3000 K STREET NW
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David M. Quinlan
David M. Quinlan, P.C.
32 Nassau Street
Suite 300
Princeton, NJ 08542

For Patent Owner

MAILED

NOV 2 0 2009

CENTRAL REEXAMINATION UNIT

George C. Beck, Esq.
Foley & Lardner LLP
3000 K Street, N.W.
Suite 600
Washington, DC 20007

For Requester

Ex Parte Reexamination Proceeding
Control No. 95/000,497
Filed: August 21, 2009
For: US Patent No. 7,138,061

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

This is a decision on the petition filed November 6, 2009 to request a one-month extension of time pursuant to 37 CFR 1.956 for filing a response to the Office action mailed October 21, 2009.

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

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

Decision

The Patent Owner requests an extension of time in which to file a response to the Office action dated October 21, 2009, which set a two-month date for filing a response thereto. The Office action is non-final. 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 is currently involved in a concurrent *inter partes* reexamination (95/000,495). A request has also been filed on a third related patent (95/000,496) and was assigned to an examiner on November 2, 2009. Patent owner is unavailable to participate in the proceeding until the middle of December due to family matters. Patent owner is also the first named inventor on these patents and, as such, his knowledge is crucial in preparing the responses to the outstanding office actions. An extension of time has also been requested in the '495 proceeding. Both requests involve many of the same references and the undersigned attorney has begun to study the requests, office actions and related histories. However, due to patent owner's unavailability, the current deadlines, and the voluminous amount of material, this

has imposed an unreasonable burden. Patent owner requests an extension of time of one month to provide a full and fair opportunity to respond to the outstanding action.

Analysis and Findings

On balance, it is considered that the petition explains the "sufficient cause" for an extension of time to be granted. Patent Owner has set forth a factual accounting that is deemed to establish reasonably diligent behavior by all those responsible for preparing a response within the statutory period. When balanced against the requirement of 35 USC 314(c) that this proceeding be handled with special dispatch, Owner's showing is adequate to justify the grant of a one-month extension of time in which to file a response to the Office action. Accordingly, the response is due January 21, 2009. Patent Owner should expect that future requests for extensions will not be granted absent strong and compelling reasons that establish the existence of an extraordinary situation necessitating the additional time.

Conclusion

1. The Patent Owner's petition for extension of time in which to file a response to the Office action of October 21, 2009 is **granted**.

2. The Patent Owner's response is due January 21, 2009.

3. Response may be submitted as follows:

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

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

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

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

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

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

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United States Patent and Trademark Office
P.O. Box 1450
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TOWNSEND AND TOWNSEND AND CREW, LLP (For Patent Owner)
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

MAILED

JUN 28 2010

CENTRAL REEXAMINATION UNIT

ANDREWS & KURTH, LLP (For Requester)
600 TRAVIS
SUITE 4200
HOUSTON, TX 77002

In re Burkholder et al.	:
Reexamination Proceeding	: DECISION
Control No.: 95/000,498	: DISMSSING
Filing Date: September 23, 2009	: PETITION
For: U.S. Patent No.: 6,934,219	:

The above reexamination proceeding is before the Director of the Central Reexamination Unit after receipt of a June 21, 2010 patent owner petition under 37 CFR § 1.181, to invoke supervisory authority to enter the proposed amendments in the patent owner's response to Action Closing Prosecution dated May 20, 2010.

The patent owner petition is dismissed.

BACKGROUND

1. U.S. Patent No. 6,934,219 (hereinafter, the '219 patent) issued on August 23, 2005.

2. A request for reexamination, assigned control No. 90/000,498 (the '0498 proceeding), was deposited by a third party Requester on September 23, 2009.

3. On November 12, 2009, the Central Reexamination Unit (CRU) issued an order granting re-examination and a first Office action on the merits.

4. On February 23, 2010, the patent owner filed a compliant response[1] to the Office action.

5. On April 21, 2010, the third party Requester filed compliant comments[2] in response to the Patent Owner's response and the Office action.

6. On May 20, 2010, the Office mailed an Action Closing Prosecution (ACP).

7. On June 21, 2010, the patent owner filed a response to the ACP and the present petition to invoke supervisory authority to enter the proposed amendments, dated June 21, 2010.

DECISION

As pointed out, the patent owner filed present petition under 37 CFR 1.181 to invoke supervisory authority to enter the proposed amendments of patent owner's response, dated June 21, 2010. However, there has been no decision by the examiner to either enter or not enter the proposed amendment of June 21, 2010. Accordingly, it is premature to invoke supervisory authority regarding entry or refusal to enter the proposed amendment because the examiner has not made his or her decision. Thus, the present petition is premature, and it is dismissed.

CONCLUSION

1. The patent owner petition under petition under 37 CFR § 1.181 is <u>dismissed</u>.

2. Should the examiner enter the declaration into the record, the patent owner would be free to again submit a petition.

3. Telephone inquiries related to this decision should be directed to Andres Kashnikow, Special Program Examiner, at (571) 272-4361.

Gregory A. Morse, Director
Central Reexamination Unit

---

[1] The original response, dated January 12, 2010, was not compliant with Office rules and procedures.
[2] The original comments, dated February 12, 2010, were not compliant with Office rules and procedures.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,503	08/31/2009	7016481	007458.0001	6222

7590 03/23/2010

NIRO, SCAVONE, HALLER & NIRO
181 W. MADISON
SUITE 4600
CHICAGO, IL 60602

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/23/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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Alexandria, VA 22313-1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
BANNER & WITCOFF, LTD
TEN SOUTH WACKER DRIVE
SUITE 3000
CHICAGO, IL 60606

Date:

MAILED

MAR 2 3 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000503
PATENT NO. : 7016481
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,165	04/01/2009	7016481	29776.178	5241

7590 03/23/2010

NIRO, SCAVONE, HALLER & NIRO
181 W. Madison
Suite 4600
Chicago, IL 60602

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/23/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patents and Trademark Office
P.O.Box 1450
Alexandria, VA 22313-1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
David L. McCombs
HAYNES & BOONE, LLP, IP SECTION
2323 Victory Lane, SUite 700
Dallas, TX 75219

Date:

MAILED.

MAR 23 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001165
PATENT NO. : 7016481
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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MAILED

MAR 23 2010

CENTRAL REEXAMINATION UNIT

Niro, Scavone, Haller & Niro
181 W. Madison
Suite 4600
Chicago, IL 60602

(For Patent Owner)

Haynes and Boone, LLP
IP Section
2323 Victory Avenue
Suite 700
Dallas, TX 75219

(For 95/001,165 Requester)

Banner & Witcoff, Ltd.
Ten South Wacker Drive
Suite 3000
Chicago, IL 60606

(For 95/000,503 Requester)

In re David McElvaney *Inter Partes* Reexamination Proceeding Control No.: 95/001,165 Filed: April 1, 2009 For: U.S. Patent No. 7,016,481	DECISION, *SUA SPONTE*, TO MERGE REEXAMINATION PROCEEDINGS
In re David McElvaney *Inter Partes* Reexamination Proceeding Control No.: 95/000,503 Filed: August 31, 2009 For: U.S. Patent No.: 7,016,481	

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 7,016,481 ("the '481 patent") issued to David McElvaney on March 21, 2006, with 16 claims.

2. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/001,165 (" '1165"), was filed April 1, 2009, by third party requester David L. McCombs identifying Cisco Systems, Incorporated as the real party in interest.

3. An order granting reexamination of claims 1-16 of the '481 patent was mailed for the '1165 reexamination proceeding on May 8, 2009; the order was accompanied by a first Office action on the merits.

4. Patent owner filed an Information Disclosure Statement (listing 327 documents) in the '1165 proceeding on June 29, 2009.

5. Patent owner filed a paper titled "Response to Office Action Mailed May 8, 2009" on July 13, 2009; the July 13, 2009 response did not include an amendment to the claims (or specification).

6. The '1165 requester filed a paper titled "Comments By Third Party Requester Under 37 C.F.R. § 1.947" on August 6, 2009.

7. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/000,503 (" 503") was filed August 31, 2009, by third party requester Shawn P. Gorman identifying RTX Telecom and Skype Technologies SA as the real parties in interest.

8. An order granting reexamination of claims 1-16 of the '481 patent was mailed for the '503 reexamination proceeding on November 25, 2009. No Office action has been issued in the '503 reexamination proceeding.

DECISION

I. MERGER OF PROCEEDINGS

Under 37 CFR 1.989(a):

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

As evidenced by the above review of facts, both the '1165 and '503 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 reason 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 95/001,165 and 95/000,503 reexamination proceedings would address these considerations. Thus, pursuant to 37 CFR 1.989(a), the 95/001,165 and 95/000,503 reexamination proceedings are hereby merged. The merged proceeding will be conducted in accordance with the guidelines and requirements which follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

The claims are identical in both proceedings. The patent owner is required to continue to maintain the same claims (and specification) in both files *throughout the merged proceeding*.

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

The present decision merges an *inter partes* reexamination proceeding with another *inter partes* reexamination proceeding. Pursuant to 37 CFR 1.989(b), the merged proceeding is governed by 37 CFR 1.902 through 1.997.

B. Papers mailed/filed:

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

All papers that are filed by the patent owner and the third party requesters should be directed:

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

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.

By U.S. Postal Service Mail:

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

By FAX to:

(571) 273-9900
Central Reexamination Unit

By hand (or delivery service):

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

The patent owner and the requesters are reminded that <u>every</u> paper filed in the merged proceeding subsequent to this Decision must be served on the other parties, including papers filed *via* facsimile transmission, 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 specification, claims, and drawings 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 a reexamination proceeding. Accordingly, clean copies of the amended claims are not required <u>and are not to be submitted</u>; rather amendments are to be presented via markings pursuant to 37 CFR 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

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

D. Fees:

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

E. Citation of Patents and Printed Publications:

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

F. Appeal Procedure Reminders for *Inter Partes* Reexamination

The parties are reminded of the procedures for taking appeal in an *inter partes* reexamination as explained in MPEP 2674 and 2675. The appeal must only be taken from (1) the rejection(s) of the claims in the Right of Appeal Notice (RAN) that the *patent owner* proposes to contest, or (2) the finding(s) of patentability of claims in the RAN that the *third party requester* proposes to contest. Therefore, in the notice of appeal, the patent owner must identify each claim rejected by examiner that the patent owner intends to contest and the third party requester must identify each rejection *that was previously proposed by that third party requester* that the third party requester intends to contest. (37 CFR 41.61) The appellant's brief shall present a concise statement of each issue. Further, no new ground of rejection can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection. (37 CFR 41.67(c)(1)(vi))

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/001,165 and *inter partes* Reexamination Control No. 95/000,503 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

2. Jurisdiction over the merged reexamination is being forwarded via the Central Reexamination Unit Director to the examiner for the preparation of an Office action, to be issued in due course for the merged proceeding.

3. Any questions concerning this communication should be directed to Raul Tamayo in the Office of Patent Legal Administration, at (571) 272-7728.

Pinchus M. Laufer
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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MAILED
MAR 08 2010
CENTRAL REEXAMINATION UNIT

Song K. Jung
MCKENNA LONG & ALDRIDGE LLP
1900 K STREET, NW
WASHINGTON DC 20006 (For Patent Owner)

Babak Redjaian
IRELL & MANELLA LLP
840 NEWPORT CENTER DRIVE
SUITE 400
NEWPORT BEACH, CA 92660 (For Third Party Requester)

Ex parte Reexamination Proceeding Control No. 90/009,586 Filed: September 23, 2009 For: U.S. Patent No. 7,218,374	**DECISION, *SUA SPONTE*, TO MERGE REEXAMINATION PROCEEDINGS**
Inter Partes Reexamination Proceeding Control No. 95/000,506 Filing Date: September 22, 2009 For: U.S. Patent No. 7,218,374	

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.

BACKGROUND

1. Patent number 7,218,374 (the '374 patent) issued on May 15, 2007, with claims 1-22.

2. The '374 patent is the subject of a concurrent proceeding styled *LG Display v. AU Optronics; Chi Mei Optoelectronics, and Chi Mei Optoelectronics USA,* Consolidated Case Nos. 06-726-JJF, 07-357-JJF, and 08-355-JJF (D.Del.). The complaints were filed on December 1, 2006, June 6, 2007, and June 12, 2008.

3. On September 22, 2009, a third party, Chi Mei Optoelectronics Corporation, filed a request for *inter partes* reexamination of claims 1, 2, 5, 6, 9, 11, 16, 17, 20, and 21 that was assigned control no. 95/000,506 (the '506 proceeding).

4. On September 23, 2009, a third party, Chi Mei Optoelectronics Corporation, filed a request for *ex parte* reexamination of claims 1, 2, 5, 6, 9, 11, 16, 17, 20, and 21 that was assigned control no. 90/009,586 (the '9586 proceeding).

5. On November 3, 2009, reexamination was ordered for claims 1, 2, 5, 6, 9, 11, 16, 17, 20, and 21 of the '556 patent in both the *inter partes* '506 proceeding and the *ex parte* '9586 proceeding. No claim amendments have been made in either proceeding. No Office action has been issued in either proceeding.

6. On January 3, 2009, the time for filing a patent owner statement under § 1.530 expired without the filing of a patent owner statement.

DECISION

I. MERGER OF PROCEEDINGS

37 CFR 1.989 provides:

> (a) If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the merged examination will normally result in the issuance of a single reexamination certificate under § 1.997.
>
> (b) An *inter partes* reexamination proceeding filed under § 1.913 which is merged with an *ex parte* reexamination proceeding filed under § 1.510 will result in the merged proceeding being governed by §§ 1.902 through 1.997, except that the rights of any third party requester of the *ex parte* reexamination shall be governed by §§ 1.510 through 1.560.

As evidenced by the above review of facts, both the *inter partes* '506 proceeding and the *ex parte* '9586 reexamination proceedings are currently pending. An order granting reexamination of claims 1, 2, 5, 6, 9, 11, 16, 17, 20, and 21 of the '556 patent has been mailed in each of the reexamination proceedings, and the time for filing a patent owner's statement has expired in the '9586 *ex parte* proceeding. Therefore, consideration of merger pursuant to 37 CFR 1.989 is appropriate at this time.

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 *inter partes* '506 proceeding and the *ex parte* '9586 reexamination proceedings would address these considerations. Thus, pursuant to 37 CFR 1.989(a), the 95/000,506 and 90/009,586 reexamination proceedings <u>are hereby merged</u>. The merged proceeding will be conducted in accordance with the guidelines and requirements which follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

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

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

The present decision merges an *ex parte* reexamination proceeding with an *inter partes* reexamination proceeding. Pursuant to 37 CFR 1.989(b), the merged proceeding is governed by 37 CFR 1.902 through 1.997, except that the rights of the third party requester of the *ex parte* reexamination are governed by 37 CFR 1.510 through 1.560. In this instance, Chi Mei Optoelectronics Corporation has full *inter partes* reexamination participation rights. The examiner will conduct reexamination in the merged proceeding for claims 1, 2, 5, 6, 9, 11, 16, 17, 20, and 21 of the '556 patent.

B. Papers mailed/filed:

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

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

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

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

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

By EFS:

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

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

C. Amendments:

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

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

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

D. Fees:

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

E. Citation of Patents and Printed Publications:

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

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/000,506 and *ex parte* Reexamination Control No. 90/009,586 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 Michael Cygan, Legal Advisor, at 571-272-7700.

Pinchus M. Laufer
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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MAILED

JUN 16 2010

CENTRAL REEXAMINATION UNIT

MCKENNA LONG & ALDRIDGE LLP 1900 K STREET, NW WASHINGTON DC 20006	:	(For Patent Owner)
IRELL & MANELLA LLP 1800 AVENUE OF THE STARS SUITE 900 LOS ANGELES, CA 90067	:	(For Third party Requester)
In re: Park *et alia* *Inter Partes* Reexamination Proceeding Control No. 95/000,506 Deposited on: 22 September 2009 For: US Patent No. 7,218,374 B2	:	DECISION GRANTING-IN-PART PETITION FOR EXTENSION OF TIME [37 CFR § 1.956]
In re: Park *et alia* *Ex Parte* Reexamination Proceeding Control No. 90/009,586 Deposited on: 23 September 2009 For: US Patent No. 7,218,374 B2	:	

This is a decision on the 08 June 2010, patent owner's "Petition for Extension of Time Under 37 CFR § 1.956," requesting that the time for responding to the non-final Office action mailed 16 April 2010 to be extended by six (6) weeks.

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

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

Discussion

The Patent Owner requests an extension of time in which to file a response to the non-final Office action dated was mailed 16 April 2010. The non-final Office action provides a two (2) month period for response. The petition requesting a six (6) weeks extension of time was timely filed on 08 June 2010. The $200 petition fee pursuant to 37 CFR §1.17 (g) is provided.

The request is granted-in-part. A one (1) month extension of time 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 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.

Decision

The patent owner petitions to extend the period for response by adding six (6) weeks to the period for response. The decision to extend the period for response is evaluated based upon a showing of "sufficient cause." There is always the consideration to balance the need for the patent owner to have a fair opportunity to respond to the Office action between the need for special dispatch.

The petitioner articulates the length of the Office action and applied references. On balance, the petitioner has demonstrated "sufficient cause" for granting-in-part the extension of time. Requests for extensions of time for more than one month will be granted only in extraordinary situations.

The concurrent proceedings are noted but since they are outside the scope of the instant proceeding are not germane to the issue of "sufficient cause."

The petition request to extend the response time is hereby granted-in-part. One (1)month time is hereby granted

Conclusion

1. The patent owner's petition for extension of time in which to file a response to the Office action dated 16 April 2010 is hereby **granted-in-part**.

2. A **one (1) month** extension of time is hereby granted.

3. The period to respond will end on **16 July 2010**.

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

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

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

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

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

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

/Mark Reinhart/

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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.
95/000,507	09/28/2009	6803984	7773.102.60	3244

30827 7590 03/05/2010

MCKENNA LONG & ALDRIDGE LLP
1900 K STREET, NW
WASHINGTON, DC 20006

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/05/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/000,507	09/28/09	6803984	160151-0012

IRELL & MANELLA LLP
1800 AVENUE OF THE STARS
SUITE 900
LOS ANGELES, CA 90067

EXAMINER
TIBBITS, PIA

ART UNIT	PAPER
3992	

DATE MAILED:
MAILED
MAR 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
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Song K. Jung
MCKENNA LONG & ALDRIDGE LLP
1900 K STREET, NW
WASHINGTON DC 20006

(For Patent Owner)

MAILED

MAR 05 2010

CENTRAL REEXAMINATION UNIT

Babak Redjaian
IRELL & MANELLA LLP
840 NEWPORT CENTER DRIVE
SUITE 400
NEWPORT BEACH, CA 92660

(For Third Party Requester)

Ex parte Reexamination Proceeding
Control No. 90/009,588
Filed: September 28, 2009
For: U.S. Patent No. 6,803,984

Inter Partes Reexamination Proceeding
Control No. 95/000,507
Filing Date: September 28, 2009
For: U.S. Patent No. 6,803,984

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.

BACKGROUND

1. Patent number 6,803,984 (the '984 patent) issued on October 12, 2004, with claims 1-21.

2. On September 28, 2009, a third party, Chi Mei Optoelectronics Corporation, filed a request for *inter partes* reexamination of claims 1, 2, 4-6, 9, and 10, that was assigned control no. 95/000,507 (the '507 proceeding).

3. On September 28, 2009, a third party, Chi Mei Optoelectronics Corporation, filed a request for *ex parte* reexamination of claims 1, 2, 4-6, 9, and 10, that was assigned control no. 90/009,588 (the '9588 proceeding).

4. On November 6, 2009, reexamination was ordered for claims 1, 2, 4-6, 9, and 10 of the '984 patent in both the *inter partes* '507 proceeding and the *ex parte* '9588 proceeding. No claim amendments have been made in either proceeding.

5. On December 24, 2009, patent owner filed a notice of concurrent proceedings stating that the '984 patent is the subject of a concurrent proceeding styled *LG Display v. AU Optronics; Chi Mei Optoelectronics, and Chi Mei Optoelectronics USA,* Consolidated Case Nos. 06-726-JJF, 07-357-JJF, and 08-355-JJF (D.Del.). The complaints were filed on December 1, 2006, June 6, 2007, and June 12, 2008. No Office action has been issued in either proceeding.

6. On January 6, 2009, the time for filing a patent owner statement under § 1.530 expired without the filing of a patent owner statement.

DECISION

I. MERGER OF PROCEEDINGS

37 CFR 1.989 provides:

> (a) If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the merged examination will normally result in the issuance of a single reexamination certificate under § 1.997.
>
> (b) An *inter partes* reexamination proceeding filed under § 1.913 which is merged with an *ex parte* reexamination proceeding filed under § 1.510 will result in the merged proceeding being governed by §§ 1.902 through 1.997, except that the rights of any third party requester of the *ex parte* reexamination shall be governed by §§ 1.510 through 1.560.

As evidenced by the above review of facts, both the *inter partes* '507 proceeding and the *ex parte* '9588 reexamination proceedings are currently pending. An order granting reexamination of claims 1, 2, 4-6, 9, and 10 of the '984 patent has been mailed in each of the reexamination proceedings, and the time for filing a patent owner's statement has expired in the '9588 *ex parte* proceeding. Therefore, consideration of merger pursuant to 37 CFR 1.989 is appropriate at this time.

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 *inter partes* '507 proceeding and the *ex parte* '9588 reexamination proceedings would address these considerations. Thus, pursuant to 37 CFR 1.989(a), the 95/000,507 and 90/009,588 reexamination proceedings <u>are hereby merged</u>. The merged proceeding will be conducted in accordance with the guidelines and requirements which follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

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

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

The present decision merges an *ex parte* reexamination proceeding with an *inter partes* reexamination proceeding. Pursuant to 37 CFR 1.989(b), the merged proceeding is governed by 37 CFR 1.902 through 1.997, except that the rights of the third party requester of the *ex parte* reexamination are governed by 37 CFR 1.510 through 1.560. In this instance, Chi Mei Optoelectronics Corporation has full *inter partes* reexamination participation rights. The examiner will conduct reexamination in the merged proceeding for claims 1, 2, 4-6, 9, and 10 of the '984 patent.

B. Papers mailed/filed:

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

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

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

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

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

By EFS:

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

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

C. Amendments:

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

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

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

D. Fees:

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

E. Citation of Patents and Printed Publications:

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

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/000,507 and *ex parte* Reexamination Control No. 90/009,588 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 Michael Cygan, Legal Advisor, at 571-272-7700.

Pinchus M. Laufer
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
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,509	10/07/2009	6781231	2550/701	5895

38939 7590 01/21/2010

DYKEMA GOSSETT PLLC
10 S. WACKER DR., STE. 2300
CHICAGO, IL 60606

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 01/21/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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Date: JAN 21 2010

CENTRAL REEXAMINATION UNIT

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
SUNSTEIN KANN MURPHY & TIMBERS LLP
125 SUMMER STREET
BOSTON, MA 02110-1618

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000509
PATENT NO. : 6784231
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

Steven McMahon Zeller
DYKEMA GOSSETT PLLC
10 S. WACKER DR., STE. 2300
CHICAGO IL 60606

(For Patent Owner)

MAILED

JAN 21 2010

CENTRAL REEXAMINATION UNIT

Robert M Asher
SUNSTEIN KANN MURPHY
& TIMBERS LLP
125 SUMMER STREET
BOSTON, MA 02110-1618

(For Third Party Requester)

In re: Anthony D Minervini
Inter Partes Reexamination Proceeding
Control No. 95/000,509
Deposited on: 07 October 2009
For: US Patent No. 6,781,231

DECISION
DISMISSING
PETITION FOR EXTENSION
OF TIME
[37 CFR §§ 1.956 & 1.181]

This is a decision on the 12 January 2010, "Petition for Extension of Time Under 37 CFR § 1.956" requesting that the time for responding to the non-final Office action mailed 25 November 2009, be 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 dismissed for the reasons set forth below.

DISCUSSION

The Patent Owner's representative requests the period of time be extended in which to file a response to the non-final Office action mailed 25 November 2009, which set two (2) months time for filing a response thereto. The petition for extension of time was timely filed on 12 January 2010, 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 petition is dismissed for the reasons set forth below.

> **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.

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.
>
> ...

DECISION

The patent owner's representative petitions under 37 CFR § 1.956 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.

On balance it is unclear how the ITC order is specifically germane to the instant proceeding. The Patent owner should note that extensions of time in *inter partes* proceedings require that the reasons for petitioning for the extension must include (A) a statement of what action the patent owner has taken to provide a response, to date as of the date the request for extension is submitted, and (B) why, in spite of the action taken thus far, the requested additional time is needed. The statement of (A) must provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period. The patent owner has stated that there is an ongoing ITC order and that there were other requests for *inter partes* reexamination, these are duly noted. What is not clear is what actions the patent owner has taken thus far, specific to this proceeding and why in spite of this action the additional time is needed.

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

CONCLUSION

1. The patent owner's petition for extension for time in which to file a response to the non-final Office action dated 25 November 2009 is hereby **dismissed.**

2. The Patent Owner's response is due **25 January 2010.**

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

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

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

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

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

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

/Mark Reinhart/

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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JUN 17 2010

CENTRAL REEXAMINATION UNIT

FOLEY AND LARDNER LLP SUITE 500 3000 K STREET NW WASHINGTON DC 20007	: : : :	(For Patent Owner)
RAYMOND J. WERNER 2056 NW ALOCLEK DRIVE SUITE 314 HILLSBORO, OR 97124	: : : :	(For Third Party Requester)
In re: Paul Warner *Ex Parte* Reexamination Proceeding Control No.: 95/000,526 Deposited: 25 January 2006 For: U.S. Patent No.: 6,867,423 B2	: : : : :	DECISION ON PETITION UNDER 37 CFR § 1.181

This is a decision on a petition filed by the patent owner on 11 June 2010. The petition is entitled "Emergency Petition Under 37 CFR 1.181 Requesting that the Office Vacate Formal Objections in Reexamination"" [hereinafter "the petition"].

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 11 June 2010 is granted with respect to vacating the formal objections to the specification, drawings and original patent claims.

REVIEW OF RELEVANT FACTS

- U.S. Patent No. 6,867,423 B2 issued on 15 March 2005.
- A request for *inter partes* reexamination was filed concerning the '423 patent and assigned control no. 95/000,526 on 04 January 2010.
- *Inter partes* reexamination was ordered in the above named proceeding.
- Prosecution progressed in 95/000,526 proceeding until an Action Closing Prosecution (hereinafter "ACP") was mailed on 03 June 2010.
- The instant proceeding ACP contains an objection to the drawings, specification and claim language from original claims of the '423 patent.
- On 11 June 2010, the instant petition was filed under 37 CFR § 1.181 requesting relief in the form of vacating the formal objection.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 CFR § 1.906 Scope of reexamination in inter partes reexamination proceeding.

(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 § 1.181 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 . . . .

DECISION

The Patent owner [hereinafter "petitioner"] states that the examiner erred in the objections to the drawings, specification and that of claims 3, 5, and 11.

On its face, 37 CFR § 1.906 (a) explicitly states "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." Since objection of claims 3, 5, and 11 is directed to language from the original patent claims rule 906 specifically excludes any such objection.

Turning to the objection to the drawings and the specification, the examiner in the Action Closing Prosecution dated 03 June 2010 relies upon 37 CFR §§ 1.83(a) &1.121(d) for authority in the objections to require changes to both the specification and the drawings. Noting that both rules cited are directed to applications and not inclusive of proceedings, the examiner does not have the authority to object on these grounds.

For the above reasons, the Director hereby vacates the objections to the drawings, specification and original patent claim language. The instant petition is hereby granted. This petition directs the proceeding to the examiner for correction of the Action Closing Prosecution vacating the objections described in this petition decision.

CONCLUSION

1. The petition under 37 CFR § 1.181 for vacating the objections to the specification, drawings and original claim language is hereby granted.

2. Jurisdiction of this proceeding remains in the Central Reexamination Unit so that the examiner may make appropriate corrections to the Action Closing prosecution.

3. The Action Closing Prosecution dated 03 June 2010 is vacated.

4. Telephone inquiries related to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner, at (571) 272-1611 or in his absence to the undersigned at (571) 272-3838.

Gregory A. Morse
Director, Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,527	01/13/2010	7598035	INV850/4-047REUS	8412

79975 7590 06/11/2010

King & Spalding LLP
P.O. Box 889
Belmont, CA 94002-0889

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/11/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/000,527	01/13/10	7598035	

EXAMINER
TURNER,SHARON L.

ART UNIT	PAPER
3991	

VINSON & ELKINS, LLP
FIRST CITY TOWER
1001 FANNIN STREET
SUITE 2500
HOUSTON, TX 77002-6760

DATE MAILED:
MAILED

JUN 1 1 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.uspto.gov

King & Spalding LLP
P.O. Box 889
Belmont, CA 94002-0889

(For Patent Owner)

Vinson & Elkins, LLP
First City Tower
1001 Fannin Street
Suite 2500
Houston, TX 77002-6760

(For Third Party Requester)

MAILED

JUN 11 2010

CENTRAL REEXAMINATION UNIT

In re Macevicz
Inter Partes Reexamination Proceeding
Control No. 95/000,527
Filed: January 13, 2010
For: U.S. Patent No. 7,598,035

: **DECISION**
: **ON**
: **PETITIONS**

On May 21, 2010, patent owner filed a paper titled "PETITION FOR SUSPENSION OF *INTER PARTES* REEXAMINATION PURSUANT TO 37 C.F.R. § 1.987," which is taken as a petition for suspension of action under 37 CFR 1.182. On May 24, 2010, patent owner filed a paper titled "PETITION TO WITHDRAW PETITION FOR SUSPENSION OF *INTER PARTES* REEXAMINATION," in which patent owner requests withdrawal of the May 21, 2010 petition for suspension of action.

Based upon the May 24, 2010 paper:

1. The May 21, 2010 petition for suspension of action is dismissed as withdrawn. The May 24, 2010 petition is granted.

2. A copy of this decision will be placed in the present *inter partes* reexamination file.

3. Jurisdiction over this proceeding is being returned to the Central Reexamination Unit.

4. Telephone inquiries with regard to this decision should be directed to Susy Tsang-Foster, Legal Advisor, at 571-272-7711.

/ Kenneth M. Schor/

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

6-8-2010
C:\Kiva\KenWD

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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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

KELLEY DRYE & WARREN LLP
3050 K STREET, N.W.
SUITE 400
WASHINGTON, DC 20007.

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

REEXAMINATION CONTROL NUMBER *95/000,530*.

PATENT NUMBER *7,123,708*.

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.

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,530	01/28/2010	7123708	019153-0001	4937

22850 7590 06/30/2010

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/30/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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.
95/000,530	01/28/2010	7123708	019153-0001	4937

22850 7590 06/30/2010

WOODCOCK WASHBURN LLP
CIRA CENTRE, 12TH FLOOR
2929 ARCH STREET
PHILADELPHIA, PA 19104-2891

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/30/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Woodcock Washburn LLP
CIRA Centre, 12th Floor
2929 Arch Street
Philadelphia, PA 19104-2891

(For Patent Owner)

Kelley Drye & Warren LLP
3050 K Street, N.W.
Suite 400
Washington, D.C. 20007

(For Third Party Requester)

MAILED

JUN 3 0 2010

CENTRAL REEXAMINATION UNIT

Scott A. McKeown
Oblon, Spivak, McClelland, Maier,
& Neustadt, LLP
1940 Duke Street
Alexandria, VA 22314

(Courtesy Copy)

In re Gavillet	:	**DECISION DISMISSING**
Inter partes Reexamination Proceeding	:	**PETITION TO SUSPEND**
Control No: 95/000,530	:	**PROCEEDING AND PETITION**
Filing Date: January 28, 2010	:	**TO STRIKE OPPOSITION**
For: U.S. Patent No.: 7,123,708	:	**PAPER**

This is a decision on the following petitions and opposition papers:

1. The April 12, 2010 patent owner petition, entitled "Petition Under 37 CFR 1.183 for Waiver of the Rules to Permit Immediate Suspension of *Inter Partes* Reexamination" (the April 12, 2010 patent owner petition);

2. The April 21, 2010 requester petition, entitled "Third-Party Requester's Petition and Opposition Under 37 CFR 1.183 in Response to Patent Owner's Petition Under 37 CFR 1.183 For Waiver of the Rules to Permit Immediate Suspension of *Inter Partes* Reexamination" (the April 21, 2010 requester opposition petition);

3. The May 19, 2010 patent owner petition, entitled "Petition Under 37 CFR 1.182 to Strike Third-Party Opposition Filing of April 21, 2010" (the May 19, 2010 patent owner petition to strike);

4. The June 10, 2010 supplement to the requester April 21, 2010 petition, entitled "Third-Party Requester's Supplement to Petition and Opposition Under 37 CFR 1.183 in Response to Patent Owner's Petition Under 37 CFR 1.183 For Waiver of the Rules to Permit Immediate Suspension of *Inter Partes* Reexamination" (the June 10, 2010 supplement to requester opposition petition); and

5. The June 15, 2010 supplemental patent owner petition, entitled "Supplemental Petition Under 1.183 for Waiver of the Rules to Permit Immediate Suspension of *Inter Partes* Reexamination" (the June 15, 2010 supplemental patent owner petition).

This decision also addresses the April 6, 2010 change of correspondence address for the patent owner.

The April 12, 2010 patent owner petition, the April 21, 2010 requester petition and opposition, the May 19, 2010 patent owner petition to strike, the June 10, 2010 supplement to requester petition, the June 15, 2010 supplemental patent owner petition, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

The $400 fees under 37 CFR 1.17(f) for the April 12, 2010 patent owner petition under 37 CFR 1.183, the May 19, 2010 patent owner petition under 37 CFR .182 to strike, and the June 15, 2010 supplemental patent owner petition under 37 CFR 1.183, have been paid.

SUMMARY

The April 12, 2010 patent owner petition under 37 CFR 1.183, as supplemented by the June 15, 2010 supplemental patent owner petition under 37 CFR 1.183, is **dismissed**.

The May 19, 2010 patent owner petition under 37 CFR 1.182 to strike requester's opposition petition is **dismissed**. Requester's opposition petition has been considered as to its opposition merits discussion.

The April 6, 2010 change of correspondence address for the patent owner is **ineffective**.

BACKGROUND

- On October 17, 2006, U.S. Patent 7,123,708 (the '708 patent) issued.
- On January 28, 2010, a request for *inter partes* reexamination was filed, and the resulting *inter partes* reexamination proceeding was assigned control no. 95/000,530 (the '530 proceeding).
- On March 26, 2010, the Office mailed an order granting reexamination in the '530 proceeding.
- Also on March 26, 2010, the Office mailed a nonfinal Office action.
- On April 6, 2010, the patent owner filed a power of attorney and change of correspondence address in the '530 proceeding.
- On April 12, 2010, the patent owner filed a petition entitled "Petition Under 37 CFR 1.183 for Waiver of the Rules to Permit Immediate Suspension of *Inter Partes* Reexamination" (the April 12, 2010 patent owner petition).

- On April 21, 2010, the requester filed a petition entitled "Third-Party Requester's Petition and Opposition Under 37 CFR 1.183 in Response to Patent Owner's Petition Under 37 CFR 1.183 For Waiver of the Rules to Permit Immediate Suspension of *Inter Partes* Reexamination" (the April 21, 2010 requester opposition petition).

- On May 13, 2010, the patent owner filed a request under 37 CFR 1.956 for a two-month extension of time.

- On May 19, 2010, the patent owner filed a petition entitled "Petition Under 37 CFR 1.182 to Strike Third-Party Opposition Filing of April 21, 2010" (the May 19, 2010 patent owner petition to strike).

- On May 20, 2010, the Office mailed a decision granting the May 13, 2010 patent owner request under 37 CFR 1.956 for a two-month extension of time.

- On June 10, 2010, the requester filed a paper entitled "Third-Party Requester's Supplement to Petition and Opposition Under 37 CFR 1.183 in Response to Patent Owner's Petition Under 37 CFR 1.183 For Waiver of the Rules to Permit Immediate Suspension of *Inter Partes* Reexamination" (the June 10, 2010 supplement to requester opposition petition).

- On June 15, 2010, the patent owner filed a supplemental petition entitled "Supplemental Petition Under 1.183 for Waiver of the Rules to Permit Immediate Suspension of *Inter Partes* Reexamination" (the June 15, 2010 supplemental patent owner petition).

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

35 U.S.C. 314(c) provides:

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

37 CFR 1.182 provides:

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

37 CFR 1.183 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 1.987 provides:

If a patent in the process of inter partes reexamination is or becomes involved in litigation, the Director shall determine whether or not to suspend the *inter partes* reexamination proceeding.

MPEP 2686.04, subsection III, provides, in pertinent part:

. . . **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.
It should also be noted that if, 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.

DECISION

I. The April 12, 2010 Patent Owner Petition and the June 15, 2010 Supplemental Patent Owner Petition

In the April 12, 2010 patent owner petition under 37 CFR 1.183, the patent owner requests the Office to suspend the present '530 *inter partes* reexamination proceeding, and to waive the requirement of 37 CFR 1.182, relating to "other requirements as may be imposed"; specifically, the provision of 37 CFR 1.181(f) that "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 for other proceedings . . .". The patent owner further requests the Office to waive the requirements of MPEP 2686.04, subsection III, that to ensure consideration on the merits of a petition to suspend when 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, [1]and

[1] Regarding item (2), because the April 12, 2010 petition also includes a discussion of whether "good cause" exists to suspend the '530 proceeding, the present petition is construed as a petition under 37 CFR 1.182 to suspend the '530 proceeding, as well as a petition under 37 CFR 1.183 to waive 37 CFR 1.182, 37 CFR 1.181(f), and the requirements of MPEP 2686.04, subsection III.

(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 patent owner argues that the district court litigation, in which the requester and the patent owner are parties, is at an "advanced stage", and that the request for *inter partes* reexamination is a tactical attempt to delay the completion of the lawsuit and increase the patent owner's costs. The patent owner asserts that forcing the patent owner to respond to the outstanding Office action prior to "the inevitable termination or suspension" of the '530 proceeding "will only serve to inflict additional expense on the Patent Holder and result in wasted effort on the part of the USPTO". Further, the patent owner asserts that the claims of the '708 patent before the Office are identical to the claims that will be subject to trial in the district court (when the trial commences), and apparently asserts that the same prior art that is before the Office in the '530 proceeding will be before the district court. In addition, the patent owner argues that, because the claims at issue will be identical, an adverse decision to either party by the court will cause the Office to vacate the proceeding, resulting in a waste of Office resources.

In the June 15, 2010 supplemental patent owner petition, however, the patent owner informs the Office that the district court trial date has been vacated, that a new trial date has not yet been set, and that the district court has ordered the parties to complete briefing on all remaining summary judgment issues (including invalidity issues) by July 16, 2010.[2]

II. Consideration of the April 12, 2010 Patent Owner Petition as Supplemented by the June 15, 2010 Supplemental Patent Owner Petition

Waiver of the rules under 37 CFR 1.183, may only be granted in an *extraordinary situation when justice requires*. In this instance, the requested waiver has not been justified.

1. It is initially pointed out that, contrary to patent owner's arguments, it is not clear which prior art will be before the district court. The patent owner draws attention to an expert report dated March 12, 2010[3] (exhibit B), in which the art at issue in the nonfinal Office action of March 26, 2010 is discussed. The patent owner does not expressly state that the expert report was submitted to the court, and on what date. Even assuming that the March 12, 2010 expert report was submitted to the court, however, it is not clear that any or all of the prior art discussed in that report will be at issue, i.e., specifically "before" the court, until the district court trial is held.

2. The patent owner argues that the district court litigation, in which the requester and the patent owner are parties, is at an "advanced stage". However, in this instance, briefing has not yet been completed, and the trial has not yet begun. In fact, no trial date is currently set. On the other hand, reexamination has been ordered in the present reexamination proceeding, and an Office action has already been issued. In the present reexamination proceeding, the issue of

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[2] In the June 15, 2010 supplemental patent owner petition, the patent owner essentially repeats the arguments that the request for *inter partes* reexamination is a tactical attempt to delay the completion of the lawsuit, and that an adverse decision to either party by the court will cause the Office to vacate the proceeding, resulting in a waste of Office resources.

[3] See Exhibit B, which is attached to the April 12, 2010 patent owner petition.

patentability has already been "joined."

3. The patent owner asserts that forcing the patent owner to respond to the already-issued Office action proceeding "will only serve to inflict additional expense on the Patent Holder and result in wasted effort on the part of the USPTO". However, reexamination and litigation proceedings are not duplicative; thus, it is appropriate that they both continue at the same time. In *Ethicon v. Quigg*, 849 F.2d 1422 (Fed. Cir. 1988), the Federal Circuit noted that district courts and the Office use different standards of proof in determining invalidity, and thus, on the same evidence, could quite correctly come to different conclusions. *Id.* at 1427-29. Specifically, invalidity in a district court must be shown by "clear and convincing" evidence, whereas in the Office, it is sufficient to show nonpatentability by a "preponderance of evidence." *Id.* at 1427. Since the "clear and convincing" standard is more difficult to satisfy than the "preponderance" standard, claims held valid by the courts may be rejected in a reexamination proceeding.

Moreover, because a patent owner can amend the claims in a reexamination proceeding, the Office gives claims their broadest reasonable interpretation consistent with the specification, which is different than the claim interpretation employed by the courts. This can be observed from the Federal Circuit's decision in *In re American Academy of Science Tech Center*, 367 F.3d 1359 (Fed. Cir. 2004), where the Court rejected American Academy's arguments for a narrow claim interpretation in a reexamination proceeding. The Federal Circuit found that claims should be given "their broadest reasonable interpretation" during examination and reexamination in the Office "because the applicant has the opportunity to amend the claims to obtain more precise claim coverage." *Id.* at 1364; see also *In re Zletz*, 893 F.2d 319, 321-22 (Fed. Cir. 1989) (the manner of claim interpretation that is used by courts in litigation is not the same as that during prosecution of a pending application before the Office).

The *American Academy*, *Zletz,* and *Ethicon* decisions show that the Federal Circuit's view of the different standards for reexamination and litigation are firmly in place. It is appropriate to continue both proceedings to obtain the results and benefits of each, as they accrue. Further, as the two proceedings progress, any information that comes to light in one may be applied to the other.

4. The patent owner compares the facts of the present case to those in *Sony Computer Entertainment America, Inc. v. Dudas*, 2006 WL 1472462 (E.D. Va. 2006), in asserted support of a showing of an extraordinary situation, toward suspension of the rules, and in support of a showing of good cause for suspending these proceedings. However, the facts in *Sony* are clearly distinguishable from this proceeding. In *Sony*, the request for *inter partes* reexamination was not filed until *after a final judgment in the district court was rendered and that judgment was adverse to the requester on the issue of patentability*. In the present case, however, the request for *inter partes* reexamination was filed well before trial has begun, and there is no judgment by the court adverse to the requester. Furthermore, reexamination in *Sony* was limited to the claims that were being litigated. In the present case, however, because trial in the district court has not yet begun, it is not clear which claims will be before the district court, contrary to patent owner's arguments. Also, unlike *Sony*, the Office has already issued a first Office action rejecting all of the claims of the '708 patent, as is argued by the requester in the April 21, 2010 opposition. Finally, a final decision in *Sony* was on the horizon. A decision is "final" after all appeals, including any appeal to the Federal Circuit, have been exhausted. In the present case, however, a

final decision is not expected in the near future, as is argued by the requester in the April 21, 2010 opposition. Without a final decision *adverse to requester*, no estoppel can attach to bar the filing of an *inter partes* reexamination request or to mandate termination of an ordered reexamination proceeding. Stated another way, the fact that estoppel could possibly attach as to an uncertain number of the patent claims at some uncertain point in the future, as argued by patent owner, does not provide the requisite showing of good cause for suspension, and it is certainly not a showing of an extraordinary situation, such that justice requires suspension of the rules.

5. The failure of the patent owner to comply with the rules, or the requirements (1) - (3) of MPEP 2686.04, subsection III, as set forth in this decision, does not rise to an *extraordinary situation* under 37 CFR 1.183 to justify suspension of the rules. Therefore, justice would not require suspension of the above-discussed requirements of 37 CFR 1.182, 37 CFR 1.181(f), and MPEP 2686.04, subsection III.

Accordingly, the April 12, 2010 patent owner petition under 37 CFR 1.183, and the June 15, 2010 supplemental patent owner petition under 37 CFR 1.183, are **dismissed**. Pursuant to MPEP 2686.04, subsection III, the '530 *inter partes* reexamination proceeding will continue, and **will not be suspended**. The **period for response** to the outstanding March 26, 2010 nonfinal Office action, as set in the May 20, 2010 decision granting a two-month extension of time, **continues to run**.

6. The patent owner also requests that the outstanding March 26, 2010 Office action be rescinded, or that the period for responding to the outstanding Office action be restarted from the date that a suspension of the proceedings is lifted, if applicable. A request to vacate or rescind an Office action, however, must be made via a petition under 37 CFR 1.181, which must be addressed by a deciding official in the Central Reexamination Unit or other Technology Center and must be filed as a separate paper pursuant to 37 CFR 1.4(c). To the extent that the present petition is also is filed as a petition under 37 CFR 1.183 to "restart" the time period for response to the outstanding Office action from the date that a suspension of the proceedings is lifted, such a petition is dismissed as inapplicable, since this decision also dismisses patent owner's petition under 37 CFR 1.183 to suspend the present proceeding.

7. Additional Comment:

If a renewed petition to suspend the '530 *inter partes* reexamination proceeding, which is in full compliance with Office requirements, is later contemplated, the factors explained in this section of the decision, parts 1 – 4 must be addressed. A failure to do so would not be consistent with MPEP 2609 which states that "[p]**atent 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.... It is expected that the parties will adhere to the provisions of 37 CFR 10.18(b) throughout the course of a reexamination proceeding.**"

III. The May 19, 2010 Patent Owner Petition Under 37 CFR 1.182 to Strike Opposition Paper

The patent owner requests that the April 21, 2010 requester petition/opposition be expunged from the record after its consideration by the Office. The patent owner states that the April 21, 2010 requester petition contains baseless accusations regarding the conduct of the patent owner's representative that have no proper place on the public record. In the interest of conducting this proceeding with special dispatch pursuant to 35 U.S.C. 314(c), the proceeding will not be delayed further by addressing "accusations", asserted or otherwise, in parties' petition papers, which could involve expungement of papers and giving time to file redacted papers. Rather, pursuant to 37 CFR 1.906(c), the Office will refrain from considering any issues that are not within the scope of reexamination. To the extent that the patent owner has identified any such issues that are not within the scope of reexamination, the patent owner's position is of record, and the discussion of the issues provided in the present decision is not inconsistent with any such identification.

Accordingly, the May 19, 2010 patent owner petition under 37 CFR 1.182 to strike is **dismissed**.

IV. The Attempted April 6 2010 Change of Correspondence Address of the Patent Owner

A change of correspondence address was filed by the patent owner in the '530 proceeding on April 6, 2010. However, the address for the patent owner in a reexamination proceeding is the official correspondence address of the patent owner *in the patent file*. In the present case, the official correspondence address for the patent owner, that is of record in application no. 10/087,363, the patent file, is shown in the caption of this decision. See MPEP 2622 and 37 CFR 1.33(c).

Accordingly, the April 6, 2010 change of correspondence address for the patent owner is **ineffective**.

A courtesy copy of this decision will be mailed to the practitioner who submitted the present patent owner petitions, Mr. Scott A. McKeown. **Absent the filing of a proper change of correspondence address in the patent file, which is application no. 10/087,363, however, all future correspondence will be mailed to the current address of record for the patent owner, as shown in the caption of this decision.**

CONCLUSION

- The patent owner petition under 37 CFR 1.183, as supplemented, is **dismissed**.
- The present *inter partes* reexamination proceeding will continue, and **will not be suspended**. The **period for response** to the outstanding March 26, 2010 nonfinal Office action, as set in the May 20, 2010 decision granting a two-month extension of time, **continues to run**. The period for response will expire after July 26, 2010.
- The patent owner petition under 37 CFR 1.182 to strike is **dismissed**.

- The April 6, 2010 change of correspondence address for the patent owner is **ineffective**. Absent the filing of a proper change of correspondence address in the patent file, application no. 10/087,363, all future correspondence will be mailed to the current address of record for the patent owner, as shown in the caption of this decision.

- Jurisdiction over this proceeding is returned to the Central Reexamination Unit to await any filing of patent owner's response, or the expiration of time to respond.

- If no timely response to the March 26, 2010 Office action is filed by the patent owner, the prosecution of this proceeding will be **terminated** in accordance with 37 CFR 1.957.

- Telephone inquiries related to this decision should be directed to Cynthia L. Nessler, Senior Legal Advisor, at (571) 272-7724, or in her absence, to the undersigned at (571) 272-7710.

Kenneth M. Schor

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

6-29-10
Kenpet8/IP/suspend

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,533	02/11/2010	7113919	068972800100	4063

23377 7590 05/12/2010

WOODCOCK WASHBURN LLP
CIRA CENTRE, 12TH FLOOR
2929 ARCH STREET
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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 05/12/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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MORRISON & FOERSTER LLP
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SAN FRANCISCO, CA 94105-2482

Date:

MAILED

MAY 12 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000533
PATENT NO. : 7113919
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

WOODCOCK WASHBURN LLP
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(For Patent Owner)

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(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/000,533
Filed: February 11, 2010
For: U.S. Patent No. 7,113,919

DECISION GRANTING PETITION

This is a decision on patent owner's petition under 37 CFR 1.183 entitled "PETITION FOR INCREASE OF PAGE LIMIT FOR PATENT OWNER'S RESPONSE PURSUANT TO 37 C.F.R. 1.183 AND 1.943(b)," filed on March 30, 2010.

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. 23-3050 on March 30, 2010.

The petition under 37 CFR 1.183 is granted.

BACKGROUND

1. On September 26, 2006, United States Patent No. 7,113,919 (the '919 patent) issued to Norris *et al.*

2. On February 11, 2010, a request for *inter partes* reexamination of claims 1-4, 6-13, 15-23, 25-35, 37-44, 46-55, 57-61, 68-70, 74-81, 88-90, and 94-100 of the '919 patent was filed by a third party requester, in which National Semiconductor Corporation was identified as the

real party in interest. The request was assigned Reexamination Control No. 95/000,533 (the '533 proceeding).

3. On March 15, 2010, *inter partes* reexamination was ordered in the '533 proceeding for claims 1-4, 6-13, 15-23, 25-35, 37-44, 46-55, 57-61, 68-70, 74-81, 88-90, and 94-100 of the '919 patent. Reexamination was not requested for claims 5, 14, 24, 36, 45, 56, 62-67, 71-73, 82-87, and 91-93.

4. Concurrently, on March 15, 2010, an Office action was mailed in the '533 proceeding, rejecting claims 1-4, 6-13, 15-23, 25-35, 37-44, 46-55, 57-61, 68-70, 74-81, 88-90, and 94-100 of the '919 patent.

5. On March 30, 2010, patent owner filed the instant petition entitled "PETITION FOR INCREASE OF PAGE LIMIT FOR PATENT OWNER'S RESPONSE PURSUANT TO 37 C.F.R. 1.183 AND 1.943(b)," (petition under 37 CFR 1.183), concurrently with a paper entitled "REQUEST FOR EXTENSION OF TIME PURSUANT TO 37 CFR 1.956" (request for extension of time).

6. On April 16, 2010, the Office mailed a decision granting patent owner's March 30, 2010 request for extension of time. Patent owner's time period for responding to the March 15, 2010 Office action will end on June 15, 2010.

DECISION

RELEVANT 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 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, patent owner requests suspension of 37 CFR 1.943(b) with respect to the 50-page limit for the patent owner response to the March 15, 2010 non-final Office action, and

requests that the page limit be extended to 400 pages.[1] In support of its request for waiver of the rule, patent owner asserts that "[t]he outstanding Office Action, including the pages incorporated by reference from the Request for Reexamination is more than 800 pages long, and presents 44 separate grounds of rejection for alleged anticipation or obviousness that are said to find bases in ten patents or publications."[2]

Patent owner further asserts that "[b]y any objective standard, 50 pages is not sufficient for a reasoned and comprehensive response to the issues raised in the 800+ page Office Action which incorporates by reference more than 800 pages from the 1000+ page Request for *Inter Partes* for Reexamination."

Further in support of its request for waiver of the 50-page limit of 37 CFR 1.943(b), patent owner asserts that "[t]he increase in the page limit is further necessitated by the fact that 41 of the outstanding grounds of rejection are for alleged obviousness " and that "[g]iven the analytical standards set forth in *KSR International co. v. Teleflex Inc.*, 127 S.Ct. 1727 (2007), Patent Owner needs adequate space to tell the full and complete story of the significant invention embodied in the patent claims that currently are subject of reexamination."[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.

Based on the individual facts and circumstances of this case including, for example, the number of claims under reexamination, the nature and number of the claim rejections, and the size of the Office action, it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance.

It is noted that, the March 15, 2010 Office action incorporates by reference a substantial amount of material from the request. Thus, even absent a fact-supported determination by petitioner of exactly how many additional pages patent owner requires to complete its response, it is deemed equitable in this instance to waive the 50-page limit of 37 CFR 1.943(b) to the extent that patent owner's response to the March 15, 2010 Office action not exceed 400 pages.[4]

Accordingly, patent owner's petition under 37 CFR 1.183 is <u>granted</u> and the page limit of 37 CFR 1.943(b) is waived to the extent that patent owner's response to the March 15, 2010 Office action <u>not exceed 400 pages</u> in length, excluding appendices of claims and reference materials,

---

[1] Petition at page 1.
[2] Petition at page 1.
[3] Petition at page 2.
[4] 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).

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.**

Patent owner's time period for responding to the March 15, 2010 Office action continues to run and will end on June 15, 2010.

THIRD PARTY REQUESTER

This decision, *sua sponte*, waives the provisions of 37 CFR 1.943(b) to the extent that 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 400 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.**

CONCLUSION

1. Patent owner's petition under 37 CFR 1.183 is granted, and the page limit of 37 CFR 1.943(b) is waived to the extent that patent owner's response to the March 15, 2010 Office action not exceed 400 pages in length, excluding appendices of claims and 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.**

2. This decision, *sua sponte*, waives the provisions of 37 CFR 1.943(b) to the extent that 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 400 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.**

3. Jurisdiction for the '533 reexamination proceeding is returned to the Central Reexamination Unit (CRU).

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

Kenneth M. Schor

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

Kenpetlog8
4-11-10

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,534	02/11/2010	7,422,053	4352.02REX01	4641

27896 7590 06/23/2010

EDELL, SHAPIRO & FINNAN, LLC
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ROCKVILLE, MD 20850

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/23/2010

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Date:

MAILED

JUN 23 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000534
PATENT NO. : 7422053
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)

Patterson, Thuente, Skaar & Christensen, P.A.
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Minneapolis, MN 55402-2100

(For Requester)

In re Siu	:
Reexamination Proceeding	: DECISION ON
Control No. 95/000,534	: PETITION
Filed: February 11, 2010	: (37 CFR 1.927)
For: U.S. Patent No. 7,422,053	:

The paper filed by requester on May 26, 2010, styled as "Petition Under 37 CFR § 1.927 and 37 CFR § 1.181 for Supervisory Review of the Examiner's Determination Refusing Inter-Partes Reexamination of Certain Claims of the Subject Patent", is before the Director of the Central Reexamination Unit (CRU). Petitioner, the reexamination requester, seeks review of the examiner's determination that a substantial new question of patentability was not raised by the reexamination request as to claims 1-7, 9-10, 18-21 and 23-25 of U.S. Patent No. 7,422,053 (hereinafter, the '053 patent) in the Order, dated April 26, 2010, granting-in-part the request for reexamination. Specifically, petitioner requests that the CRU Director find that a substantial new question of patentability (SNQ) exists for claims 1-7, 9-10, 18-21 and 23-25 of the '053 patent, and to order reexamination of claims 1-7, 9-10, 18-21 and 23-25.

The petition is denied for the reasons set forth below.

REVIEW OF FACTS

1. The '053 patent issued on September 9, 2008. The '053 patent is a continuation of application no. 10/390,773, filed March 19, 2003, which is now abandoned.

2. On February 11, 2010, the third party requested deposited a request for *inter partes* reexamination, and the resulting reexamination proceeding was assigned Control No. 95/000,534 (hereinafter, the '534 proceeding).

3. Reexamination was requested for claims 1-25 of the '053 patent.

4. A Notice of Reexamination Request Filing Date was issued on March 8, 2010.

5. An order granting the request for reexamination for claims 8, 11-17 and 22 was issued on April 26, 2010.

6. On May 26, 2010, the third party requested filed the above-mentioned petition under 37 CFR § 1.927.

Petitioner's Grounds in Support of the Requested Relief

Petitioner advances the following grounds in support of his position that the denial of the request for reexamination for claims 1-7, 9-10, 18-21 and 23-25 should be reversed by the Director:

1. Petitioner argues that the examiner applied an improper standard in assessing whether the newly cited references raised and SNQ (see pages 16-24 of the petition).
2. Petitioner argues that, as a result of the application of the improper standard, the examiner's analysis of the newly filed references was flawed and incorrect and the references do present a SNQ (see pages 30-56 of the petition).[1]

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

[1] It is noted that at pages 24-29 of the petition, petitioner presents the argument that the "mandatory nature of the new, non-cumulative technological teaching requirement of MPEP § 2616 is improper because it is inconsistent with the purpose for reexamination intended by Congress and unduly limits access to reexamination procedures." However, this argument will not be address in this petition decision.

Director's review on petition is *de novo*. Therefore, the review will determine whether the examiner's refusal to order reexamination for claims 1-7, 9-10, 18-21 and 23-25 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 1-7, 9-10, 18-21 and 23-25 of the '053 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." Questions relating to grounds of rejection other than those based on prior art patents or printed publications should **not** be included in the request and will not be considered by the examiner if included. A substantial question of patentability is raised by a cited patent or printed publication when there is a substantial likelihood that a reasonable examiner would consider the prior art patent or printed publication important in deciding whether or not the claim is patentable. If the prior art patents and printed publications relied upon in the request raise a substantial question of patentability, then a "substantial new question of patentability" is present, unless the same question of patentability has already been decided by a final holding of invalidity after all appeals, or by the Office in a previous examination or in a reexamination of a patent. If a substantial new question of patentability is found, an order for *inter partes* reexamination of the patent is issued.

An SNQ is not raised by the old prior art if the Office has previously considered (in an earlier examination of the patent) the <u>same</u> question of patentability as to the patent and has decided that question in favor of the patent owner based on the same prior art patents or printed publications. *In re Recreative Technologies*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996).

Looking to the legislative history for the original reexamination statute,[2] Congress stated:

> "Section I provides for a system of administrative reexamination of patents within the patent office. This new procedure will permit any party to petition the patent office to review the efficacy of a patent, subsequent to its issuance, on the basis of **new information about preexisting technology which may have escaped review at the time of the initial examination of the patent application**. H.R. Rep. No. 96-1307, 96th Cong., 2d Sess. 3 (1980), reprinted in 1980 U.S.C.C.A.N. 6460, 6461, 6462." [Emphasis added]

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

Reexamination is limited to review of **new information** about preexisting **technology** that may have escaped review at the time of the initial examination of the patent application. It was not designed for harassment of a patent owner by review of old information about preexisting technology, even if a third party feels the Office's conclusion based on that old information was erroneous.

In accordance with this legislative history, MPEP 2242, part II.A. was drafted to require, in order to raise a SNQ for old art, that the old art must be "presented/viewed in a new light, or in a different way, as compared with its use in the earlier concluded examination(s), in view of a material new argument or interpretation presented in the request." This new light must be in terms of how to interpret the state of the "pre-existing technology," as was envisioned by the authors of the original reexamination statute, and left unchanged by the 2002 enactment. For example, a reference may be read in a "new light" if the requester draws attention to a portion of the reference that was not relied upon, or otherwise addressed, in a rejection during the earlier concluded examination of the patent for which reexamination is requested. Similarly, a reference may be interpreted in a new light, or in a different way, by defining a term of art used in the reference, where the definition of the term of art had not been previously presented in the earlier concluded examination of the patent.

III. Analysis of the Request for Reexamination

A. The request fails to raise a substantial new question of patentability regarding claims 1-7, 9-10, 18-21 and 23-25 of the '053 patent. Upon review of the reexamination record, it is found that the examiner appropriately applied the provisions of the MPEP, specifically MPEP 2640, in deciding whether or not an SNQ exists. For example, regarding Japanese Patent App. Pub. No. H07-208884 (hereinafter "JP 884"), the examiner correctly noted that all of claims 1, 5, 6, 19 and 21 include the "wicking power limitation" (see paragraph 2b of the order granting reexamination) and that requester, in the request, discussed the claim interpretation of "wicking power", suggesting that it may be reasonably interpreted as "a structure having an increased quantity of wicking material or the ability to exert capillary force (see pages 27-29 and chart A of the request and paragraph 2bi of the order granting reexamination). The examiner then correctly notes that requester was suggesting that the wicking structure of JP 884 has an increased wicking power in the evaporation region because of the presence of the centermost first wick (see paragraphs 2bi and 2bii of the order granting reexamination). The examiner then correctly analyzes this proposal of requester's noting that "it is unclear how the centermost first wick 13, by itself, can be considered to be in the evaporation area. Since there is a layer of a material (second wick 14) having a relatively weak capillary force between the layer having a stronger capillary force (first wick 13) and the evaporation region 11a. . ." (see paragraph 2biv of the order granting reexamination). The examiner then correctly concludes that it is unclear how JP 884 discloses the wicking power limitation (see paragraph 2biv of the order granting reexamination).

The examiner then goes on to correctly state that requester suggests that JP 884 raises an SNQ because it meets the wicking power limitation (see paragraph 2bvii of the order granting reexamination). The examiner then correctly notes that U.S. Patent No. 6,460,612 to Sehmbey (hereinafter "Sehmbey"), which was considered and applied during the previous reexamination, teaches the wicking power limitation (see paragraphs 2bv and 2bvii of the order granting reexamination). Accordingly, the examiner correctly concludes that it has not been demonstrated that JP 884 presents a new, non-cumulative technological teaching that was not previously considered and discussed on the record (see paragraph 2bvii of the order granting reexamination). A review of the record supports that the examiner appropriately analyzed all the SNQs asserted by the request as she did for the alleged SNQ raised by JP 884. Therefore, the examiner correctly applied the policies of MPEP 2616 in making the determinations stated in the order, dated April 26, 2010. The examiner's analysis of the prior art presented by the requester was sound and without error. Requester's argument that the examiner's substitution of "one skilled in the art" for "reasonable examiner" in the syntax of the decision resulted in a fatal error in the examiner's analysis is thus without merit. There is no indication from the record that the examiner was applying a "prima facie case of unpatentability" standard in determining whether an SNQ exists. Accordingly, the examiner appropriately denied the request for reexamination for claims 1-7, 9-10, 18-21 and 23-25.

The petitioner also alleges error in the order because the examiner "summarily" discarded references as cumulative or applied the rigid and restrictive requirement of *Portola Packaging*. See, e.g., pages 22-27 of the petition. This argument is also without merit because the record does not show that the examiner summarily discarded the teachings asserted by the requester as the basis for the SNQ. Instead, as discussed above in detail, the examiner appropriately applied the law and policies, carefully analyzed the facts, and determined that the asserted SNQs were not sufficient to grant reexamination of claims 1-7, 9-10, 18-21 and 23-25 of the '053 patent because the identified teachings that formed the basis for the SNQ were cumulative to teachings of the prior art applied in the prior examination.

Furthermore, The petitioner states that the determination in the order was improper because the examiner "... completely ignored the new technical teachings ... relative to other [than the wicking power limitation] claim limitations." See page 15 of the petition. However, the record shows that the request for reexamination solely relied upon the teaching of wicking power limitation or the bridging wick structures as the basis for the asserted SNQ. For example, see page 17 of the request, which states:

> "This prior art document provides teachings not provided during prosecution of the '053 patent, and those teachings would have been important to a reasonable examiner in assessing the patentability of the claims of the '053 patent. In particular, JP '884 discloses a vapor chamber heat transfer device with a multi-wick structure, wherein 'a wicking power of the multi-wick structure increases with decreasing flow distance to the evaporation region to facilitate an increased flow rate of the condensate as the condensate approaches the evaporation region' as required in independent claims 1, 5, 6, 19, and 21 of the '053 patent. Further, JP

> '884 discloses bridging wick structures as required in claims 6 and 21, and discloses that the bridging wick structures can be internal chamber supports as required in claim 7. "

The order clearly addressed all the asserted SNQs. For example, pages 1-3 of the order address the asserted SNQ raised by the teaching of the wicking power limitation for claims 1, 5, 6, 19, and 21 and pages 3-4 of the order address the asserted SNQ raised by the teaching of the wick structure bridge for claims 6, 7, and 21. There was no discussion in the request of how JP 884 establishes an SNQ by other teachings other than teachings of the wicking power limitation and the bridging wick structures limitation. Petitioner cannot bootstrap new basis for the asserted SNQ in an attempt to establish error in the examiner's determination that the request for reexamination failed to raise SNQs by now making arguments directed to new teachings in the present petition.

CONCLUSION

1. Given the facts involved in this proceeding, the examiner's determination that the request for *inter partes* reexamination failed to establish a SNQ for claims 1-7, 9-10, 18-21 and 23-25 of the '053 patent was proper and made in accordance with reexamination laws and policies.

2. Accordingly, the PETITION is DENIED.

3. Telephone inquiries related to this decision should be directed to Andres Kashnikow, Special Program Examiner, at (571) 272-4361, or in their absence to the undersigned at (571) 272-1596.

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.
95/000,537	02/18/2010	7650931	4352.03REX01	7156

27896 7590 06/23/2010

EDELL, SHAPIRO & FINNAN, LLC
1901 RESEARCH BOULEVARD
SUITE 400
ROCKVILLE, MD 20850

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/23/2010

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

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/000,537	02/18/2010	7650931	

EXAMINER
CLARKE, SARA

ART UNIT	PAPER
3993	

PATTERSON, THUENTE, SKAAR & CHRISTENSEN, PA
ATTN: Bradley J. Thorson
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80 SOUTH 8th STREET
MINNEAPOLIS, MN 55402-2100

DATE MAILED:

06/23/10

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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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/000,537	02/18/2010	7650931	

EXAMINER
CLARKE, SARA

ART UNIT	PAPER
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Suite 400
Rockville, MD 20850

(For Patent Owner)

MAILED

JUN 23 2010

CENTRAL REEXAMINATION UNIT

Patterson, Thuente, Skaar & Christensen, P.A.
Attn: Bradley J. Thorson
4800 IDS Center, 80 South 8th Street
Minneapolis, MN 55402-2100

(For Requester)

In re Siu	:
Reexamination Proceeding	: DECISION ON
Control No. 95/000,537	: PETITION
Filed: February 18, 2010	: (37 CFR 1.927)
For: U.S. Patent No. 7,650,931	:

The paper filed by requester on June 11, 2010, styled as "Petition Under 37 CFR § 1.927 and 37 CFR § 1.181 for Supervisory Review of the Examiner's Determination Refusing Inter-Partes Reexamination of Certain Claims of the Subject Patent", is before the Director of the Central Reexamination Unit (CRU). Petitioner, the reexamination requester, seeks review of the examiner's determination that a substantial new question of patentability was not raised by the reexamination request as to claims 1-7, 9, 12-16 and 18 of U.S. Patent No. 7,650,931 (hereinafter, the '931 patent) in the Order, dated May 12, 2010, granting-in-part the request for reexamination. Specifically, petitioner requests that the CRU Director find that a substantial new question of patentability (SNQ) exists for claims 1-7, 9, 12-16 and 18 of the '931 patent, and to order reexamination of claims 1-7, 9, 12-16 and 18.

The petition is denied for the reasons set forth below.

REVIEW OF FACTS

1. The '931 patent issued on January 26, 2010. The '931 patent is a continuation of application no. 11/272,145, now U.S. Patent No. 7,422,503, which is a continuation of application no. 10/390,773, filed March 19, 2003, which is now abandoned.

2. On February 18, 2010, the third party requested deposited a request for *inter partes* reexamination, and the resulting reexamination proceeding was assigned Control No. 95/000,537 (hereinafter, the '537 proceeding).

3. Reexamination was requested for claims 1-18 of the '931 patent.

4. A Notice of Reexamination Request Filing Date was issued on February 26, 2010.

5. A order granting the request for reexamination for claims 8, 10, 11 and 17 was issued on May 12, 2010.

6. On June 11, 2010, the third party requested filed the above-mentioned petition under 37 CFR § 1.927.

Petitioner's Grounds in Support of the Requested Relief

Petitioner advances the following grounds in support of his position that the denial of the request for reexamination for claims 1-7, 9, 12-16 and 18 should be reversed by the Director:

1. Petitioner argues that the examiner applied an improper standard in assessing whether the newly cited references raised and SNQ (see pages 17-24 of the petition).
2. Petitioner argues that, as a result of the application of the improper standard, the examiner's analysis of the newly filed references was flawed and incorrect and the references do present a SNQ (see pages 28-32 and 38-57 of the petition).[1]

DECISION

I. Standard of Review

[1] It is noted that at pages 32-37 of the petition, petitioner presents the argument that the "mandatory nature of the new, non-cumulative technological teaching requirement of MPEP § 2616 is improper because it is inconsistent with the purpose for reexamination intended by Congress and unduly limits access to reexamination procedures." However, this argument will not be address in this petition decision.

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 1-7, 9, 12 - 16, and 18 was correct, and will not necessarily indicate agreement or disagreement with every aspect of the examiner's rationale for the denial of the request to order reexamination for claims 1-7, 9, 12 - 16 and 18 of the '053 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." Questions relating to grounds of rejection other than those based on prior art patents or printed publications should **not** be included in the request and will not be considered by the examiner if included. A substantial question of patentability is raised by a cited patent or printed publication when there is a substantial likelihood that a reasonable examiner would consider the prior art patent or printed publication important in deciding whether or not the claim is patentable. If the prior art patents and printed publications relied upon in the request raise a substantial question of patentability, then a "substantial new question of patentability" is present, unless the same question of patentability has already been decided by a final holding of invalidity after all appeals, or by the Office in a previous examination or in a reexamination of a patent. If a substantial new question of patentability is found, an order for *inter partes* reexamination of the patent is issued.

An SNQ is not raised by the old prior art if the Office has previously considered (in an earlier examination of the patent) the <u>same</u> question of patentability as to the patent and has decided that question in favor of the patent owner based on the same prior art patents or printed publications. *In re Recreative Technologies*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996).

Looking to the legislative history for the original reexamination statute,[2] Congress stated:

> "Section I provides for a system of administrative reexamination of patents within the patent office. This new procedure will permit any party to petition the patent office to review the efficacy of a patent, subsequent to its issuance, on the basis of **new information about preexisting technology which may have escaped review at the time of the initial examination of the patent application**. H.R. Rep. No. 96-1307,

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

96th Cong., 2d Sess. 3 (1980), reprinted in 1980 U.S.C.C.A.N. 6460, 6461, 6462." [Emphasis added]

Reexamination is limited to review of **new information** about preexisting **technology** that may have escaped review at the time of the initial examination of the patent application. It was not designed for harassment of a patent owner by review of old information about preexisting technology, even if a third party feels the Office's conclusion based on that old information was erroneous.

In accordance with this legislative history, MPEP 2242, part II.A. was drafted to require, in order to raise a SNQ for old art, that the old art must be "presented/viewed in a new light, or in a different way, as compared with its use in the earlier concluded examination(s), in view of a material new argument or interpretation presented in the request." This new light must be in terms of how to interpret the state of the "pre-existing technology," as was envisioned by the authors of the original reexamination statute, and left unchanged by the 2002 enactment. For example, a reference may be read in a "new light" if the requester draws attention to a portion of the reference that was not relied upon, or otherwise addressed, in a rejection during the earlier concluded examination of the patent for which reexamination is requested. Similarly, a reference may be interpreted in a new light, or in a different way, by defining a term of art used in the reference, where the definition of the term of art had not been previously presented in the earlier concluded examination of the patent.

III. Analysis of the Request for Reexamination

A. The request fails to raise a substantial new question of patentability regarding claims 1-7, 9, 12-16 and 18 of the '931 patent. Upon review of the reexamination record, it is found that the examiner appropriately applied the provisions of the MPEP, specifically MPEP 2640, in deciding whether or not an SNQ exists. For example, regarding Japanese Patent App. Pub. No. H07-208884 (hereinafter "JP 884"), the examiner correctly noted that claim 1 includes the "wicking power limitation" (see paragraph 2ai of the order granting reexamination) and that requester, in the request, discussed the claim interpretation of "wicking power", suggesting that it may be reasonably interpreted as "a structure having an increased quantity of wicking material or the ability to exert capillary force (see pages 24-27 and chart A of the request and paragraph 2aii of the order granting reexamination). The examiner then correctly notes that requester was suggesting that the wicking structure of JP 884 has an increased wicking power in the evaporation region because of the presence of the centermost first wick (see paragraphs 2aii and 2aiii of the order granting reexamination). The examiner then correctly analyzes this proposal of requester's noting that "it is unclear how the centermost first wick 13, by itself, can be considered to be in the evaporation area. Since there is a layer of a material (second wick 14) having a relatively weak capillary force between the layer having a stronger capillary force (first wick 13) and the evaporation region 11a. . ." (see paragraph 2av of the order granting reexamination). The examiner then correctly concludes that it is unclear how JP 884 discloses the wicking power limitation (see paragraph 2av of the order granting reexamination).

Accordingly, the examiner correctly concludes that it has not been demonstrated that JP 884 presents a new, non-cumulative technological teaching that was not previously considered and discussed on the record (see paragraph 2avi of the order granting reexamination). A review of the record supports that the examiner appropriately analyzed all the SNQs asserted by the request as she did for the alleged SNQ raised by JP 884. Therefore, the examiner correctly applied the policies of MPEP 2616 in making the determinations stated in the order, dated May 12, 2010. The examiner's analysis of the prior art presented by the requester was sound and without error. Requester's argument that the examiner's substitution of "one skilled in the art" for "reasonable examiner" in the syntax of the decision resulted in a fatal error in the examiner's analysis is thus without merit. There is no indication from the record that the examiner was applying a "prima facie case of unpatentability" standard in determining whether an SNQ exists. Accordingly, the examiner appropriately denied the request for reexamination for claims 1-7, 9, 12-16 and 18.

The petitioner also alleges error in the order because the examiner "summarily" discarded references as cumulative or applied the rigid and restrictive requirement of *Portola Packaging*. See, e.g., pages 28-29 of the petition. This argument is also without merit because the record does not show that the examiner summarily discarded the teachings asserted by the requester as the basis for the SNQ. Instead, as discussed above in detail, the examiner appropriately applied the law and policies, carefully analyzed the facts, and determined that the asserted SNQs were not sufficient to grant reexamination of claims 1-7, 9, 12-16 and 18 of the '931 patent because the identified teachings that formed the basis for the SNQ were cumulative to teachings of the prior art applied in the prior examination.

Furthermore, the petitioner states that the determination in the order was improper because the examiner "... completely ignored the new technical teachings ... relative to other [than the wicking power limitation] claim limitations." See page 31 of the petition. However, the record shows that the request for reexamination solely relied upon the teaching of wicking power limitation or the bridging wick structures as the basis for the asserted SNQ. For example, see page 14 of the request, which states:

> "This prior art document provides teachings not provided during prosecution of the '931 patent, and those teachings would have been important to a reasonable examiner in assessing the patentability of the claims of the '931 patent. In particular, JP '884 discloses a vapor chamber heat transfer device with a multi-wick structure, wherein 'a wicking power of the multi-wick structure increases with decreasing flow distance to the evaporation region to facilitate an increased flow rate of the condensate as the condensate approaches the evaporation region' as required in independent claims 1-5 of the '931 patent and a spatially varying wick structure as required in claims 4, 5, 6 and 7 of the '931 patent. Further, JP '884 discloses bridging wick structures as required in claims 6 and 21, and discloses that the bridging wick structures can be internal chamber supports as required in claim 10. "

The order clearly addressed all the asserted SNQs. For example, pages 1-2 of the order address the asserted SNQ raised by the teaching of the wicking power limitation for claims 1-5 and pages 4-5 of the order address the asserted SNQ raised by the teaching of the wick structure bridge for claims 1, 6-8, 10, 11, 17 and 18. Pages 2-4 of the order address the spatially varying wick structure limitation for claims 4-7. There was no discussion in the request of how JP 884 establishes an SNQ by other teachings other than teachings of the wicking power limitation and the bridging wick structures limitation. Petitioner cannot bootstrap new basis for the asserted SNQ in an attempt to establish error in the examiner's determination that the request for reexamination failed to raise SNQs by now making arguments directed to new teachings in the present petition.

CONCLUSION

1. Given the facts involved in this proceeding, the examiner's determination that the request for *inter partes* reexamination failed to establish a SNQ for claims 1-7, 9, 12-16 and 18 of the '931 patent was proper and made in accordance with reexamination laws and policies.

2. Accordingly, the PETITION is DENIED.

3. Telephone inquiries related to this decision should be directed to Andres Kashnikow, Special Program Examiner, at (571) 272-4361, or in their absence to the undersigned at (571) 272-1596.

Gregory Morse, Director
Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,543	05/24/2010	6,993,661	112056-0345RX	5339

7590 07/06/2010
ENCRYPTION STORAGE TECHNOLOGIES, LLC
75 MONTEBELLO ROAD
SUFFERN, NY 10901-3746

EXAMINER
KISS, ERIC B

ART UNIT	PAPER NUMBER
3992	

MAIL DATE	DELIVERY MODE
07/06/2010	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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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,543	05/24/2010	6,993,661	112056-0345RX	5339

26161 7590 07/03/2010
FISH & RICHARDSON PC
P.O. BOX 1022
MINNEAPOLIS, MN 55440-1022

EXAMINER
KISS, ERIC B

ART UNIT	PAPER NUMBER
3992	

MAIL DATE	DELIVERY MODE
07/05/2010	PAPER

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date:

CESARI AND MCKENNA, LLP
88 BLACK FALCON AVENUE
BOSTON, MA 02210

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000543
PATENT NO. : 6993661
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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Alexandria, VA 22313-1450
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MARC M. WEFERS
FISH & RICHARDSON P.C.
225 FRANKLIN STREET
BOSTON, MA 02110

In re Application of	:	
Simpson L. Garfinkel	:	
Control No. 95/000,543 (U.S. Patent 6,993,661)	:	DECISION ON PETITION
Filed: June 18, 2010	:	TO WITHDRAW
Attorney Docket No. 01997-0317001	:	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 June 18, 2010.

The request is **APPROVED**.

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

The request was signed by Marc M. Wefers on behalf of all attorneys of record. All attorneys/agents have been withdrawn.

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

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

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

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

cc: **Encryption Storage Technologies LLC**
75 Montebello Road
Suffern, NY 10901-3746

Cesari and McKenna, LLP
88 Black Falcon Avenue
Boston, MA 02210

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,001	09/07/2007	7,145,902	8096.046.RXUS00	2435

28694 7590 04/17/2008

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/17/2008

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Commissioner for Patents
United States Patent and Trademark Office
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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

BYRON COOPER
GOODWIN PROTCTER LLP
EXCHANGE PLACE
BOSTON, MA 02109

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

REEXAMINATION CONTROL NUMBER *95/001,001*.

PATENT NUMBER *7,145,902*.

TECHNOLOGY CENTER *3999*.

ART UNIT *3992*.

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1300 EYE STREET NW
SUITE 1000 WEST TOWER
WASHINGTON DC 20005

BRYAN COOPER (For Third Party Requester)
GOODWIN PROCTOR LLP
EXCHANGE PLACE

In re Reexamination Proceeding	:
Schindler et al.	:
Control No. 95/001,001	: DECISION GRANTING PETITION
Filed: September 7, 2007	:
U.S. Patent No. 7,145,902	:
Attorney Docket No. 8096.046.RXUS00	:

This is a decision on the Petition To The Director Under 37 CFR 1.181filed by the Third Party Requester on February 27, 2008, for holding of the Response To *Inter Partes* Reexamination Office Action ("Response") filed by the Patent Owner on February 11, 2008, as being improper under 37 CFR 1.943(b).

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

BACKGROUND

1. On November 27, 2007, an Order Granting Request For *Inter Partes* Reexamination and an Office action were mailed.
2. In response, on February 11, 2008, the Patent Owner filed, *inter alia*, a response comprising 49 pages and an appendix of approximately 366 pages.
3. On February 27, 2008, the Third Party Requester filed, *inter alia*, the present petition requesting that the appendix filed be expunged or the Response treated as being improper under 37 CFR 1.943(b); an authorization to charge Third Party Requester's deposit account for any fee required, and a Certificate of Service on the Patent Owner.
4. On March 11, 2008, a communication entitled Third Party Requestor's Comments To Patent Owner's Response To Office Action Under 37 CFR § 1.947 was filed.

DECISION

37 CFR 1.943(b) states:

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

MPEP 2667(I)(A)(2) states:

"2. Response Is Too Long

Where the length of the patent owner submission exceeds that permitted by 37 CFR 1.943, the submission is improper. Accordingly, pursuant to 37 CFR 1.957(d), a Notice will be mailed to the patent owner. The Notice will be issued by the examiner and will permit the patent owner to exercise one of the following two options:

(A)Submit a re-drafted response that does not exceed the page limit set by 37 CFR 1.943; or

(B)File a copy of the supplemental response with pages redacted to satisfy the 37 CFR 1.943 page limit requirement.

The Notice will set a period of 15 days from the date of the notice to respond. If no response is received, the improper patent owner submission will not be considered. If the submission was necessary to respond to an outstanding Office action, the prosecution of the reexamination proceeding is either terminated pursuant to 37 CFR 1.957(b) or limited pursuant to 37 CFR 1.957(c). Any previously submitted third party comments in response to this improper patent owner submission would also not be considered, as being moot, since the patent owner did not in fact respond to the Office action in accordance with the rules.

If a response to the Notice is received, then under 37 CFR 1.947, the third party requester may once file written comments, limited to issues raised by the Office action or the patent owner's response to the Notice, within 30 days from the date of service of the patent owner's response to the Notice."

A review of the record reveals that the 366 page appendix is in actuality a part of the 49 page response and as such the Response exceeds the 50 page limit, 37 CFR 1.943 because it goes to the merits of the rejection set forth in the Office action mailed November 27, 2007.

The petition under 37 CFR 1.181 is granted. No petition fee is required and none has been charged to Third Party Requester's deposit account.

CONCLUSION

1. Patent Owner has **FIFTEEN (15) days from the mailing date of this decision** 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 supplemental response with pages redacted to satisfy the 37 CFR 1.943 page limit requirement.
2. If no response is timely received, the improper Patent Owner submission will not be considered. As the submission was necessary to respond to an outstanding Office action, the prosecution of the reexamination proceeding will be either terminated pursuant to 37 CFR 1.957(b) or limited pursuant to 37 CFR 1.957(c). The Third Party comments filed February 27, 2008, in response to this improper Patent Owner submission would be considered as being moot and not be considered since the Patent Owner did not in fact respond to the Office action in accordance with the rules. If a proper response to this

Decision is timely 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 this Decision, within 30 days from the date of service of the Patent Owner's response to this Decision.

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

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

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

By hand: Customer Service 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 Fred A. Silverberg, Senior Legal Advisor in the Office of Patent Legal Administration at 571-272-7719.

Lissi Marquis
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.
95/001,001	09/07/2007	7,145,902	8096.046.RXUS00	2435

28694 7590 08/28/2008

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 08/28/2008

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date:

BYRON COOPER
GOODWIN PROCTER LLP
EXCHANGE PLACE
BOSTON, MA 02109

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001001
PATENT NO. : 7145902
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
1300 EYE STREET NW
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WASHINGTON DC 20005

(For Patent Owner)

MAILED

AUG 28 2008

CENTRAL REEXAMINATION UNIT

GOODWIN PROCTER LLP
Bryan Cooper
EXCHANGE PLACE
BOSTON, MA 02109-2881

(For Third Party Requester)

DECISION
GRANTING-IN-PART
PETITION FOR EXTENSION
OF TIME
[37 CFR § 1.956]

In re: Schindler *et alia*
Inter Partes Reexamination Proceeding
Control No. 95/001,001
Deposited: 7 September 2007
For: US Patent No. 7,145,902

This is a decision on the 15 August 2008, patent owner's "Petition for Extension of Time Under 37 CFR § 1.956," requesting that the time for responding to the Action Closing Prosecution mailed 6 August 2008, be extended by one-month.

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

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

Decision

The Patent Owner requests an extension of time in which to file a response to the Action Closing Prosecution dated 6 August 2008, which set a one month date for filing a response thereto. The request for extension is the first request for an extension of time with respect to the Action Closing Prosecution. The petition for extension of time was timely filed on 15 August 2008, together with the approval to collect the required petition fee as set forth in 37 CFR § 1.17(g) from a deposit account.

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 fee as set forth in § 1.17(g). See § 1.304(a) for extensions of time for filing a notice of appeal to the U.S. Court of Appeals for the Federal Circuit."

MPEP § 2665 Extension of Time for Patent Owner Response
States in-part.

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

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

On balance, the patent owner has noted that Dr Schindler is fully occupied and engaged with pressing corporate matters in Europe throughout the month of August. The showing of "sufficient cause" must always be balanced against the need that the proceedings be conducted with special dispatch. It is this balance which must be fully considered in determining the length of time in granting any extension of time in reexamination proceedings. It is in this light that the determination is made that there is sufficient support for a determination of granting the request for extension of time in-part.

Analysis and Findings

On balance, it is considered that the petition explains the "sufficient cause" for why the extension of time should be granted-in-part. The patent owner notes that Dr. Schindler is preoccupied and engaged with pressing corporate matters in Europe throughout the month of August. The request for extension of time filed under 37 CFR § 1.956 for filing a response to the outstanding Office action, is **granted-in-part** and is hereby extended by **two-weeks.**

Conclusion

1. The patent owner's petition for extension of time in which to file a response to the non-final Office action dated 15 August 2008 is **granted in part** with the time for response extended from 6 September 2008 by **two-weeks**.

2. The Patent Owner's response to the Action Closing Prosecution is due **20 September 2008.**

3. Response may be submitted as follows:

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

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

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

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

MARK J. REINHART
SPE ~~SPRE~~-AU 3992
CENTRAL REEXAMINATION UNIT

for

Gregory Morse,
Director,
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,001	09/07/2007	7,145,902	8096.046.RXUS00	2435

28694 7590 03/13/2009

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/13/2009

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
BYRON COOPER
GOODWIN PROCTER LLP
EXCHANGE PLACE
BOSTON, MA 02109

Date: MAILED

MAR 13 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001001
PATENT NO. : 7145902
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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Vincent M. DeLuca NOVAK DRUCE + QUIGG LLP 1300 EYE STREET NW SUITE 1000 WEST TOWER WASHINGTON DC 20005	:	(For Patent Owner)
Byron Cooper John Forcier GOODWIN PROCTOR LLP Exchange Place Boston, MA 02109	:	(For Third Party Requester)
	:	PETITION DECISION GRANTING REQUEST TO STRIKE AS NON-COMPLIANT REQUESTER BRIEF 37 CFR 1.181(a), (c), [§ 1.943(c) & §41.68]
In re: Schindler *et alia* *Inter Partes* Reexamination Proceeding Control No. 95/001,001 Deposited on: 7 September 2007 For: U.S. Patent No. 7,145,902	:	

MAILED

MAR 13 2009

CENTRAL REEXAMINATION UNIT

This is a decision on the 9 February 2009 patent owner "Patent Owner's Petition Under 37 CFR § 1.181 to Strike Requester's Response Brief."

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

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

SUMMARY OF RELVANT FACTS

1. On 5 December 2006, US Patent No. 7,145,902 was granted to Sigram Schindler *et alia.*

2. On 7 September 2007 a request for *Inter Partes* Reexamination was deposited requesting reexamination of US Patent No. 7,145,902 by a Third Party Requester.

3. On 3 October 2008 the Right of Appeal Notice was mailed.

4. On 31 October 2008 the Third Party Requester filed a Notice of Appeal.

5. On 3 November 2008 the Patent Owner filed a Notice of Appeal.

6. On 5 January 2009 the third party requester filed an Appeal Brief.

7. On 5 January 2009 the patent owner filed an Appeal Brief.

8. On 5 February 2009 the third party requester filed a Rebuttal Brief.

9. On 9 February 2009 the patent owner filed a petition to strike the requester's brief.

DISCUSSION AND CITATION OF RELEVENT AUTHORITY

On 9 February 2009 the Patent Owner petitioned the USPTO to strike the requester's response brief pursuant to 37 CFR 1.181, § 1.943(c) & § 14.68(a)(3). The petition is before the director of the Central Reexamination. The petition was timely filed. Further, the petition fee was electronically filed. The fee as requires by 37 CFR § 1.17(g) accompanied the petition.

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.

...

(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.

37 CFR § 1.943 Requirements of responses, written comments, and briefs in inter partes reexamination. (in-part)

(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 § 41.68 Respondent's brief. (in-part)

(a)(3) The respondent brief shall be limited to issues raised in the appellant brief to which the respondent brief is directed.

....

(b)(1)(*vi*) Issues to be reviewed on appeal . A statement accepting or disputing appellant's statement of the issues presented for review. If appellant's statement of the issues presented for review is disputed, the errors in appellant's statement must be specified. A counter statement of the issues for review may be made. No new ground of rejection can be proposed by a requester respondent.

37 CFR § § 41.71 Rebuttal brief.

(a) Within one month of the examiner's answer, any appellant may once file a rebuttal brief.

(b)

(1) The rebuttal brief of the owner may be directed to the examiner's answer and/or any respondent brief.

(2) The rebuttal brief of the owner shall not include any new or non-admitted amendment, or an affidavit or other evidence. See § 1.116 of this title for amendments, affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.63 for amendments, affidavits or other evidence filed after the date of filing the appeal.

(c)

(1) The rebuttal brief of any requester may be directed to the examiner's answer and/or the respondent brief of the owner.

(2) The rebuttal brief of a requester may not be directed to the respondent brief of any other requester.

(3) No new ground of rejection can be proposed by a requester.

(4) The rebuttal brief of a requester shall not include any new or non-admitted affidavit or other evidence. See § 1.116(d) of this title for affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.63(c) for affidavits or other evidence filed after the date of filing the appeal.
(d) The rebuttal brief must include a certification that a copy of the rebuttal brief has been served in its entirety on all other parties to the proceeding. The names and addresses of the parties served must be indicated.
(e) If a rebuttal brief is timely filed under paragraph (a) of this section but does not comply with all the requirements of paragraphs (a) through (d) of this section, appellant will be notified of the reasons for non-compliance and provided with a non-extendable period of one month within which to file an amended rebuttal brief. If the appellant does not file an amended rebuttal brief during the one-month period, or files an amended rebuttal brief which does not overcome all the reasons for non-compliance stated in the notification, that appellant's rebuttal brief and any amended rebuttal brief by that appellant will not be considered.

DECISION

The patent owner petitions to have the Office strike the third party requester's rebuttal brief as being non-compliant with the requirements of 37 CFR § 1.943(c) and § 41.68. The patent owner identified the requester's respondent brief as exceeding the length in both pages and word count.

A review of the third party requester's brief filed 5 February 2009 indicates that the length of the brief exceeds the allowed page limit or word count as required by 37 CFR § 1.943(c). This is further confirmed by the third party requesters certification of the length of the brief as containing 13,897 word count in the paper dated 5 February 2009. As required by § 1.943(c), "All other briefs filed by any party shall not exceed fifteen pages in length or 7,000 words."

The patent owner further cites compliance issues with 37 CFR § 41.68(a)(3) as requiring that the issues be limited to issues raised in the appellant brief. The patent owner notes foot note number 14 on page 9 of the brief as discussing another reexamination proceeding. The proceeding identified by the patent owner is ex parte proceeding 90/010,017. Clearly other proceedings before the Office have no bearing on the instant proceeding, Further other proceedings are inappropriate for inclusion in any reexamination for which its merger was not a part of the prosecution history. Specifically, since other proceedings are not an issue raised by the appellant brief to which the respondent brief is directed pursuant to 37 CFR 41.68(a)(3) the inclusion is inappropriate and not within compliance with the rules.

The petitioner further notes on page 14 that the reminder to the board that the BPAI "could reject the claims as obvious over one or more of the cited references" is outside the scope of the respondent's brief. This is non-compliant with 37 CFR § 41.68(a)(3).

The third party requester's mention on page 46, Conclusion, of the patentability of claims 91 and 104 while appropriate in the brief filed 5 January 2009, is not in compliance with 37 CFR § (a)(3) as not being limited to issues raised in the

appellant brief to which the respondent brief is directed. Additionally in the page 46, Conclusion, all mention of respondent's rejections which were not specifically a part of the patent owners brief filed 5 January 2009 are non-compliant pursuant to 37 CFR § 41.68(a)(3).

The petitioner identifies the issues to be reviewed on appeal in the brief filed 5 February 2009 as being deficient for lacking the specified errors in the patent owner's brief. This is pursuant to 37 CFR 41.68 (b)(1)(vi) which provides, "If appellant's statement of the issues presented for review is disputed, the errors in appellant's statement must be specified."

Review of the Issues to be Reviewed on Appeal to which the section is identified on page 11 of the 5 February 2009 brief, finds that the patent owner is correct in that the requester's respondent rebuttal brief does not limit the issues to "the errors in appellant's statement."

Pursuant to 37 CFR § 41.71 the third party requester is given one (1) month to correct the deficiencies of the brief submitted 5 February 2009. The third party requester is also reminded of the requirements of § 41.71(e) (in part) "If the appellant does not file an amended rebuttal brief during the one-month period, or files an amended rebuttal brief which does not overcome all the reasons for non-compliance stated in the notification, that appellant's rebuttal brief and any amended rebuttal brief by that appellant will not be considered." [emphasis added]

The patent owner's petition of 9 February 2009 to strike the requester's response brief of 5 February 2009 is granted.

CONCLUSION

1. The patent owner's petition dated 9 February 2009 to strike the requester's response brief for non-compliance is hereby **granted.**

2. To correct the deficiencies of the brief filed 5 February 2009 the **third party requester** is hereby given **one (1) month**.

3. Future correspondence may be submitted as follows:

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

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

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

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

/Mark Reinhart/
for

Gregory Morse
Director,
Central Reexamination Unit 3999

UNITED STATES PATENT AND TRADEMARK OFFICE

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Novak Druce + Quigg LLP
1300 Eye St NW
Suite 1000 West Tower
Washington, DC 20005

(For Patent Owner)

MAILED

DEC 01 2009

CENTRAL REEXAMINATION UNIT

Byron Cooper
Goodwin Procter LLP
Exchange Place
Boston, MA 02109

(For Third Party Requester)

Inter Partes Reexamination Proceeding	: **DECISION**
Control No.: 95/001,001	: **ON PETITION**
Filing Date: April 15, 2009	: **FILED UNDER**
For: U.S. Patent No. 6,174,325	: **37 CFR §1.182**

This is a decision on the September 24, 2008 third party requester petition entitled "Petition and Request for Clarification under 37 CFR §1.182", which has been treated as a petition under 37 CFR §1.181.

The third party requester petition under is before the Director of the Central Reexamination Unit for consideration.

For the reasons set forth below, the petition is dismissed.

DECISION

On August 6, 2008, an Action Closing Prosecution was mailed in this proceeding. The Patent Owner did not respond to the action by the due date of September 20, 2008. On September 24, 2008, the third party requester filed the present petition, which seeks clarification of the status of certain claims under reexamination.

While the petition is styled as a petition under 37 CFR §1.182, the matter is addressed in MPEP 2672(V):

> If the patent owner does not timely file comments and/or a proposed amendment pursuant to 37 CFR 1.951(a), then the third party requester is precluded from filing comments under 37 CFR 1.951(b). Accordingly, a Right of Appeal Notice (RAN) will be issued where the time

for filing the patent owner comments and/or amendment has expired and no patent owner paper containing comments and/or amendment has been received. It should be noted that where the patent owner chooses not to file a submission pursuant to 37 CFR 1.951(a), no rights of appeal are lost.

As the third party requester expressly cannot comment on an office action where patent owner does not reply, the same content cannot be filed under 37 CFR §1.182 as a situation not otherwise provided for. Phrased another way, the situation is provided for; third party remarks are not permitted.

The petition is being treated as a request for supervisory review under 37 CFR §1.181. As the examiner mailed a Right of Appeal Notice on 10/3/2008 as appropriate (i.e. without addressing the petition), the petition is dismissed.

CONCLUSION

1. Third party requester's petition of September 24, 2008 is **DISMISSED**.

2. Telephone inquiries related to the present decision should be directed to Eric Keasel, SPE, GAU 3992 at 571-272-4929 or, in his absence, to the undersigned at 571-272-3838.

Gregory A Morse
Director
Central Reexamination Unit

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.
95/001,003	09/06/2007	6397136	ATI-214 REEX	1940

22846 7590 02/19/2010

BRIAN ROFFE, ESQ
540-B WILLOW AVENUE
CEDARHURST, NY 11516-2211

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/19/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
Rickard K. DeMille
BRINKS, HOFER, GILSON & LIONE
P.O. BOX 10395
CHICAGO, IL 60610

Date:
MAILED
FEB 19 2010
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001003
PATENT NO. : 6397136
TECHNOLOGY CENTER : 3999
ART UNIT : 3900

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAILED

FEB 19 2010

CENTRAL REEXAMINATION UNIT

BRIAN ROFFE, ESQ 540-B WILLOW AVENUE CEDARHURST NY 11516-2211	: : :	(For Patent Owner)
Rickard K DeMille BRINKS HOFER GILSON & LIONE P.O. BOX 10395 CHICAGO, IL 60610	: : : :	(For Third Party Requester)
In re: Breed *et alia* *Inter Partes* Reexamination Proceeding Control No. 95/001,003 Deposited on: 17 August 2007 For: US Patent No. 6,397,136	: : : : :	DECISION GRANTING PETITION FOR CORRECTION OF MAILING DATE [37 CFR § 1.181]

This is a decision on the 14 January 2010, "Petition to Rest a Period for Reply Due to a Postmark Date Later that the Mail Date Printed on an Office Action" requesting the response period be reset according to the postmark of the mailing envelope. The petition timely submitted 14 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 for the reasons set forth below.

DISCUSSION

The Patent Owner's representative requests the period for response to be corrected to reflect the postmark date of the mailing envelope. The petition for extension of time was timely filed on 14 January 2010. A certificate of service was provided with the petition.

The request is granted.

CITATION OF RELEVENT 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.
(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.

DECISION

The patent owner's representative petitions to have corrected the mailing date of the Office action. The petitioner has provided evidence that the actual mailing date is different than that of the date indicated on the Office action. Consequently the period for response will be corrected to reflect the mailing date of 06 January 2010.

Correction of the mailing date is hereby granted

The mailing date hereby corrected to reflect the actual mailing date indicated on the mailing envelope of 06 January 2010.

CONCLUSION

1. The patent owner's petition for extension for correction of the mailing date is hereby **granted.**

2. The period for response is corrected to 06 January 2010.

3. The one month response date is corrected to 06 February 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
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,008	10/01/2007	6715020	38512.13	5604

22852 7590 07/02/2008

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

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

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.
95/001008	10/01/07	6715020	38512.12

EXAMINER
ESCALANTE,OVIDIO

ART UNIT	PAPER
3992	

HAYNES AND BOONE, LLP
901 MAIN STREET
SUITE 3100
DALLAS, TX 75202

DATE MAILED:

07/02/08

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

Paul Anderson
Rambus Inc.
4440 El Camino Real
Los Altos, CA 94022

(For Patent Owner)

MAILED

JUL 02 2008

CENTRAL REEXAMINATION UNIT

David L. McCombs
Haynes and Boone LLP
901 Main Street
Suite 3100
Dallas, TX 75202

(For Third Party Requester)

In re Rambus, Inc.
Inter Partes Reexamination Proceeding
Control No. 95/001,008
Filed: October 1, 2007
For: U.S. Patent No. 6,715,020

: **DECISION**
: **DENYING**
: **PETITION**

This is a decision on the patent owner petition filed on March 7, 2008 entitled "PETITION TO VACATE FILING DATES, ORDERS GRANTING INTER PARTES REEXAMINATION, AND OFFICE ACTION" (hereinafter "patent owner petition"). Receipt is also acknowledged of a paper filed on March 20, 2008 by third party requester entitled "THIRD PARTY REQUESTER'S PETITION FOR CLARIFICATION OF REAL PARTY IN INTEREST AND OPPOSITOIN TO PETITION TO VACATE FILING DATES, ORDERS GRANTING INTER PARTES REEXAMINATION, AND OFFICE ACTION (hereinafter "third party opposition paper").

The March 7, 2008 patent owner petition to vacate, the March 20, 2008 third party opposition and clarification paper, and *inter partes* reexamination proceeding control number 95/001,008 are before the Office of Patent Legal Administration for consideration.

Summary:

1) The patent owner petition is denied.
2) The present decision is designated as a final agency action under 5 U.S.C. § 704.

FEES

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Petitioner patent owner has remitted the $400.00 petition fee required for the present petition that is necessitated by the fact that petitioner requests relief not provided for by the rules. [1] In addition, the Office will charge a $400.00 fee against Deposit Account No. 08-1394 as authorized by third party requester, to permit consideration of the third party paper, which is not provided for by the rules.

[1] See: 37 CFR 1.182.

REVIEW OF FACTS

1. U.S. Patent number 6,715,020 ("the '5020 patent") issued to Michael Farmwald *et al* on March 20, 2004, and is assigned to Rambus, Inc.

2. On October 1, 2007, a request for *inter partes* reexamination of the '5020 patent was filed by a third party requester, and the request was assigned control number 95/001,008 (the '1008 proceeding). In the request, the third party requester identified Samsung Electronics, Inc. as being "the real party in interest," pursuant to 37 CFR 1.915(b) and 35 U.S.C. 311(b). [2]

3. On December 19, 2007, reexamination was ordered for claims 1-49 (*i.e.*, all of the claims) of the '5020 patent.

4. On February 15, 2008, a first Office action on the merits (*i.e.*, addressing the patentability of the claims subject to reexamination) was mailed.

5. On March 7, 2008, the present patent owner petition to vacate was filed.

6. On March 20, 2008, the present third party opposition and clarification paper was filed.

7. On April 15, 2008, patent owner filed a timely response to the first Office action on the merits.

8. On May 15, 2008, third party requester timely filed written comments directed to the February 15th first Office action on the merits and patent owner's response thereto.

RELEVANT STATUTORY, REGULATORY AND PRACTICE PROVISIONS

35 U.S.C. §§ 311(a) and (b) provide:

> (a) IN GENERAL.— Any third-party requester at any time may file a request for inter partes reexamination by the Office of a patent on the basis of any prior art cited under the provisions of section 301.
> (b) REQUIREMENTS.— The request shall—
> (1) be in writing, include the identity of the real party in interest, and be accompanied by payment of an inter partes reexamination fee established by the Director under section 41; and
> (2) set forth the pertinency and manner of applying cited prior art to every claim for which reexamination is requested.

35 U.S.C. § 315(c) provides:

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

[2] However, in the third party opposition papers, third party requester has admitted that the real party in interest was inadvertently misidentified, and has unambiguously identified the third part requester as Samsung Electronics, Co., Ltd.. See: Third party opposition paper, at pages 1and 3.

assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the inter partes reexamination proceedings.

35 U.S.C. § 317 provides:

(a) ORDER FOR REEXAMINATION.— Notwithstanding any provision of this chapter, once an order for inter partes reexamination of a patent has been issued under section 313, neither the third-party requester nor its privies may file a subsequent request for inter partes reexamination of the patent until an inter partes reexamination certificate is issued and published under section 316, unless authorized by the Director.
(b) FINAL DECISION.— Once a final decision has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit or if a final decision in an inter partes reexamination proceeding instituted by a third-party requester is favorable to the patentability of any original or proposed amended or new claim of the patent, then neither that party nor its privies may thereafter request an inter partes reexamination of any such patent claim on the basis of issues which that party or its privies raised or could have raised in such civil action or inter partes reexamination proceeding, and an inter partes reexamination requested by that party or its privies on the basis of such issues may not thereafter be maintained by the Office, notwithstanding any other provision of this chapter. This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the inter partes reexamination proceedings.

37 CFR 1.105 provides:

(a)(1) In the course of examining or treating a matter in a pending or abandoned application filed under 35 U.S.C. 111 or 371 (including a reissue application), in a patent, or in a reexamination proceeding, the examiner or other Office employee may require the submission, from individuals identified under § 1.56(c), or any assignee, of such information as may be reasonably necessary to properly examine or treat the matter, for example:

(i) *Commercial databases*: The existence of any particularly relevant commercial database known to any of the inventors that could be searched for a particular aspect of the invention.

(ii) *Search*: Whether a search of the prior art was made, and if so, what was searched.

(iii)*Related information*: A copy of any non-patent literature, published application, or patent (U.S. or foreign), by any of the inventors, that relates to the claimed invention.

(iv) *Information used to draft application*: A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used to draft the application.

(v) *Information* used in invention process: A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used in the invention process, such as by designing around or providing a solution to accomplish an invention result.

(vi) *Improvements*: Where the claimed invention is an improvement, identification of what is being improved.

(vii) *In Use*: Identification of any use of the claimed invention known to any of the inventors at the time the application was filed notwithstanding the date of the use.

(viii) *Technical information* known to applicant.
Technical information known to applicant concerning the related art, the disclosure, the claimed subject matter, other factual information pertinent to patentability, or concerning the accuracy of the examiner's stated interpretation of such items.

(2) Where an assignee has asserted its right to prosecute pursuant to § 3.71(a) of this chapter, matters such as paragraphs (a)(1)(i), (iii), and (vii) of this section may also be applied to such assignee.

(3) Requirements for factual information known to applicant may be presented in any appropriate manner, for example:

(i) A requirement for factual information;

(ii) Interrogatories in the form of specific questions seeking applicant's factual knowledge; or

(iii) Stipulations as to facts with which the applicant may agree or disagree.

(4) Any reply to a requirement for information pursuant to this section that states either that the information required to be submitted is unknown to or is not readily available to the party or parties from which it was requested may be accepted as a complete reply.

(b)The requirement for information of paragraph (a)(1) of this section may be included in an Office action, or sent separately.

(c) A reply, or a failure to reply, to a requirement for information under this section will be governed by §§ 1.135 and 1.136.

37 CFR 1.907 provides:

(a) Once an order to reexamine has been issued under § 1.931, neither the third party requester, nor its privies, may file a subsequent request for *inter partes* reexamination of the patent until an *inter partes* reexamination certificate is issued under § 1.997, unless authorized by the Director.

(b) Once a final decision has been entered against a party in a civil action arising in whole or in part under 28 U.S.C. 1338 that the party has not sustained its burden of proving invalidity of any patent claim-in-suit, then neither that party nor its privies may thereafter request *inter partes* reexamination of any such patent claim on the basis of issues which that party, or its privies, raised or could have raised in such civil action, and an *inter partes* reexamination requested by that party, or its privies, on the basis of such issues may not thereafter be maintained by the Office.

(c) If a final decision in an *inter partes* reexamination proceeding instituted by a third party requester is favorable to patentability of any original, proposed amended, or new claims of the patent, then neither that party nor its privies may thereafter request *inter partes* reexamination of any such patent claims on the basis of issues which that party, or its privies, raised or could have raised in such *inter partes* reexamination proceeding.

37 CFR 1.913 provides:

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

37 CFR 1.915(b)(7), (b)(8) and (d) provide:

(b) A request for *inter partes* reexamination must include the following parts:

(7) A certification by the third party requester that the estoppel provisions of § 1.907 do not prohibit the inter partes reexamination.

(8) A statement identifying the real party in interest to the extent necessary for a subsequent person filing an *inter partes* reexamination request to determine whether that person is a privy.

...

(d) If *the inter partes* request does not include the fee for requesting *inter partes* reexamination required by paragraph (a) of this section and meet all the requirements of paragraph (b) of this section, then the person identified as requesting *inter partes* reexamination will be so notified and will generally be given an opportunity to complete the request within a specified time. Failure to comply with the notice will result in the *inter partes* reexamination request not being granted a filing date, and will result in placement of the request in the patent file as a citation if it complies with the requirements of § 1.501.

37 CFR 1.919(a) provides:

(a) The filing date of a request for *inter partes* reexamination is the date on which the request satisfies all the requirements for the request set forth in § 1.915.

MPEP § 2614 provides, in part:

The reexamination request must identify the real party in interest who is responsible for filing the reexamination request. This information will be used by future parties requesting reexamination of the same patent, in making the certifications required by 37 CFR 1.915(b)(8).

PRELIMINARY MATTER

The present patent owner and third party requester are also parties in six other *inter partes* reexamination proceedings, in which the same third party requester requested reexamination of patents owned by the same patent owner. The same issue of alleged misidentification of the real party in interest by the third party requester that has been raised in the present '1008 *inter partes* reexamination proceeding has been raised by patent owner in all six of these concurrent proceedings. Stated another way, the same issue regarding identification of the real party in interest forms the basis for the relief requested by patent owner, (vacatur of the filing date, Order granting *inter partes* reexamination and Office action) in the present patent owner petition, and in the petitions of five other concurrent reexamination proceedings. In four of the other *inter partes* reexamination proceedings, [3] the alleged misidentification of the real party in interest by the third party requester was the subject of an original patent owner petition filed on May 15, 2007 that was opposed by third party requester on June 14, 2007. The patent owner petition in the four earlier *inter partes* reexamination proceedings sought vacatur of the filing date of the proceeding and the Order granting *inter partes* reexamination based on the alleged misidentification of the real party in interest. In each of the four earlier *inter partes* reexamination proceedings, a decision dismissing the patent owner petition was mailed on November 9, 2007. Thereafter, a reconsideration petition was filed by patent owner on January 23, 2008 in each of the four earlier *inter partes* reexamination proceedings requesting reconsideration of the November 9, 2007 decision. In the January 23, 2008 petition, patent owner also asserted an ambiguity in the identification of the real party in interest in the *inter partes* reexamination request. [4]

In view of the asserted ambiguity of the identification of the real party in interest that was raised in the January 23, 2008 patent owner petition, the Office issued an Order to Show Cause in each of the four earlier *inter partes* reexamination proceedings. The Order to Show Cause required third party requester to explain why the filing date of the proceeding should not be vacated for failure to properly identify the real party in interest as required by 35 U.S.C. § 311(b)(1) and 37 CFR 1.915(b)(8). On March 4, 2008, third party requester filed a response in each of the four earlier *inter partes* reexamination proceedings. In that response, third party requester explained that the ambiguity in the identification of the real party in interest was due to inadvertent error. The third party requester also unambiguously identified the real party in interest as Samsung Electronics Co., Ltd. in each of the four earlier *inter partes* reexamination proceedings. On April 7, 2008, the Office issued a decision in each of the four earlier *inter partes* reexamination proceedings accepting the third party requester's response to the Order to Show Cause.

Thereafter, the January 23, 2008 patent owner renewed petition and the third party requester February 6, 2008 opposition thereto were again taken up for consideration by the Office. It was determined that patent owner had not established entitlement to the relief

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[3] These proceedings are 95/000,166 95/000,178 95/000,183 and 95/000,250. These proceedings will be referred to as "the four earlier *inter partes* reexamination proceedings."

[4] Third party requester filed an opposition to the January 23, 2008 patent owner petition on February 6, 2008 in each of the four earlier *inter partes* reexamination proceedings.

requested, and that neither the filing date nor the Order for reexamination in each of the four earlier *inter partes* reexamination proceedings would be vacated. Accordingly, on June 17, 2008, a decision was mailed in each of the four earlier *inter partes* reexamination proceedings that (1) denied the January 23, 2008 patent owner petition and (2) was designated as a final agency action pursuant to 5 U.S.C. § 704.

In view of the above, the issue of the identification of the real party in interest has been previously addressed in sufficient detail, such that the present decision on patent owner's original petition (to vacate) is being designated as a final agency action pursuant to 5 U.S.C. § 704.

DISCUSSION

I. Patent Owner's Position

The position taken by patent owner in the present petition is essentially identical to the position taken in each of the four earlier *inter partes* reexamination proceedings discussed in the previous section of this decision. Patent owner argues that because:

(1) Patent owner is the plaintiff in litigation in which the '5020 patent has been asserted against a number of defendants;
(2) The real party in interest identified in the request for reexamination of the '5020 patent, "Samsung," [5] is one of those co-defendants; and
(3) Samsung and certain co-defendants have formed a "joint defense group";

the third party requester did not properly identify the real party in interest, given that only Samsung is named as the real party in interest in the '1008 *inter partes* reexamination proceeding. Patent owner reasons that based on the alleged improper identification of the real party in interest, the Office is required to vacate both the filing date of the '1008 *inter partes* reexamination proceeding and the Order granting *inter partes* reexamination.

Patent owner's position is not persuasive because:

(A) The mere fact that any given party was a co-defendant of Samsung in the '5020 patent litigation, or a member of a "joint defense group" together with Samsung in that litigation, does not mean that such a party was (or is) entitled to direct or control input into the conduct of '1008 *inter partes* reexamination proceeding, or has ever done so.
(B) Patent owner has failed to provide any factual showing that would support an allegation that any of Samsung's co-defendants in the '5020 patent litigation, or who are members of the "joint defense group" in that litigation together with Samsung, actually is/was in control of, or is/was directly contributing input into the prosecution of the present '1008 *inter partes* reexamination proceeding.
(C) There is no requirement of the reexamination statute that the Office conduct an investigation into the accuracy of the certification made by a third party requester that files a request for reexamination.

[5] In the third party requester opposition paper, third party requester has addressed an ambiguity in the identification of the real party in interest. In the opposition paper, third party requester has now unambiguously identified the real party in interest as Samsung Electronics, Inc., Ltd. (hereinafter "Samsung"). The Office accepts this identification.

(D) Congress has not provided the Office with the investigative tools of subpoena powers or discovery, [6] or the ability to conduct hearings to elicit testimony or to conduct cross-examination to support the investigation requested. Further, Congress has also not provided the Office with authority to impose punitive sanctions for noncompliance with a failure to cooperate in such an investigation.

(E) Investigative evidentiary tools and the ability to impose sanctions are fully available to the courts.

(F) There is precedent showing that the courts have the ability to rule on the issue of "real party in interest" in matters ranging from diversity or amount of suit [7] to matters in which the principle is applied to prevent multiple or conflicting lawsuits by persons such as assignees. [8]

(F) Patent owner did not explain why patent owner had not approached the District Court for relief as, for example by investigation into the matter and issuing an appropriate order.

(G) The identification by third party requester is deemed to be adequate for purposes of 37 CFR 1.915(b)(8), because a subsequent party wishing to file an *inter partes* reexamination request for the '5020 patent, or who may be subject to estoppels resulting from the present *inter partes* reexamination proceeding, would be able to determine for itself whether any relationship with Samsung would bar the *inter partes* reexamination request or trigger statutory estoppel.

(H) Pursuant to 37 CFR 10.18(b), the Office relies on factual assertions made before the Office as being true. [9]

II. Patent Owner is Not Entitled to Vacatur of the Filing Date, The Order Granting *Inter Partes* Reexamination, or The February 15, 2008 Office Action

Patent owner argues that the Office has the ability to investigate the accuracy of the identification of the real party in interest in an *inter par*tes reexamination proceeding, and has the duty to investigate the accuracy of the identification of the real party in interest in the '1008 *inter partes* reexamination proceeding. Patent owner urges that the Office vacate the present proceeding based upon the real party in interest investigation issue it raises. All of patent owner's arguments have been carefully considered. However, for the reasons that follow, patent owner's arguments and assertions are not persuasive that patent owner is entitled to the requested investigatory relief or the requested vacatur of the proceeding filing date and order granting *inter partes* reexamination in the '1008 *inter partes* reexamination proceeding.

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[6] While 35 U.S.C. §§ 23 and 24 do authorize the Office to establish rules for taking affidavits and depositions required in cases in the Office, no such rules have been established with respect to taking affidavits or depositions with respect to reexamination proceedings, or with respect to parties not before the Office in a given proceeding whose compliance cannot be compelled by the Office. Further, these provisions do not appear to be directed to conducting discovery in a proceeding before the Office such as a reexamination proceeding.

[7] *Varlotta Construction Corporation v. Carla Development Corporation*, 886 F. Supp 315 (E.D.N.Y. 1995)

[8] *First Hartford Corporation Pension Plan & Trust v. United States*, 194 F.3d 1279 (Fed. Cir. 1999)

[9] It is pointed out that the ability of the Office to require a party to a matter before the Office to address ambiguities or inaccuracies in factual assertions of record made by that party to resolve such an ambiguity is a wholly different matter from the Office having the statutory authority or the evidentiary tools to conduct an investigation regarding parties not before the Office based upon mere allegations that such an investigation is desired by a party before the Office.

A. When the Identification of the Real Party in Interest Is Not Facially Inaccurate Or Ambiguous, the Office Lacks the Authority and the Tools to Question That Identification

The arguments presented in the patent owner petition fail to establish that the Office has either the authority/duty to question the accuracy of a third party requester's facially accurate and unambiguous identification of the real party in interest in an *inter partes* reexamination proceeding, or the tools to competently conduct an investigation of the matter.

Patent owner's argument that the Office has the ability to investigate the accuracy of the identification of the real party in interest in an *inter partes* reexamination proceeding is based upon drawing an analogy between (a) the requirement of 37 CFR 1.915(b)(8) that the request for reexamination identify the real party in interest and (b) the requirement of 37 CFR 1.915(b)(7) that the request for reexamination include a statement certifying the filing of the request is not barred by 37 CFR 1.907. [10] Patent owner begins by pointing out that the legislative history of 35 U.S.C § 311(b) shows that Congress enacted the requirement for identification of the real party in interest in order to prevent harassment of the patent owner. [11] Patent owner then alleges that the Office has the stated in the *inter partes* reexamination rulemaking that it has the authority to investigate the accuracy of a third party requester's certification under 37 CFR 1.915(b)(7) (*i.e.*, that the estoppel provisions of 37 CFR 1.907 do not preclude the filing of the request for *inter partes* reexamination). [12] Patent owner then states the Office, (in its November 9, 2007 Decision on Petition discussed in the Preliminary Matter section above), has taken the position that the Office does not have the ability or authority to investigate the accuracy and identification of the real party in interest. Patent owner opines that these positions are inconsistent. Patent owner argues that the Office must take consistent positions, and therefore, patent owner concludes that the Office has the authority and the tools to investigate allegations of requester misidentification of the real party in interest, in the same manner that it would investigate the accuracy of a requester's 37 CFR 1.915(b)(7) certification statement. Patent owner concludes the Office has a duty to conduct such an investigation in the '1008 *inter partes* reexamination proceeding, that as a result of such investigation the Office will find that the real party in interest has not been properly identified, and that the Office should thereafter vacate both the filing date of the '1008 *inter partes* reexamination proceeding, and the Order granting reexamination.

Patent owner's argument is not, however, persuasive, because it does not reflect the intent of, or the plain language of, the provisions of 37 CFR 1.915(b)(7) and (b)(8).

A certification statement made pursuant to 37 CFR 1.915(b)(7) is a statement by the third party requester to the effect that the third party requester is not itself estopped by the statutory estoppel provisions from filing a request for *inter partes* reexamination of a given patent. The *inter partes* rulemaking, at 65 Fed. Reg. 76756, 76759 (Dec. 7, 2000), provides that:

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[10] The estoppel provisions of 37 CFR 1.907 incorporate the estoppel provisions established by 35 U.S.C. §§ 315(c) and 317. These provisions will be referred to collectively as "statutory estoppel."

[11] Intellectual Property and Communications Omnibus Reform Act of 199, H.R. Conf. Rep. 10-464, 1999 WL 1095089, *133.

[12] See: MPEP § 2612; see also 65 Fed. Reg. 76756 at pages 76759 and 76764 (stating that "where a challenge to the accuracy of the certification is raised by the patent, that the question would then need to be addressed.")

> "It should be noted that the Office generally will not have a need to resolve the factual issue of whether or not one party is a privy of another party. Section 1.915(b)(7) requires a third party requester to certify that the estoppel provisions of §1.907 do not prohibit the filing of the inter partes reexamination request, and the Office does not intend to look beyond this required certification. It is only in the rare instance where a challenge to the accuracy of the certification is raised by the patent owner, that the question would then need to be addressed."

A substantially identical statement also appears at MPEP § 2612. These statements establish that the Office will, in the rare instance that it is necessary to do so, "address" the issue of the accuracy of a certification that statutory estoppel does not bar the filing of a request for *inter partes* reexamination. However, the rulemaking does not, in any way, discuss the type or depth of investigation that can and will be undertaken, and, more importantly, does not anywhere state or imply that an investigation can or will be undertaken by the Office. Rather, it is the duty of any party moving in favor of vacating a reexamination proceeding to provide the facts of any prior investigation that establish its position, including what it has obtained by resort to the courts' investigative power. It is nowhere stated or indicated in the statute, rules, or Office procedural guidelines that a patent owner may trigger an investigation of the accuracy of the certification - merely by advancing an unsupported allegation that the third party requester is estopped from filing a request for *inter partes* reexamination.

While the Office would clearly query an ambiguous or facially inaccurate 37 CFR 1.915(b)(7) certification statement, such a query is based on an ambiguity or inaccuracy provided by the record of the proceeding. A third party making such a statement for the record is a party appearing before the Office. Therefore, a third party requester may appropriately be asked by the Office to clarify or support a 37 CFR 1.915(b)(7) certification statement that is ambiguous or facially inaccurate on the record. In such a case, the third party requester would be called upon to respond based on facts wholly within its knowledge and possession. The Office would be able to obtain information from the patent owner and the third party requester, and would have no need to try to obtain information from parties not before the Office in the reexamination proceeding. Analogously, where the identification of the real party in interest required by 37 CFR 1.915(b)(8) is ambiguous or facially inaccurate, a third party requester that is before the Office can be queried by the Office. In fact, the records of the four earlier *inter partes* proceedings (discussed in the Preliminary Matter section above) show that where the identification of the real party in interest was ambiguous on the record, the third party requester was required to clarify its identification of the real party in interest. Third party requester promptly clarified the ambiguity. [13]

Patent owner additionally relies on the decisions in *Lacavera v. Dudas*, 441 F.3d 1380, 1382 (Fed. Cir. 2006); *Stevens v. Tamai*, 366 F.3d 1325, 1333 (Fed. Cir. 2004; and *In re Bogese*, 303 F.3d 1362, 1368 (Fed. Cir. 2002) as authority for the proposition that the Office can for conduct an investigation to determine the accuracy of a third party requester's identification of the real party in interest in an *inter partes* reexamination proceeding.
In the *Lacavera* decision, the court discussed the authority of the Office to regulate attorney practice before the Office pursuant to 35 U.S.C. § 2(b)(2)(D). The *Stevens* case involved an interference proceeding, and the court's decision in *Stevens* cited 35 U.S.C. § 2(b)(2)(A) as giving the Office authority to establish rules not inconsistent with law to govern the conduct

[13] In the present '1008 *inter partes* reexamination proceeding, third party requester has proactively clarified an ambiguity in the identification of the real party in interest. Thus there is no issue of such ambiguity in the '1008 *inter partes* reexamination proceeding.

of proceedings in the Office and parties before the Office. The *Bogese* case concerned the authority of the Office to reject claims in a patent application based upon laches arising from unreasonable and unexplained delay in prosecution, notwithstanding that the applicant before the Office complied with pertinent statutes and rules. None of these decisions have been found to be relevant to the authority of the Office to conduct an investigation into the identity of a real party in interest, as to whether other parties not before the Office are involved (included). Rather, the cases cited by patent owner involve circumstances in which the patent statute provides authority for the Office to promulgate regulations not inconsistent with law that will govern the conduct of proceedings in the Office, as well as the recognition and conduct of parties before the Office (including practitioners, applicants and other parties).

Patent owner fails to point to any established regulation that would provide a mechanism for conducting an investigation of the sort patent owner envisions, other than 37 CFR 1.105. Although patent owner opines that the Office can conduct an investigation into a third party requester's identification of the real party in interest in a request for *inter partes* reexamination, and require information from a third party requester under the provisions of 37 CFR 1.105, patent owner is simply mistaken. 37 CFR 1.105 was promulgated pursuant to 35 U.S.C. §§ 131 and 132 - statutes that relate to the examination of applications and the conduct of reexamination proceedings as to patentability. The regulation was promulgated for the purpose of requiring submission of information material to patentability from persons having a duty under 37 CFR 1.56 to disclose information to the Office that is material to patentability. [14] 37 CFR 1.105 has no applicability to requesting information from a third party requester regarding that requester's identification of the real party in interest in an *inter partes* reexamination proceeding, which would require investigation into activity by parties not party to the proceeding before the Office. The identification of the real party in interest has no relationship to the duty to disclose information that is material to patentability that applies to an applicant for patent and to a patent owner (and other 37 CFR 1.56(c) parties) in a reexamination proceeding. [15] Further, patent owner has not adequately explained the basis under which the Office would proceed to require a third party requester to supply information regarding the identity of the real party in interest, or to conduct an investigation into the identity of the real party in interest, given that there is no ambiguity or facial inaccuracy in the third party requester's identification of the real party in interest. And, to the extent that it would be necessary to obtain information from a party who is alleged to be an undisclosed real party in interest in an *inter partes* reexamination proceeding, patent owner has not explained how 37 CFR 1.105 could be applied to a party who is not before the Office in that proceeding.

Rather than the Office conducting an investigation based on a raw allegation that a patent believes an identification of the real party in interest to be facially inaccurate, the courts are the appropriate venue in which the patent owner should seek relief in the form of an investigation. [16] (This point is especially relevant here, where the identification appears to be

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[14] 65 Fed. Reg. 54604, 54633, (Sept. 8, 2000.)

[15] See 37 CFR 1.933, which refers back to 37 CFR 1.555, which in turn, references 37 CFR 1.105. These regulations do not create a duty to disclose information material to patentability, (or any duty of disclosure), that attaches to a reexamination third party requester.

[16] See: *In re Epstein*, 32 F.3d 1559, 31 USPQ2d 1817 (Fed. Cir. 1994), where the court took note of party's availability of the court's investigative powers, to address the absence of same to the Office.

> "During ex parte PTO examination, applicants are free to investigate hearsay assertions relied upon by an examiner during the three to six month period available to respond to an office action. They also have the right to introduce rebuttal evidence under 37 C.F.R. Section 1.132 (1993). Moreover, if applicants wish to cross-examine the authors of written hearsay assertions, under 35 U.S.C. Section

unambiguous on the record, and it is patent owner that is alleging an inaccuracy.) It is to be noted that there is precedent on the issue of "real party in interest" in the federal courts, on matters ranging from jurisdiction (*e.g.*, presence of diversity or amount of suit) to actions in which the principle is applied to prevent multiple or conflicting lawsuits by persons such as assignees (*e.g.*, assignee estoppel or *res judicata*). [17] Where such precedent requires a party whose disclosure has been challenged to provide support for the disclosure, the examples of court proceedings resolving "real party in interest" issues demonstrate the reason why the Office cannot perform such a function here. Upon obtaining jurisdiction over the parties, courts may order discovery, take testimony and employ other evidentiary tools (*e.g.*, subpoena power and sanctions). Accordingly, the courts are the forums best equipped to determine who is, and who is not, the "real party in interest" when a party has a doubt as to the third party requester's identification of a party or parties as being the real party in interest in an *inter partes* reexamination proceeding. Further, courts may provide relief with respect to patents, as appropriate, by enjoining the filing of a further *inter partes* reexamination request by the other parties in a civil action, or as to the filing of a subsequent civil action. Even if an *inter partes* reexamination request is filed by one of the other parties in the civil action who is barred from requesting *inter partes* reexamination by statutory estoppel, a court could always enjoin participation by that requester in the proceeding and essentially turn the proceeding into an *ex parte* reexamination proceeding, the filing of which does not require identification of "a real party in interest" (35 U.S.C §§ 301 and 302), and is not prohibited by statute or rule, even after an *inter partes* reexamination has been filed by the same real party in interest. [18]

A patent owner concerned with the issue of misidentification of the real party in interest in a request for *inter partes* reexamination may immediately seek relief from the alleged erroneous identification of the "real party in interest" via the courts, which possess the tools to investigate and obtain information as to the relationship of the parties to ascertain the veracity of the identified "real party in interest." The present petition is silent as to why patent owner did not approach the appropriate District Court for relief (*e.g.*, an investigation into the matter and an appropriate order). Given the emphasis that petitioner patent owner has placed on the importance of the "real party in interest" disclosure requirement, it would appear that patent owner could have immediately sought relief in the appropriate court regarding the identity of the real party in interest. The record does not show that patent owner has done so. Patent owner's argument that it is the Office, not a district court, "that administers the patent statute," is wholly unpersuasive. The Office may consider that it is "the sole agency that administers the patent statute," [19] in conducting the *inter partes* proceeding. However, it is common knowledge that the federal courts (which are not an agency in the sense used in the *inter partes* reexamination rulemaking) routinely adjudicate matters arising under the patent statute. Further, patent owner should

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145 (1988) they may bring a civil action in the United States District Court for the District of Columbia seeking adjudication that they are entitled to receive a patent. In such an action, testimony could be compelled by subpoena under Federal Civil Procedure Rule 45. See Gould v. Quigg, 822 F.2d 1074, 1076, 3 USPQ2d 1302, 1303 (Fed. Cir. 1987) ("While the evidentiary record before the Board serves as the 'evidentiary nucleus' of the district court proceeding in a section 145 action, the parties are entitled to submit additional evidence."). [32 F.3d at 1565, 31 USPQ2d at 1821]

[17] See, for example: *Varlotta Construction Corporation v. Carla Development Corporation*, 886 F. Supp 315 (E.D.N.Y. 1995) (presence of diversity or amount of suit); *First Hartford Corporation Pension Plan & Trust v. United States*, 194 F.3d 1279 (Fed. Cir. 1999) (application of the principle of "real party in interest" applied to prevent multiple or conflicting lawsuits by persons such as assignees.

[18] If the court makes a finding that the "real party in interest" was misstated, the Office can then take action, if appropriate, based upon the court's findings.

[19] 65 Fed. Reg. 76756, 76759 (Dec. 7, 2000), emphasis added.

appreciate the difference between conducting a reexamination proceeding, which is the provenance of the Office, and enforcing an estoppel provision of Federal law as a matter of equitable relief. Patent owner has not provided any basis for believing that the district courts lack authority to act as described above.

As a final point, even if a District Court were approached and declined to investigate the matter until the court was faced with the question of a party other than Samsung trying to assert the same issue the Samsung lost in the Office (which would require (a) that Samsung lose, and (b) that another party assert the same issue - both of which have not happened), there is no reason why the Office should be called upon to address the matter which is not ripe for decision (as discussed immediately below) and for which the Office does not possess the appropriate tools (as discussed above).

B. The Office Has No Duty To Investigate The Identity Of The Real Party In Interest In The '1008 *Inter Partes* Reexamination Proceeding

(1) Patent Owner Does Not Allege A Present Injury

The reexamination statute requires, *inter alia*, that a request for *inter partes* reexamination proceeding "shall ... include the identity of the real party in interest ... ." [20] The *inter partes* reexamination rules require that a request for *inter partes* reexamination include, *inter alia*, "[A] statement identifying the real party in interest to the extent necessary for a subsequent person filing an *inter partes* reexamination request to determine whether that person is a privy." [21] Neither the *inter partes* reexamination statute nor the *inter partes* reexamination rules imposes a duty on the Office to investigate the accuracy of an unambiguous identification of the real party in interest in a third party requester's request for *inter partes* reexamination proceeding and the identification is not facially inaccurate.

In the present '1008 *inter partes* reexamination proceeding, the real party in interest is unambiguously identified in the current record. [22] The identification of the real party is not found to be facially inaccurate. The Office will refuse to accord a filing date to any request for *inter partes* reexamination that does not identify the real party in interest, or which provides an identification of the real party in interest that is ambiguous or facially inaccurate. If the Office accords a filing date to a request for *inter partes* reexamination, and later discovers an ambiguity or a facial inaccuracy in the identification of the real party in interest, the Office can, and will, require that a party appearing before it as third party requester in an *inter partes* reexamination proceeding clarify the ambiguity or facial inaccuracy. [23] However, it does not follow that the Office is empowered to conduct an investigation into the identity of the real party in interest when the statement identifying the real in interest in the record of an *inter partes* reexamination proceeding is neither facially inaccurate nor ambiguous. The Office will not conduct an investigation into the accuracy of the identification of the real party interest in the '1008 *inter partes* reexamination proceeding, because there is no established reason to do so.

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[20] 35 U.S.C. § 311(b)(1).
[21] 37 CFR 1.915(b)(8).
[22] See footnote 12. The present identification of Samsung Electronics Inc., Ltd. as the real party in interest applies to this proceeding *nunc pro tunc*, and will allow any subsequent party to draw the necessary conclusions for purposes of 37 CFR 1.907 and statutory estoppel in *inter partes* reexamination.
[23] See the discussion in the Preliminary Matter section of this decision.

Further, it is also to be noted that in the present '1008 *inter partes* reexamination proceeding, patent owner is requesting relief based upon an injury that has not yet occurred. Patent owner does not allege that the named real party in interest is itself estopped from filing and participating in the '1008 *inter partes* reexamination proceeding. Rather, patent owner's concern is that patent owner might be harassed by the filing of a subsequent request for *inter partes* reexamination of the '5020 patent by a party that should have been identified as a real party in interest in the '1008 *inter partes* reexamination proceeding, but was not so identified. Such a party, as a real party in interest in the '1008 *inter partes* reexamination proceeding, would (if one existed) be subject to a statutory estoppel that would preclude the filing of such a request by that third party requester. While a patent owner is entitled to be protected from harassment by the filing of a subsequent request for *inter partes* reexamination of the '5020 patent by a party who is estopped from filing such a request, the record simply does not show that such a circumstance presently exists in the '1008 *inter partes* reexamination proceeding. No additional requests for *inter partes* reexamination of the '5020 patent have been filed, so clearly there is presently no cause for concern that a misidentification of the real party in interest has permitted a party subject to statutory estoppel to file an additional request for *inter partes* reexamination of the '5020 patent. Accordingly, there is presently no basis for granting the relief requested by patent owner in the present *inter partes* reexamination proceeding, since patent owner cannot, at this point, have been injured by the filing of another request for *inter partes* reexamination for the '5020 patent that would be barred by statutory estoppel.

(2) Patent Owner Has Presented No Evidence That The Real Party in Interest Has Not Been Properly Identified

A further reason why the Office will not conduct an investigation into the identity of the real party in interest in the '1008 *inter partes* reexamination proceeding is that patent owner has not presented any factual basis that would establish that the third party requester's identification of the real party in interest is inaccurate or ambiguous. Rather, patent owner relies solely on the fact that third party requester is one of a number of co-defendants in litigation directed to the '5020 patent and that certain co-defendants have formed a "joint defense group," of which the identified real party in interest is a member, as providing the reason why the Office must investigate the accuracy of the identification of the real party in interest in the request for reexamination of the '5020 patent. However, patent owner *has not provided any factual showing* that would suggest that one or more of members of the "joint defense group" has, in fact: (a) participated in the filing of the request for reexamination of the '5020 patent any way or was involved in the decision to file, or (b) in any way participated in the prosecution of the resulting '1008 *inter partes* reexamination proceeding or was involved in the decision as to prosecution. Assuming, *arguendo*, that (1) the Office has authority to conduct an investigation and to require that third party requester provide information in the form of documents, or answers to interrogatories, requiring information, and (2) that patent owner believed that it had been injured due to the filing of another request for *inter partes* reexamination of the '5020 patent by a party subject to statutory estoppel, patent owner still has not provided the Office with any evidentiary basis to justify conducting an investigation into the accuracy of a third party requester's identification of the real party in interest in the '1008 *inter partes* reexamination proceeding. Patent owner's belief that one or more unnamed entities are also real parties in interest is not evidence. The Office will not act on mere beliefs, any more than a court would act on allegations that are not supported by facts. The record in the '1008 *inter partes* reexamination proceeding shows that third party requester has unambiguously identified the real party in interest in the request. The record does not show that Office has been provided with any concrete

evidence suggesting reason to doubt the accuracy of requester's identification of the real party in interest. On the present record, the Office can only conclude that further inquiry by the Office directed to the third party requester regarding the identity of the real party in interest would merely result in third party requester confirming that that "Samsung Electric Co, Limited" is the real party in interest, as third party requester has previously stated. Note is taken that such a statement by a party appearing before the Office is a certification that such statement is believed to be true. [24] The record in the '1008 *inter partes* reexamination proceeding provides no basis for the Office to doubt the statement, and accordingly, provides no basis to investigate the accuracy of that statement.

III. Synopsis

Patent owner has previously filed a petition to vacate, on January 23, 2008, in each of four earlier *inter partes* reexamination proceedings requested by the present third party requester. The January 23, 2008 patent owner petitions each requested reconsideration of petition decisions dated November 9, 2007 in each of the four earlier *inter partes* reexamination proceedings. In the present petition, patent owner has referenced the November 9, 2007 petition decisions [25] and has presented arguments that track those presented in the January 23, 2008 petitions for reconsideration of the November 9, 2007 decisions that were filed in the four earlier *inter partes* reexamination proceedings.

In the present petition, patent owner has not demonstrated that the Office has the authority or the procedural tools to conduct an investigation into the otherwise facially unambiguous and facially accurate identification of the real party in interest in this *inter partes* reexamination proceeding. Also, patent owner has not demonstrated any present injury in the '1008 *inter partes* reexamination that could warrant the requested relief. The present record in the '1008 *inter partes* reexamination proceeding does not show that the identification of the real party in interest is inaccurate or ambiguous. Accordingly, patent owner has not demonstrated any basis for the requested relief of vacatur of the filing date of the '1008 *inter partes* reexamination proceeding, vacatur of the Order granting reexamination and vacatur of the February 15, 2008 Office action. On the other hand, requester has unequivocally stated that Samsung ("Samsung Electric Co, Ltd") is the only real party in interest for the present proceeding, and pursuant to 37 CFR 10.18(b), the Office relies on factual assertions made before the Office as being true. Therefore, the relief requested by patent owner will not be granted. Further, because patent owner's underlying rationale for the requested relief has been previously considered in the four earlier *inter partes* reexamination proceedings, the relief requested in the present patent owner petition is denied, and this decision is being designated as a final agency action within the meaning of 5 U.S.C. § 704.

ADDITIONAL DISCUSSION

As this decision is designated as a final agency action under 5 U.S.C. § 704, patent owner is advised that - to the extent that patent owner may disagree with the disposition of the issues in this decision, those issues are now ripe for judicial review. Any further patent owner petition paper, for relief by the Office, which is directed to the issues that have been decided herein will not be considered, unless accompanied by a strong showing of additional facts warranting further review by the Office. The filing by patent owner of a petition paper

[24] 37 CFR 10.18(b)

[25] See pages 8-18 of the present patent owner petition.

directed the issues decided herein, that does not include such showing may be construed as being a paper interposed for purposes of delay. See: 37 CFR 10.18(b)(2)(i).

CONCLUSION

1. The March 7, 2008 petition to vacate the filing date, the Order granting reexamination, and the first Office action, of the '1008 *inter partes* reexamination proceeding is granted to the extent that the petition has been considered.

2. The March 7, 2008 petition is denied as to the requested vacatur of the filing date, the Order, and the first Office action, of the '1008 *inter partes* reexamination proceeding.

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

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

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

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June 30, 2008

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,008	10/01/2007	6715020	38512.13	5604

22852 7590 04/20/2010

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP
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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/20/2010

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95/001,008	10/01/07	6715020	3851213

EXAMINER
ESCALANTE, OVIDIO

ART UNIT	PAPER
3992	

HAYNES AND BOONE, LLP
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ESCALANTE, OVIDIO

ART UNIT	PAPER
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APR 20 2010

CENTRAL REEXAMINATION UNIT

In re: Farmwald *et al.*
Inter Partes Reexamination Proceeding
Control No. 95/001,008
Filed: October 1, 2007
For: U.S. Patent No. 6,715,020

DECISION DISMISSING PETITION

This is a decision on patent owner's petition paper entitled "PETITION SEEKING WAIVER OF 37 C.F.R § 1.955," filed on February 25, 2010.

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 by patent owner's EFS-WEB fee transmittal.

REVIEW OF THE RELEVANT FACTS

1. On March 30, 2004, U. S. Patent No. 6,715,020 (the '020 patent) issued to Farmwald *et al.*

2. On October 1, 2007, a request for *inter partes* reexamination of the '020 patent, assigned Reexamination Control No. 95/001,008 (the '1008 proceeding), was filed by a third party requester.

3. On December 19, 2007, the Office issued an order granting *inter partes* reexamination in the '1008 proceeding, stating that an Office action on the merits would be issued in due course.

4. On February 25, 2008, the Office issued a non-final Office action on the merits in the '1008 proceeding.

5. The proceeding progressed until, on December 11, 2009, the Office issued an Action Closing Prosecution (ACP).

6. On February 11, 2010, third party requester filed a paper entitled "NOTICE OF NON-PARTICIPATION IN *INTER PARTES* REEXAMINATION," notifying the Office of third party requester's withdrawal from participation in the '1008 proceeding.

7. On February 25, 2010, patent owner filed a petition paper entitled "PETITION SEEKING WAIVER OF 37 C.F.R. § 1.955," (a 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.

In the February 25, 2010 petition under 37 CFR 1.183, patent owner requests waiver of the requirements of 37 CFR 1.955, prohibiting interviews on the merits in an *inter partes* reexamination proceeding, in view of third party requester's February 11, 2010 withdrawal from participation in the '1008 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 37 CFR 1.955 Prohibition of Interviews

In patent owner's petition under 37 CFR 1.183 patent owner has requested "a waiver of the requirements of 37 C.F.R § 1.955."[2] 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 '1013

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

proceeding, "only one party—the patent owner Rambus—will now participate in any interviews with the Office."[3] Patent owner also asserts that because the third party requester will no longer participate in the present proceeding, "interview rights" should be granted because the Office has granted "interview rights" in other proceedings with a non-participating third party requester.[4] Finally patent owner asserts that by allowing patent owner to discuss the merits of the proceeding interviews, "will promote an expedited resolution of all outstanding issues in keeping with the statutory special dispatch requirements."[5]

In the instant petition under 37 CFR 1.183, patent owner has requested waiver of the prohibition against merits interviews under 37 CFR 1.955, couched as a "right" and not a "request," *as opposed to waiver of the regulation for a particular interview request.* This amounts to a request for an unlimited right to interview in general. Initially, it is to be noted that the Office cannot grant a right that does not exist. Rather, the Office can grant a waiver of the rule and permit patent owner to "request" an interview from the examiner, in the same manner a patent owner may request an interview in an *ex parte* reexamination proceeding. Patent owner has not set forth with specificity the facts that give rise to ***an extraordinary situation in which justice requires suspension*** of 37 CFR 1.955 which would justify a right to unlimited interviews, which would severely retard the proceeding contrary to the requirement for special dispatch set for in 35 U.S.C. 314(c). Rather, the patent owner may petition under 37 CFR 1.183 for waiver of the prohibition of interviews on the merits on an interview-by-interview "request" basis. In each instance where an interview is requested, the patent owner will need to satisfy the following preliminary requirements prescribed for requesting an interview in MPEP 2281:

Preliminary Requirements

1. Promptly upon receipt of a favourable decision, patent owner must contact the examiner of record in 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 telephone number.

2. At least five (5) working days prior to the interview, patent owner must:

   (a) File a written statement confirming the issues to be discussed at the interview, together with a copy of any proposed claim amendments to be discussed; and
   (b) Transmit a copy of such papers to the examiner's desktop facsimile telephone number.

3. Patent owner must (a) serve a copy of the papers discussed in item (2) above on the third party requester in accordance with 37 CFR 1.903, and (b) include a copy of the certificate of service

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[3] Id. at page 3.
[4] Id., See also Reexamination Control. No. 95/000.142 Decision dated April 17, 2007, wherein the Office granted a patent owner request for a waiver of 37 CFR 1.955 for a single interview and NOT a "right" to conduct interviews. (Petitioner's Exhibit B)
[5] Id.

of such papers in both the papers as filed (item 2(a) above), and as transmitted by facsimile to the examiner (see item 2(b) above).

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 February 25, 2010 petition is dismissed.

2. Jurisdiction for the '1008 reexamination proceeding is returned to the Central Reexamination Unit (CRU).

3. Any questions concerning this communication should be directed to Joseph F. Weiss, Jr., Legal Advisor, at (571) 272-7759.

Kenneth M. Schor

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

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.
95/001,008	10/01/2007	6715020	38512.13	5604

22852 7590 07/08/2010

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 07/08/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/001,008	10/01/07	6715020	3851213

EXAMINER
ESCALANTE, OVIDIO

ART UNIT	PAPER
3992	

HAYNES AND BOONE, LLP
IP SECTION
2323 VICTORY AVENUE
SUITE 700
DALLAS, TX 75219

DATE MAILED: MAILED

JUL 08 2010

CENTRAL REEXAMINATION UNIT

INTER PARTES REEXAMINATION COMMUNICATION

BELOW/ATTACHED YOU WILL FIND A COMMUNICATION FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE OFFICIAL(S) IN CHARGE OF THE PRESENT REEXAMINATION PROCEEDING.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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(For Patent Owner)

David L. McCombs, Esq.
Hayes and Boone, LLP
IP Section
2323 Victory Avenue
Suite 700
Dallas, TX 75219

(For Requester)

MAILED

JUL 08 2010

CENTRAL REEXAMINATION UNIT

In re: Farmwald *et al.*
Inter Partes Reexamination Proceeding
Control No. 95/001,008
Filed: October 1, 2007
For: U.S. Patent No. 6,715,020

DECISION DISMISSING PETITION

This is a decision on patent owner's petition paper entitled "EXPEDITED RENEWED PETITION SEEKING WAIVER OF 37 C.F.R § 1.955," filed on May 3, 2010.

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.

REVIEW OF THE RELEVANT FACTS

1. On March 30, 2004, U. S. Patent No. 6,715,020 (the '020 patent) issued to Farmwald *et al.*

2. On October 1, 2007, a request for *inter partes* reexamination of the '020 patent, assigned Reexamination Control No. 95/001,008 (the '1008 proceeding), was filed by a third party requester.

3. On December 19, 2007, the Office issued an order granting *inter partes* reexamination in the '1008 proceeding, stating that an Office action on the merits would be issued in due course.

4. On February 25, 2008, the Office issued a non-final Office action on the merits in the '1008 proceeding.

5. The proceeding progressed until, on December 11, 2009, the Office issued an Action Closing Prosecution (ACP).

6. On February 11, 2010, third party requester filed a paper entitled "NOTICE OF NON-PARTICIPATION IN *INTER PARTES* REEXAMINATION," notifying the Office of third party requester's withdrawal from participation in the '1008 proceeding.

7. On February 25, 2010, patent owner filed a petition paper entitled "PETITION SEEKING WAIVER OF 37 C.F.R. § 1.955," (a petition under 37 CFR 1.183).

8. On April 20, 2010, the Office mailed a decision dismissing patent owner's February 25, 2010 petition under 37 CFR 1.183.

9. On May 3, 2010, patent owner filed the instant petition paper entitled "EXPEDITED RENEWED PETITION SEEKING WAIVER OF 37 C.F.R § 1.955," (a 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.

In the May 3, 2010 renewed petition under 37 CFR 1.183, patent owner requests waiver of the requirements of 37 CFR 1.955, prohibiting interviews on the merits in an *inter partes* reexamination proceeding, in view of third party requester's February 11, 2010 withdrawal from participation in the '1008 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.

[1] Petition under 37 CFR 1.183 at page 2.

Request to Waive the 37 CFR 1.955 Prohibition of Interviews

In patent owner's petition under 37 CFR 1.183, patent owner has requested "a waiver of the requirements of 37 C.F.R § 1.955" to request a single interview[2] 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 '1008 proceeding, "only one party—the patent owner Rambus—will now participate in any interviews with the Office."[3] Patent owner also asserts that, because the third party requester will no longer participate in the present proceeding, an interview should be permitted, because the Office has granted an interview in other proceedings with a non-participating third party requester.[4] Finally patent owner asserts that by allowing patent owner to discuss the merits of the proceeding in an interview the "few remaining" issues can be resolved and "will promote an expedited resolution of all outstanding issues in keeping with the statutory special dispatch requirements."[5]

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.[6] 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."[7] 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 '1008 *inter partes* reexamination proceeding.[8] Thus, only a single party (patent owner) will now participate in the '1008 *inter partes* reexamination proceeding, and any interview that might be permitted in 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 only makes the bald assertion that the facts of the present proceeding are similar to that of *inter partes* reexamination control no.

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[2] Id. at page 2-3.
[3] Id.
[4] Id., See also Reexamination Control. No. 95/000,142 Decision dated April 17, 2007, wherein the Office granted a patent owner request for a waiver of 37 CFR 1.955 for a single interview. (Petitioner's Exhibit A)
[5] Id.
[6] 65 FR at 76768.
[7] 65 FR at 76769.
[8] *Notice of Non-participation in inter partes Reexamination*, filed February 11, 2010 (stating "Samsung Electronics Co., Ltd. ("Samsung"), the third party requester for *inter partes* reexamination Control No., hereby gives notice that it no longer intends to participate in the present reexamination.")

95/000,142 (the '142 proceeding)[9] where 37 CFR 1.955 was waived and a single interview was granted.[10] Patent owner, provides only a copy of the Office decision and does not provide any of the facts and circumstances regarding the '142 proceeding, incident with the granted decision, and makes no correlation of the facts between the present proceeding and the '142 proceeding. The Office is not bound by prior decisions, as all matters are addressed and resolved on a case-by-case basis. Upon a review of the February 15, 2007 patent owner petitions (with supporting exhibits) in the '142 proceeding requesting waiver of 37 CFR 1.955, that petitioner patent owner did not merely cite to the fact that the requester would no longer non-participate in the *inter partes* proceeding. Patent owner in the '142 proceeding included support reflecting the tacit consent of the non-participating requester for waiver of 37 CFR 1.955 to conduct an interview.[11] Furthermore, patent owner provided in the '142 proceeding a summary of the current state of the proceedings, focusing upon the few matters at issue in the proceeding.[12]

In the present petition patent owner has provided not a single specific fact that gives rise to the existence of an extraordinary situation where justice requires suspension of the rule, despite the specific notice provided to provide such in the April 20, 2010 decision dismissing patent owner's February 25, 2010 initial petition. Patent owner alleges the existence of a "few remaining issues" in the proceeding.[13] Upon a review of the outstanding Office action, a 130 page ACP issued on December 11, 2009, all of the pending claims, Claims 1-49, stand rejected under one or more rejections, with a total of twelve rejections in all. Of the twelve rejections, three are based upon anticipation, and nine are based upon obviousness. Several of the rejections are based upon intervening references, due to an apparent break in the priority/benefit claims for claimed subject matter. Also, the issues of claim interpretation required approximately thirty pages of the Office action alone. Therefore, the allegation of a "few remaining issues" <u>is contrary to the facts of the present proceeding.</u>

In view of the current lack of a showing of an extraordinary situation by patent owner in the present petition, in this instance, the '1008 proceeding does NOT present an extraordinary situation which justifies waiver of 37 CFR 1.955 to further the interests justice. Thus, patent owner's renewed petition under 37 CFR 1.183 is <u>dismissed</u>.

In order to complete its petition, patent owner may provide, via renewed petition, a summary of the current state of the proceeding, focusing upon the central matters at issue in the proceeding, and showing that, given the nature of the matters at issue, an interview would enhance the understanding of the relevant patentability issues. In the event patent owner files a <u>renewed</u> petition under 37 CFR 1.183 for waiver of 37 CFR 1.955 to complete the petition 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.

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[9] On September 11, 2009 the '142 proceeding was vacated and on November 19, 2009 the proceeding closed from public view.
[10] Petition under 37 CFR 1.183 at page 2-3.
[11] *Inter partes* Reexamination Control. No. 95/000,142 patent owner petition dated February 15, 2007, with exhibits.
[12] <u>Id.</u>
[13] Petition under 37 CFR 1.183 at page 2.

CONCLUSION

1. Patent owner's May 3, 2010 renewed petition is dismissed.

2. In order to complete its petition, patent owner may provide, via renewed petition, a summary of the current state of the proceeding, focusing upon the central matters at issue in the proceeding, and showing that, given the nature of the matters at issue, an interview would enhance the understanding of the relevant patentability issues.

3. Jurisdiction over the '1008 *inter partes* reexamination proceeding is returned to the Central Reexamination Unit for action not inconsistent with this decision.

4. Any questions concerning this communication should be directed to Joseph F. Weiss, Jr., Legal Advisor, at (571) 272-7759.

Kenneth M. Schor

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

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UNITED STATES PATENT AND TRADEMARK OFFICE
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JUN 10 2008

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Ex parte Reexamination Proceeding
Control No. 90/010,016
Filed: August 29, 2007
For: U.S. Patent No. 7,090,906

Inter Partes Reexamination Proceeding
Control No. 95/001,010
Filed: October 23, 2007
For: U.S. Patent No. 7,090,906

Inter Partes Reexamination Proceeding
Control No. 95/001,020
Filed: January 7, 2008
For: U.S. Patent No. 7,090,906

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 SALIENT FACTS

1. U.S. patent No. 7,090,906 ("the '906 patent") issued to William O'Keeffe on August 15, 2006, and was assigned to O'Keeffe's, Inc.

2. A request for *ex parte* reexamination of claims 1-6 of the '906 patent was filed on August 29, 2007, by Anemostat Products, as the third party requester, and the request was assigned control number 90/010,016 (the '016 *ex parte* reexamination proceeding).

3. On November 2, 2007, *ex parte* reexamination was ordered based upon the examiner's determination that the August 29, 2007 request for *ex parte* reexamination raised a substantial new question of patentability for claims 1-6 of the '906 patent.

4. Patent owner filed a statement and amended claim 5 of the '906 patent on January 2, 2008. No Office action has been mailed for the'016 *ex parte* reexamination proceeding.

5. A request for *inter partes* reexamination of claims 1-6 the '906 patent was filed on October 23, 2007, by third party requester Anemostat Products. The request was assigned control number 95/001,010 (the '1010 *inter partes* reexamination proceeding).

6. A second request for *inter partes* reexamination of claims 1-6 the '906 patent was filed on January 7, 2008, by another third party requester, Technical Glass Products. The request was assigned control number 95/001,020 (the '1020 *inter partes* reexamination proceeding).

7. On January 17, 2008, *inter partes* reexamination was ordered for the '1010 reexamination proceeding based on the examiner's determination that the October 23, 2007 request raised a substantial new question of patentability for claims 1-6 of the '906 patent.

8. On March 28, 2008, *inter partes* reexamination was ordered for the '1020 reexamination proceeding based on the examiner's determination that the January 7, 2008 request raised a substantial new question of patentability for claims 1-6 of the '906 patent.

9. No Office action has been mailed, and no amendments to the claims have been made, in the '1010 and '1020 *inter partes* reexamination proceedings.

DECISION

I. MERGER OF PROCEEDINGS

Reexamination has been ordered in all three proceedings for the same claims of the same patent. Two of the proceedings (the '1010 proceeding and the '0102 proceeding) are *inter partes* reexamination proceedings and one proceeding (the '016 proceeding) is an *ex parte* reexamination proceeding. All of the proceedings are still pending, and have not been terminated. Therefore, consideration of merger pursuant to 37 CFR 1.989 is ripe at this point in time.

37 CFR 1.989 provides:

> (a) If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where 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 general policy of the Office is that multiple 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 multiple proceedings on behalf of the patent owner, (2) to provide a comprehensive examination of the patent based on the issues raised in all of the proceedings, and (3) to expedite the prosecution of all of the proceedings. In the present instance, merger of the '016, the '1010 and the '1020 proceedings would address these considerations. In accordance with 37 CFR 1.989(a), the 90/010,016, 95/001,010, and 95/001,020 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 ALL PROCEEDINGS

1. Patent owner is required to maintain the same claims (and specification) in all files *throughout the merged proceeding*. Since claim 5 has been amended in the '016 proceeding, so that the claims are not currently the same in both files, a "housekeeping amendment" is needed to place the same amendments in all of the proceedings.

Patent owner is required to submit an appropriate "housekeeping amendment" within <u>one month</u> of this decision placing the same amendments in all files. The paper should be strictly limited to the bare presentation of the amendments. Any discussion of the merits or issues of the proceeding 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.

2. It should be noted that submission of such an appropriate 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. [1]

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.

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

The present decision merges an *ex parte* reexamination proceeding with 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, except that the rights of the third party requester of the *ex parte* reexamination are governed by 37 CFR 1.510 through 1.560. In this instance, however, the *ex parte* reexamination was requested by the same third party as in one of the two *inter partes* reexaminations. Therefore, the third party requester has the full *inter partes* reexamination participation rights in the merged proceeding that are set forth in 37 CFR 1.902 through 1.997.

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 the third party requesters, will contain the identifying data for all three of the proceedings and will be physically entered in each reexamination file. All papers filed by the patent owner and the third party requesters must consist of a single paper, filed in **triplicate**, each bearing a signature and identifying data for all three of the proceedings, 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

[1] The regulations governing the filing of third party requester written comments, 37 CFR 1.947 and 1.951(b), do not provide for the filing of any third party requester comments unless the written comments are directed to a patent owner paper filed in response to "an Office action." A merger decision is not an Office action on the merits of patentability; thus requester is not authorized to respond to the house-keeping amendment. This is based on 35 U.S.C. 314(b)(2) which only authorizes comments after a patent owner "response to an action on the merits," and goes no further. The third party requester may comment on any new claim after patent owner responds to an Office action, or, if patent owner does not respond to any action, then by way of appeal.

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

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

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

C. Amendments:

The filing of any amendments to the drawings, specification or claims must comply with 37 CFR 1.943, (which incorporates the provisions of 37 CFR 1.530), and the guidelines of MPEP § 2666.01, which in turn references the guidelines of MPEP § 2250. 37 CFR 1.121 does not apply to amendments in reexamination. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather, amendments are to be presented via markings pursuant to paragraph 37 CFR 1.530(f) of this section, except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

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

D. Fees:

Where a paper is filed that requires payment of a fee (*e.g.*, petition fee, excess claims fee, extension of time fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For example, only one fee need be paid for any patent owner's appellant brief (or that of each *inter partes* requester) which may be filed, even though the brief relates to merged multiple proceedings and a copy 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. Reexamination Control Nos. 95/001,010, 95/001,020 and 90/010,016 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 the mail date of this decision**, placing the same amendments in all three cases of the present merged proceeding.

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

4. The examiner should not issue an Office action for the present merged proceeding until after the earlier of: (a) the submission of the required housekeeping amendment to place the same amendments in all cases, or (b) the expiration of the ONE MONTH period from the mailing of this decision for filing the amendment.

5. Any questions concerning this communication should be directed to the Caroline D. Dennison, Legal Advisor, at 571-272-7729.

Kenneth M. Schor

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.
90/008,351	11/27/2006	6942248	ATI-233 RE	5110

22846 7590 02/20/2008

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/20/2008

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,012	10/11/2007	6,942,248	ATI-233 IP REEX	5467

22846 7590 02/20/2008

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/20/2008

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(For Patent Owner)

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FEB 20 2008

CENTRAL REEXAMINATION UNIT

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(For Third Party Requester)

Ex parte Reexamination Proceeding
Control No. 90/008,351
Filed: November 27, 2006
For: U.S. Patent No. 6,942,248

Inter Partes Reexamination Proceeding
Control No. 95/001,012
Filed: October 11, 2007
For: U.S. Patent No. 6,942,248

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 SALIENT FACTS

1. U.S. patent No. 6,942,248 (the '248 patent) issued to David Breed *et al.* on September 13, 2005 and was assigned to Automotive Technologies International Inc.

2. A request for *ex parte* reexamination of claims 1-6, 8, 11-14, 16, 19, 24, 32, 37, 44, and 46 of the '248 patent was filed on November 27, 2006, by Rickard DeMille, as the third party requester, and the request was assigned control number 90/008,351 (the '8351 *ex parte* reexamination proceeding).

3. On January 4, 2007, *ex parte* reexamination was ordered for claims 1-6, 8, 11-14, 16, 19, 24, 32, 37, 44, and 46 of the '248 patent, based upon the examiner's determination that the request for *ex parte* reexamination raised a substantial new question of patentability for these claims.

4. Patent owner notified the Office of two concurrent litigations [1] involving the '248 patent, which have been stayed pending results of the reexamination proceeding.

5. A non-final Office action was mailed June 22, 2007, rejecting claims 1-6, 8, 11-14, 16, 19, 24, 32, 37, 44, and 46 of the '248 patent.

6. After an interview with the Examiner on July 17, 2007, the patent owner filed a response on August 24, 2007, proposing an amendment adding claims 48-51 to the '248 patent and changing the drawings.

7. A request for *inter partes* reexamination of claims 1-18 the '248 patent was filed on October 11, 2007, by third party requester Rickard DeMille, in which Elesys North America, Inc. (ENA) was identified as the real party in interest. The request was assigned control number 95/001,012 (the '1012 *inter partes* reexamination proceeding).

8. On January 9, 2008, *inter partes* reexamination was ordered based on the examiner's determination that the October 11, 2007 request raised a substantial new question of patentability for claims 7 and 15 of the '248 patent.

9. There has been no further Office action in the '1012 *inter partes* reexamination proceeding, but, on October 19, 2007, an Office action was mailed in the '8351 *ex parte* reexamination proceeding finally rejecting claims 1-6, 8, 11-14, 16, 19, 24, 32, 37, 44, 46 and 48-51 of the '248 patent.

10. Patent owner filed a response in the '8351 *ex parte* reexamination proceeding to the October 19, 2007 Office action on November 19, 2007. On November 29, 2007, an advisory action was mailed that denied entry of the response.

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 '1012 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

[1] *Automotive Technologies International, Inc. v. American Honda Motor Co., Inc. et al.*, Civil Action No. 06-187-GMS, and *Automotive Technologies International, Inc. v. Hyundai Motor America et al.*, Civil Action No. 06-391-GMS, both in the U.S. District Court for the District of Delaware.

proceedings. Where merger is ordered, the merged examination will normally result in the issuance of a single reexamination certificate under § 1.997.

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

In accordance with 37 CFR 1.989(a), the 95/001,012 and 90/008,351 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

Patent owner is required to maintain the same claims (and specification) in both files *throughout the merged proceeding*. Since claims 48-51 have been added and changes to the drawings have been proposed in the '8351 proceeding, so that the claims and the specification are not currently the same in both files, a "housekeeping amendment" is needed to place the same amendments in both proceedings.

Patent owner is required to submit an appropriate "housekeeping amendment" within <u>one month</u> of this decision placing the same amendments in both files. The paper should be strictly limited to the bare presentation of the amendments. Any discussion of the merits or issues of the proceeding 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.

It should be noted that submission of such an appropriate housekeeping amendment will not create a reply right for the *inter partes* third party requester. Any comments paper filed by the requester 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 requester at the next opportunity that requester has to file a paper directed to the merits having an entry right. [2]

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

[2] The regulations governing the filing of third party requester written comments, 37 CFR 1.947 and 1.951(b), do not provide for the filing of any third party requester comments unless the written comments are directed to a patent owner paper filed in response to "an Office action." A merger decision is not an Office action on the merits of patentability; thus requester is not authorized to respond to the house-keeping amendment. This is based on 35 U.S.C. 314(b)(2) which only authorizes comments after a patent owner "response to an action on the merits," and goes no further. The third party requester may comment on any new claim after patent owner responds to an Office action, or, if patent owner does not respond to any action, then by way of appeal.

37 CFR 1.902 through 1.997, except that the rights of the third party requester of the *ex parte* reexamination are governed by 37 CFR 1.510 through 1.560. In this instance, however, the *ex parte* reexamination was requested by the same third party as in the *inter partes* reexamination. Therefore, the third party requester has the full *inter partes* reexamination participation rights in the merged proceeding that are set forth in 37 CFR 1.902 through 1.997.

It is noted that reexamination was ordered for claims 1-6, 8, 11-14, 16, 19, 24, 32, 37, 44, and 46 of the of the '248 patent in the '8351 *ex parte* reexamination proceeding, while reexamination was ordered for claims 7 and 15 of the '248 patent in the '1012 *inter partes* proceeding. The examiner will conduct reexamination in the merged proceeding for claims 1-8, 11-16, 19, 24, 32, 37, 44, and 46 of the of the '248 patent and for new claims 48-51 (from the '8351 *ex parte* proceeding), which will be added by amendment in the merged proceeding.

B. Papers mailed/filed:

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

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

by Mail to:

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

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

by Hand to:

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

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

C. Amendments:

The filing of any amendments to the drawings, specification or claims must comply with 37 CFR 1.943, (which incorporates the provisions of 37 CFR 1.530), and the guidelines of MPEP § 2666.01, which in turn references the guidelines of MPEP § 2250. 37 CFR 1.121 does not apply to amendments in reexamination. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via markings pursuant to paragraph 37 CFR 1.530(f) of this section, except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

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

D. Fees:

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

E. Citation of Patents and Printed Publications:

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

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/001,012 and *ex parte* Reexamination Control No. 90/008,351 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 the mail date of this decision, placing the same amendments in both cases of the present merged proceeding.

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

4. The examiner should not issue an Office action for the present merged proceeding 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.

5. Any questions concerning this communication should be directed to the Caroline D. Dennison, Legal Advisor, at 571-272-7729.

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

Finnegan, Henderson et al., LLP
901 New York Avenue, NW
Washington, DC 20001-4413

(For Patent Owner)

MAILED

APR 17 2008

CENTRAL REEXAMINATION UNIT

David L. McCombs, Esq.
Hayes and Boone, LLP
901 Main Street, Suite 3100
Dallas, TX 75202-3789

(For Requester)

In re Farmweld et al.
Reexamination Proceeding
Control No.: 95/001,013
Filed: October 11, 2007
For: U.S. Patent No. 6,697,295

: DECISION GRANTING
: PETITION UNDER
: 37 CFR § 1.183

This is a decision on the March 7, 2008 patent owner petition entitled "PETITION TO WAIVE 37 CFR § 1.98(a)(2) AND ENTER INTO THE FILE RECORD DOCUMENTS FROM CO-PENDING REEXAMINATION PROCEEDING," treated under 37 CFR 1.183. The petition requests waiver of the formal submission requirements for an Information Disclosure Statement (IDS) under 37 CFR 1.555 and 1.98 by dint of a filing of an identical IDS in a related case, i.e. petitioner requests waiver of the copy requirement.

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. 6,697,295 (the '295 patent) issued on February 24, 2004.

2. U.S. Patent No. 6,715,020 (the '020 patent) issued on March 30, 2004.

3. The '295 patent and the '020 patent are sibling patent application filings, both of which ultimately claim benefit to U.S. application 07/510,898, filed April 18, 1990, now abandoned.

4. A request for reexamination of the '295 patent was filed on October 11, 2007. The request was assigned control No. 95/001,013 (the '1013 reexamination proceeding).

5. A request for reexamination of the '020 patent was filed on October 1, 2007. The request was assigned control No. 90/001,008 (the '1008 reexamination proceeding).

6. Reexamination was ordered for the '1013 proceeding on January 9, 2008.

7. Reexamination was ordered for the '1008 proceeding on December 19, 2007.

8. On February 19, 2008, patent owner filed an IDS under 37 CFR §§ 1.555, 1.97 and 1.98 in the '1008 proceeding.

9. On March 7, 2008, patent owner filed, in the '1013 proceeding, under 37 CFR §§ 1.555, 1.97 and 1.98 an IDS identical to the February 19, 2008 IDS in the '1008 proceeding, but without copies of the references listed in the IDS.

10. Concurrent with the IDS submission of March 7, 2008, in the '1013 proceeding, patent owner filed a petition under 1.183 requesting waiver of the formal submission requirements for the IDS's under 37 CFR 1.555 and 1.98, i.e. waiver of the copy requirement, by dint of filing an identical IDS in the '8441 proceeding with copies of all the listed references.

DECISION

37 CFR 1.555(a) states (in part):

> . . . .
> Any information disclosure statement must be filed with the items listed in § 1.98(a) as applied to individuals associated with the patent owner in a reexamination proceeding, and should be filed within two months of the date of the order for reexamination, or as soon thereafter as possible.

37 CFR 1.98 states (in part):

> (a) Any information disclosure statement filed under § 1.97 shall include the items listed in paragraphs (a)(1), (a)(2) and (a)(3) of this section.
> . . . .
> (2) A legible copy of:
> (i) Each foreign patent;
> (ii) Each publication or that portion which caused it to be listed, other than U.S. patents and U.S. patent application publications unless required by the Office;
> (iii) For each cited pending unpublished U.S. application, the application specification including the claims, and any drawing of the application, or that portion of the application which caused it to be listed including any claims directed to that portion; and
> (iv) All other information or that portion which caused it to be listed.
> . . . .

37 CFR 1.555 requires that information material to patentability must be filed in a reexamination proceeding in accordance with 37 CFR 1.98(a). 37 CFR 1.98(a) requires that copies of certain types of references must be provided in each application for which applicant files an IDS, to constitute a proper IDS. The scanning in of a single submission of references and subsequent electronic transfer of

the same scanned references in an identical IDS between related reexamination proceedings eases the burden of handling the references for the Office, as well as the patent owner, without prejudice to the third party requesters. Accordingly, the petition is granted.

The grant of this petition is not based upon the individual facts and circumstances of these proceedings. Furthermore, grant of this petition is not an acknowledgement that patent owner's March 7, 2008 submission complies with all other requirements of the relevant rules. The examiner of record will make such a determination, in light of this decision's waiving the reference copy submission requirement.

A fee o f $400.00 under 37 CFR 1.17(f) was paid in accordance with patent owner's March 7, 2008 petition submission.

ADDITIONAL DISCUSSION

EFS-Web recently became available for reexamination filings, which should minimize the need for such requests in the future as references could be scanned in and electronically submitted directly into each case.

CONCLUSION

1. The petition under 37 CFR 1.183 for waiver of the requirements of 37 CFR 1.555 and 1.98 is granted.

2. Jurisdiction over this proceeding is returned to the Central Reexamination Unit..

3. Telephone inquiries with regard to this decision should be directed to Joseph F. Weiss, Jr., Office of Patent Legal Administration, at (571) 272-7759.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examining Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,013	10/11/2007	6697295	38512.14	5575

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

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

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.
95/001013	10/11/07	6697295	38512.14

EXAMINER
ESCALANTE,OVIDIO

ART UNIT	PAPER
3992	

HAYNES AND BOONE, LLP
901 MAIN STREET
SUITE 3100
DALLAS, TX 75202

DATE MAILED:

07/02/08

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

Paul Anderson
Rambus Inc.
4440 El Camino Real
Los Altos, CA 94022

(For Patent Owner)

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CENTRAL REEXAMINATION UNIT

David L. McCombs
Haynes and Boone LLP
901 Main Street
Suite 3100
Dallas, TX 75202

(For Third Party Requester)

In re Rambus, Inc.
Inter Partes Reexamination Proceeding
Control No. 95/001,013
Filed: October 11, 2007
For: U.S. Patent No. 6,697,295

: **DECISION**
: **DENYING**
: **PETITION**

This is a decision on the patent owner petition filed on March 7, 2008 entitled "PETITION TO VACATE FILING DATES, ORDERS GRANTING INTER PARTES REEXAMINATION, AND OFFICE ACTION" (hereinafter "patent owner petition"). Receipt is also acknowledged of a paper filed on March 20, 2008 by third party requester entitled "THIRD PARTY REQUESTER'S PETITION FOR CLARIFICATION OF REAL PARTY IN INTEREST AND OPPOSITION TO PETITION TO VACATE FILING DATES, ORDERS GRANTING INTER PARTES REEXAMINATION, AND OFFICE ACTION (hereinafter "third party opposition paper").

The March 7, 2008 patent owner petition to vacate, the March 20, 2008 third party opposition and clarification paper, and *inter partes* reexamination proceeding control number 95/001,013 are before the Office of Patent Legal Administration for consideration.

Summary:

1) The patent owner petition is denied.
2) The present decision is designated as a final agency action under 5 U.S.C. § 704.

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Petitioner patent owner has remitted the $400.00 petition fee required for the present petition that is necessitated by the fact that petitioner requests relief not provided for by the rules. [1] In addition, the Office will charge a $400.00 fee against Deposit Account No. 08-1394 as authorized by third party requester, to permit consideration of the third party paper, which is not provided for by the rules.

[1] See: 37 CFR 1.182.

REVIEW OF FACTS

1. U.S. Patent number 6,697,295 ("the '295 patent") issued to Michael Farmwald *et al* on February 24, 2004, and is assigned to Rambus, Inc.

2. On October 11, 2007, a request for *inter partes* reexamination of the '295 patent was filed by a third party requester, and the request was assigned control number 95/001,013 (the '1013 proceeding). In the request, the third party requester identified Samsung Electronics, Inc. as being "the real party in interest," pursuant to 37 CFR 1.915(b) and 35 U.S.C. 311(b). [2]

3. On January 9, 2008, reexamination was ordered for claims 1-51 (*i.e.*, all of the claims) of the '295 patent.

4. A first Office action on the merits (*i.e.*, addressing the patentability of the claims subject to reexamination) has not yet been mailed.

5. On March 7, 2008, the present patent owner petition to vacate was filed.

6. On March 20, 2008, the present third party opposition and clarification paper was filed.

RELEVANT STATUTORY, REGULATORY AND PRACTICE PROVISIONS

35 U.S.C. §§ 311(a) and (b) provide:

> (a) IN GENERAL.— Any third-party requester at any time may file a request for inter partes reexamination by the Office of a patent on the basis of any prior art cited under the provisions of section 301.
> (b) REQUIREMENTS.— The request shall—
> (1) be in writing, include the identity of the real party in interest, and be accompanied by payment of an inter partes reexamination fee established by the Director under section 41; and
> (2) set forth the pertinency and manner of applying cited prior art to every claim for which reexamination is requested.

35 U.S.C. § 315(c) provides:

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

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[2] However, in the third party opposition papers, third party requester has admitted that the real party in interest was inadvertently misidentified, and has unambiguously identified the third part requester as Samsung Electronics, Co., Ltd.. See: Third party opposition paper, at pages 1and 3.

35 U.S.C. § 317 provides:

(a) ORDER FOR REEXAMINATION.— Notwithstanding any provision of this chapter, once an order for inter partes reexamination of a patent has been issued under section 313, neither the third-party requester nor its privies may file a subsequent request for inter partes reexamination of the patent until an inter partes reexamination certificate is issued and published under section 316, unless authorized by the Director.
(b) FINAL DECISION.— Once a final decision has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit or if a final decision in an inter partes reexamination proceeding instituted by a third-party requester is favorable to the patentability of any original or proposed amended or new claim of the patent, then neither that party nor its privies may thereafter request an inter partes reexamination of any such patent claim on the basis of issues which that party or its privies raised or could have raised in such civil action or inter partes reexamination proceeding, and an inter partes reexamination requested by that party or its privies on the basis of such issues may not thereafter be maintained by the Office, notwithstanding any other provision of this chapter. This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the inter partes reexamination proceedings.

37 CFR 1.105 provides:

(a)(1) In the course of examining or treating a matter in a pending or abandoned application filed under 35 U.S.C. 111 or 371 (including a reissue application), in a patent, or in a reexamination proceeding, the examiner or other Office employee may require the submission, from individuals identified under § 1.56(c), or any assignee, of such information as may be reasonably necessary to properly examine or treat the matter, for example:

(i) *Commercial databases*: The existence of any particularly relevant commercial database known to any of the inventors that could be searched for a particular aspect of the invention.

(ii) *Search*: Whether a search of the prior art was made, and if so, what was searched.

(iii)*Related information*: A copy of any non-patent literature, published application, or patent (U.S. or foreign), by any of the inventors, that relates to the claimed invention.

(iv) *Information used to draft application*: A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used to draft the application.

(v) *Information* used in invention process: A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used in the invention process, such as by designing around or providing a solution to accomplish an invention result.

(vi) *Improvements*: Where the claimed invention is an improvement, identification of what is being improved.

(vii) *In Use*: Identification of any use of the claimed invention known to any of the inventors at the time the application was filed notwithstanding the date of the use.

(viii) *Technical information* known to applicant.
Technical information known to applicant concerning the related art, the disclosure, the claimed subject matter, other factual information pertinent to patentability, or concerning the accuracy of the examiner's stated interpretation of such items.

(2) Where an assignee has asserted its right to prosecute pursuant to § 3.71(a) of this chapter, matters such as paragraphs (a)(1)(i), (iii), and (vii) of this section may also be applied to such assignee.

(3) Requirements for factual information known to applicant may be presented in any appropriate manner, for example:

(i) A requirement for factual information;

(ii) Interrogatories in the form of specific questions seeking applicant's factual knowledge; or

(iii) Stipulations as to facts with which the applicant may agree or disagree.

(4) Any reply to a requirement for information pursuant to this section that states either that the information required to be submitted is unknown to or is not readily available to the party or parties from which it was requested may be accepted as a complete reply.

(b)The requirement for information of paragraph (a)(1) of this section may be included in an Office action, or sent separately.
(c) A reply, or a failure to reply, to a requirement for information under this section will be governed by §§ 1.135 and 1.136.

37 CFR 1.907 provides:

(a) Once an order to reexamine has been issued under § 1.931, neither the third party requester, nor its privies, may file a subsequent request for *inter partes* reexamination of the patent until an *inter partes* reexamination certificate is issued under § 1.997, unless authorized by the Director.
(b) Once a final decision has been entered against a party in a civil action arising in whole or in part under 28 U.S.C. 1338 that the party has not sustained its burden of proving invalidity of any patent claim-in-suit, then neither that party nor its privies may thereafter request *inter partes* reexamination of any such patent claim on the basis of issues which that party, or its privies, raised or could have raised in such civil action, and an *inter partes* reexamination requested by that party, or its privies, on the basis of such issues may not thereafter be maintained by the Office.
(c) If a final decision in an *inter partes* reexamination proceeding instituted by a third party requester is favorable to patentability of any original, proposed amended, or new claims of the patent, then neither that party nor its privies may thereafter request *inter partes* reexamination of any such patent claims on the basis of issues which that party, or its privies, raised or could have raised in such *inter partes* reexamination proceeding.

37 CFR 1.913 provides:

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

37 CFR 1.915(b)(7), (b)(8) and (d) provide:

(b) A request for *inter partes* reexamination must include the following parts:
(7) A certification by the third party requester that the estoppel provisions of § 1.907 do not prohibit the inter partes reexamination.
(8) A statement identifying the real party in interest to the extent necessary for a subsequent person filing an *inter partes* reexamination request to determine whether that person is a privy.

...

(d) If *the inter partes* request does not include the fee for requesting *inter partes* reexamination required by paragraph (a) of this section and meet all the requirements of paragraph (b) of this section, then the person identified as requesting *inter partes* reexamination will be so notified and will generally be given an opportunity to complete the request within a specified time. Failure to comply with the notice will result in the *inter partes* reexamination request not being granted a filing date, and will result in placement of the request in the patent file as a citation if it complies with the requirements of § 1.501.

37 CFR 1.919(a) provides:

(a) The filing date of a request for *inter partes* reexamination is the date on which the request satisfies all the requirements for the request set forth in § 1.915.

MPEP § 2614 provides, in part:

The reexamination request must identify the real party in interest who is responsible for filing the reexamination request. This information will be used by future parties requesting reexamination of the same patent, in making the certifications required by 37 CFR 1.915(b)(8).

PRELIMINARY MATTER

The present patent owner and third party requester are also parties in six other *inter partes* reexamination proceedings, in which the same third party requester requested reexamination of patents owned by the same patent owner. The same issue of alleged misidentification of the real party in interest by the third party requester that has been raised in the present '1013 *inter partes* reexamination proceeding has been raised by patent owner in all six of these concurrent proceedings. Stated another way, the same issue regarding identification of the real party in interest forms the basis for the relief requested by patent owner, (vacatur of the filing date and vacatur of the Order granting *inter partes* reexamination) in the present patent owner petition, and in the petitions of five other concurrent reexamination proceedings. In four of the other *inter partes* reexamination proceedings, [3] the alleged misidentification of the real party in interest by the third party requester was the subject of an original patent owner petition filed on May 15, 2007 that was opposed by third party requester on June 14, 2007. The patent owner petition in the four earlier *inter partes* reexamination proceedings sought vacatur of the filing date of the proceeding and the Order granting *inter partes* reexamination based on the alleged misidentification of the real party in interest. In each of the four earlier *inter partes* reexamination proceedings, a decision dismissing the patent owner petition was mailed on November 9, 2007. Thereafter, a reconsideration petition was filed by patent owner on January 23, 2008 in each of the four earlier *inter partes* reexamination proceedings requesting reconsideration of the November 9, 2007 decision. In the January 23, 2008 petition, patent owner also asserted an ambiguity in the identification of the real party in interest in the *inter partes* reexamination request. [4]

In view of the asserted ambiguity of the identification of the real party in interest that was raised in the January 23, 2008 patent owner petition, the Office issued an Order to Show Cause in each of the four earlier *inter partes* reexamination proceedings. The Order to Show Cause required third party requester to explain why the filing date of the proceeding should not be vacated for failure to properly identify the real party in interest as required by 35 U.S.C. § 311(b)(1) and 37 CFR 1.915(b)(8). On March 4, 2008, third party requester filed a response in each of the four earlier *inter partes* reexamination proceedings. In that response, third party requester explained that the ambiguity in the identification of the real party in interest was due to inadvertent error. The third party requester also unambiguously identified the real party in interest as Samsung Electronics Co., Ltd. in each of the four earlier *inter partes* reexamination proceedings. On April 7, 2008, the Office issued a decision in each of the four earlier *inter partes* reexamination proceedings accepting the third party requester's response to the Order to Show Cause.

Thereafter, the January 23, 2008 patent owner renewed petition and the third party requester February 6, 2008 opposition thereto were again taken up for consideration by the Office. It was determined that patent owner had not established entitlement to the relief requested, and that neither the filing date nor the Order for reexamination in each of the four earlier *inter partes* reexamination proceedings would be vacated. Accordingly, on June 17, 2008, a decision was mailed in each of the four earlier *inter partes* reexamination

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[3] These proceedings are 95/000,166 95/000,178 95/000,183 and 95/000,250. These proceedings will be referred to as "the four earlier *inter partes* reexamination proceedings."

[4] Third party requester filed an opposition to the January 23, 2008 patent owner petition on February 6, 2008 in each of the four earlier *inter partes* reexamination proceedings.

proceedings that (1) denied the January 23, 2008 patent owner petition and (2) was designated as a final agency action pursuant to 5 U.S.C. § 704.

In view of the above, the issue of the identification of the real party in interest has been previously addressed in sufficient detail, such that the present decision on patent owner's original petition (to vacate) is being designated as a final agency action pursuant to 5 U.S.C. § 704.

DISCUSSION

I. Patent Owner's Position

The position taken by patent owner in the present petition is essentially identical to the position taken in each of the four earlier *inter partes* reexamination proceedings discussed in the previous section of this decision. Patent owner argues that because:

(1) Patent owner is the plaintiff in litigation in which the '295 patent has been asserted against a number of defendants;
(2) The real party in interest identified in the request for reexamination of the '295 patent, "Samsung," [5] is one of those co-defendants; and
(3) Samsung and certain co-defendants have formed a "joint defense group";

the third party requester did not properly identify the real party in interest, given that only Samsung is named as the real party in interest in the '1013 *inter partes* reexamination proceeding. Patent owner reasons that based on the alleged improper identification of the real party in interest, the Office is required to vacate both the filing date of the '1013 *inter partes* reexamination proceeding and the Order granting *inter partes* reexamination.

Patent owner's position is not persuasive because:

(A) The mere fact that any given party was a co-defendant of Samsung in the '295 patent litigation, or a member of a "joint defense group" together with Samsung in that litigation, does not mean that such a party was (or is) entitled to direct or control input into the conduct of '1013 *inter partes* reexamination proceeding, or has ever done so.
(B) Patent owner has failed to provide any factual showing that would support an allegation that any of Samsung's co-defendants in the '295 patent litigation, or who are members of the "joint defense group" in that litigation together with Samsung, actually is/was in control of, or is/was directly contributing input into the prosecution of the present '1013 *inter partes* reexamination proceeding.
(C) There is no requirement of the reexamination statute that the Office conduct an investigation into the accuracy of the certification made by a third party requester that files a request for reexamination.
(D) Congress has not provided the Office with the investigative tools of subpoena powers or discovery, [6] or the ability to conduct hearings to elicit testimony or to

[5] In the third party requester opposition paper, third party requester has addressed an ambiguity in the identification of the real party in interest. In the opposition paper, third party requester has now unambiguously identified the real party in interest as Samsung Electronics, Inc., Ltd. (hereinafter "Samsung"). The Office accepts this identification.

[6] While 35 U.S.C. §§ 23 and 24 do authorize the Office to establish rules for taking affidavits and depositions required in cases in the Office, no such rules have been established with respect to taking affidavits or

conduct cross-examination to support the investigation requested. Further, Congress has also not provided the Office with authority to impose punitive sanctions for noncompliance with a failure to cooperate in such an investigation.

(E) Investigative evidentiary tools and the ability to impose sanctions are fully available to the courts.

(F) There is precedent showing that the courts have the ability to rule on the issue of "real party in interest" in matters ranging from diversity or amount of suit [7] to matters in which the principle is applied to prevent multiple or conflicting lawsuits by persons such as assignees. [8]

(F) Patent owner did not explain why patent owner had not approached the District Court for relief as, for example by investigation into the matter and issuing an appropriate order.

(G) The identification by third party requester is deemed to be adequate for purposes of 37 CFR 1.915(b)(8), because a subsequent party wishing to file an *inter partes* reexamination request for the '295 patent, or who may be subject to estoppels resulting from the present *inter partes* reexamination proceeding, would be able to determine for itself whether any relationship with Samsung would bar the *inter partes* reexamination request or trigger statutory estoppel.

(H) Pursuant to 37 CFR 10.18(b), the Office relies on factual assertions made before the Office as being true. [9]

II. Patent Owner is Not Entitled to Vacatur of Either the Filing Date or The Order Granting *Inter Partes* Reexamination

Patent owner argues that the Office has the ability to investigate the accuracy of the identification of the real party in interest in an *inter par*tes reexamination proceeding, and has the duty to investigate the accuracy of the identification of the real party in interest in the '1013 *inter partes* reexamination proceeding. Patent owner urges that the Office vacate the present proceeding based upon the real party in interest investigation issue it raises. All of patent owner's arguments have been carefully considered. However, for the reasons that follow, patent owner's arguments and assertions are not persuasive that patent owner is entitled to the requested investigatory relief or the requested vacatur of the proceeding filing date and order granting *inter partes* reexamination in the '1013 *inter partes* reexamination proceeding.

A. When the Identification of the Real Party in Interest Is Not Facially Inaccurate Or Ambiguous, the Office Lacks the Authority and the Tools to Question That Identification

The arguments presented in the patent owner petition fail to establish that the Office has either the authority/duty to question the accuracy of a third party requester's facially

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depositions with respect to reexamination proceedings, or with respect to parties not before the Office in a given proceeding whose compliance cannot be compelled by the Office. Further, these provisions do not appear to be directed to conducting discovery in a proceeding before the Office such as a reexamination proceeding.

[7] *Varlotta Construction Corporation v. Carla Development Corporation*, 886 F. Supp 315 (E.D.N.Y. 1995)

[8] *First Hartford Corporation Pension Plan & Trust v. United States*, 194 F.3d 1279 (Fed. Cir. 1999)

[9] It is pointed out that the ability of the Office to require a party to a matter before the Office to address ambiguities or inaccuracies in factual assertions of record made by that party to resolve such an ambiguity is a wholly different matter from the Office having the statutory authority or the evidentiary tools to conduct an investigation regarding parties not before the Office based upon mere allegations that such an investigation is desired by a party before the Office.

accurate and unambiguous identification of the real party in interest in an *inter partes* reexamination proceeding, or the tools to competently conduct an investigation of the matter.

Patent owner's argument that the Office has the ability to investigate the accuracy of the identification of the real party in interest in an *inter partes* reexamination proceeding is based upon drawing an analogy between (a) the requirement of 37 CFR 1.915(b)(8) that the request for reexamination identify the real party in interest and (b) the requirement of 37 CFR 1.915(b)(7) that the request for reexamination include a statement certifying the filing of the request is not barred by 37 CFR 1.907. [10] Patent owner begins by pointing out that the legislative history of 35 U.S.C § 311(b) shows that Congress enacted the requirement for identification of the real party in interest in order to prevent harassment of the patent owner. [11] Patent owner then alleges that the Office has the stated in the *inter partes* reexamination rulemaking that it has the authority to investigate the accuracy of a third party requester's certification under 37 CFR 1.915(b)(7) (*i.e.*, that the estoppel provisions of 37 CFR 1.907 do not preclude the filing of the request for *inter partes* reexamination). [12] Patent owner then states the Office, (in its November 9, 2007 Decision on Petition discussed in the Preliminary Matter section above), has taken the position that the Office does not have the ability or authority to investigate the accuracy and identification of the real party in interest. Patent owner opines that these positions are inconsistent. Patent owner argues that the Office must take consistent positions, and therefore, patent owner concludes that the Office has the authority and the tools to investigate allegations of requester misidentification of the real party in interest, in the same manner that it would investigate the accuracy of a requester's 37 CFR 1.915(b)(7) certification statement. Patent owner concludes the Office has a duty to conduct such an investigation in the '1013 *inter partes* reexamination proceeding, that as a result of such investigation the Office will find that the real party in interest has not been properly identified, and that the Office should thereafter vacate both the filing date of the '1013 *inter partes* reexamination proceeding, and the Order granting reexamination.

Patent owner's argument is not, however, persuasive, because it does not reflect the intent of, or the plain language of, the provisions of 37 CFR 1.915(b)(7) and (b)(8).

A certification statement made pursuant to 37 CFR 1.915(b)(7) is a statement <u>by</u> the third party requester to the effect that the third party requester is not <u>itself</u> estopped by the statutory estoppel provisions from filing a request for *inter partes* reexamination of a given patent. The *inter partes* rulemaking, at 65 Fed. Reg. 76756, 76759 (Dec. 7, 2000), provides that:

> "It should be noted that the Office generally will not have a need to resolve the factual issue of whether or not one party is a privy of another party. Section 1.915(b)(7) requires a third party requester to certify that the estoppel provisions of §1.907 do not prohibit the filing of the <u>inter partes</u> reexamination request, and the Office does not intend to look beyond this required certification. It is only in the rare instance where a challenge to the

[10] The estoppel provisions of 37 CFR 1.907 incorporate the estoppel provisions established by 35 U.S.C. §§ 315(c) and 317. These provisions will be referred to collectively as "statutory estoppel."

[11] Intellectual Property and Communications Omnibus Reform Act of 199, H.R. Conf. Rep. 10-464, 1999 WL 1095089, *133.

[12] <u>See</u>: MPEP § 2612; see also 65 Fed. Reg. 76756 at pages 76759 and 76764 (stating that "where a challenge to the accuracy of the certification is raised by the patent, that the question would then need to be addressed.")

> accuracy of the certification is raised by the patent owner, that the question would then need to be addressed."

A substantially identical statement also appears at MPEP § 2612. These statements establish that the Office will, in the rare instance that it is necessary to do so, "address" the issue of the accuracy of a certification that statutory estoppel does not bar the filing of a request for *inter partes* reexamination. However, the rulemaking does not, in any way, discuss the type or depth of investigation that can and will be undertaken, and, more importantly, does not anywhere state or imply that an investigation can or will be undertaken by the Office. Rather, it is the duty of any party moving in favor of vacating a reexamination proceeding to provide the facts of any prior investigation that establish its position, including what it has obtained by resort to the courts' investigative power. It is nowhere stated or indicated in the statute, rules, or Office procedural guidelines that a patent owner may trigger an investigation of the accuracy of the certification - merely by advancing an unsupported allegation that the third party requester is estopped from filing a request for *inter partes* reexamination.

While the Office would clearly query an ambiguous or facially inaccurate 37 CFR 1.915(b)(7) certification statement, such a query is based on an ambiguity or inaccuracy provided by the record of the proceeding. A third party making such a statement for the record is a party appearing before the Office. Therefore, a third party requester may appropriately be asked by the Office to clarify or support a 37 CFR 1.915(b)(7) certification statement that is ambiguous or facially inaccurate on the record. In such a case, the third party requester would be called upon to respond based on facts wholly within its knowledge and possession. The Office would be able to obtain information from the patent owner and the third party requester, and would have no need to try to obtain information from parties not before the Office in the reexamination proceeding. Analogously, where the identification of the real party in interest required by 37 CFR 1.915(b)(8) is ambiguous or facially inaccurate, a third party requester that is before the Office can be queried by the Office. In fact, the records of the four earlier *inter partes* proceedings (discussed in the Preliminary Matter section above) show that where the identification of the real party in interest was ambiguous on the record, the third party requester was required to clarify its identification of the real party in interest. Third party requester promptly clarified the ambiguity. [13]

Patent owner additionally relies on the decisions in *Lacavera v. Dudas*, 441 F.3d 1380, 1382 (Fed. Cir. 2006); *Stevens v. Tamai*, 366 F.3d 1325, 1333 (Fed. Cir. 2004; and *In re Bogese*, 303 F.3d 1362, 1368 (Fed. Cir. 2002) as authority for the proposition that the Office can for conduct an investigation to determine the accuracy of a third party requester's identification of the real party in interest in an *inter partes* reexamination proceeding.

In the *Lacavera* decision, the court discussed the authority of the Office to regulate attorney practice before the Office pursuant to 35 U.S.C. § 2(b)(2)(D). The *Stevens* case involved an interference proceeding, and the court's decision in *Stevens* cited 35 U.S.C. § 2(b)(2)(A) as giving the Office authority to establish rules not inconsistent with law to govern the conduct of proceedings in the Office and parties before the Office. The *Bogese* case concerned the authority of the Office to reject claims in a patent application based upon laches arising from unreasonable and unexplained delay in prosecution, notwithstanding that the applicant before the Office complied with pertinent statutes and rules. None of these decisions have

[13] In the present '1013 *inter partes* reexamination proceeding, third party requester has proactively clarified an ambiguity in the identification of the real party in interest. Thus there is no issue of such ambiguity in the '1013 *inter partes* reexamination proceeding.

been found to be relevant to the authority of the Office to conduct an investigation into the identity of a real party in interest, as to whether other parties not before the Office are involved (included). Rather, the cases cited by patent owner involve circumstances in which the patent statute provides authority for the Office to promulgate regulations not inconsistent with law that will govern the conduct of proceedings in the Office, as well as the recognition and conduct of parties before the Office (including practitioners, applicants and other parties).

Patent owner fails to point to any established regulation that would provide a mechanism for conducting an investigation of the sort patent owner envisions, other than 37 CFR 1.105. Although patent owner opines that the Office can conduct an investigation into a third party requester's identification of the real party in interest in a request for *inter partes* reexamination, and require information from a third party requester under the provisions of 37 CFR 1.105, patent owner is simply mistaken. 37 CFR 1.105 was promulgated pursuant to 35 U.S.C. §§ 131 and 132 - statutes that relate to the examination of applications and the conduct of reexamination proceedings as to patentability. The regulation was promulgated for the purpose of requiring submission of information material to patentability from persons having a duty under 37 CFR 1.56 to disclose information to the Office that is material to patentability. [14] 37 CFR 1.105 has no applicability to requesting information from a third party requester regarding that requester's identification of the real party in interest in an *inter partes* reexamination proceeding, which would require investigation into activity by parties not party to the proceeding before the Office. The identification of the real party in interest has no relationship to the duty to disclose information that is material to patentability that applies to an applicant for patent and to a patent owner (and other 37 CFR 1.56(c) parties) in a reexamination proceeding. [15] Further, patent owner has not adequately explained the basis under which the Office would proceed to require a third party requester to supply information regarding the identity of the real party in interest, or to conduct an investigation into the identity of the real party in interest, given that there is no ambiguity or facial inaccuracy in the third party requester's identification of the real party in interest. And, to the extent that it would be necessary to obtain information from a party who is alleged to be an undisclosed real party in interest in an *inter partes* reexamination proceeding, patent owner has not explained how 37 CFR 1.105 could be applied to a party who is not before the Office in that proceeding.

Rather than the Office conducting an investigation based on a raw allegation that a patent believes an identification of the real party in interest to be facially inaccurate, the courts are the appropriate venue in which the patent owner should seek relief in the form of an investigation. [16] (This point is especially relevant here, where the identification appears to be

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[14] 65 Fed. Reg. 54604, 54633, (Sept. 8, 2000.)

[15] See 37 CFR 1.933, which refers back to 37 CFR 1.555, which in turn, references 37 CFR 1.105. These regulations do not create a duty to disclose information material to patentability, (or any duty of disclosure), that attaches to a reexamination third party requester.

[16] See: *In re Epstein*, 32 F.3d 1559, 31 USPQ2d 1817 (Fed. Cir. 1994), where the court took note of party's availability of the court's investigative powers, to address the absence of same to the Office.

> "During ex parte PTO examination, applicants are free to investigate hearsay assertions relied upon by an examiner during the three to six month period available to respond to an office action. They also have the right to introduce rebuttal evidence under 37 C.F.R. Section 1.132 (1993). Moreover, if applicants wish to cross-examine the authors of written hearsay assertions, under 35 U.S.C. Section 145 (1988) they may bring a civil action in the United States District Court for the District of Columbia seeking adjudication that they are entitled to receive a patent. In such an action, testimony could be compelled by subpoena under Federal Civil Procedure Rule 45. See Gould v. Quigg, 822 F.2d 1074, 1076, 3 USPQ2d 1302, 1303 (Fed. Cir. 1987) ("While the evidentiary record before the Board

unambiguous on the record, and it is patent owner that is alleging an inaccuracy.) It is to be noted that there is precedent on the issue of "real party in interest" in the federal courts, on matters ranging from jurisdiction (*e.g.*, presence of diversity or amount of suit) to actions in which the principle is applied to prevent multiple or conflicting lawsuits by persons such as assignees (*e.g.*, assignee estoppel or *res judicata*). [17] Where such precedent requires a party whose disclosure has been challenged to provide support for the disclosure, the examples of court proceedings resolving "real party in interest" issues demonstrate the reason why the Office cannot perform such a function here. Upon obtaining jurisdiction over the parties, courts may order discovery, take testimony and employ other evidentiary tools (*e.g.*, subpoena power and sanctions). Accordingly, the courts are the forums best equipped to determine who is, and who is not, the "real party in interest" when a party has a doubt as to the third party requester's identification of a party or parties as being the real party in interest in an *inter partes* reexamination proceeding. Further, courts may provide relief with respect to patents, as appropriate, by enjoining the filing of a further *inter partes* reexamination request by the other parties in a civil action, or as to the filing of a subsequent civil action. Even if an *inter partes* reexamination request is filed by one of the other parties in the civil action who is barred from requesting *inter partes* reexamination by statutory estoppel, a court could always enjoin participation by that requester in the proceeding and essentially turn the proceeding into an *ex parte* reexamination proceeding, the filing of which does not require identification of "a real party in interest" (35 U.S.C §§ 301 and 302), and is not prohibited by statute or rule, even after an *inter partes* reexamination has been filed by the same real party in interest. [18]

A patent owner concerned with the issue of misidentification of the real party in interest in a request for *inter partes* reexamination may immediately seek relief from the alleged erroneous identification of the "real party in interest" via the courts, which possess the tools to investigate and obtain information as to the relationship of the parties to ascertain the veracity of the identified "real party in interest." The present petition is silent as to why patent owner did not approach the appropriate District Court for relief (*e.g.*, an investigation into the matter and an appropriate order). Given the emphasis that petitioner patent owner has placed on the importance of the "real party in interest" disclosure requirement, it would appear that patent owner could have immediately sought relief in the appropriate court regarding the identity of the real party in interest. The record does not show that patent owner has done so. Patent owner's argument that it is the Office, not a district court, "that administers the patent statute," is wholly unpersuasive. The Office may consider that it is "the sole agency that administers the patent statute," [19] in conducting the *inter partes* proceeding. However, it is common knowledge that the federal courts (which are not an agency in the sense used in the *inter partes* reexamination rulemaking) routinely adjudicate matters arising under the patent statute. Further, patent owner should appreciate the difference between conducting a reexamination proceeding, which is the provenance of the Office, and enforcing an estoppel provision of Federal law as a matter of equitable relief. Patent owner has not provided any basis for believing that the district courts lack authority to act as described above.

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serves as the 'evidentiary nucleus' of the district court proceeding in a section 145 action, the parties are entitled to submit additional evidence."). [32 F.3d at 1565, 31 USPQ2d at 1821]

[17] See, for example: *Varlotta Construction Corporation v. Carla Development Corporation*, 886 F. Supp 315 (E.D.N.Y. 1995) (presence of diversity or amount of suit); *First Hartford Corporation Pension Plan & Trust v. United States*, 194 F.3d 1279 (Fed. Cir. 1999) (application of the principle of "real party in interest" applied to prevent multiple or conflicting lawsuits by persons such as assignees.

[18] If the court makes a finding that the "real party in interest" was misstated, the Office can then take action, if appropriate, based upon the court's findings.

[19] 65 Fed. Reg. 76756, 76759 (Dec. 7, 2000), emphasis added.

As a final point, even if a District Court were approached and declined to investigate the matter until the court was faced with the question of a party other than Samsung trying to assert the same issue the Samsung lost in the Office (which would require (a) that Samsung lose, and (b) that another party assert the same issue - both of which have not happened), there is no reason why the Office should be called upon to address the matter which is not ripe for decision (as discussed immediately below) and for which the Office does not possess the appropriate tools (as discussed above).

B. The Office Has No Duty To Investigate The Identity Of The Real Party In Interest In The '1013 *Inter Partes* Reexamination Proceeding

(1) Patent Owner Does Not Allege A Present Injury

The reexamination statute requires, *inter alia*, that a request for *inter partes* reexamination proceeding "shall ... include the identity of the real party in interest ... ." [20] The *inter partes* reexamination rules require that a request for *inter partes* reexamination include, *inter alia*, "[A] statement identifying the real party in interest to the extent necessary for a subsequent person filing an *inter partes* reexamination request to determine whether that person is a privy." [21] Neither the *inter partes* reexamination statute nor the *inter partes* reexamination rules imposes a duty on the Office to investigate the accuracy of an unambiguous identification of the real party in interest in a third party requester's request for *inter partes* reexamination proceeding and the identification is not facially inaccurate.

In the present '1013 *inter partes* reexamination proceeding, the real party in interest is unambiguously identified in the current record. [22] The identification of the real party is not found to be facially inaccurate. The Office will refuse to accord a filing date to any request for *inter partes* reexamination that does not identify the real party in interest, or which provides an identification of the real party in interest that is ambiguous or facially inaccurate. If the Office accords a filing date to a request for *inter partes* reexamination, and later discovers an ambiguity or a facial inaccuracy in the identification of the real party in interest, the Office can, and will, require that a party appearing before it as third party requester in an *inter partes* reexamination proceeding clarify the ambiguity or facial inaccuracy. [23] However, it does not follow that the Office is empowered to conduct an investigation into the identity of the real party in interest when the statement identifying the real in interest in the record of an *inter partes* reexamination proceeding is neither facially inaccurate nor ambiguous. The Office will not conduct an investigation into the accuracy of the identification of the real party interest in the '1013 *inter partes* reexamination proceeding, because there is no established reason to do so.

Further, it is also to be noted that in the present '1013 *inter partes* reexamination proceeding, patent owner is requesting relief based upon an injury that has not yet occurred. Patent owner does not allege that the named real party in interest is itself estopped from filing and participating in the '1013 *inter partes* reexamination proceeding. Rather, patent owner's concern is that patent owner might be harassed by the filing of a subsequent request for

[20] 35 U.S.C. § 311(b)(1).
[21] 37 CFR 1.915(b)(8).
[22] See footnote 12. The present identification of Samsung Electronics Inc., Ltd. as the real party in interest applies to this proceeding *nunc pro tunc*, and will allow any subsequent party to draw the necessary conclusions for purposes of 37 CFR 1.907 and statutory estoppel in *inter partes* reexamination.
[23] See the discussion in the Preliminary Matter section of this decision.

inter partes reexamination of the '295 patent by a party that should have been identified as a real party in interest in the '1013 *inter partes* reexamination proceeding, but was not so identified. Such a party, as a real party in interest in the '1013 *inter partes* reexamination proceeding, would (if one existed) be subject to a statutory estoppel that would preclude the filing of such a request by that third party requester. While a patent owner is entitled to be protected from harassment by the filing of a subsequent request for *inter partes* reexamination of the '295 patent by a party who is estopped from filing such a request, the record simply does not show that such a circumstance presently exists in the '1013 *inter partes* reexamination proceeding. No additional requests for *inter partes* reexamination of the '295 patent have been filed, so clearly there is presently no cause for concern that a misidentification of the real party in interest has permitted a party subject to statutory estoppel to file an additional request for *inter partes* reexamination of the '295 patent. Accordingly, there is presently no basis for granting the relief requested by patent owner in the present *inter partes* reexamination proceeding, since patent owner cannot, at this point, have been injured by the filing of another request for *inter partes* reexamination for the '295 patent that would be barred by statutory estoppel.

(2) Patent Owner Has Presented No Evidence That The Real Party in Interest Has Not Been Properly Identified

A further reason why the Office will not conduct an investigation into the identity of the real party in interest in the '1013 *inter partes* reexamination proceeding is that patent owner has not presented any factual basis that would establish that the third party requester's identification of the real party in interest is inaccurate or ambiguous. Rather, patent owner relies solely on the fact that third party requester is one of a number of co-defendants in litigation directed to the '295 patent and that certain co-defendants have formed a "joint defense group," of which the identified real party in interest is a member, as providing the reason why the Office must investigate the accuracy of the identification of the real party in interest in the request for reexamination of the '295 patent. However, patent owner *has not provided any factual showing* that would suggest that one or more of members of the "joint defense group" has, in fact: (a) participated in the filing of the request for reexamination of the '295 patent any way or was involved in the decision to file, or (b) in any way participated in the prosecution of the resulting '1013 *inter partes* reexamination proceeding or was involved in the decision as to prosecution. Assuming, *arguendo*, that (1) the Office has authority to conduct an investigation and to require that third party requester provide information in the form of documents, or answers to interrogatories, requiring information, and (2) that patent owner believed that it had been injured due to the filing of another request for *inter partes* reexamination of the '295 patent by a party subject to statutory estoppel, patent owner still has not provided the Office with any evidentiary basis to justify conducting an investigation into the accuracy of a third party requester's identification of the real party in interest in the '1013 *inter partes* reexamination proceeding. Patent owner's belief that one or more unnamed entities are also real parties in interest is not evidence. The Office will not act on mere beliefs, any more than a court would act on allegations that are not supported by facts. The record in the '1013 *inter partes* reexamination proceeding shows that third party requester has unambiguously identified the real party in interest in the request. The record does not show that Office has been provided with any concrete evidence suggesting reason to doubt the accuracy of requester's identification of the real party in interest. On the present record, the Office can only conclude that further inquiry by the Office directed to the third party requester regarding the identity of the real party in interest would merely result in third party requester confirming that that "Samsung Electric Co, Limited" is the real party in interest, as third party requester has previously stated.

Note is taken that such a statement by a party appearing before the Office is a certification that such statement is believed to be true. [24] The record in the '1013 *inter partes* reexamination proceeding provides no basis for the Office to doubt the statement, and accordingly, provides no basis to investigate the accuracy of that statement.

III. Synopsis

Patent owner has previously filed a petition to vacate, on January 23, 2008, in each of four earlier *inter partes* reexamination proceedings requested by the present third party requester. The January 23, 2008 patent owner petitions each requested reconsideration of petition decisions dated November 9, 2007 in each of the four earlier *inter partes* reexamination proceedings. In the present petition, patent owner has referenced the November 9, 2007 petition decisions [25] and has presented arguments that track those presented in the January 23, 2008 petitions for reconsideration of the November 9, 2007 decisions that were filed in the four earlier *inter partes* reexamination proceedings.

In the present petition, patent owner has not demonstrated that the Office has the authority or the procedural tools to conduct an investigation into the otherwise facially unambiguous and facially accurate identification of the real party in interest in this *inter partes* reexamination proceeding. Also, patent owner has not demonstrated any present injury in the '1013 *inter partes* reexamination that could warrant the requested relief. The present record in the '1013 *inter partes* reexamination proceeding does not show that the identification of the real party in interest is inaccurate or ambiguous. Accordingly, patent owner has not demonstrated any basis for the requested relief of vacatur of the filing date of the '1013 *inter partes* reexamination proceeding or vacatur of the Order granting reexamination. On the other hand, requester has unequivocally stated that Samsung ("Samsung Electric Co, Ltd") is the only real party in interest for the present proceeding, and pursuant to 37 CFR 10.18(b), the Office relies on factual assertions made before the Office as being true. Therefore, the relief requested by patent owner will not be granted. Further, because patent owner's underlying rationale for the requested relief has been previously considered in the four earlier *inter partes* reexamination proceedings, the relief requested in the present patent owner petition is denied, and this decision is being designated as a final agency action within the meaning of 5 U.S.C. § 704.

ADDITIONAL DISCUSSION

As this decision is designated as a final agency action under 5 U.S.C. § 704, patent owner is advised that - to the extent that patent owner may disagree with the disposition of the issues in this decision, those issues are now ripe for judicial review. Any further patent owner petition paper, for relief by the Office, which is directed to the issues that have been decided herein will not be considered, unless accompanied by a strong showing of additional facts warranting further review by the Office. The filing by patent owner of a petition paper directed the issues decided herein, that does not include such showing may be construed as being a paper interposed for purposes of delay. See: 37 CFR 10.18(b)(2)(i).

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[24] 37 CFR 10.18(b)

[25] See pages 8-18 of the present patent owner petition.

CONCLUSION

1. The March 7, 2008 petition to vacate both the filing date of the '1013 *inter partes* reexamination proceeding and the Order granting reexamination in the '1013 *inter partes* reexamination proceeding is granted to the extent that the petition has been considered.

2. The March 7, 2008 petition is denied, both as to the requested vacatur of the filing date of the '1013 *inter partes* reexamination proceeding and vacatur of the Order granting reexamination therein.

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

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

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

sm
June 30, 2008

6-30-08
C:\Kiva\Kenpet7\IP\RPI\95_1013 deny orig pet to vacate_ no RPI.doc

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,013	10/11/2007	6697295	38512.14	5575

22852 7590 09/23/2009

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/23/2009

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
DAVID L. MCCOMBS, ESQ.
HAYES AND BOONE, LLP (IP SECTION)
2323 VICTORY AVENUE, SUITE 700
DALLAS, TX 75219

Date:
MAILED
SEP 23 2009
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001013
PATENT NO. : 6697295
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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Naveen Modi FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON DC 20001-4413	: : : : :	(For Patent Owner)

MAILED

SEP 23 2009

CENTRAL REEXAMINATION UNIT

David L. McCombs HAYNES AND BOONE, LLP IP SECTION 2323 VICTORY AVENUE SUITE 700 DALLAS, TX 75219	: : : : : :	(For Third Party Requester)

In re: Farmwald *et alia* *Inter Partes* Reexamination Proceeding Control No. 95/001,013 Deposited on: 11 October 2007 For: US Patent No. 6,697,295	: : : : :	DECISION GRANTING PETITION FOR EXTENSION OF TIME [37 CFR §§ 1.956 & 1.181]

This is a decision on the 17 September 2009, "Patent Owner's Petition for Extension of Time Pursuant to 37 CFR 1.956" requesting that the time for responding to the non-Final Office action mailed 07 August 2009, be extended by one (1) month. The petition was timely filed.

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

The petition is granted for the reasons set forth below.

DISCUSSION

The Patent Owner's representative requests the period of time be extended in which to file a response to the non-final Office action mailed 07 August 2009, which set two (2) months time for filing a response thereto. The petition for extension of time was timely filed on 17 September 2009, 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.

> **37 CFR § 1.956. Patent owner extensions of time in inter partes reexamination.** *The time for taking any action by a patent owner in an inter partes reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified. Any request for such extension must be filed on or before the day on which action by the patent owner is due, but in no case will the mere filing of a request effect any extension. Any request for such extension must be accompanied by the petition set forth in § 1.17(g). See § 1.304(a) for extensions of time for filing a notice of appeal to the U.S. Court of Appeals for the Federal Circuit.*

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

> As noted above, a request for extension of time under 37 CFR § 1.956 will be granted only for sufficient cause, ...
>
> Evaluation of whether "sufficient cause" has been shown for an extension must be made by **balancing** the desire to provide the patent owner with a fair opportunity to respond, **against** the requirement of the statute, 35 U.S.C. § 314(c), that the proceedings be conducted with special dispatch. ...

Any petition request must include the required petition fee as set forth according to 37 CFR § 1.17 (g) and 37 CFR § 1.956.

MPEP § 2665 Extension of Time for Patent Owner Response (in-part)

> Requests for an extension of time in an inter partes reexamination proceeding will be considered only after the first Office action on the merits in the reexamination is mailed. Any request for an extension of time filed prior to the first action will be denied.

The certificate of mailing and the certificate of transmission procedures (37 CFR § 1.8), and the "Express Mail" mailing procedure (37 CFR § 1.10), may be used to file a request for extension of time, as well as any other paper in an existing *inter partes* reexamination proceeding (see MPEP § 2666).

As noted above, a request for extension of time under 37 CFR § 1.956 will be granted only for sufficient cause, and the request must be filed on or before the day on which action by the patent owner is due. In no case, will the mere filing of a request for extension of time automatically effect any extension, because the showing of cause may be insufficient or incomplete. In the prosecution of an *ex parte* reexamination, an automatic 1-month extension of time to take further action is granted upon filing a first timely response to a final Office action (see MPEP § 2272). The automatic extension given in *ex parte* reexamination does not apply to the first response to an Action Closing Prosecution (ACP) in an inter partes reexamination. The reason is that in *inter partes* reexamination, parties do not file an appeal in response to an ACP, and a further Office action (Right of Appeal Notice) will issue even if the parties make no response at all. Thus, there is no time period to appeal running against the parties after the ACP is issued, unlike ex parte reexamination where an appeal is due after final rejection and the time is thus automatically extended one month to provide time for the patent owner to review the Office's response to the amendment before deciding whether to appeal.

Evaluation of whether "sufficient cause" has been shown for an extension must be made by balancing the desire to provide the patent owner with a fair opportunity to respond, against the requirement of the statute, 35 U.S.C. § 314(c), that the proceedings be conducted with special dispatch.

DECISION

The patent owner's representative petitions under 37 CFR § 1.956 to extend the period for response by adding 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 07 August 2009. The patent owner submitted a timely filed the petition on 17 September 2009 with the appropriate fee and certificate of service.

The petition dated 17 September 2009 cites the complexity of the lengthy Office action with its many rejections as the incorporation by reference of the proposed rejections from the third party requesters two requests for *inter partes* reexamination. On balance, the petitioner has demonstrated "sufficient cause" to grant a one (1) month extension of time based upon the length, complexity of the Office action.

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

CONCLUSION

1. The patent owner's petition for extension for one (1) month time in which to file a response to the non-final Office action dated 07 August 2009 is hereby **granted.**

2. The period for response is extended by one (1) month.

3. The response is extended to **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
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Alexandria, VA 22313-1450

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

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

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

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

/Mark Reinhart/
for

Gregory Morse,
Director,
Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,013	10/11/2007	6697295	38512.14	5575

22852 7590 03/11/2010

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP
901 NEW YORK AVENUE, NW
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EXAMINER

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DATE MAILED: 03/11/2010

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/001,013	10/11/07	6697295	38512.14

EXAMINER
ESCALANTE, OVIDIO

HAYNES AND BOONE, LLP
IP SECTION
2323 VICTORY AVENUE
SUITE 700
DALLAS, TX 75219

ART UNIT	PAPER
3992	

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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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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/001,013	10/11/07	6697295	38512.14

EXAMINER
ESCALANTE, OVIDIO

HAYNES AND BOONE, LLP
IP SECTION
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Naveen Modi FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON DC 20001-4413	: : : : :	(For Patent Owner)

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MAR 1 1 2010

CENTRAL REEXAMINATION UNIT

David L. McCombs HAYNES AND BOONE, LLP IP SECTION 2323 VICTORY AVENUE SUITE 700 DALLAS, TX 75219	: : : : : :	(For Third Party Requester)

In re: Farmwald *et alia* *Inter Partes* Reexamination Proceeding Control No. 95/001,013 Deposited on: 11 October 2007 For: US Patent No. 6,697,295	: : : : :	DECISION DISMISSING PETITION FOR EXTENSION OF TIME [37 CFR §§ 1.956 & 1.181]

This is a decision on the 05 March 2010, "Patent Owner's Petition for Extension of Time Pursuant to 37 CFR 1.956" requesting that the time for responding to the Action Closing Prosecution mailed 07 August 2009, be extended by one (1) month. The petition was timely filed.

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

The petition is dismissed for the reasons set forth below.

DISCUSSION

The Patent Owner's representative requests the period of time be extended in which to file a response to the Action Closing Prosecution mailed 19 February 2010, which set one (1) month time for filing a response thereto. The petition for extension of time was timely filed on 03 March 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.

> **37 CFR § 1.956. Patent owner extensions of time in inter partes reexamination.** *The time for taking any action by a patent owner in an inter partes reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified. Any request for such extension must be filed on or before the day on which action by the patent owner is due, but in no case will the mere filing of a request effect any extension. Any request for such extension must be accompanied by the petition set forth in § 1.17(g). See § 1.304(a) for extensions of time for filing a notice of appeal to the U.S. Court of Appeals for the Federal Circuit.*

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

> As noted above, a request for extension of time under 37 CFR § 1.956 will be granted only for sufficient cause, ...
>
> Evaluation of whether "sufficient cause" has been shown for an extension must be made by **balancing** the desire to provide the patent owner with a fair opportunity to respond, **against** the requirement of the statute, 35 U.S.C. § 314(c), that the proceedings be conducted with special dispatch. ...

Any petition request must include the required petition fee as set forth according to 37 CFR § 1.17 (g) and 37 CFR § 1.956.

MPEP § 2665 Extension of Time for Patent Owner Response (in-part)

> Requests for an extension of time in an inter partes reexamination proceeding will be considered only after the first Office action on the merits in the reexamination is mailed. Any request for an extension of time filed prior to the first action will be denied.

The certificate of mailing and the certificate of transmission procedures (37 CFR § 1.8), and the "Express Mail" mailing procedure (37 CFR § 1.10), may be used to file a request for extension of time, as well as any other paper in an existing *inter partes* reexamination proceeding (see MPEP § 2666).

As noted above, a request for extension of time under 37 CFR § 1.956 will be granted only for sufficient cause, and the request must be filed on or before the day on which action by the patent owner is due. In no case, will the mere filing of a request for extension of time automatically effect any extension, because the showing of cause may be insufficient or incomplete. In the prosecution of an *ex parte* reexamination, an automatic 1-month extension of time to take further action is granted upon filing a first timely response to a final Office action (see MPEP § 2272). The automatic extension given in *ex parte* reexamination does not apply to the first response to an Action Closing Prosecution (ACP) in an inter partes reexamination. The reason is that in *inter partes* reexamination, parties do not file an appeal in response to an ACP, and a further Office action (Right of Appeal Notice) will issue even if the parties make no response at all. Thus, there is no time period to appeal running against the parties after the ACP is issued, unlike ex parte reexamination where an appeal is due after final rejection and the time is thus automatically extended one month to provide time for the patent owner to review the Office's response to the amendment before deciding whether to appeal.

Evaluation of whether "sufficient cause" has been shown for an extension must be made by balancing the desire to provide the patent owner with a fair opportunity to respond, against the requirement of the statute, 35 U.S.C. § 314(c), that the proceedings be conducted with special dispatch.

DECISION

The patent owner's representative petitions under 37 CFR § 1.956 to extend the period for response by adding 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 Action Closing Prosecution was mailed 19 February 2010. The patent owner submitted a timely filed the petition on 05 March 2010 with the appropriate fee and certificate of service.

The petition dated 05 March 2010 cites the complexity of the lengthy Office action, the petition filed on 25 February 2010 for which the patent owner awaits a response, an interview with the examiner for which the petition dated 25 February 2010 is directed and lastly various other proceedings to which the patent owners representatives are engaged. It is noted that the complexity remains the same as the first action for which the patent owner sought and was granted an extension of time. The petition is noted, however, the mere filing of a petition will not serve to stay reexamination proceedings. The request for interview is noted, given that interviews are not permitted in *inter partes* reexamination proceedings the request can have to weight in consideration of the response

time. Lastly, the various other proceedings are noted, since they are not a part of the instant proceeding, they can have no bearing on the time for response in this proceeding.

On balance, the petitioner has not demonstrated "sufficient cause" to grant a one (1) month extension of time.

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

CONCLUSION

1. The patent owner's petition for extension for one (1) month time in which to file a response to the Action Closing Prosecution is hereby **dismissed.**

2. The period for response continues to run from the date of the Action Closing Prosecution.

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

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Alexandria, VA 22313-1450

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

By Hand: Customer Service Window
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Alexandria, VA 22314

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reexamination proceeding, which offers parties the opportunity to review the content of their submissions after the "soft scanning" process is complete.

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

/Mark Reinhart/
for

Gregory Morse,
Director,
Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,013	10/11/2007	6697295	38512.14	5575

22852 7590 04/20/2010

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP
901 NEW YORK AVENUE, NW
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ART UNIT	PAPER NUMBER

DATE MAILED: 04/20/2010

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DAVID L. MCCOMBS, ESQ.
HAYES AND BOONE, LLP (IP SECTION)
2323 VICTORY AVENUE, SUITE 700
DALLAS, TX 75219

Date:
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APR 2 0 2010
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001013
PATENT NO. : 6697295
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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Naveen Modi
Finnegan, Henderson et al., LLP
901 New York Avenue, NW
Washington, DC 20001-4413

(For Patent Owner)

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APR 20 2010

CENTRAL REEXAMINATION UNIT

David L. McCombs, Esq.
Hayes and Boone, LLP
IP Section
2323 Victory Avenue
Suite 700
Dallas, TX 75219

(For Requester)

In re: Farmwald *et al.*
Inter Partes Reexamination Proceeding
Control No. 95/001,013
Filed: October 11, 2007
For: U.S. Patent No. 6,697,295

DECISION DISMISSING PETITION

This is a decision on patent owner's petition paper entitled "PETITION SEEKING WAIVER OF 37 C.F.R § 1.955," filed on February 25, 2010.

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 by patent owner's EFS-WEB fee transmittal.

REVIEW OF THE RELEVANT FACTS

1. On February 24, 2004, U. S. Patent No. 6,697,295 (the '295 patent) issued to Farmwald *et al.*

2. On October 11, 2007, a request for *inter partes* reexamination of the '295 patent, assigned Reexamination Control No. 95/001,013 (the '1013 proceeding), was filed by a third party requester.

3. On January 9, 2008, the Office issued an order granting *inter partes* reexamination in the '1013 proceeding, stating that an Office action on the merits would be issued in due course.

4. On August 25, 2008, the Office issued a non-final Office action on the merits in the '1013 proceeding.

5. On February 11, 2010, third party requester filed a paper entitled "NOTICE OF NON-PARTICIPATION IN *INTER PARTES* REEXAMINATION," notifying the Office of third party requester's withdrawal from participation in the '1013 proceeding.

6. The proceeding progressed until, on February 19, 2010, the Office issued an Action Closing Prosecution (ACP).

7. On February 25, 2010, patent owner filed a petition paper entitled "PETITION SEEKING WAIVER OF 37 C.F.R. § 1.955," (a 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.

In the February 25, 2010 petition under 37 CFR 1.183, patent owner requests waiver of the requirements of 37 CFR 1.955, prohibiting interviews on the merits in an *inter partes* reexamination proceeding, in view of third party requester's February 11, 2010 withdrawal from participation in the '1013 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 37 CFR 1.955 Prohibition of Interviews

In patent owner's petition under 37 CFR 1.183 patent owner has requested "a waiver of the requirements of 37 C.F.R § 1.955."[2] 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 '1013

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

proceeding, "only one party—the patent owner Rambus—will now participate in any interviews with the Office."[3] Patent owner also asserts that because the third party requester will no longer participate in the present proceeding, "interview rights" should be granted because the Office has granted "interview rights" in other proceedings with a non-participating third party requester.[4] Finally patent owner asserts that by allowing patent owner to discuss the merits of the proceeding interviews, "will promote an expedited resolution of all outstanding issues in keeping with the statutory special dispatch requirements."[5]

In the instant petition under 37 CFR 1.183, patent owner has requested waiver of the prohibition against merits interviews under 37 CFR 1.955, couched as a "right" and not a "request," *as opposed to waiver of the regulation for a particular interview request*. This amounts to a request for an unlimited right to interview in general. Initially, it is to be noted that the Office cannot grant a right that does not exist. Rather, the Office can grant a waiver of the rule and permit patent owner to "request" an interview from the examiner, in the same manner a patent owner may request an interview in an *ex parte* reexamination proceeding. Patent owner has not set forth with specificity the facts that give rise to ***an extraordinary situation in which justice requires suspension*** of 37 CFR 1.955 which would justify a right to unlimited interviews, which would severely retard the proceeding contrary to the requirement for special dispatch set for in 35 U.S.C. 314(c). Rather, the patent owner may petition under 37 CFR 1.183 for waiver of the prohibition of interviews on the merits on an interview-by-interview "request" basis. In each instance where an interview is requested, the patent owner will need to satisfy the following preliminary requirements prescribed for requesting an interview in MPEP 2281:

Preliminary Requirements

1. Promptly upon receipt of a favourable decision, patent owner must contact the examiner of record in 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 telephone number.

2. At least five (5) working days prior to the interview, patent owner must:

   (a) File a written statement confirming the issues to be discussed at the interview, together with a copy of any proposed claim amendments to be discussed; and
   (b) Transmit a copy of such papers to the examiner's desktop facsimile telephone number.

3. Patent owner must (a) serve a copy of the papers discussed in item (2) above on the third party requester in accordance with 37 CFR 1.903, and (b) include a copy of the certificate of service

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[3] Id. at page 3.
[4] Id., See also Reexamination Control. No. 95/000.142 Decision dated April 17, 2007, wherein the Office granted a patent owner request for a waiver of 37 CFR 1.955 for a single interview and NOT a "right" to conduct interviews. (Petitioner's Exhibit B)
[5] Id.

of such papers in both the papers as filed (item 2(a) above), and as transmitted by facsimile to the examiner (see item 2(b) above).

In view of the above, 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 February 25, 2010 petition is dismissed.

2. Jurisdiction for the '1013 reexamination proceeding is returned to the Central Reexamination Unit (CRU).

3. Any questions concerning this communication should be directed to Joseph F. Weiss, Jr., Legal Advisor, at (571) 272-7759.

Kenneth M. Schor

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,013	10/11/2007	6697295	38512.14	5575

22852 7590 07/08/2010

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 07/08/2010

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
DAVID L. MCCOMBS, ESQ.
HAYES AND BOONE, LLP (IP SECTION)
2323 VICTORY AVENUE, SUITE 700
DALLAS, TX 75219

Date:

MAILED

JUL 0 8 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001013
PATENT NO. : 6697295
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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Naveen Modi
Finnegan, Henderson et al., LLP
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Washington, DC 20001-4413

(For Patent Owner)

MAILED

JUL 08 2010

CENTRAL REEXAMINATION UNIT

David L. McCombs, Esq.
Hayes and Boone, LLP
IP Section
2323 Victory Avenue
Suite 700
Dallas, TX 75219

(For Requester)

In re: Farmwald *et al.*
Inter Partes Reexamination Proceeding
Control No. 95/001,013
Filed: October 11, 2007
For: U.S. Patent No. 6,697,295

DECISION DISMISSING PETITION

This is a decision on patent owner's petition paper entitled "EXPEDITED RENEWED PETITION SEEKING WAIVER OF 37 C.F.R § 1.955," filed on May 3, 2010.

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.

REVIEW OF THE RELEVANT FACTS

1. On February 24, 2004, U. S. Patent No. 6,697,295 (the '295 patent) issued to Farmwald *et al.*

2. On October 11, 2007, a request for *inter partes* reexamination of the '295 patent, assigned Reexamination Control No. 95/001,013 (the '1013 proceeding), was filed by a third party requester.

3. On January 9, 2008, the Office issued an order granting *inter partes* reexamination in the '1013 proceeding, stating that an Office action on the merits would be issued in due course.

4. On August 25, 2008, the Office issued a non-final Office action on the merits in the '1013 proceeding.

5. On February 11, 2010, third party requester filed a paper entitled "NOTICE OF NON-PARTICIPATION IN *INTER PARTES* REEXAMINATION," notifying the Office of third party requester's withdrawal from participation in the '1013 proceeding.

6. The proceeding progressed until, on February 19, 2010, the Office issued an Action Closing Prosecution (ACP).

7. On February 25, 2010, patent owner filed a petition paper entitled "PETITION SEEKING WAIVER OF 37 C.F.R. § 1.955," (a petition under 37 CFR 1.183).

8. On April 20, 2010, the Office mailed a decision dismissing patent owner's February 25, 2010 petition under 37 CFR 1.183.

9. On May 3, 2010, patent owner filed the instant petition paper entitled "EXPEDITED RENEWED PETITION SEEKING WAIVER OF 37 C.F.R § 1.955," (a 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.

In the May 3, 2010 renewed petition under 37 CFR 1.183, patent owner requests waiver of the requirements of 37 CFR 1.955, prohibiting interviews on the merits in an *inter partes* reexamination proceeding, in view of third party requester's February 11, 2010 withdrawal from participation in the '1013 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.

[1] Petition under 37 CFR 1.183 at page 2.

Request to Waive the 37 CFR 1.955 Prohibition of Interviews

In patent owner's petition under 37 CFR 1.183, patent owner has requested "a waiver of the requirements of 37 C.F.R § 1.955" to request a single interview[2] 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 '1013 proceeding, "only one party—the patent owner Rambus—will now participate in any interviews with the Office."[3] Patent owner also asserts that, because the third party requester will no longer participate in the present proceeding, an interview should be permitted, because the Office has granted an interview in other proceedings with a non-participating third party requester.[4] Finally patent owner asserts that by allowing patent owner to discuss the merits of the proceeding in an interview the "few remaining" issues can be resolved and "will promote an expedited resolution of all outstanding issues in keeping with the statutory special dispatch requirements."[5]

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.[6] 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."[7] 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 '1013 *inter partes* reexamination proceeding.[8] Thus, only a single party (patent owner) will now participate in the '1013 *inter partes* reexamination proceeding, and any interview that might be permitted in 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 only makes the bald assertion that the facts of the present proceeding are similar to that of *inter partes* reexamination control no.

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[2] Id. at page 2-3.
[3] Id.
[4] Id., See also Reexamination Control. No. 95/000,142 Decision dated April 17, 2007, wherein the Office granted a patent owner request for a waiver of 37 CFR 1.955 for a single interview. (Petitioner's Exhibit A)
[5] Id.
[6] 65 FR at 76768.
[7] 65 FR at 76769.
[8] *Notice of Non-participation in inter partes Reexamination*, filed February 11, 2010 (stating "Samsung Electronics Co., Ltd. ("Samsung"), the third party requester for *inter partes* reexamination Control No., hereby gives notice that it no longer intends to participate in the present reexamination.")

95/000,142 (the '142 proceeding)[9] where 37 CFR 1.955 was waived and a single interview was granted.[10] Patent owner, provides only a copy of the Office decision and does not provide any of the facts and circumstances regarding the '142 proceeding, incident with the granted decision, and makes no correlation of the facts between the present proceeding and the '142 proceeding. The Office is not bound by prior decisions, as all matters are addressed and resolved on a case-by-case basis. Upon a review of the February 15, 2007 patent owner petitions (with supporting exhibits) in the '142 proceeding requesting waiver of 37 CFR 1.955, that petitioner patent owner did not merely cite to the fact that the requester would no longer non-participate in the *inter partes* proceeding. Patent owner in the '142 proceeding included support reflecting the tacit consent of the non-participating requester for waiver of 37 CFR 1.955 to conduct an interview.[11] Furthermore, patent owner in the '142 proceeding provided a summary of the current state of the proceedings, focusing upon the few matters at issue in the proceeding.[12]

In the present petition patent owner has provided not a single specific fact that gives rise to the existence of an extraordinary situation where justice requires suspension of the rule, despite the specific notice provided to provide such in the April 20, 2010 decision dismissing patent owner's February 25, 2010 initial petition. Patent owner alleges the existence of a "few remaining issues" in the proceeding.[13] Upon a review of the outstanding Office action, a 96 page ACP issued on February 19, 2010, of the 51 claims pending, claims 1-30, 32-33, 35-37, 41-42 and 44-45 stand confirmed, and claims 31, 34, 38-40, 43 and 46-51 stand rejected under one or more rejections, with a total of seven rejections in all. Of the seven rejections, two are based upon anticipation, and five are based upon obviousness. Some of the rejections are based upon intervening references, due to an apparent break in the priority/benefit claims for claimed subject matter. Also, the issues of claim interpretation required approximately twenty pages of the Office action alone. Therefore, the allegation of a "few remaining issues" <u>is contrary to the facts of the present proceeding</u>.

In view of the current lack of a showing of an extraordinary situation by patent owner in the present petition, in this instance, the '1013 proceeding does NOT present an extraordinary situation which justifies waiver of 37 CFR 1.955 to further the interests of justice. Thus, patent owner's renewed petition under 37 CFR 1.183 is <u>dismissed</u>.

In order to complete its petition, patent owner may provide, via renewed petition, a summary of the current state of the proceeding, focusing upon the central matters at issue in the proceeding, and showing that, given the nature of the matters at issue, an interview would enhance the understanding of the relevant patentability issues. In the event patent owner files a <u>renewed</u> petition under 37 CFR 1.183 for waiver of 37 CFR 1.955 to complete the petition 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.

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[9] On September 11, 2009 the '142 proceeding was vacated and on November 19, 2009 the proceeding closed from public view.
[10] Petition under 37 CFR 1.183 at page 2-3.
[11] *Inter partes* Reexamination Control. No. 95/000,142 patent owner petition dated February 15, 2007, with exhibits.
[12] <u>Id.</u>
[13] Petition under 37 CFR 1.183 at page 2.

CONCLUSION

1. Patent owner's May 3, 2010 renewed petition is dismissed.

2. In order to complete its petition, patent owner may provide, via renewed petition, a summary of the current state of the proceeding, focusing upon the central matters at issue in the proceeding, and showing that, given the nature of the matters at issue, an interview would enhance the understanding of the relevant patentability issues.

3. Jurisdiction over the '1013 *inter partes* reexamination proceeding is returned to the Central Reexamination Unit for action not inconsistent with this decision.

4. Any questions concerning this communication should be directed to Joseph F. Weiss, Jr., Legal Advisor, at (571) 272-7759.

Kenneth M. Schor

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

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NOVOZYMES NORTH AMERICA, INC
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(For Patent Owner)

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MAR 06 2008

CENTRAL REEXAMINATION UNIT

THOMAS J. KOWALSKI
FROMMER LAWRENCE & HAUG LLP
745 FIFTH AVE.
NEW YORK, NY 10151

(For Third Party Requester)

In re Spendler et al.
Inter Partes Reexamination Proceeding
Control No.: 95/001,015
Deposited: November 7, 2007
For: U.S. Patent No.: 6,365,204

DECISION TERMINATING REEXAMINATION PROCESSING

This is a decision addressing the January 28, 2008 third party requester paper entitled "Response to Notice of Failure to Comply with *Inter Partes* Reexamination Filing Requirements... And Request for Refund." This decision is also responsive to the communication filed on February 7, 2008 that requested a decision on the above-mentioned petitions. In view of the relief requested, requester's papers are taken together to provide a petition under 37 CFR 1.181, 37 CFR 1.182, and CFR 1.183.

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

The petition under 37 CFR 1.181, 37 CFR 1.182, and CFR 1.183 is dismissed.

In addition, the processing of the present *inter partes* reexamination request papers assigned Control No. 95/001,015 is terminated.

REVIEW OF FACTS

1. U.S. Patent No. 6,365,204 (hereinafter, the '204 patent) issued on April 2, 2002. The '204 patent issued from application number 09/286,037, which was filed April 5, 1999.

2. On November 7, 2007, a request for *inter partes* reexamination was deposited by the third party requester, and this reexamination proceeding was assigned Control No. 95/001,015 (hereinafter, the '1015 proceeding).

3. A Notice of Failure to Comply with *Inter Partes* Reexamination Request Filing Requirements was issued on January 22, 2008, which stated that several requirements of 37 CFR 1.915(d) were missing in the request.

4. On January 28, 2008, the third party requester filed a paper entitled "Response to Notice of Failure to Comply with *Inter Partes* Reexamination Filing Requirements... And Request for Refund" (hereinafter "the instant Petitions").

5. On January 29, 2008, a Notice of Termination of Preprocessing of *Inter Partes* Reexamination Request was mailed.

6. On February 7, 2008, the third party requester filed a communication requesting a decision on the instant petitions.

DECISION

Upon further review of the request papers, it has been determined that the present patent for which *inter partes* reexamination was requested is not eligible for *inter partes* reexamination (pursuant to Section 4608 of the American Inventor's Protection Act). Accordingly, the filing fee submitted with the proceeding will be refunded as stated in the January 29, 2008 "Notice of Termination of Preprocessing...". 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 '204 patent, for which patent the present reexamination has been requested, was filed April 5, 1999, which is prior to November 29, 1999 (the date of enactment of the AIPA). Thus, the instant patent is not eligible for *inter partes* reexamination.

Since, under the AIPA, the '204 patent is not eligible for *inter partes* reexamination, the Notice of Failure to Comply with *Inter Partes* Reexamination Request Filing Requirements in response to the '1015 proceeding request papers was mailed in error, and is hereby vacated. The termination of the processing of the request papers, of which requester was notified in the notice mailed January 29, 2008, remains in place, due to the fact that the '204 patent is not eligible for *inter partes* reexamination.

A file history for the request papers was scanned into the electronic Image File Wrapper (IFW). Since the processing of the reexamination request papers has been terminated, the file history papers will be marked "closed" and "non-public," and will not constitute part of the public record.

In response to the aspect of the petition requesting that the Office *sua sponte* order a reexamination proceeding for the '204 patent, the Director of the USPTO will not normally consider requests to order reexamination at the Director's initiative received from members of the public. If a member of the public desires reexamination of a patent, a request and fee should be filed in accordance with 37 CFR 1.510. It is further noted that a decision to order reexamination at the Director's initiative is rare. Only in compelling circumstances, after a review of all the facts concerning the patent, would such a decision be made. See MPEP 2239.

In response to the remaining aspects of the petition, the filing of multiple petitions in a single paper, this practice does not comply with 37 CFR 1.4(c) and must be avoided in the future.

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.

Accordingly, petitions requesting different relief or filed under different rules must be separate papers to avoid confusion and delay, and the present petition must be dismissed.

As a final point, to the extent that the present petition requests waiver of the rules (see page 3 of the petition), 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). [Emphasis added.]

The statutory preclusion of the *inter partes* reexamination for any patent issuing from an original application filed in the United States prior to November 29, 1999, is a requirement of the statute.

CONCLUSION

1. The petition under 37 CFR 1.181, 37 CFR 1.182, and CFR 1.183 is <u>dismissed</u>.

2. Processing of the present *inter partes* reexamination request papers assigned Control No. 95/001,015 is <u>terminated</u>.

3. A refund of the $8,800 reexamination filing fee will be made to requester in due course.

4. Jurisdiction over the vacated *inter partes* reexamination proceeding is being forwarded to the Central Reexamination Unit, where the proceeding will be processed to mark its file history papers "closed" and "non-public," and for the determination of compliance with § 1.501 for adding the papers to the file for the '204 patent in due course.

5. Telephone inquiries related to this decision should be directed to the to Jeanne Clark, at (571) 272-7714, or Lissi Marquis, Director of the Central Reexamination Unit, at (571) 272-1596, or in their absence to the undersigned at (571) 272-7710.

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

03-06-08
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,017	12/07/2007	7,108,689	35678-751RE1	1050

30623 7590 05/01/2008

MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND POPEO, P.C
ATTN: PATENT INTAKE CUSTOMER NO. 30623
ONE FINANCIAL CENTER
BOSTON, MA 02111

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 05/01/2008

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

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Carol H. Peters
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(For Patent Owner)

MAILED
MAY 01 2008
CENTRAL REEXAMINATION UNIT

John V. Forcier
Goodwin Proctor L.L.P.
Exchange Place
Boston, MA 02109

(For Requester)

In re Eckhouse et al
Inter Partes Reexamination Proceeding
Control No. 95/001,017
Filed: December 7, 2007
For: U.S. Patent No. 7,108,689

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

This is a decision on the April 11, 2008 third party requester petition under 37 CFR 1.181 requesting the Director to hold patent owner's April 8, 2008 response as improper under 37CFR 1.943(b) because the response exceeds 50 pages in length (hereinafter, the April 11, 2008 requester petition).

The April 11, 2008 requester petition and the record as a whole are before the Director of the Central Reexamination Unit for decision.

The April 11, 2008 requester petition under 37 CFR 1.181 requesting the Director to hold patent owner's April 8, 2008 response as improper under 37CFR 1.943(b) is **granted**.

REVIEW OF FACTS

- On September 19, 2006, U.S. Patent No. 7,108,689 issued to Shimon Eckhouse and Hillel Bachrach.
- On December 7, 2007, a request for *inter partes* reexamination was filed by the third party requester,[1] and the resulting reexamination proceeding was assigned control number 95/001,017 (hereinafter, "the '1017 proceeding").
- On February 8, 2008, an order granting the reexamination request, accompanied by a first Office action on the merits, was mailed.
- On March 7, 2008, the patent owner filed a document entitled "information disclosure statement", taken as a citation of prior art under 37 CFR 1.933 and 37 CFR 1.555.

[1] The request for *inter partes* reexamination was filed by Alma Lasers Inc. and Alma Lasers, Ltd., the real parties in interest.

- On April 8, 2008, the patent owner filed a response to the February 8, 2008 first Office action.

- On April 11, 2008, the third party requester filed the instant petition under 37 CFR 1.181, requesting the Director to hold patent owner's April 8, 2008 response as improper under 37CFR 1.943(b) because the response exceeds 50 pages in length (hereinafter, the April 11, 2008 requester petition).

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

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(b) provides:

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

MPEP 2667 I A, provides, in pertinent part:

A. Filed by Patent Owner

*
*
*

2. Response is Too Long

Where the length of the patent owner submission exceeds that permitted by 37 CFR 1.943, the submission is improper. Accordingly, pursuant to 37 CFR 1.957(d), a Notice will be mailed to the patent owner. The Notice will be issued by the examiner and will permit the patent owner to exercise one of the following two options:

(A) Submit a re-drafted response that does not exceed the page limit set by 37 CFR 1.943; or

(B) File a copy of the supplemental response with pages redacted to satisfy the 37 CFR 1.943 page limit requirement.

The Notice will set a period of 15 days from the date of the notice to respond. If no response is received, the improper patent owner submission will not be considered. If the submission was necessary to respond to an outstanding Office action, the prosecution of the reexamination proceeding is either terminated pursuant to 37 CFR 1.957(b) or limited pursuant to 37 CFR 1.957(c). Any previously submitted third party comments in response to this improper patent owner submission would also not be considered, as being moot, since the patent owner did not in fact respond to the Office action in accordance with the rules.

If a response to the Notice is received, then under 37 CFR 1.947, the third party requester may once file written comments, limited to issues raised by the Office action or the patent owner's response to the Notice, within 30 days from the date of service of the patent owner's response to the Notice.

DECISION

A review of the record reveals that patent owner's April 8, 2008 response, which consists entirely of arguments directed to the merits of the rejections set forth in the February 8, 2008 Office action, totals 105 pages, exceeding the 50-page limit set forth in 37 CFR 1.943(b).

For the reasons given above, the April 11, 2008 requester petition under 37 CFR 1.181 is **granted**.

CONCLUSION

1. The patent owner has **FIFTEEN (15) days from the mailing date of this decision** to exercise one of the following two options:

   a. Submit a re-drafted response that does not exceed the 50-page limit set forth in 37 CFR 1.943(b); or

   b. File a supplemental response with pages redacted to satisfy the 37 CFR 1.943(b) 50-page limit requirement.

2. If no response is timely received, the improper patent owner submission will not be entered. As the submission was necessary to respond to an outstanding Office action, the prosecution of the reexamination proceeding will be either terminated pursuant to 37 CFR 1.957(b) or limited pursuant to 37 CFR 1.957(c). Any third party requester comments filed in response to this improper patent owner submission will be considered as moot, and will not be considered since the patent owner did not in fact respond to the Office action in accordance with the rules.

3. If a proper response to this decision is timely received, 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 to this decision, **within 30 days from the date of service of the patent owner's response to this decision.**

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 FAX: (571) 273-9900
   Central Reexamination Unit

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

Telephone inquiries related to this decision should be directed to Cynthia L. Nessler, Senior Legal Advisor, Office of Patent Legal Administration, at (571) 272-7724.

Lissi Marquis
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.
95/001,018	12/07/2007	6,928,479		1015

33797 7590 07/02/2008

MILLER THOMPSON, LLP
Scotia Plaza
40 King Street West, Suite 5800
TORONTO, ON M5H 3S1
CANADA

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 07/02/2008

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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.
95/001018	12/07/07	6928479	

EXAMINER
LEE,CHRISTOPHER

ART UNIT	PAPER
3992	

ROBERT S. BLASI, ESQ.
GOODWIN PROCTER LLP
PATENT ADMINISTRATOR
EXCHANGE PLACE
BOSTON, MA 02109

DATE MAILED:

07/02/08

INTER PARTES REEXAMINATION COMMUNICATION

BELOW/ATTACHED YOU WILL FIND A COMMUNICATION FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE OFFICIAL(S) IN CHARGE OF THE PRESENT REEXAMINATION PROCEEDING.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MILLER THOMPSON, LLP Scotia Plaza 40 King Street West, Suite 5800 TORONTO ON M5H 3S1 CA CANADA	:	(For Patent Owner)
GOODWIN PROCTER LLP Robert Blasi, Jr. PATENT ADMINISTRATOR EXCHANGE PLACE BOSTON, MA 02109-2881	:	(For Third Party Requester)
	:	DECISION GRANTING PETITION FOR EXTENSION OF TIME [37 CFR § 1.956]
In re: Gretz *Inter Partes* Reexamination Proceeding Control No. 95/001,018 Deposited: 7 December 2007 For: US Patent No. 6,928,479	:	

MAILED

JUL 02 2008

CENTRAL REEXAMINATION UNIT

This is a decision on the June 30 2008, patent owner "Petition for Extension of Time Under 37 CFR § 1.956," requesting that the time for responding to the Non-Final Office action mailed 16 June 2008, be extended by two-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.

Decision

The Patent Owner requests an extension of time in which to file a response to the Non-Final Office action mailed 16 June 2008, which set a one month date for filing a response thereto. The request for extension is the first request for an extension of time with respect to the Non-Final Office action. The petition for extension of time was timely filed on 30 June 2008, together with the petition fee.

37 CFR § 1.956 Patent owner extensions of time in inter partes reexamination.

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

MPEP § 2665 Extension of Time for Patent Owner Response
States in part.

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

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

On balance the patent owner has shown sufficient cause for granting the extension of time in part. The patent owner notes that the non-final Office action is 230 pages in length. In consideration of the desire to balance the desire to provide the patent owner with a fair opportunity to respond with the need for special dispatch the request for a two-month extension of time is thusly considered. The patent owner could not have anticipated such a detailed Office action to which to respond and since the shortened statutory time for response is one month, it is considered sufficient to support granting a one-month extension of time.

Analysis and Findings

On balance, it is considered that the petition explains the "sufficient cause" for why the extension of time should be granted in part. The request for extension of time filed under 37 CFR § 1.956 for filing a response to the outstanding Office action, is **granted in part** and is hereby extended by **one-month.**

Conclusion

1. The patent owner's petition for extension of time in which to file a response to the non-final Office action dated 16 June 2008 is **granted in part** with the time for response extended by **one month**.

2. The Patent Owner's response is due **18 August 2008**.

3. Response may be submitted as follows:

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

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

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

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

MARK J. REINHART
CRU SPE-AU 3992
for

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.
95/001,018	12/07/2007	6,928,479		1015

30734 7590 11/12/2008

BAKER & HOSTETLER LLP
WASHINGTON SQUARE, SUITE 1100
1050 CONNECTICUT AVE. N.W.
WASHINGTON, DC 20036-5304

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/12/2008

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UNITED STATES PATENT AND TRADEMARK OFFICE

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

CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/001,018	12/07/07	6928479	

EXAMINER
LEE,CHRISTOPHER

GOODWIN PROCTER LLP
PATENT ADMINISTRATOR
53 STATE STREET
EXCHANGE PLACE
BOSTON, MA 02109-2881

ART UNIT	PAPER
3992	

DATE MAILED:

11/12/08

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
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

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Washington Square, Suite 1100
1050 Connecticut Ave., N.W.
Washington, D.C. 20036-5304

(For Patent Owner)

Robert S. Blasi, Esq.
Goodwin Proctor LLP
Exchange Place
53 State Street
Boston, MA 02109

(For Requester)

MAILED

NOV 12 2008

CENTRAL REEXAMINATION UNIT

In re Meyer et al.
Inter Partes Reexamination Proceeding
Control No.: 95/001,018
Filed: December 7, 2007
For: U.S. Patent No.: 6,928,479

: **DECISION GRANTING**
: **PETITION IN PART**
: **AND DECISION**
: **REFUSING ENTRY OF THIRD**
: **PARTY PAPER**

This is a decision on the patent owner petition entitled "Petition Under 37 C.F.R. §§ 1.183, 1.182, or 1.137(b)" filed September 3, 2008.

This decision also addresses third party requester's comments filed August 22, 2008.

The petition and *inter partes* reexamination control number 95/001,018 are before the Office of Patent Legal Administration.

SUMMARY

The petition is granted to the extent that the redrafted response and declaration of Dr. Ganger, along with all the accompanying attachments and exhibits, filed September 3, 2008 with the petition is accepted.

The patent owner's response filed July 25, 2008, and the supplemental responses filed August 20, 2008, and August 21, 2008, are refused entry into the record for the reasons set forth below.

The third party requester's response paper filed August 22, 2008 is refused entry into the record for the reasons set forth below. The third party requester is given **30 days** from the mailing date of this decision to file a response under 37 CFR 1.947 to patent owner's redrafted response filed September 3, 2008.

RELEVANT BACKGROUND

1. U.S Patent number 6,928,479 (the '479 patent) issued on August 9, 2005.
2. On December 7, 2007, a request for *inter partes* reexamination of the '479 patent was filed in the Office by a third party requester. The request was assigned reexamination proceeding control number 95/001,018 (the '018 reexamination proceeding).
3. On March 4, 2008, the Office issued an order, in the '018 reexamination proceeding, granting *inter partes* reexamination of the '479 patent.
4. On June 16, 2008, a non-final first Office action was mailed in the '018 reexamination proceeding.
5. On June 30, 2008, patent owner filed a petition for extension of time under 37 CFR 1.956 requesting a two-month extension of time.
6. On July 2, 2008, the Office mailed a decision which granted-in-part the petition for extension of time and extended the time for response to the Office action by one month.
7. On July 25, 2008, patent owner filed a response to the Office action including a proposed amendment to the claims (appendix A), declarations under 37 CFR 1.131 and/or 1.132, and a number of other appendices.
8. On August 20, 2008, the Office received a supplemental response from the patent owner in which the amendment to the claims was resubmitted to correct errors.
9. On August 21, 2008, the Office received another supplemental response from the patent owner, which was purportedly submitted before the supplemental response received August 20, 2008, in which the amendment to the claims was resubmitted to correct formatting by underlining the text of the proposed new claims.
10. On August 22, 2008, the third party requester filed comments to the patent owner's response under 37 CFR 1.947.
11. On September 3, 2008, patent owner filed the instant petition under 37 CFR 1.183, 1.182, or 1.137(b) requesting waiver of the page limit for patent owner's response to the Office action, acceptance of a redrafted response and declaration, or, if necessary, revival of the reexamination proceeding based on unintentional delay in responding to the Office action. The petition was accompanied by a redrafted response to the Office action and a redrafted declaration of Dr. Ganger.

RELEVANT STATUTORY, REGULATORY, AND PROCEDURAL PROVISIONS

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(b) states:

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

37 CFR 1.945 states:

> The patent owner will be given at least thirty days to file a response to any Office action on the merits of the *inter partes* reexamination.

37 CFR 1.947 states in pertinent part:

> Each time the patent owner files a response to an Office action on the merits pursuant to § 1.945, a third party requester may once file written comments within a period of 30 days from the date of service of the patent owner's response.

37 CFR 1.957(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.

37 CFR 1.137(b) states, in part:

> "*Unintentional.* If the delay in reply by applicant or patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive an abandoned application, a reexamination proceeding terminated under §§ 1.550(d) or 1.957(b) or limited under § 1.957(c), or a lapsed patent. A grantable petition pursuant to this paragraph must be accompanied by: (1) The reply required to the outstanding Office action or notice, unless previously filed; (2) The petition fee as set forth in § 1.17(m); (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional...."

DECISION ON PETITION

The patent owner argues that the response filed July 25, 2008 did not exceed the page limit or, alternatively, that it should not be held to have exceeded the page limit because the MPEP was revised in July 2008 and it does not appear to have been released by the USPTO until sometime in the middle of August, which was after the response was filed. Patent owner refers to MPEP 2667, I.A.2., which states that "[a]ny affidavit or declaration (or a clearly defined portion thereof) that contains opinion(s) of the affiant/declarant, or argument(s) that the art 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...and is subject to the page limit requirements of 37 CFR 1.943." However, this MPEP revision was merely a clarification of the Office's policy that had already been in effect for some time. The patent owner's response did exceed the page limit requirement of 37 CFR 1.943.

The patent owner also argues that the examiner may waive any deficiency in the response, if not serious, and requests the Director to waive the page limit requirements of 37 CFR 1.943(b) pursuant to 37 CFR 1.183 because the policies were not published until after the response was filed and are not consistent with the treatment of such declarations in other proceedings, any non-compliance was inadvertent, and no serious deficiency has occurred. However, patent owner has not shown that this is an extraordinary circumstance where justice requires a waiver of the rules as required by 37 CFR 1.183. Therefore, the petition, as it relates to waiver of the page limit requirements of 37 CFR 1.943(b), is dismissed.

The patent owner submitted a redrafted response and declaration of Dr. Ganger with the petition. The patent owner points out that when an action is a *bona fide* attempt to respond and to advance the prosecution and is a substantially complete response to the Office action, but compliance with some matter has been inadvertently omitted, an opportunity to explain and supply the omission may be given. Furthermore, MPEP 2667 provides that where a patent owner submission is found to exceed the page limit set forth in 37 CFR 1.943(b), the examiner will issue a notice giving the patent owner the option of submitting a redrafted response that does not exceed the page limit. The redrafted response and declaration of Dr. Ganger submitted with the petition uses 11 point Times New Roman font. It is noted that papers in a reexamination proceeding are required to be legibly written. See 37 CFR 1.52(a). Furthermore, 37 CFR 1.52(b) currently requires amendments in reexamination proceedings to have "[t]ext written in nonscript type font (*e.g.*, Arial, Times Roman, or Courier, preferably a font size of 12) lettering style having capital letters which should be a least 0.3175 cm. (0.125 inch) high, but may be no smaller than 0.21 cm. (0.08 inch) high (*e.g.*, a font size of 6)." In this instance, the redrafted response and declaration of Dr. Ganger is legible. It should be noted, however, that in some instances 11 point font may not be legible. It is also pointed out that it is the Office's experience that font smaller than 11 point is usually not legible. The patent owner alternatively petitions under 37 CFR 1.182 to have the redrafted response and declaration of Dr. Ganger, along with all accompanying attachments and exhibits, be treated as having been filed in response to a notice under 37 CFR 1.957(d). The redrafted response and declaration of Dr. Ganger, along with all accompanying attachments and exhibits, is accepted. Accordingly, the petition, as it relates to accepting the redrafted response and declaration of Dr. Ganger, is <u>granted</u>.

To the extent deemed necessary, the patent owner also petitions the Director to treat the application as having been unintentionally abandoned and that the reexamination be revived under 37 CFR 1.137(b). The reexamination was not terminated under 37 CFR 1.957(b) because a response to the Office action was timely filed. Even though the response exceeded the page limit requirement, it was a *bona fide* attempt to respond and to advance the prosecution and was a substantially complete response to the Office action. Therefore, the petition, as it relates to revival of the reexamination under 37 CFR 1.137(b), is <u>dismissed</u> as moot.

Pursuant to 37 CFR 1.939(a), "[I]f an authorized 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 response filed July 25, 2008, exceeded 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 before the discovery of the impropriety of the paper, the original patent owner response paper cannot be physically returned to the patent owner. Rather, the patent owner's response filed July 25, 2008, and the supplemental responses thereto filed August 20, 2008 and August 21, 2008, will be expunged from the record by marking them "non-public" and "closed" in the IFW. See MPEP 2667. A copy of the present decision will be made of record in the IFW.

DECISION REFUSING ENTRY OF THIRD PARTY REQUESTER'S COMMENTS

The third party requester's written comments filed August 22, 2008 do not comply with 37 CFR 1.943(b) because they exceed 50 pages in length. Exhibits I, S-Z, and AA-CC are claim charts which are included in the number of pages of written comments submitted by third party requester. Claim charts are not excluded by 37 CFR 1.943(b). Furthermore, third party requester included what appear to be inappropriate comments regarding alleged inequitable conduct on pages 46-47.

In addition, since the patent owner's response filed July 25, 2008 was improper, it was not ripe for written comments by third party requester. In view of the acceptance of patent owner's redrafted response filed September 3, 2008, the third party requester is given **30 days** from the mailing date of this decision to file a response under 37 CFR 1.947 to the patent owner's redrafted response filed September 3, 2008.

Third party requester should ensure that the comments that are submitted are in compliance with 37 CFR 1.943(b) and that no inappropriate comments are included. While third party requester may wish to file a petition under 37 CFR 1.183, if appropriate, to exceed the page length set forth in 37 CFR 1.943(b), the third party requester should be mindful that the Office would consider such factors as the patent owner's length of response and whether any proposed rejections being made by third party requester for newly added claims are cumulative in determining whether there is an extraordinary situation where justice requires waiver of the requirement in 37 CFR 1.943(b) that written comments shall not exceed 50 pages in length.

For the reasons discussed above, the third party requester's paper filed August 22, 2008 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 response paper was incorporated into the electronic Image File Wrapper (IFW) for the proceeding before discovery of the impropriety of the paper, the original response paper cannot be physically returned to the third party requester. Rather, the third party requester's response 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 IFW.

CONCLUSION

1. The petition is granted to the extent that the redrafted response and declaration of Dr. Ganger, along with all the accompanying attachments and exhibits, filed September 3, 2008 is accepted for entry.

2. The patent owner's response filed July 25, 2008, and the supplemental responses filed August 20, 2008 and August 21, 2008, are refused entry into the record. Because the patent owner's responses were previously incorporated into the IFW for the present reexamination proceeding, the responses are being expunged from the IFW for the proceeding by marking them "not public" and "closed" in the IFW. These patent owner responses will not constitute part of the record of the present reexamination proceeding.

3. The third party requester's response paper filed August 22, 2008, is refused entry into the record as it is an improper paper. Because the third party requester's response paper was previously incorporated into the IFW for the present reexamination proceeding, the paper is being expunged from the IFW for the proceeding by marking it "not public" and "closed" in the IFW. The third party requester's response paper will not constitute part of the record of the present reexamination proceeding.

4. A copy of this decision will be made of record in the IFW record of the present reexamination proceeding.

5. The third party requester is given **30 days** from the mailing date of this decision to submit a response under 37 CFR 1.947 to the patent owner's redrafted response filed September 3, 2008.

6. Telephone inquiries related to this decision should be directed to Eugenia Jones, Senior Legal Advisor, at (571) 272-7727.

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

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.
95/001,018	12/07/2007	6,928,479	79123-00006	1015

30734 7590 03/02/2009

BAKER & HOSTETLER LLP
WASHINGTON SQUARE, SUITE 1100
1050 CONNECTICUT AVE. N.W.
WASHINGTON, DC 20036-5304

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/02/2009

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Commissioner for Patents
United States Patents and Trademark Office
P.O.Box 1450
Alexandria, VA 22313-1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
ROBERT S. BLASI, ESQ.
GOODWIN PROCTER LLP
EXCHANGE PLACE
BOSTON, MA 02109

Date: MAILED

MAR 02 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001018
PATENT NO. : 6928479
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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Baker & Hostetler LLP
Washington Square, Suite 1100
1050 Connecticut Ave., N.W.
Washington, D.C. 20036-5304

(For Patent Owner)

MAILED

MAR 02 2009

CENTRAL REEXAMINATION UNIT

Robert S. Blasi, Esq.
Goodwin Proctor LLP
Exchange Place
53 State Street
Boston, MA 02109

(For Requester)

In re Meyer et al.
Inter Partes Reexamination Proceeding
Control No.: 95/001,018
Filed: December 7, 2007
For: U.S. Patent No.: 6,928,479

DECISION GRANTING PETITION

This is a decision on the third party requester petition entitled "Petition Under 37 C.F.R. § 1.183 for Waiver of Page Limit under 37 C.F.R. § 1.943(b)" filed November 24, 2008.

The petition and *inter partes* reexamination control number 95/001,018 are before the Office of Patent Legal Administration.

SUMMARY

The petition under 37 CFR 1.183 filed November 24, 2008 is granted.

The petition fee of $400.00 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183 has been charged to third party requester's deposit account as authorized in the petition fee transmittal.

RELEVANT BACKGROUND

1. U.S Patent number 6,928,479 (the '479 patent) issued on August 9, 2005.
2. On December 7, 2007, a request for *inter partes* reexamination of the '479 patent was filed in the Office by a third party requester. The request was assigned reexamination proceeding control number 95/001,018 (the '018 reexamination proceeding).

3. On March 4, 2008, the Office issued an order, in the '018 reexamination proceeding, granting *inter partes* reexamination of the '479 patent.

4. On June 16, 2008, a non-final first Office action was mailed in the '018 reexamination proceeding.

5. On June 30, 2008, patent owner filed a petition for extension of time under 37 CFR 1.956 requesting a two-month extension of time.

6. On July 2, 2008, the Office mailed a decision which granted-in-part the petition for extension of time and extended the time for response to the Office action by one month.

7. On July 25, 2008, patent owner filed a response to the Office action including a proposed amendment to the claims (appendix A), declarations under 37 CFR 1.131 and/or 1.132, and a number of other appendices.

8. On August 20, 2008, the Office received a supplemental response from the patent owner in which the amendment to the claims was resubmitted to correct errors.

9. On August 21, 2008, the Office received another supplemental response from the patent owner, which was purportedly submitted before the supplemental response received August 20, 2008, in which the amendment to the claims was resubmitted to correct formatting by underlining the text of the proposed new claims.

10. On August 22, 2008, the third party requester filed comments to the patent owner's response under 37 CFR 1.947.

11. On September 3, 2008, patent owner filed a petition under 37 CFR 1.183, 1.182, or 1.137(b) requesting waiver of the page limit for patent owner's response to the Office action, acceptance of a redrafted response and declaration, or, if necessary, revival of the reexamination proceeding based on unintentional delay in responding to the Office action. The petition was accompanied by a redrafted response to the Office action and a redrafted declaration of Dr. Ganger.

12. On September 26, 2008, the third party requester filed a paper opposing the patent owner's September 3, 2008 petition.

13. On November 12, 2008, a decision granting-in-part the petition filed September 3, 2008, was mailed. The petition was granted to the extent that the redrafted response and declaration of Dr. Ganger, along with all the accompanying attachments and exhibits filed with the petition, were accepted. The decision also provided that patent owner's response filed July 25, 2008, and the supplemental responses filed August 20, 2008, and August 21, 2008, were refused entry into the record. The third party requester's response paper filed August 22, 2008 was also refused entry into the record, and the third party requester was given 30 days from the mailing date of the decision to file a response under 37 CFR 1.947 to patent owner's redrafted response filed September 3, 2008.

14. In addition, on November 12, 2008, a decision refusing entry of the third party requester's paper filed September 26, 2008 was mailed.

15. On November 24, 2008, the third party requester filed the instant petition, accompanied by the petition fee, requesting that the page limit imposed by 37 CFR 1.943(b) be waived

for requester's comments. The petition was accompanied by claim charts identified as Exhibits I, S, T, U, V, W, X, Y, Z, AA, BB, and CC.

16. On November 26, 2008, the patent owner filed a petition entitled "Petition Under 37 C.F.R. §§ 1.182 and 1.183 To Strike and Expunge Exhibit I Of Third-Party Requester's November 24, 2008 Filing As Inappropriate." The patent owner's petition filed November 26, 2008, is being addressed in a separate decision.

17. On December 12, 2008, the third party requester filed revised comments to patent owner's response to the Office action under 37 CFR 1.947, including additional exhibits.

18. On February 17, 2009, the patent owner filed an information disclosure statement.

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(b) states:

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

DECISION ON PETITION

In the instant petition, the third party requester requests waiver of the page limit requirement of 37 CFR 1.943(b), which limits third party requester's written comments to 50 pages in length. Specifically, the third party requester is requesting that 37 CFR 1.943(b) be waived to permit the exhibits filed with the petition on November 24, 2008, which are claim charts, to be entered along with third party requester's revised comments, which requester has stated in the petition would not otherwise exceed the 50 page limit. After the filing of the petition, the third party requester filed 49 pages of written comments along with additional exhibits on December 12, 2008.

The response to the Office action filed by the patent owner on September 3, 2008, included an amendment that added new claims 47-100. The claims charts filed by the third party requester are directed to the newly added claims, and the charts apply the same prior art references that were used by the examiner in the Office action to reject other claims. It is noted that claim charts are not excluded by 37 CFR 1.943(b) and thus are included in the number of pages of written comments submitted by third party requester.

37 CFR 1.183 permits waiver of the page limitation requirement of the regulations in an extraordinary situation when justice requires. Based upon the above facts and the individual facts and circumstances of this reexamination proceeding, the 49 pages of written comments filed on December 12, 2008, with exhibits, and the claim charts (Exhibits I, S, T, U, V, W, X, Y, Z, AA, BB, and CC) filed on November 24, 2008, by the third party requester are deemed equitable to address the patent owner's response filed on September 3, 2008.

Accordingly, the petition is granted.

CONCLUSION

1. The third party requester petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b) is granted.

2. The third party requester's written comments filed December 12, 2008, with exhibits, and the exhibits filed with the petition on November 24, 2008, are entered into the record.

3. Jurisdiction is being transferred to the Central Reexamination Unit for appropriate action on the proceeding by the examiner in due course.

4. Telephone inquiries related to this decision should be directed to Eugenia Jones, Senior Legal Advisor, at (571) 272-7727.

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

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.
95/001,018	12/07/2007	6,928,479	79123-00006	1015

30734 7590 03/02/2009

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/02/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
ROBERT S. BLASI, ESQ.
GOODWIN PROCTER LLP
EXCHANGE PLACE
BOSTON, MA 02109

Date: MAILED
MAR 02 2009
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001018
PATENT NO. : 6928479
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

MAR 02 2009

CENTRAL REEXAMINATION UNIT

Robert S. Blasi, Esq.
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Exchange Place
53 State Street
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(For Requester)

In re Meyer et al.
Inter Partes Reexamination Proceeding
Control No.: 95/001,018
Filed: December 7, 2007
For: U.S. Patent No.: 6,928,479

DECISION DISMISSING PETITION

This is a decision on the November 26, 2008 patent owner petition entitled "Petition Under 37 C.F.R. §§ 1.182 and 1.183 To Strike and Expunge Exhibit I Of Third-Party Requester's November 24, 2008 Filing As Inappropriate." The petition is being treated as a petition under 37 CFR 1.182. Patent owner has not identified any requirement of the regulations for which waiver is being requested, and the Office considers the petition to be directed to a situation that is not specifically provided for in the regulations.

The petition and *inter partes* reexamination control number 95/001,018 are before the Office of Patent Legal Administration.

SUMMARY

The petition filed November 26, 2008 is dismissed.

The petition fee of $400.00 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.182 has been charged to patent owner's deposit account as authorized in the petition.

RELEVANT BACKGROUND

1. U.S Patent number 6,928,479 (the '479 patent) issued on August 9, 2005.

2. On December 7, 2007, a request for *inter partes* reexamination of the '479 patent was filed in the Office by a third party requester. The request was assigned reexamination proceeding control number 95/001,018 (the '018 reexamination proceeding).

3. On March 4, 2008, the Office issued an order, in the '018 reexamination proceeding, granting *inter partes* reexamination of the '479 patent.

4. On June 16, 2008, a non-final first Office action was mailed in the '018 reexamination proceeding.

5. On June 30, 2008, patent owner filed a petition for extension of time under 37 CFR 1.956 requesting a two-month extension of time.

6. On July 2, 2008, the Office mailed a decision which granted-in-part the petition for extension of time and extended the time for response to the Office action by one month.

7. On July 25, 2008, patent owner filed a response to the Office action including a proposed amendment to the claims (appendix A), declarations under 37 CFR 1.131 and/or 1.132, and a number of other appendices.

8. On August 20, 2008, the Office received a supplemental response from the patent owner in which the amendment to the claims was resubmitted to correct errors.

9. On August 21, 2008, the Office received another supplemental response from the patent owner, which was purportedly submitted before the supplemental response received August 20, 2008, in which the amendment to the claims was resubmitted to correct formatting by underlining the text of the proposed new claims.

10. On August 22, 2008, the third party requester filed comments to the patent owner's response under 37 CFR 1.947.

11. On September 3, 2008, patent owner filed a petition under 37 CFR 1.183, 1.182, or 1.137(b) requesting waiver of the page limit for patent owner's response to the Office action, acceptance of a redrafted response and declaration, or, if necessary, revival of the reexamination proceeding based on unintentional delay in responding to the Office action. The petition was accompanied by a redrafted response to the Office action and a redrafted declaration of Dr. Ganger.

12. On September 26, 2008, the third party requester filed a paper opposing the patent owner's September 3, 2008 petition.

13. On November 12, 2008, a decision granting-in-part the petition filed September 3, 2008, was mailed. The petition was granted to the extent that the redrafted response and declaration of Dr. Ganger, along with all the accompanying attachments and exhibits filed with the petition, were accepted. The decision also provided that patent owner's response filed July 25, 2008, and the supplemental responses filed August 20, 2008, and August 21, 2008, were refused entry into the record. The third party requester's response paper filed August 22, 2008 was also refused entry into the record, and the third party requester was given 30 days from the mailing date of the decision to file a response under 37 CFR 1.947 to patent owner's redrafted response filed September 3, 2008.

14. In addition, on November 12, 2008, a decision refusing entry of the third party requester's paper filed September 26, 2008 was mailed.

15. On November 24, 2008, the third party requester filed a petition under 37 CFR 1.183, accompanied by the petition fee, requesting that the page limit imposed by 37 CFR 1.943(b) be waived for requester's comment. The petition was accompanied by claim charts identified as Exhibits I, S, T, U, V, W, X, Y, Z, AA, BB, and CC. The third party requester's petition filed November 24, 2008 is being addressed in a separate decision.

16. On November 26, 2008, the patent owner filed the instant petition.

17. On December 12, 2008, the third party requester filed revised comments to patent owner's response to the Office action under 37 CFR 1.947, including additional exhibits.

18. On February 17, 2009, the patent owner filed an information disclosure statement.

RELEVANT STATUTORY, REGULATORY, AND PROCEDURAL PROVISIONS

37 CFR 1.182 provides:

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

37 CFR 1.183 provides:

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

37 CFR 1.947 provides, 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.

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.

DECISION ON PETITION

In the instant petition, patent owner requests that the Director strike and expunge Exhibit I of the third party requester's November 24, 2008 filing. Patent owner states that the claims as presented in the Exhibit I claim charts are not the claims in this *inter partes* reexamination proceeding, and thus the Exhibit I claim charts are inappropriate material. Patent owner points out that the claims charts compare the claims of U.S. Patent No. 6,938,076 with claims that are not present in this reexamination proceeding, because the elements of the intervening dependent claims are not included in the claims labeled as 51, 56, 62, 67, and 73.

The examiner does not, however, rely on claim charts as containing an accurate copy of the claims. The examiner will examine the claims that are present in this reexamination proceeding and make any appropriate rejections of the claims. The examiner will be able to readily determine that the claims in the claim charts of Exhibit I are not an accurate copy of the claims present in this reexamination proceeding. Therefore, Exhibit I is not inappropriate material, and it will not be expunged. Accordingly, the petition is dismissed.

CONCLUSION

1. The patent owner petition under 37 CFR 1.182 is dismissed.

2. Jurisdiction is being transferred to the Central Reexamination Unit for appropriate action on the proceeding by the examiner in due course.

3. Telephone inquiries related to this decision should be directed to Eugenia Jones, Senior Legal Advisor, at (571) 272-7727.

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