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JUN 10 2008

CENTRAL REEXAMINATION UNIT

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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 one month 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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DALLAS, TEXAS 75201-2784

(For Patent Owner)

MAILED

JUN 08 2009

CENTRAL REEXAMINATION UNIT

SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE NW
SUITE 800
WASHINGTON, DC 20037

(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,021
Filed: February 26, 2008
For: U.S. Patent No. 7,110,562

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

This is a decision on patent owner's petition entitled "PETITION UNDER 37 C.F.R. §§ 1.183 TO WAIVE PAGE LIMIT REQUIREMENT WITH RESPECT TO PATENT OWNER'S RESPONSE TO THE OFFICE ACTION OF MARCH 18, 2009)," filed on May 13, 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 Deposit Account as authorized on page 4 of the petition.

The petition under 37 CFR 1.183 is granted under the conditions set forth below.

REVIEW OF THE RELEVANT FACTS

1. On February 19, 2006, United States Patent Number 7,110,562 (the '562 patent) issued.

2. On February 26, 2008, a request for *inter partes* reexamination of the '562 patent, assigned Reexamination Control No. 95/001,021 (the '1021 proceeding), was filed by a third party requester.

3. On April 14, 2008, the Office issued an order granting *inter partes* reexamination in the '1021 proceeding. On March 6, 2009, an Office action on the merits was issued.

4. On March 18, 2009, the Office issued, *sua sponte*, an Office Action. Patent owner filed a petition on April 3, 2009 requesting relief for a non-exclusive list of mistakes and omissions in the Office action. The petition is still outstanding.

5. On May 13, 2009, patent owner filed the instant "PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE PAGE LIMIT REQUIREMENT WITH RESPECT TO PATENT OWNER'S RESPONSE TO THE OFFICE ACTION OF MARCH 18, 2009."

6. Concurrently on May 13, 2009, patent owner filed an "AMENDMENT AND RESPONSE TO NON-FINAL ACTION)," with accompanying declarations and witness testimony, in response to the March 18, 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.

On May 13, 2009, concurrently with the petition under 37 CFR 1.183, patent owner filed a response to the March 18, 2009 Office action with accompanying declarations and witness testimony. Patent owner asserts that the May 13, 2009 response has 65 pages, as well as pages of witness testimony in various declarations attached to the response.[1] Patent owner asserts that it was able to reduce the page count to contain 54 pages of arguments, excluding the declarations, exhibits, etc.[2] Thus, based on patent owner's assertions, the arguments portion of patent owner's response exceeds the 50-page limit set forth in 37 CFR 1.943(b) by 4 pages.[3] In the 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 May 13, 2009 response.

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[1] *See* petition at page 2.

[2] *See* petition at page 3.

[3] Patent owner does not assert that any of the pages of witness testimony in the various declarations attached to the response include arguments that would count toward the 50-page limit. *See* petition 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).

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 petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b). Additionally, patent owner explains that it took steps to reduce the page count, such as consolidating and avoiding repetition of arguments.[4]

Based on the specific facts and explanations 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 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 portion of patent owner's May 13, 2009 response exceeds the 50-page limit by 4 pages.

Accordingly, patent owner's petition under 37 CFR 1.183 is granted to the extent that the page limit of 37 CFR 1.943(b) is waived as to 4 pages of the arguments portion of patent owner's May 13, 2009 response that exceed the 50-page limit. This waiver is conditional on the submission being in at least 12 point font and double spaced, with appropriate margins.

CONCLUSION

1. Patent owner's petition under 37 CFR 1.183 is granted. The page limit of 37 CFR 1.943(b) is waived as to 4 pages of the arguments portion of patent owner's May 13, 2009 response that exceed the 50-page limit. This waiver is conditional on the submission being in at least 12 point font and double spaced, with appropriate margins.

2. Jurisdiction for the '1021 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.

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

Kenpet7\IP\length
6-5-09

[4] Petition at page 3.

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CENTRAL REEXAMINATION UNIT

R. Ross Viguet
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DALLAS TX 75201-2784

(For Patent Owner)

David J Cushing
SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

(For Third Party Requester)

In re: Feeley *et alia*
Inter Partes Reexamination Proceeding
Control No. 95/001,021
Deposited on: 26 February 2008
For: US Patent No. 7,001,562

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

This is a decision on the 09 April 2009, patent owner "Petition for Extension of Time Under 37 CFR § 1.956," requesting that the time for responding to the Office action mailed 31 March 2010 to be extended by one (1) month.

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

The petition is granted for the reasons set forth below.

Discussion

The Patent Owner requests an extension of time in which to file a response to the non-final Office action was mailed 31 March 2010. The non-final Office action provides one (1) month period for response. The petition requesting a one (1) month extension of time was timely filed on 09 April 2010. The $200 petition fee pursuant to 37 CFR §1.17 (g) is provided.

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

The petitioner notes the time is needed since there was a disparity of time before which the action was available to counsel and the inventors are involved at the prescheduled conference. On balance, the petitioner has demonstrated "sufficient cause" for granting the extension of time.

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

Conclusion

1. The patent owner's petition for extension of one (1) month time in which to file a response to the Office action dated 31 March 2009 is hereby **granted**.

2. A **one (1) month** extension of time is hereby granted.

3. The office action mailed set a one (1) month response time for which to respond, with the granting of this extension of time, the period will end on **31 May 2009**.

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

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

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

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

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

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

/Mark Reinhart/

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

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(For Patent Owner)

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JUN 08 2009

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2100 PENNSYLVANIA AVENUE NW
SUITE 800
WASHINGTON, DC 20037

(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,022
Filed: February 26, 2008
For: U.S. Patent No. 7,016,512

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

This is a decision on patent owner's petition entitled "PETITION UNDER 37 C.F.R. §§ 1.183 TO WAIVE PAGE LIMIT REQUIREMENT WITH RESPECT TO PATENT OWNER'S RESPONSE TO THE OFFICE ACTION OF MARCH 18, 2009)," filed on May 12, 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 Deposit Account as authorized on page 4 of the petition.

The petition under 37 CFR 1.183 is granted under the conditions set forth below.

REVIEW OF THE RELEVANT FACTS

1. On March 12, 2006, United States Patent Number 7,016,512 (the '512 patent) issued.

2. On February 26, 2008, a request for *inter partes* reexamination of the '512 patent, assigned Reexamination Control No. 95/001,022 (the '1022 proceeding), was filed by a third party requester.

3. On April 22, 2008, the Office issued an order granting *inter partes* reexamination in the '1022 proceeding. On March 4, 2009, the Office issued an Office action on the merits.

4. On March 18, 2009, the Office re-issued, *sua sponte,* an Office Action.

5. On May 12, 2009, patent owner filed the instant "PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE PAGE LIMIT REQUIREMENT WITH RESPECT TO PATENT OWNER'S RESPONSE TO THE OFFICE ACTION OF MARCH 18, 2009."

6. Concurrently on May 12, 2009, patent owner filed an "AMENDMENT AND RESPONSE TO NON-FINAL ACTION)," with accompanying declarations and witness testimony, in response to the March 18, 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.

On May 12, 2009, concurrently with the petition under 37 CFR 1.183, patent owner filed a response to the March 18, 2009 Office action, with accompanying declarations. Patent owner asserts that the May 12, 2009 response and accompanying declarations include 110 pages: 55 pages of arguments from the remarks section of the response, 17 pages from the declarations and 38 pages of *curriculum vitae* for two of the declarants. Thus, based on patent owner's assertions, the arguments portion of patent owner's response exceeds the 50-page limit set forth in 37 CFR 1.943(b) by 5 pages.[1] In the 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 May 12, 2009 response.

In this instance, patent owner has made a showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft a response in compliance with the 50-page limit, and submitting the resulting response, which is in excess of 50 pages, concurrently with the petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b). Additionally, patent owner

[1] Patent owner does not assert that any of the 17 pages from the declarations and 38 pages of *curriculum vitae* for two of the declarants include arguments that would count toward the 50-page limit. *See* petition at page 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).

explains that it took steps to reduce the page count, such as consolidating and avoiding repetition of arguments.[2]

Based on the specific facts and explanations 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 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 portion of patent owner's May 13, 2009 response exceeds the 50-page limit by 5 pages.

Accordingly, patent owner's petition under 37 CFR 1.183 is granted to the extent that the page limit of 37 CFR 1.943(b) is waived as to 5 pages of the arguments portion of patent owner's May 13, 2009 response that exceeds the 50-page limit. This waiver is conditional on the submission being in at least 12 point font and double spaced, with appropriate margins.

CONCLUSION

1. Patent owner's petition under 37 CFR 1.183 is granted. The page limit of 37 CFR 1.943(b) is waived as to 5 pages of the arguments portion of patent owner's May 12, 2009 response that exceeds the 50-page limit. This waiver is conditional on the submission being in at least 12 point font and double spaced, with appropriate margins.

2. Jurisdiction for the '1022 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.

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

Kenpet7\IP\length
6-5-09

[2] Petition at page 3.

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,022	02/26/2008	7,016,512	Q105784	1648

29053 7590 06/23/2010

FULBRIGHT & JAWORSKI L.L.P
2200 ROSS AVENUE
SUITE 2800
DALLAS, TX 75201-2784

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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United States Patents and Trademark Office
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
DAVID J. CUSHING
SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVE., N.W. SUITE 800
WASHINGTON, DC 20037

Date:
MAILED

JUN 23 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001022
PATENT NO. : 7016512
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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FULBRIGHT & JAWORSKI L.L.P
2200 ROSS AVENUE
SUITE 2800
DALLAS TX 75201-2784

(For Patent Owner)

MAILED

JUN 23 2010

CENTRAL REEXAMINATION UNIT

(For Third Party Requester)

SUGHRUE MION, PLLC
2100 Pennsylvania Ave., NW, Suite 800
Washington, DC 20037

In re Feeley *et alia*
Reexamination Proceeding
Control No. 95/001,022
For: U.S. Patent No. 7,016,512

The *inter partes* reexamination is before the Central Reexamination Unit for consideration of the following papers:

1. Requester's comments filed June 11, 2009.

2. Patent Owner petition filed June 23, 2009 requesting the office return the requester's comments of June 11, 2009.

3. Notice of December 1, 2009 giving requester 15 days to rectify and refile comments.

4. Revised requester comments filed December 16, 2009.

5. Patent Owner petition filed December 23, 2009 requesting the office return the requester's revised comments filed December 16, 2009.

6. Patent Owner petition filed December 23, 2009 to expunge the requester's comments of June 11, 2009.

Decision

The requester's comments filed June 11, 2009 were found **improper** as noted in the office letter mailed December 1, 2009. In accordance with MPEP 2666.05, the requester's comments filed June 11, 2009 are **expunged** from the record. Since this proceeding is not a paper file and the papers of June 11, 2009 were electronically filed, the papers are being **closed** from public view.

In view of the finding that the requester's submission of June 11, 2009 was improper and expunged from the file, the Patent Owner petitions filed June 23, 2009 and December 23, 2009 are **dismissed as moot**.

The revised requester's comments filed December 16, 2009 are found **improper**.

The revised requester's comments exceed the page-limit requirement in 37 CFR 1.943. Requester electronically submitted a 45-page .pdf file and a 4-page .pdf file on December 16, 2009. Both files appear to be comments and both contain one page for the certificate of service. The longer file contains 3 pages of table of contents and one page containing a fee authorization, signature, and contact information. The comments also assert that only nine pages of the Thompson declaration (originally submitted with the comments of June 11, 2009) should be counted against the page limit. The table of contents pages are explicitly stated as being excluded from the page limit in MPEP 2667. Excluding the certificate of service pages and the signature page and taking into account the assertion that only (i.e. at least) nine pages of the Thompson declaration count against the page limit, the comments exceed the 50-page limit. It is

unclear which other pages requester thinks should not count against the page limit. Arguably, other portions of the Thompson declaration should be counted against the page limit as it contains arguments of which art meets various specific claim elements (i.e. which references describe ITC and BTE components). Further complicating matters are statements that comments and prosecution from other reexamination proceedings (e.g., control numbers 95/001,036 and 95/001,021) should be considered when reconsidering the non-adoption of the ten proposed rejections of claims 3 and 9. As the discussion of the various references in these ten proposed rejections takes many pages in control numbers 95/001,036 and 95/001,021, it is unclear how many pages should count against the page limit. The undersigned can not find a plausible manner in which to find the comments submitted on December 16, 2009 (taken as a whole) to be within the 50-page limit.

The revised requester's comments also present modified rejections from than those set forth in the request for reexamination. In the request for *inter partes* reexamination, the third party requester proposed ten rejections for claims 3 and 9 that corresponded to issues that raised a substantial new question of patentability. The patent owner has not amended the claims, and therefore, there is no basis for proposing new modifications to those rejections (including reliance on different teachings within the references and/or different rationales for combining references and/or providing declaration evidence to buttress the rejections). Instead of limiting the discussion to a rebuttal of the examiner's or patent owner's findings of fact as to the cited references, the requester has sought to introduce modified rejections.

These new variations of proposed rejections presented in the revised requester's comments are improper as such comments are not in compliance with MPEP § 2666.05. Office policies require that where a newly proposed rejection is presented, the third party requester must present the newly proposed rejection in compliance with the guidelines set forth in MPEP § 2617, since any such new proposed rejection stands on the same footing as a proposed rejection presented with the request for reexamination, and is treated the same way as to future Office actions and any appeal. However, the requester has sought to introduce new or modified proposed rejections without the detailed explanation for how the references apply to the claim limitations. For example, the comments purport to alter 10 of the rejections, but lump together the explanations without separate detailed explanations in accordance with the guidelines set forth in MPEP § 2617. Therefore, the proposals of new or modified rejections are improper as such comments are not in compliance with Office policies.

Since the revised requester's comments are found **improper** as noted above, in accordance with MPEP 2666.05, the revised requester's comments are **expunged** from the record. Since this proceeding is not a paper file and the papers of December 16, 2009 were electronically filed, the papers are being **closed** from public view.

In view of the finding that the revised requester's comments of December 16, 2009 was improper and expunged from the file, the Patent Owner petition filed December 23, 2009 is **dismissed as moot**.

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

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

By Mail to: Mail Stop *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

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.

This is not a final agency action. The decision is made without prejudice to a request for reconsideration or higher-level review.

Eric Keasel
SPE, AU 3992

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,024	12/31/2007	6853714	6620-80115-01	7561

7590 06/27/2008

THRASHER ASSOCIATES, LLC
STEVEN THRASHER
391 SANDHILL DRIVE
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RICHARDSON, TX 75080

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/27/2008

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

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

RICHARD D MCLEOD
KLARQUIST SPARKMAN LLP
121 SW SALMON STREET
PORTLAND, OR 97204

MAILED

JUN 27 2008

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NUMBER *95/001,024*.

PATENT NUMBER *6,853,714*.

TECHNOLOGY CENTER *3900*.

ART UNIT *3992*.

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

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

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

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

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Thrasher Associates, LLC (For Patent Owner)
Steven Thrasher
391 Sandhill Drive
Suite 1600
Richardson, TX 75080

MAILED

JUN 27 2008

CENTRAL REEXAMINATION UNIT

Richard D. McLeod (For 95/001,024 Requester)
Klarquist Sparkman LLP
121 SW Salmon Street
Portland, OR 97204

Patterson & Sheridan LLP NJ Office (For 95/001,034 Requester)
595 Shrewsbury Ave, Ste 100
First Floor
Shrewsbury, NJ 07702

In re Liljestrand et al.
Inter partes Reexamination Proceeding
Control No. 95/001,024
Filed: December 31, 2007
For: U.S. Patent No. 6,853,714

In re Liljestrand et al.
Inter partes Reexamination Proceeding
Control No. 95/001,034
Filed: March 19, 2008
For: U.S. Patent No. 6,853,714

: DECISION, *SUA SPONTE*,
: TO MERGE REEXAMINATION
: PROCEEDINGS

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

REVIEW OF FACTS

1. United States Patent Number 6,853,714 (the '714 patent) issued to Keith A. Liljestrand et al. on February 23, 2001, with 9 claims.

2. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/001,024 ('024), was filed on December 31, 2007, by a first third party requester.

3. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/001,034 ('034), was filed on March 19, 2008, by a second third party requester.

4. An order granting *inter partes* reexamination of claims 1-9 of the '714 patent was mailed for the '024 reexamination proceeding on March 14, 2008.

5. An order granting *inter partes* reexamination of claims 1-9 of the '714 patent was mailed for the '034 reexamination proceeding on April 25, 2008.

DECISION

I. MERGER OF PROCEEDINGS

Under 37 CFR 1.989(a):

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

As evidenced by the above review of facts, both the '024 and the '034 reexamination proceedings are currently pending. The order to reexamine has been mailed for both reexamination proceedings, and a decision under 37 CFR 1.989(a) is timely.

The general policy of the Office is that two reexamination proceedings will not be conducted separately, and at the same time, as to a particular patent. The rationale for this policy is (1) to prevent inconsistent, and possibly conflicting, amendments from being introduced into the two proceedings on behalf of the patent owner, (2) to provide a comprehensive examination of the patent based on the issues raised in both of the proceedings, and (3) to expedite the prosecution of both proceedings. In the present instance, merger of the 95/001,024 and 95/001,034 reexamination proceedings would address these considerations. Thus, pursuant to 37 CFR 1.989(a), the 95/001,024 and 95/001,034 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 reexamination proceedings. The patent owner is required to continue to maintain the same claims (and specification) in both files *throughout the merged proceeding*.

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

The present decision merges an *inter partes* reexamination proceeding with another *inter partes* reexamination proceeding. Pursuant to 37 CFR 1.989(b), the merged proceeding is governed by 37 CFR 1.902 through 1.997.

B. Papers mailed/filed:

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

All papers that are filed by the patent owner and the third party requesters should be directed:

By U.S. Postal Service Mail:

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

By FAX to:

(571) 273-990100
Central Reexamination Unit

By hand (or delivery service):

Customer Service Window
Attn: Central Reexamination Unit
Randolph Building, Lobby Level
401 Dulaney St.
Alexandria, VA 22314

The patent owner and the requesters are reminded that every paper filed in the merged proceeding subsequent to this decision must be served on the other parties, including papers filed *via* facsimile transmission.

C. Amendments:

The filing of any amendments to the specification, claims, and drawings must comply with the provisions of 37 CFR 1.530 and the guidelines of MPEP § 2666. 37 CFR 1.121 does not apply to amendments in a reexamination proceeding. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via markings pursuant to 37 CFR 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

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

D. Fees:

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

E. Citation of Patents and Printed Publications:

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

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/001,024 and *inter partes* Reexamination Control No. 95/001,034 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 Kenneth M. Schor in the Office of Patent Legal Administration, at (571)272-7710.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,026	01/31/2008	6378020	38512.9	1090

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

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/001026	01/31/08	6378020	38512.9

HAYNES AND BOONE, LLP
901 MAIN STREET
SUITE 3100
DALLAS, TX 75202

EXAMINER
ESCALANTE,OVIDIO

ART UNIT	PAPER
3992	

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. 95/001,026
Filed: January 31, 2008
For: U.S. Patent No. 6,378,020

: **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 95/001,026 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

07/02/2008 RHELL1 00000003 081394 95001026
01 FC:1462 400.00 DA

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 6,378,020 ("the '8020 patent") issued to Michael Farmwald *et al* on March 20, 2004, and is assigned to Rambus, Inc.

2. On January 24, 2008, a request for *inter partes* reexamination of the '8020 patent was filed by a third party requester, and the request was assigned control number 95/001,026 (the '1026 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 25, 2008, a "Notice of Failure to Comply With *Inter Partes* Reexamination Request Filing Requirements (37 CFR 1.915(d))" was mailed to third party requester.

4. On January 31, 2008, a replacement request for *inter partes* reexamination was filed to address the January 25, 2008 Notice, and the January 31, 2008 replace request was accorded a filing date of January 31, 2008.

5. On April 9, 2008, reexamination was ordered for claims 30-33, 35, 36 and 38-41 of the '8020 patent.

6. A first Office action on the merits (*i.e.*, addressing the patentability of the claims subject to reexamination) has not yet been mailed..

7. On March 7, 2008, the present patent owner petition to vacate was filed.

8. 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

[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.

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

35 U.S.C. § 317 provides:

(a) ORDER FOR REEXAMINATION.– Notwithstanding any provision of this chapter, once an order for inter partes reexamination of a patent has been issued under section 313, neither the third-party requester nor its privies may file a subsequent request for inter partes reexamination of the patent until an inter partes reexamination certificate is issued and published under section 316, unless authorized by the Director.
(b) FINAL DECISION.– Once a final decision has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit or if a final decision in an inter partes reexamination proceeding instituted by a third-party requester is favorable to the patentability of any original or proposed amended or new claim of the patent, then neither that party nor its privies may thereafter request an inter partes reexamination of any such patent claim on the basis of issues which that party or its privies raised or could have raised in such civil action or inter partes reexamination proceeding, and an inter partes reexamination requested by that party or its privies on the basis of such issues may not thereafter be maintained by the Office, notwithstanding any other provision of this chapter. This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the inter partes reexamination proceedings.

37 CFR 1.105 provides:

(a)(1) In the course of examining or treating a matter in a pending or abandoned application filed under 35 U.S.C. 111 or 371 (including a reissue application), in a patent, or in a reexamination proceeding, the examiner or other Office employee may require the submission, from individuals identified under § 1.56(c), or any assignee, of such information as may be reasonably necessary to properly examine or treat the matter, for example:

(i) *Commercial databases*: The existence of any particularly relevant commercial database known to any of the inventors that could be searched for a particular aspect of the invention.

(ii) *Search*: Whether a search of the prior art was made, and if so, what was searched.

(iii)*Related information*: A copy of any non-patent literature, published application, or patent (U.S. or foreign), by any of the inventors, that relates to the claimed invention.

(iv) *Information used to draft application*: A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used to draft the application.

(v) *Information* used in invention process: A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used in the invention process, such as by designing around or providing a solution to accomplish an invention result.

(vi) *Improvements*: Where the claimed invention is an improvement, identification of what is being improved.

(vii) *In Use*: Identification of any use of the claimed invention known to any of the inventors at the time the application was filed notwithstanding the date of the use.

(viii) *Technical information* known to applicant.
Technical information known to applicant concerning the related art, the disclosure, the claimed subject matter, other factual information pertinent to patentability, or concerning the accuracy of the examiner's stated interpretation of such items.

(2) Where an assignee has asserted its right to prosecute pursuant to § 3.71(a) of this chapter, matters such as paragraphs (a)(1)(i), (iii), and (vii) of this section may also be applied to such assignee.

(3) Requirements for factual information known to applicant may be presented in any appropriate manner, for example:

(i) A requirement for factual information;

(ii) Interrogatories in the form of specific questions seeking applicant's factual knowledge; or
(iii) Stipulations as to facts with which the applicant may agree or disagree.
(4) Any reply to a requirement for information pursuant to this section that states either that the information required to be submitted is unknown to or is not readily available to the party or parties from which it was requested may be accepted as a complete reply.
(b)The requirement for information of paragraph (a)(1) of this section may be included in an Office action, or sent separately.
(c) A reply, or a failure to reply, to a requirement for information under this section will be governed by §§ 1.135 and 1.136.

37 CFR 1.907 provides:

(a) Once an order to reexamine has been issued under § 1.931, neither the third party requester, nor its privies, may file a subsequent request for *inter partes* reexamination of the patent until an *inter partes* reexamination certificate is issued under § 1.997, unless authorized by the Director.
(b) Once a final decision has been entered against a party in a civil action arising in whole or in part under 28 U.S.C. 1338 that the party has not sustained its burden of proving invalidity of any patent claim-in-suit, then neither that party nor its privies may thereafter request *inter partes* reexamination of any such patent claim on the basis of issues which that party, or its privies, raised or could have raised in such civil action, and an *inter partes* reexamination requested by that party, or its privies, on the basis of such issues may not thereafter be maintained by the Office.
(c) If a final decision in an *inter partes* reexamination proceeding instituted by a third party requester is favorable to patentability of any original, proposed amended, or new claims of the patent, then neither that party nor its privies may thereafter request *inter partes* reexamination of any such patent claims on the basis of issues which that party, or its privies, raised or could have raised in such *inter partes* reexamination proceeding.

37 CFR 1.913 provides:

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

37 CFR 1.915(b)(7), (b)(8) and (d) provide:

(b) A request for *inter partes* reexamination must include the following parts:
(7) A certification by the third party requester that the estoppel provisions of § 1.907 do not prohibit the inter partes reexamination.
(8) A statement identifying the real party in interest to the extent necessary for a subsequent person filing an *inter partes* reexamination request to determine whether that person is a privy.
...
(d) If *the inter partes* request does not include the fee for requesting *inter partes* reexamination required by paragraph (a) of this section and meet all the requirements of paragraph (b) of this section, then the person identified as requesting *inter partes* reexamination will be so notified and will generally be given an opportunity to complete the request within a specified time. Failure to comply with the notice will result in the *inter partes* reexamination request not being granted a filing date, and will result in placement of the request in the patent file as a citation if it complies with the requirements of § 1.501.

37 CFR 1.919(a) provides:

(a) The filing date of a request for *inter partes* reexamination is the date on which the request satisfies all the requirements for the request set forth in § 1.915.

MPEP § 2614 provides, in part:

> The reexamination request must identify the real party in interest who is responsible for filing the reexamination request. This information will be used by future parties requesting reexamination of the same patent, in making the certifications required by 37 CFR 1.915(b)(8).

PRELIMINARY MATTER

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 '1026 *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

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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.

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 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 '8020 patent has been asserted against a number of defendants;
(2) The real party in interest identified in the request for reexamination of the '8020 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 '1026 *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 '1026 *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 '8020 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 '1026 *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 '8020 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 '1026 *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 '8020 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 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 '1026 *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 '1026 *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 '1026 *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 '1026 *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 '1026 *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 '1026 *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 '1026 *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 '1026 *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 '1026 *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 '1026 *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 '1026 *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 '8020 patent by a party that should have been identified as a real party in interest in the '1026 *inter partes* reexamination proceeding, but was not so identified. Such a party, as a real party in interest in the '1026 *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 '8020 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 '1026 *inter partes* reexamination proceeding. No additional requests for *inter partes* reexamination of the '8020 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 '8020 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 '8020 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 '1026 *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 '8020 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 '8020 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 '8020 patent any way or was involved in the decision to file, or (b) in any way participated in the prosecution of the resulting '1026 *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 '8020 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 '1026 *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 '1026 *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 '1026 *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 '1026 *inter partes* reexamination that could warrant the requested relief. The present record in the '1026 *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 '1026 *inter partes* reexamination proceeding and 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

[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).

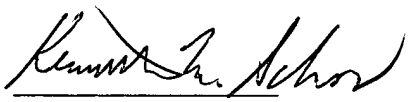
CONCLUSION

1. The March 7, 2008 petition to vacate both the filing date of the '1026 *inter partes* reexamination proceeding and the Order granting reexamination in the '1026 *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 '1026 *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

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June 30, 2008

6-30-08
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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.
95/001,026	01/31/2008	6378020	38512.9	1090

22852 7590 07/31/2008

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 07/31/2008

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JUL 31 2008

CENTRAL REEXAMINATION UNIT

Finnegan, Henderson et al., LLP
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Washington, DC 20001-4413

(For Patent Owner)

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.: 95/001,026
Filed: January 24, 2008
For: U.S. Patent No. 6,378,020

: DECISION GRANTING
: PETITION UNDER
: 37 CFR § 1.183

This is a decision on the May 13, 2008 patent owner petition entitled "PETITION TO WAIVE 37 CFR § 1.98(a) (2) AND ENTER INTO THE FILE DOCUMENTS FROM CO-PENDING REEXAMINATION PROCEEDING," being treated under 37 CFR 1.183. The petition requests waiver of the formal submission requirements of 37 CFR 1.555 and 1.98(a), for entry into the record of reexamination proceeding control No. 95/001,026 - the foreign and non-patent literature documents that were previously submitted in a copending reexamination proceeding.

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. 6,378,020 (the '8020 patent) issued on April 23, 2002.

2. U.S. Patent Nos. 6,715,020 (the '5020 patent) issued on March 30, 2004.

3. The '8020 patent and the '5020 patent are related patent application filings, both of which ultimately claim benefit to US application 07/510,898, filed April 18, 1990, now abandoned.

4. A request for reexamination of the '5020 patent was filed on October 1, 2007. The request was assigned control No. 95/001,008 (the '1008 reexamination proceeding).

5. A request for reexamination of the '8020 patent was filed on January 24, 2008.

The request was assigned control No. 95/001,026 (the '1026 reexamination proceeding).

6. Reexamination was ordered for the '1008 proceeding on December 19, 2007.

7. Reexamination was ordered for the '1026 proceeding on April 9, 2008.

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 May 13, 2008, patent owner filed in the '1026 proceeding - a document entitled "Information Disclosure Statement" that is identical to the document of the same title filed on February 19, 2008 in the '1008 proceeding. Office records fail to reveal, however, that copies of the references listed in the May 13, 2008 document entitled "Information Disclosure Statement"were received by the Office in the '1026 proceeding.

10. Concurrent with the May 13, 2008 submission in the '1026 proceeding, the patent owner filed the instant petition under 1.183 requesting waiver of the formal submission requirements of 37 CFR 1.555 and 1.98(a), and requesting entry into the record of reexamination proceeding control no. 95/001,026 - the foreign and non-patent literature documents that were previously submitted in the copending reexamination proceeding.

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 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 information disclosure statement. Copies of the Information Disclosure Statement references were not appropriately provided in this proceeding; accordingly, patent owner has requested waiver of the rules to permit transfer of scanned-in references of a related reexamination proceeding (such references submitted for an identical document entitled "information disclosure statement" from the related reexamination proceeding to the present proceeding. The scanning of a single submission of references and subsequent electronic transfer of the same scanned references in an identical document entitled "information disclosure statement" from a related reexamination proceeding 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 based upon the individual facts and circumstances of these proceedings. Furthermore, the grant of this petition is not an acknowledgement that patent owner's May 13, 2008 submission complies with all other requirements of the relevant rules. The examiner of record will make such a determination, in light of the waiver of the formal submission requirements of 37 CFR 1.555 and 1.98 granted by this decision.

A petition fee of $400.00 under 37 CFR 1.17(f) has been received and processed by the Office.

ADDITIONAL DISCUSSION

Petitioner asserts that a granting of a waiver of the "copy requirement" is supported by the granting of a similar petition in another reexamination proceeding.[1] However, that decision expressly states that EFS-Web is now available for reexamination filings thus minimizing the need for such a request for relief. The Office (via the Electronic Business Center) released a notice in the summer of 2007 stating that EFS-Web version 1.1.4 is designed to receive papers for reexamination proceedings.[2] Also, in December 2007 the Office issued a legal notice stating that EFS-Web was available for both initial and ***follow-on*** papers in reexamination proceedings.[3] Accordingly, petitioner now has multiple instances of both constructive and actual notice that e-filing of initial and follow on papers is available in reexamination proceedings. Any subsequent submission of a document entitled "information disclosure statement" filed with a petition requesting a waiver of the "copy requirement," absent a showing of ***extraordinary*** circumstances significantly above and beyond the mere convenience rationale set forth in the present instance, will not receive favorable consideration. The Office has provided a readily usable alternative for the submission of documents that minimizes the burden of document handling for all parties, EFS-Web, but only if utilized. Therefore, petitioner, having been placed on notice is

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[1] Petitioner discusses a petition decision issued on April 17, 2008 in reexamination proceeding 95/001,013.
[2] See http://www.uspto.gov/ebc/portal/efs/efs_web_114_v13.pdf
[3] Memorandum signed by John J. Love, Deputy Commissioner for Patent Examination Policy, Legal Framework for EFS-Web page 10, § XXII (Signed November 29, 2007) at http://www.uspto.gov/ebc/portal/efs/legalframework.pdf

cautioned to utilize EFS-Web in filing large duplicative submissions in multiple Office proceedings, in order to minimize those burdens and not cause unnecessary expenditure of the Office's limited resources.

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. Patent owner and counsel have been placed on notice to utilize EFS-Web in future filings of large duplicative submissions in multiple Office proceedings.

3. Jurisdiction over this proceeding is returned to the Central Reexamination Unit for transfer of the references from the copending reexamination proceeding to the '1026 proceeding.

4. 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

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CENTRAL REEXAMINATION UNIT

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Finnegan, Henderson, Farabow, (Courtesy Copy - Patent Owner)
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In re Farmwald et al.
Inter partes Reexamination Proceeding
Control No. 95/001,026
Filed: January 31, 2008
For: U.S. Patent No. 6,378,020

In re Farmwald et al.
Inter partes Reexamination Proceeding
Control No. 95/001,128
Filed: December 15, 2008
For: U.S. Patent No. 6,378,020

DECISION, *SUA SPONTE*,
TO MERGE REEXAMINATION
PROCEEDINGS

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

REVIEW OF FACTS

1. United States Patent Number 6,378,020 (the '020 patent) issued to Farmwald et al. on April 23, 2002, with 41 claims.

2. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/001,026 ('1026), was initially deposited by third party requester, identifying Samsung Electronics Co., Ltd. as the real party in interest, on January 24, 2008 and received a filing date of January 31, 2008.

3. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/001,128 ('1128), was initially deposited by third party requester Micron Technology on December 15, 2008 and received a filing date of December 15, 2008.

4. An order granting reexamination of claims 30-33, 35-36, and 38-41 of the '020 patent was mailed for the '1026 reexamination proceeding on April 9, 2008.

5. An order granting reexamination of claims 30, 35, and 36 of the '020 patent was mailed for the '1128 reexamination proceeding on February 6, 2009.

6. No Office action has been mailed, and no amendments to the claims have been made, in either of the '1026 and the '1128 *inter partes* reexamination proceedings.

DECISION

I. MERGER OF PROCEEDINGS

Under 37 CFR 1.989(a):

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

As evidenced by the above review of facts, both the '1026 and the '1128 reexamination proceedings are currently pending. The order to reexamine has been mailed for both reexamination proceedings, and a decision under 37 CFR 1.989(a) is timely.

The general policy of the Office is that two reexamination proceedings will not be conducted separately, and at the same time, as to a particular patent. The rationale for this policy is (1) to prevent inconsistent, and possibly conflicting, amendments from being introduced into the two proceedings on behalf of the patent owner, (2) to provide a comprehensive examination of the patent based on the issues raised in both of the proceedings, and (3) to expedite the prosecution of

both proceedings. In the present instance, where there is overlap in the claims subject to reexamination in the two proceedings, merger of the 95/001,026 and 95/001,128 reexamination proceedings would address these considerations. Thus, pursuant to 37 CFR 1.989(a), the 95/001,026 and 95/001,128 reexamination proceedings are hereby merged. The merged proceeding will be conducted in accordance with the guidelines and requirements which follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

The claims are identical in both proceedings. The patent owner is required to continue to maintain the same claims (and specification) in both files *throughout the merged proceeding.*

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

The present decision merges an *inter partes* reexamination proceeding with another *inter partes* reexamination proceeding. Pursuant to 37 CFR 1.989(b), the merged proceeding is governed by 37 CFR 1.902 through 1.997.

B. Papers mailed/filed:

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

All papers that are filed by the patent owner and the third party requesters should be directed:

By U.S. Postal Service Mail:

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

By FAX to:

(571) 273-9900
Central Reexamination Unit

By hand (or delivery service):

Customer Service Window
Attn: Central Reexamination Unit
Randolph Building
401 Dulaney St.
Alexandria, VA 22314

The patent owner and the requesters are reminded that every paper filed in the merged proceeding subsequent to this Decision must be served on the other parties, including papers filed *via* facsimile transmission.

C. Amendments:

The filing of any amendments to the specification, claims, and drawings must comply with the provisions of 37 CFR 1.530 and the guidelines of MPEP § 2666. 37 CFR 1.121 does not apply to amendments in a reexamination proceeding. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via markings pursuant to 37 CFR 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

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

D. Fees:

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

E. Citation of Patents and Printed Publications:

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

PATENT OWNER'S ADDRESS

The current correspondence address of record for the patent file is the proper patent owner address for reexamination mailings pursuant to 37 CFR 1.33(c), and it is that of Ann Williams, Rambus, Inc., 4440 El Camino Real, Los Altos, CA 94022.

A change of correspondence address was filed in each of the reexamination proceedings designating the Finnegan Henderson address noted above for all future correspondence to patent owner. As a courtesy, this decision is being mailed to both patent owner addresses.

The address of Ann Williams, Rambus, Inc., 4440 El Camino Real, Los Altos, CA 94022, will be the sole address for patent owner used in future correspondence, until a change in correspondence address in the patent and the reexamination is made in accordance with 37 CFR 1.33(c).

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/001,026 and *inter partes* Reexamination Control No. 95/001,128 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

2. Jurisdiction over the merged reexamination is being forwarded via the Central Reexamination Unit Director to the examiner for the preparation of an Office action, to be issued in due course for the merged proceeding.

3. Any questions concerning this communication should be directed to Pinchus M. Laufer, Legal Advisor at (571)272-7726.

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

July 10, 2009
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,029	02/28/2008	6459806	89310.0002	5797

41230 7590 05/06/2009

CUMMINS-ALLISON CORP.
C/O NIXON PEABODY LLP
161 N. CLARK ST., 48TH FLOOR
CHICAGO, IL 60601

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 05/06/2009

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
CONLEY ROSE, P.C.
DAVID A. ROSE
P.O. BOX 3267
HOUSTON, TX 77253-3267

Date: MAILED

MAY 0 6 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001029
PATENT NO. : 6459806
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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Stephen Rudisill, Esq.
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(For Patent Owner)

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CENTRAL REEXAMINATION UNIT

Mahbub A Siddiqui
CONLEY ROSE, P.C.
DAVID A. ROSE
P. O. BOX 3267
HOUSTON, TX 77253-3267

(For Third Party Requester)

DECISION
GRANTING-IN-PART
PETITION FOR EXTENSION
OF TIME
[37 CFR § 1.956 and § 1.181]

In re: Raterman *et alia*
Inter Partes Reexamination Proceeding
Control No. 95/001,029
Deposited on: 28 February 2008
For: US Patent No. 6,459,806

This is a decision on the 15 April 2009, "Request for Six-Week Extension of Time Pursuant to 37 CFR 1.550(c)" requesting that the time for responding to the non-final Office action mailed 19 March 2009, be extended by six (6) weeks. The petition was timely filed with the petition fee. The petition indicates the required certificate of service.

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

The petition is granted-in-part for the reasons set forth below.

Statement of Relevant Facts

1. On 01 October 2002 US patent No. 6,459,806 was granted to Raterman *et alia*.

2. On 28 February 2008 a request for reexamination was deposited by a third party requester for *inter partes* Reexamination with the Office identified by control number 95/001,029.

3. On 22 May 2008 an Order Granting Request for *inter partes* Reexamination 95/001,029 was mailed.

7. On 27 March 2009 a non-Final Office action was mailed.

8. On 15 April 2009 the instant petition for a six (6) weeks extension of time was submitted by the patent owner.

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 27 March 2009, which set a one (2) month time for filing a response thereto. The petition for extension of time was timely filed on 15 April 2009, together with electronic fee transmittal for the $200.00 petition fee as required by 37 CFR § 1.956 and 37 CFR § 1.17 (g). A certificate of service was provided with the petition.

The request is granted-in-part

> **37 CFR § 1.956. Patent owner extensions of time in inter partes reexamination.** *The time for taking any action by a patent owner in an inter partes reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified. Any request for such extension must be filed on or before the day on which action by the patent owner is due, but in no case will the mere filing of a request effect any extension. Any request for such extension must be accompanied by the petition set forth in § 1.17(g). See § 1.304(a) for extensions of time for filing a notice of appeal to the U.S. Court of Appeals for the Federal Circuit.*

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

> As noted above, a request for extension of time under 37 CFR § 1.956 will be granted only for sufficient cause, ...
>
> Evaluation of whether "sufficient cause" has been shown for an extension must be made by **balancing** the desire to provide the patent owner with a fair opportunity to respond, **against** the requirement of the statute, 35 U.S.C. § 314(c), that the proceedings be conducted with special dispatch. ...

Any petition request must include the required petition fee as set forth according to 37 CFR § 1.17 (g) and 37 CFR § 1.956.

MPEP § 2665 Extension of Time for Patent Owner Response (in-part)

> Requests for an extension of time in an inter partes reexamination proceeding will be considered only after the first Office action on the merits in the reexamination is mailed. Any request for an extension of time filed prior to the first action will be denied.
>
> ...
>
> 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 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 non-final Office action was mailed 27 March 2009. The patent owner submitted a timely filed the petition on 15 April 2009 with the appropriate fee and certificate of service.

The petition dated 15 April 2009 articulates the complexity of the lengthy Office action with its many rejections as well as the number of concurrently handled proceedings by the patent owner. While concurrent proceedings are generally not considered to rise to the level of sufficient cause, on balance, the petitioner has demonstrated "sufficient cause" to grant a one (1) month extension of time based upon the length, complexity of the Office action and consideration of a declaration.

The petition request to extend the response time by six (6) weeks is hereby granted-in-part.

The time granted is one (1) month

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 27 March 2009 is hereby **granted-in-part.**

2. The period for response is extended by one (1) month.

3. The Patent Owner's response is due **27 June 2009.**

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

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

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

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

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

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

/Mark Reinhart/
for

Gregory Morse,
Director,
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,029	02/28/2008	6459806	89310.0002	5797

41230 7590 07/22/2009

CUMMINS-ALLISON CORP.
C/O NIXON PEABODY LLP
300 S. Riverside Plaza
16th Floor
CHICAGO, IL 60606

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 07/22/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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Date: JUL 22 2009

CENTRAL REEXAMINATION UNIT

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
CONLEY ROSE, P.C.
DAVID A. ROSE
P.O. BOX 3267
HOUSTON, TX 77253-3267

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001029
PATENT NO. : 6459806
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 Patent
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

MAILED
JUL 22 2009
CENTRAL REEXAMINATION UNIT

Stephen G. Rudisill (For Patent Owner)
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Chicago, Illinois 60606

Collin A. Rose (For Third Party Requester)
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In re Raterman et al.
Inter Partes Reexamination Proceeding
Control No. 95/001,029
Filed: February 28, 2008
For: U.S. Patent No. 6,459,806

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

This is a decision on the May 20, 2009 patent owner petition entitled "REQUEST FOR SUSPENSION OF THE RULES PURSUANT TO 37 CFR SECTION 1.183," as supplemented on June 29, 2009. The petition (as supplemented) requests suspension of the requirement of 37 CFR 1.943(b) that the response by patent owner not exceed fifty (50) pages in length, and requests that the page limit be extended to 118 pages in order to fully respond to the March 27, 2009 non-final Office action. Patent owner concurrently filed a timely response to the Office action with the supplemental petition.

The patent owner petition and *inter partes* reexamination control number 95/001,029 are 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 76 pages in length, excluding amendments, 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 petition under 37 CFR 1.183 was charged to patent owner's Deposit Account No. 50-4181 on May 20, 2009.

REVIEW OF THE RELEVANT FACTS

1. U.S. Patent No. 6,459,806 ("the '806 patent") issued to Raterman et al. on October 1, 2002, and is currently assigned to Cummins-Allison Corp.

2. The '806 patent is the subject of civil litigation captioned *Cummins-Allison Corp., v. Shinwoo Information & Telecommunications Co., Ltd. and Amro-Asian Trade, Inc.*, U.S. District Court for the Eastern District of Texas, Civil Action No. 9:07cv196, which commenced on August 27, 2007.

3. On February 7, 2008, a request for *inter partes* reexamination of the '806 patent, assigned control No. 95/001,029 (the '1029 proceeding) was initially deposited by third party requester and, requester received a filing date of February 28, 2008. Amro-Asian Trade, Inc., is identified as the real party in interest (hereafter "third party requester").

4. On May 22, 2008, the Office issued an order granting the request for *inter partes* reexamination of claims 1-133, i.e., all of the '806 patent claims.

5. On March 27, 2009, a non-final Office action rejecting claims 1-133 was mailed.

6. On April 15, 2009, patent owner filed a petition entitled "REQUEST FOR SIX-WEEK EXTENSION OF TIME PURSUANT TO 37 C.F.R. § 1.550(c)" to extend the time to respond to the Office action to July 8, 2009.

7. On May 6, 2009, the Office mailed a decision on the April 15, 2009 patent owner petition, extending the period to respond (to the March 27, 2009 Office action) by one month to June 27, 2009. The patent owner petition was treated as a petition under 37 CFR 1.956 (patent owner extensions of time in *inter partes* reexamination).

8. On May 20, 2009, patent owner filed the present petition entitled "REQUEST FOR SUSPENSION OF THE RULES PURSUANT TO 37 CFR SECTION 1.183," as supplemented on June 29, 2009.

9. On June 29, 2009, patent owner filed a timely response to the March 27, 2009 Office action concurrently with a supplemental petition for waiver of 37 CFR 1.943(b) with respect to the submitted 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), (TYPES OF PAPERS RETURNED WITH CENTRAL REEXAMINATION UNIT DIRECTOR OR REEXAMINATION LEGAL ADVISOR APPROVAL REQUIRED), provides in pertinent part:

*****

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

I. PATENT OWNER'S PETITION

In the instant petition (as supplemented on June 29, 2009), 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 27, 2009 non-final Office action, and requests that the page limit be extended to 118 pages.[1] In support for waiver of the rule, patent owner indicates that the non-final Office action: 1) rejected all 133 claims of the patent at issue, 2) adopted or adopted as modified 20 of the 22 proposed

[1] Supplemental Petition at page 1.

grounds of rejections, 3) incorporated over 280 paragraphs of the proposed rejections set forth by the Requester in the claims charts submitted with the Request for Reexamination, and 4) relied on both of Requester's declarations and 14 prior art references.[2]

II. ANALYSIS AND FINDINGS

The March 27, 2009 non-final Office action is 19 pages (excluding 3 cover sheets, and 1 page of correspondence information) and incorporates by reference 283 paragraphs of the proposed rejections in the Request for Reexamination.[3] A review of the claim charts submitted in the Request shows that each paragraph of proposed rejection is approximately half a page in length. Hence, the non-final Office action is effectively substantively 160 pages in length.

In this instance, petitioner has made a showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft a patent owner's response in compliance with the 50-page limit, and submitting the resulting response, which is in excess of 50 pages, concurrently with the June 29, 2009 supplemental petition for waiver of 37 CFR 1.943(b) with respect to the submitted response. The patent owner response (excluding 15 pages of claims and one cover sheet) consists of 70 pages of arguments, five declarations, and five exhibits. Petitioner asserts that each of the five exhibits is a portion of a deposition transcript, product literature, or contemporaneous notes that do not constitute argument or opinion under MPEP § 2667.[4] Therefore, these five exhibits are not counted toward the page limit.

It is noted that, any portion of an affidavit/declaration that does not strictly adhere to presenting and explaining the evidence is subject to the 50-page limit of 37 CFR 1.943. Thus, opinion evidence that goes beyond explaining the evidence - legal assertions and conclusions, 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.

A review of the declarations submitted with the patent owner response reveals that three of the five declarations contain legal conclusions. Specific findings: The declaration of Geoffrey Young and the declaration of William Jones[5] are not found to contain legal arguments and conclusions regarding the prior art applied in the non-final Office action; thus, these two declarations are not counted as remarks falling within the 37 CFR 1.943(b) page limit. The declarations of Francisco Lopez, Douglas Mennie, and John Diblasio are found to contain legal conclusions as follows:

---

[2] Petition at page 2.

[3] See summary of proposed grounds of rejection on page 19 of the March 27, 2009 non-final Office action.

[4] Supplemental petition at page 2.

[5] It is noted that on page 4 of the Jones declaration, the statement "This invention is claimed in the '806 patent, and the fact that it was needed for such a long time is strong evidence that it was not obvious to those of ordinary skill, in this art, including Glory, Toshiba and De La Rue" is peripheral to the evidence of long-felt need proffered in the declaration and is not a legal conclusion that is necessary in the declaration. Similarly, on pages 7-8 of the Jones declaration, the statement "This failure by all those working on this problem around the world, to make such a machine after 20 years of trying, is convincing evidence that the solution to the problem was NOT obvious" is peripheral to the evidence of failure of others proffered in the declaration and is not a legal conclusion that is necessary in the declaration.

On page 4 of the Lopez declaration, Mr. Lopez asserts, "DLR3000 does not qualify as a printed publication because it was not publicly disseminated or accessible." (While evidence showing extent of dissemination or accessibility, or lack thereof would be proper, this statement goes further than the presentation of the evidence.)

On page 5 of the Lopez declaration, Mr. Lopez asserts, "...these documents did not place one of ordinary skill in the art in possession of this required feature of the claims of the '456 and '806 patents."

On page 6 of the Lopez declaration, Mr. Lopez asserts, "Without this information, the document was non-enabling of the verification function, and it was certainly non-enabling for the denominating function required in the '456 and '806 claims."

On page 2 of the Mennie declaration, Mr. Mennie asserts, "The Specification on Toshiba Currency Fitness Sorter Model CF-401 ("Toshiba") does not enable one skilled in the art of currency discrimination to make a currency denominating device as disclosed and claimed in Cummins' patents without undue experimentation."

On page 5 of the Mennie declaration, Mr. Mennie asserts, "It would certainly not have occurred to a person of ordinary skill in the art reading this document that one or more of the stackers could or should have been eliminated. Such a modification would have been contrary to the entire content of the document."

On page 4 of the Diblasio declaration, Mr. Diblasio asserts, "Furthermore, the Jones '804 patent does not teach or suggest a currency denominating device that can count and denominate bills at the high rates claimed in the '456 patent...The Jones '804 patent provides no teachings or suggestions..."

Combined, the Lopez, Mennie, and Diblasio declarations total six pages of substantive argument/commentary.

Therefore, *in toto*, the patent owner response is 76 pages in length (70 pages in the remarks section and 6 pages from the declarations).

Upon review of the submitted response for economizing, extraneous material, and arrangement, without repetition of information already of record, it is found that the 26 pages of arguments in excess of 50 required to complete the patent owner's response are not unreasonable in this instance, in view of the present facts and circumstances.

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 present *inter partes* reexamination proceeding, the instant patent owner petition is deemed to establish that a waiver of 37 CFR 1.943(b) to the extent of permitting patent owner's response to run 76 pages in length is appropriate in the interest of justice.

Accordingly, the patent owner petition under 37 CFR 1.183 is **granted** to the extent that the page limit of 37 CFR 1.943(b) is waived as to the **26 pages** of the arguments portion of the patent owner's June 29, 2009 response 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 that any written comments by third party requester filed after the patent owner's response as set forth in this decision shall not exceed 76 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 in-part, and the page limit of 37 CFR 1.943(b) is waived to the extent that patent owner's response to the March 27, 2009 Office action not exceed 76 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 March 27, 2009 Office action page-length compliant.

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 76 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 '1029 reexamination proceeding is returned to the Central Reexamination Unit (CRU) to await the filing of any party papers, and to process any and all party papers at the point where there is no further time remaining for filing such papers. After the Central Reexamination Unit has processed all party papers, or there are no such papers and the time for filing same has expired, jurisdiction will be transferred to the primary examiner for appropriate action on the proceeding.

4. Telephone inquiries 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

Kenpet7/ 7-21-09

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,030	02/26/2008	6985494	12566/40	8011

50048 7590 08/05/2008

MIELE LAW GROUP, PC
36 LOVERING STREET
MEDWAY, MA 02053

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 08/05/2008

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

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Commissioner for Patents
United States Patents and Trademark Office
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

KENYON & KENYON LLP
RIVERPARK TOWERS, SUITE 600
333 W. SAN CARLOS ST.
SAN JOSE, CA 95110

Date:

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 95001030
PATENT NO. : 6985494
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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AUG 05 2008

CENTRAL REEXAMINATION UNIT

Miele Law Group, PC
36 Lovering Street
Medway, MA 02053

(For Patent Owner)

Kenyon & Kenyon LLP
Riverpark Towers Suite 600
333 W. San Carlos Street
San Jose, CA 95110

(For Third Party Requester)

In re Reexamination Proceedings :
Thompson :
Control No. 95/001,030 :
Filed: February 26, 2008 :
For: U.S. Patent No. 6,985,494 :

DECISION GRANTING PETITION

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on July 14, 2008, for entry of late papers based upon unintentional delay.

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

37 CFR 1.137(b) states:

> "(b) *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 §§ 1.55(d) or 1.957(b) or (c), or a lapsed patent. A grantable petition pursuant to this paragraph must be accompanied by: (1) The reply required to the outstanding Office action or notice, unless previously filed; (2) The petition fee as set forth in § 1.17(m); (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional; and (4) Any terminal disclaimer (and fee as set forth in § 1.20(d) required pursuant to paragraph (d) of this section."

A review of the present petition reveals that it includes the requisite $770.00 fee under 37 CFR 1.17(m), and a response to the outstanding Office action was filed on June 30, 2008. Petitioner incorrectly noted in the July 14, 2008 petition that the reply to the Office action was filed on June 25, 2008. The third party requester filed comments after the patent owner response, and such comments are timely filed.

Petitioner has provided the response required by 37 CFR 1.137(b) (item 1). Payment of the requisite unintentional delay fee for a small entity has been made (item 2). The petition contains the proper statement for unintentional delay in filing the required response (item 3). A terminal disclaimer pursuant to 37 CFR 1.137 is not required in reexamination (item 4).

Accordingly, the present petition under 37 CFR 1.137(b) is granted.

CONCLUSION

1. The petition for entry of late papers is **granted.**

2. Jurisdiction over the reexamination proceeding is being returned to the Central Reexamination Unit (CRU) for processing of any papers not yet processed, after which jurisdiction will be returned to (CRU) Art Unit 3992 for consideration of the proceeding.

3. Telephone inquiries with regard to this decision should be directed to Kenneth M. Schor at 571-272-7710.

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

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.
95/001,031	03/11/2008	7,113,152	TI-65980XX	1945

49443 7590 11/18/2008

Pearl Cohen Zedek Latzer, LLP
1500 Broadway
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New York, NY 10036

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 11/18/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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.
95/001,031	03/11/08	7113152	

EXAMINER
LEE,CHRISTOPHER

CHARLES A. BRILL
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ART UNIT	PAPER
3992	

DATE MAILED:

11/18/08

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
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(For 95/000,347 Requester)

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P.O. BOX 655474, M/S 3999
DALLAS, TX 75265

(For 95/001,031 Requester)

MAILED

NOV 18 2008

CENTRAL REEXAMINATION UNIT

Inter Partes Reexamination Proceeding
Control No. 95/000,348
Filed: February 19, 2008
For: U.S. Patent No. 7,113,152

Inter Partes Reexamination Proceeding
Control No. 95/000,347
Filed: February 19, 2008
For: U.S. Patent No. 7,113,152

Inter Partes Reexamination Proceeding
Control No. 95/001,031
Filed: March 11, 2008
For: U.S. Patent No. 7,113,152

DECISION GRANTING PETITION TO MERGE REEXAMINATION PROCEEDINGS

This is a decision on the third party requester petition entitled "Petition To Merge Multiple Copending Reexamination Proceedings Under M.P.E.P. § 2686.01(VI)" filed September 16, 2008 in *inter partes* Reexamination Control No. 95/000,348, requesting that the above-captioned reexamination proceedings be merged.

The petition is before the Office of Patent Legal Administration for consideration of whether the proceedings should be merged under 37 CFR 1.989 at this time.

The petition is granted.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 7,113,152 (the '152 patent) issued to Ben-David *et al.* on September 26, 2006.

2. A request for *inter partes* reexamination of claims 1-10 of the '152 patent was filed on February 19, 2008, by third party requester Samsung Electronics Co., Ltd. (Samsung), and the request was assigned control number 95/000,348 (the '348 *inter partes* proceeding).

3. A request for *inter partes* reexamination of claims 1-10 of the '152 patent was filed on February 19, 2008, by third party requester Mitsubishi Electric Corporation and Mitsubishi Digital Electronics America, Inc. (hereinafter, collectively identified as "third party requester Mitsubishi"), and the request was assigned control number 95/000,347 (the '347 *inter partes* proceeding).

4. A request for *inter partes* reexamination of claims 1-10 of the '152 patent was initially deposited on February 14, 2008, by third party requester Texas Instruments Incorporated (Texas Instruments), and the request was assigned control number 95/001,031 (the '1031 *inter partes* proceeding) and subsequently received a filing date of March 11, 2008.

5. On May 2, 2008, *inter partes* reexamination was ordered in the '347 *inter partes* proceeding for claims 1-10 of the '152 patent, based on the examiner's determination that the February 19, 2008 request raised a substantial new question of patentability affecting these claims.

6. On May 10, 2008, *inter partes* reexamination was ordered in the '348 *inter partes* proceeding for claims 1-10 of the '152 patent, based on the examiner's determination that the February 19, 2008 request raised a substantial new question of patentability affecting these claims.

7. On May 14, 2008, *inter partes* reexamination was ordered in the '1031 *inter partes* proceeding for claims 1-10 of the '152 patent, based on the examiner's determination that the March 11, 2008 request raised a substantial new question of patentability affecting these claims.

8. On September 16, 2008, the instant petition was filed in the '348 *inter partes* proceeding by third party requester Samsung. The petition was re-filed on September 17, 2008.

DECISION

I. MERGER OF PROCEEDINGS

Reexamination has been ordered in three proceedings for the same claims of the same patent. All three reexamination proceedings are currently pending, and have not been terminated. Therefore, consideration of merger pursuant to 37 CFR 1.989 is ripe at this point in time.

37 CFR 1.989 provides:

> (a) If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the merged examination will normally result in the issuance of a single reexamination certificate under § 1.997.
>
> (b) An *inter partes* reexamination proceeding filed under § 1.913 which is merged with an *ex parte* reexamination proceeding filed under § 1.510 will result in the merged proceeding being governed by §§ 1.902 through 1.997, except that the rights of any third party requester of the *ex parte* reexamination shall be governed by §§ 1.510 through 1.560.

The petition filed September 16, 2008 in the '348 *inter partes* proceeding is granted.

In accordance with 37 CFR 1.989(a), the 95/000,348, 95/000,347, and 95/001,031 proceedings are merged. The merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

The claims are identical in all three proceedings. The patent owner is required to continue to maintain the same claims (and specification) in each of the three files throughout the merged proceeding.

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

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

B. Papers mailed/filed:

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

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

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

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

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

Patent owner and third party requesters are reminded that every paper filed in the merged proceeding subsequent to this decision must be served on all of the other parties (including papers filed *via* facsimile transmission), and every paper filed must reflect that such paper was served on all the other parties, pursuant to 37 CFR 1.903. All patent owner and requester papers are to be addressed to the Central Reexamination Unit as provided above.

C. Amendments:

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

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

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

D. Fees:

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

E. Citation of Patents and Printed Publications:

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

CONCLUSION

1. The petition requesting merger is granted.

2. *Inter partes* Reexamination Control No. 95/000,348, *inter partes* Reexamination Control No. 95/000,347, and *inter partes* Reexamination Control No. 95/001,031 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

2. Jurisdiction over the merged reexamination files is being forwarded via the Director of the Central Reexamination Unit (CRU) to the examiner for the preparation of an Office action, to be issued in due course for the merged proceeding.

3. Any questions concerning this communication should be directed to Eugenia Jones, Senior Legal Advisor, at 571-272-7727.

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

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.
95/001,034	03/19/2008	6853714	ATT/005	9952

7590 06/27/2008

EXAMINER	

THRASHER ASSOCIATES, LLC
STEVEN THRASHER
391 SANDHILL DRIVE
SUITE 1600
RICHARDSON, TX 75080

ART UNIT	PAPER NUMBER

DATE MAILED: 06/27/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

PATTERSON & SHERIDAN L.L.P. NJ OFFICE
595 SHREWSBURY AVE, STE 100
FIRST FLOOR
SHREWSBURY, NJ 07702

MAILED

JUN 27 2008

CENTRAL REEXAMINATION UNIT

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

REEXAMINATION CONTROL NUMBER *95/001,034*.

PATENT NUMBER *6,853,714*.

TECHNOLOGY CENTER *3992*.

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

Thrasher Associates, LLC (For Patent Owner)
Steven Thrasher
391 Sandhill Drive
Suite 1600
Richardson, TX 75080

MAILED

JUN 27 2008

CENTRAL REEXAMINATION UNIT

Richard D. McLeod (For 95/001,024 Requester)
Klarquist Sparkman LLP
121 SW Salmon Street
Portland, OR 97204

Patterson & Sheridan LLP NJ Office (For 95/001,034 Requester)
595 Shrewsbury Ave, Ste 100
First Floor
Shrewsbury, NJ 07702

In re Liljestrand et al.
Inter partes Reexamination Proceeding
Control No. 95/001,024
Filed: December 31, 2007
For: U.S. Patent No. 6,853,714

In re Liljestrand et al.
Inter partes Reexamination Proceeding
Control No. 95/001,034
Filed: March 19, 2008
For: U.S. Patent No. 6,853,714

DECISION, *SUA SPONTE*,
TO MERGE REEXAMINATION
PROCEEDINGS

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

REVIEW OF FACTS

1. United States Patent Number 6,853,714 (the '714 patent) issued to Keith A. Liljestrand et al. on February 23, 2001, with 9 claims.

2. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/001,024 ('024), was filed on December 31, 2007, by a first third party requester.

3. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/001,034 ('034), was filed on March 19, 2008, by a second third party requester.

4. An order granting *inter partes* reexamination of claims 1-9 of the '714 patent was mailed for the '024 reexamination proceeding on March 14, 2008.

5. An order granting *inter partes* reexamination of claims 1-9 of the '714 patent was mailed for the '034 reexamination proceeding on April 25, 2008.

DECISION

I. MERGER OF PROCEEDINGS

Under 37 CFR 1.989(a):

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

As evidenced by the above review of facts, both the '024 and the '034 reexamination proceedings are currently pending. The order to reexamine has been mailed for both reexamination proceedings, and a decision under 37 CFR 1.989(a) is timely.

The general policy of the Office is that two reexamination proceedings will not be conducted separately, and at the same time, as to a particular patent. The rationale for this policy is (1) to prevent inconsistent, and possibly conflicting, amendments from being introduced into the two proceedings on behalf of the patent owner, (2) to provide a comprehensive examination of the patent based on the issues raised in both of the proceedings, and (3) to expedite the prosecution of both proceedings. In the present instance, merger of the 95/001,024 and 95/001,034 reexamination proceedings would address these considerations. Thus, pursuant to 37 CFR 1.989(a), the 95/001,024 and 95/001,034 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 reexamination proceedings. The patent owner is required to continue to maintain the same claims (and specification) in both files *throughout the merged proceeding.*

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

The present decision merges an *inter partes* reexamination proceeding with another *inter partes* reexamination proceeding. Pursuant to 37 CFR 1.989(b), the merged proceeding is governed by 37 CFR 1.902 through 1.997.

B. Papers mailed/filed:

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

All papers that are filed by the patent owner and the third party requesters should be directed:

By U.S. Postal Service Mail:

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

By FAX to:

(571) 273-990100
Central Reexamination Unit

By hand (or delivery service):

Customer Service Window
Attn: Central Reexamination Unit
Randolph Building, Lobby Level
401 Dulaney St.
Alexandria, VA 22314

The patent owner and the requesters are reminded that every paper filed in the merged proceeding subsequent to this decision must be served on the other parties, including papers filed *via* facsimile transmission.

C. Amendments:

The filing of any amendments to the specification, claims, and drawings must comply with the provisions of 37 CFR 1.530 and the guidelines of MPEP § 2666. 37 CFR 1.121 does not apply to amendments in a reexamination proceeding. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via markings pursuant to 37 CFR 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

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

D. Fees:

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

E. Citation of Patents and Printed Publications:

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

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/001,024 and *inter partes* Reexamination Control No. 95/001,034 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 Kenneth M. Schor in the Office of Patent Legal Administration, at (571)272-7710.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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Alexandria, VA 22313-1450
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MAR 25 2009

CENTRAL REEXAMINATION UNIT

Craig J Cox
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DALLAS TX 75201-2784

(For Patent Owner)

David J. Cushing
SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

(For Third Party Requester)

DECISION
DISMISSING
AS MOOT
EXTENSION
OF TIME
[37 CFR § 1.956]

In re: Feeley *et alia*
Inter Partes Reexamination Proceeding
Control No. 95/001,036
Deposited on: 21 November 2006
For: US Patent No. 7,139,404

This is a decision on the patent owner's "Petition for Extension of Time Under 37 CFR § 1.956" submitted 17 March 2009."

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

The petition is dismissed as moot.

Statement of Relevant Facts

1. On 21 November 2006 US patent No. 7,139,404 was granted.

2. On 2 April 2008 a request for reexamination was filed by a third party requester for *Inter Partes* Reexamination with the Office.

3. On 12 June 2008 an Order Granting Request for *Inter Partes* Reexamination was mailed.

4. On 25 February 2009 a non-final Office action was mailed setting a time for response of one (1) month.

5. On 26 February 2009 a petition for a one (1) month extension of time was received.

6. On 5 March 2009 the petition was granted.

7. On 11 March 2009 a corrected non-Final was mailed setting a one (1) month period for response.

8. On 17 March 2009 the patent owner submitted the instant petition seeking an extension of time for which to respond to the outstanding Office action.

9. On 18 March 2009 an extension of time was granted *sua sponte* to correct the period for response in the action mailed 11 March 2009.

Discussion

The instant petition seeks extension of time for response to the corrected Office action mailed on 11 March 2009. The Office upon realizing that the period for response was shortened by the corrected Office action extended the period for response *sua sponte* in a decision mailed on 18 March 2009. Since the period for response has already been extended to the requested response date sought in the instant petition filed on 17 March 2009 the petition is dismissed as moot.

> **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 period for response was corrected *sua sponte* on 18 March 2009 to 11 May 2009. The petition for extension of time seeking extension of time to 11 May 2009 is dismissed as moot.

The petition submitted 17 March 2009 is dismissed as moot

Conclusion

1. The patent owner's time for response to the corrected Office action mailed on 11 March 2009 is **two (2) months**.

2. The response period will end on **11 May 2009**.

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

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

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

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

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

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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Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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JUN 23 2009

CENTRAL REEXAMINATION UNIT

Craig J. Cox
FULBRIGHT & JAWORSKI L.L.P.
2200 ROSS AVENUE
SUITE 2800
DALLAS, TX 75201-2784

(For Patent Owner)

David J. Cushing
SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVE. NW
SUITE 800
WASHINGTON, DC 20037

(For Third Party Requester)

In re Feeley et al.
Inter Partes Reexamination Proceeding
Control No. 95/001,036
Filed: April 2, 2008
For: U.S. Patent No. 7,139,404

DECISION GRANTING PETITION

This is a decision on patent owner's petition entitled "PETITION UNDER 37 C.F.R. 1.183 TO WAIVE THE PAGE LIMIT REQUIREMENTS WITH RESPECT TO PATENT OWNER'S RESPONSE TO OFFICE ACTION OF MARCH 11, 2009" filed on May 11, 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 deposit account, as authorized on page 4 of the petition.

The petition under 37 CFR 1.183 is granted.

REVIEW OF THE RELEVANT FACTS

1. On Nov. 21, 2006, United States Patent Number 7,139,404 (the '404 patent) issued with 45 claims.

2. On April 2, 2008, a request for *inter partes* reexamination of the '404 patent was filed by a third party requester, K/S hearing Instrument Manufacturers Patent Partnership (HIMPP), and was assigned Reexamination Control No. 95/001,036 (the '1036 proceeding).

3. On June 12, 2008, the Office issued an order granting *inter partes* reexamination of claims 1-45 of the '404 patent in the '1036 proceeding.

4. On February 25, 2009, the first non-final Office action rejecting claims 1-45 was mailed.

5. A request for an extension of time filed February 26, 2009, was granted on March 5, 2009, extending the period for response to April 27, 2009.

6. A petition requesting a new Office action was filed on March 3, 2009. A new Office action was issued on March 11, 2009.

7. On March 18, 2009, the period for response was extended *sua sponte* to May 11, 2009. A March 17, 2009 request for an extension of time was dismissed as moot on March 25, 2009.

8. A renewed petition requesting a new Office action was filed on March 20, 2009, followed by a supplemental petition on March 30, 2009.

9. On May 11, 2009, a response to the non-final Office action was filed by patent owner, accompanied by a petition to waive the page limit requirement for the response. The petition is the subject of this decision.

10. On June 10, 2009, the third party requestor filed requestor comments under 37 CFR 1.947.

DECISION

37 CFR 1.183 provides:

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

37 CFR 1.943(b) provides:

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

In this instance, on May 11, 2009, concurrently with the present petition under 37 CFR 1.183, patent owner filed a response to the March 11, 2009 Office action, with appendices accompanying the response. Patent owner asserts that the May 11, 2009 response includes 125 total pages of arguments and witness testimony in declarations attached to the response. Thus,

based on patent owner's assertions, the argument portions of patent owner's response and accompanying declarations exceed the 50-page limit set forth in 37 CFR 1.943(b) by 75 pages.[1]

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 May 11, 2009 petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b). Further, in the 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 March 11, 2009 Office action. Additionally, patent owner has provided detailed explanations of how the submitted response consolidates arguments and cross references common issues and arguments.[2]

Based on the specific facts and explanations 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 draft a response in compliance with the 50-page limit and submitting the resulting response, 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 May 11, 2009 response and accompanying declarations exceed the 50-page limit by 66 pages.

Accordingly, patent owner's petition under 37 CFR 1.183 is granted to the extent that the page limit of 37 CFR 1.943(b) is waived as to the 66 pages of the argument portions of patent owner's May 11, 2009 response that exceed the 50-page limit.

Additional discussion: It is noted that the third party requestor has already filed responsive comments in a document that is less than 50 pages.[3] Patent owner and the third party requestor should note that, with respect to any future requests for waiver of the page limit requirements, submissions must be in at least 12 point font and double spaced, with appropriate margins.

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 66 pages of the argument portions of patent owner's May 11, 2009 response that exceed the 50-page limit.

2. Jurisdiction for the '1036 reexamination proceeding is returned to the Central Reexamination Unit (CRU).

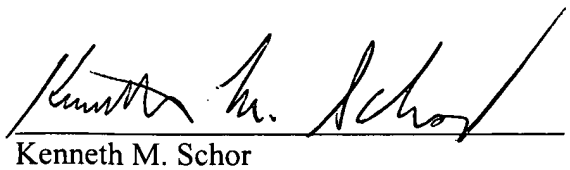
---

[1] Only those pages of patent owner's response upon which arguments appear will be included against the page limit count. *See* MPEP 2667(I)(A)(2). It appears that the response only includes 116 pages, which exceeds the page limit by 66 pages.

[2] *See* Fact 9, petition under 1.183 at page 3.

[3] *See* Fact 10, third party comments.

3. Any questions concerning this communication should be directed to Caroline D. Dennison, Legal Advisor, at (571) 272-7729.



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

6-18-09
Kenpet7\IP\length

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Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,037	04/10/2008	7162458	8332.001.458	7186

7590 03/18/2010

MAUREEN STRETCH
26 CHARLES STREET
NATICK, MA 01760

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/18/2010

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

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NOVAK, DRUCE & QUIGG(NDQ REEXAMINATION GROUP)
1000 Louisiana Street, 53rd Floor
Houston, TX 77002

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MAR 18 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NUMBER *95/001,037*.

PATENT NUMBER *7,162,458*.

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.
95/001,037	04/10/08	7162458	8332.001.458

EXAMINER
GRAHAM, MATTHEW

ART UNIT	PAPER
3993	

NOVAK, DRUCE & QUIGG
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET
53th FLOOR
HOUSTON, TX 77002

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INTER PARTES REEXAMINATION COMMUNICATION

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

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Maureen Stretch
26 Charles Street
Natick, MA 01760

(For Patent Owner)

MAILED

MAR 18 2010

CENTRAL REEXAMINATION UNIT

Novak, Druce & Quigg LLP
(NDQ Reexamination Group)
1000 Louisiana Street
53rd Floor
Houston, TX 77002

(For Requester)

In re William J. Flanagan et al.
Inter Partes Reexamination Proceeding
Control No. 95/001,037
Filed: April 10, 2008
For: U.S. Patent No. 7,162,458

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

This is a decision on the September 25, 2009 patent owner petition under 37 CFR 1.137(b) to accept patent owner's late Response After Action Closing Prosecution in the above-identified reexamination proceeding ("the September 25, 2009 patent owner petition").

Third party requester filed Third Party Requestor's Opposition To Patent Owner's Petition For Entry Of Late Papers For Revival Of Reexamination Proceeding on October 25, 2009 ("the October 25, 2009 third party requester opposition petition").

Both the September 25, 2009 patent owner petition and the October 25, 2009 third party requester opposition petition are before the Office of Patent Legal Administration (OPLA) for consideration. In this instance, the October 25, 2009 third party requester opposition petition is being considered, since it does not challenge the merits of whether the requirements of 37 CFR 1.137(b) have been met. Instead, the opposition petition challenges the jurisdictional basis for granting a 1.137(b) petition on the present facts.

Patent owner has been charged the petition fee of $1,620.00 set forth in 37 CFR 1.17(m) for the September 25, 2009 patent owner petition. In accordance with the authorization at page 2 of the October 25, 2009 third party requester opposition petition, third party requester has been charged the petition fee of $400.00 set forth in

37 CFR 1.17(f) for the October 25, 2009 third party requester opposition petition, which is being treated as a petition under 37 CFR 1.182.

The September 25, 2009 patent owner petition is **dismissed**.

STATUTES, LEGISLATIVE HISTORY, REGULATIONS, AND PATENT EXAMINING PROCEDURES

35 U.S.C. 41(a)(7), as amended by the AIPA of 1999 to include reexamination, provides (emphasis added):

> REVIVAL FEES. — On filing each petition for the revival of an unintentionally abandoned application for a patent, for the unintentionally delayed payment of the fee for issuing each patent, or for an unintentionally delayed ***response*** by the patent owner in any reexamination proceeding, $1,500, unless the petition is filed under section 133 or 151 of this title, in which case the fee shall be $500.

The legislative history on the 1999 AIPA amendment to 35 U.S.C. 41(a)(7) provides (emphasis added):

> Sec. 4605. Conforming amendments
>
> Section 4605 makes the following conforming amendments to the Patent Act:
>
> A patent owner must pay a fee of $1,210 for each petition in connection with an unintentionally abandoned application, delayed payment, or delayed ***response*** by the patent owner during any reexamination.
>
> [145 Cong. Rec. S14,708, 14,720 (1999) (daily ed. Nov. 17, 1999)]

As to unavoidable delay, 35 U.S.C. 133 provides (emphasis added):

> Upon ***failure of the applicant to prosecute*** the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Director in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Director that such delay was unavoidable.

37 CFR 1.137. Revival of abandoned application, terminated reexamination proceeding, or lapsed patent.

> (a) *Unavoidable.* If the delay in ***reply by*** applicant or ***patent owner*** was unavoidable, a petition may be filed pursuant to this paragraph ***to revive*** an abandoned application, ***a reexamination prosecution terminated under §§ 1.550(d) or 1.957(b) or***

limited under § 1.957(c), or a lapsed patent. 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;

*

*

*

(b) *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 prosecution 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;

[Bold and italicized emphasis added; italicized emphasis in the original.]

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

(a) After an Office action closing prosecution in an *inter partes* reexamination, the patent owner may once file ***comments*** limited to the issues raised in the Office action closing prosecution. The ***comments can include a proposed amendment to the claims***, which amendment will be subject to the criteria of § 1.116 as to whether or not it shall be admitted. The comments must be filed within the time set for response in the Office action closing prosecution.

[Bold and italicized emphasis added; italicized emphasis in the original.]

37 CFR 1.957. Failure to file a timely, appropriate or complete response or comment in *inter partes* reexamination.

*

(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.

[Bold and italicized emphasis added; italicized emphasis in the original.]

37 CFR 1.958. Petition to *revive inter partes* reexamination prosecution *terminated for lack of patent owner response.*

(a) If ***a response*** by the patent owner is not timely filed in the Office, the delay in filing such response may be excused if it is shown to the satisfaction of the Director that the delay was unavoidable. A grantable petition to accept an unavoidably delayed ***response*** must be filed in compliance with § 1.137(a).

(b) Any ***response*** by the patent owner not timely filed in the Office may be accepted if the delay was unintentional. A grantable petition to accept an unintentionally delayed ***response*** must be filed in compliance with § 1.137(b).

[Emphasis added.]

MPEP 2672, part II provides (emphasis added):

The patent owner ***submission under 37 CFR 1.951(a) of comments and/or proposed amendment*** must be filed within the time period set for response to the ACP. Normally, the ACP will set a period of 30 days or one month (whichever is longer) from the mailing date of the ACP.

An extension of the time period for filing the patent owner's submission under 37 CFR 1.951(a) may be requested under 37 CFR 1.956. The time period may not, however, be extended to run past 6 months from the date of the ACP.

MPEP 2672, part V is titled Patent Owner Does Not Make Submission After ACP and provides (emphasis added):

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***.

DECISION

The Petition Under 37 CFR 1.137(b) is Dismissed

On July 31, 2009, the Office issued an Action Closing Prosecution (37 CFR 1.949) ("the July 31, 2009 ACP") in the instant reexamination proceeding. The July 31, 2009 ACP

set a one month period for patent owner to file a submission pursuant to 37 CFR 1.951(a). Patent owner, however, did not file a 1.951(a) submission within the one month period. Instead, patent owner's Response After Action Closing Prosecution was filed on September 25, 2009, together with the September 25, 2009 patent owner petition under 37 CFR 1.137(b).

37 CFR 1.958(b) provides that an *inter partes* reexamination prosecution ***terminated*** for the lack of a patent owner ***response*** may be revived by filing a petition in compliance with 37 CFR 1.137(b), if patent owner's delay in filing the ***response*** was unintentional.

However, the instant reexamination proceeding is ***not terminated***. In this regard, MPEP 2672, part V, states that "where the patent owner chooses not to file a submission pursuant to 37 CFR 1.951(a), no rights of appeal are lost." Accordingly, the consequences of 37 CFR 1.957(b) and (c) do not apply where the patent owner does not file a timely 1.951(a) submission. Thus, the present reexamination proceeding is not terminated as to any of the claims based on patent owner's failure to file a timely 1.951(a) submission after the July 31, 2009 ACP, and 37 CFR §§ 1.958(b) and 1.137 do not apply to this situation.

In addition, patent owner's September 25, 2009 Response After Action Closing Prosecution is ***not a response***. 37 CFR 1.951(a) states that after an ACP, the patent owner may once file ***comments***, which may include a proposed amendment to the claims, limited to the issues raised in the ACP. Therefore, patent owner's September 25, 2009 Response After Action Closing Prosecution is properly a "comment" on the July 31, 2009 ACP, despite it being designated as a "response" by patent owner.

In view of the above, no regulatory or statutory provision supports the availability of 1.137 for relief as to late comments filed pursuant to 1.951(a) after an *inter partes* reexamination action closing prosecution.

For the foregoing reasons, the September 25, 2009 patent owner petition is **dismissed**.

A 37 CFR 1.183 petition would be the only vehicle for relief possible here, if the fact-situation met the standard of 1.183 for relief. However, to obtain relief, the situation would need to be shown to be "an extraordinary situation, when justice requires, any requirement of the regulations ... which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee...subject to such other requirements as may be imposed."

CONCLUSION

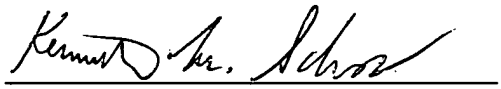
1. The September 25, 2009 patent owner petition under 37 CFR 1.137(b) to accept patent owner's unintentionally delayed Response After Action Closing Prosecution is **dismissed**.

2. Given that the September 25, 2009 patent owner petition is being dismissed, patent owner's September 25, 2009 Response After Action Closing Prosecution and third party requester's October 25, 2009 Third Party Requestor's Comments Under 37 CFR § 1.951 To Patent Owner's Response Of September 25, 2009 are not being considered, and these papers have been sealed by closing them in the Image File Wrapper (IFW) for the '1037 *inter partes* reexamination proceeding and marking them "not public." They will not constitute part of the record of the present reexamination proceeding.

3. A copy of this decision will be made of record in the '1037 reexamination file.

4. Jurisdiction over the present reexamination proceeding is being forwarded to the Central Reexamination Unit.

5. Any inquiry concerning this decision should be directed to Raul Tamayo, Legal Advisor, at (571) 272-7728.



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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,040	04/28/2008	7363167	069165.0124	9576

46764 7590 11/30/2009

EXAMINER

REILLY INTELLECTUAL PROPERTY LAW FIRM
1325 East 16th Avenue
DENVER, CO 80218

ART UNIT	PAPER NUMBER

DATE MAILED: 11/30/2009

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

BAKER BOTTS L.L.P.
PATENT DEPARTMENT
98 SAN JACINTO BLVD., SUITE 1500
AUSTIN, TX 78701-4039

Date:

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NOV 30 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001040
PATENT NO. : 7363167
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

REILLY INTELLECTULA PROPERTY LAW FIRM
1325 East 16th Avenue
Denver, CO 80218

: (For Patent Owner)

BAKER BOTTS LLP
Patent Department
98 San Jacinto Blvd., Suite 1500
Austin TX 78701-4039

: (For Third Party Requester)

In re: Csore *et alia*
Inter partes Reexamination Proceeding
Control No. 95/001,040
Deposited: April 22, 2009
For: U.S. Patent No. 7,363,167

: DECISION
: GRANTING PETITION
: FOR EXTENSION OF TIME
: (37 CFR § 1.956)

This is a decision on the November 23, 2009 patent owner's petition titled "Petition for Extension of Time for Respond Under 37 CFR § 1.956." Owner seeks fifteen (15) days additional time for response. The petition is before the Director of the Central Reexamination Unit for consideration .

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

DECISION

Patent Owner petitions the director of the Central Reexamination Unit for a fifteen (15) 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 second request for an extension of time: a one month extension was granted on October 16, 2009.

STATEMENT OF RELEVANT FACTS

1. On April 22, 2008 US patent No. 7,363,167 was granted.

2. On April 22, 2008 a request for reexamination was filed by a third party requester for Inter Partes Reexamination with the Office.

3. On September 30, 2009 an Action Closing Prosecution Office action was mailed setting a time for response for one (1) month.

4. On October 13, 2009 a petition for a thirty (30) day extension of time was received and granted on October 16, 2009.

5. On November 23, 2009 a second petition for extension of time was received. This petition requests an additional fifteen (15) days for response.

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 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.
>
> Second or subsequent requests for extensions of time, or requests for more than one month, will be granted only in **extraordinary** situations.

DISCUSSION

The Patent owner has set forth that preparation of a response to the September 30, 2009 office action is ongoing and patent owner requests additional time to prepare the response due to the relocation and illness of council. 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. Further, the situation described is deemed to rise to the level of extraordinary situation warranting granting of an additional 15 days to respond.

The extension of time of fifteen (15) additional days is hereby granted.

CONCLUSION

1. Patent owner's petition for a 15 day additional extension of time in which to file a response to the Office action dated September30, 2009 is hereby **granted**.

2. The period for response is hereby extended to **December 14, 2009.**

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,040	04/28/2008	7363167	069165.0124	9576

46764 7590 02/01/2010

REILLY INTELLECTUAL PROPERTY LAW FIRM
1325 East 16th Avenue
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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 02/01/2010

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PATENT DEPARTMENT
98 SAN JACINTO BLVD., SUITE 1500
AUSTIN, TX 78701-4039

Date: MAILED

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CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001040
PATENT NO. : 7363167
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

REILLY INTELLECTUAL PROPERTY LAW FIRM
1325 EAST 16th AVENUE
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(For Patent Owner)

BAKER BOTTS LLP
PATENT DEPARTMENT
98 SAN JACINTO BLVD, SUITE 1500
AUSTIN, TX 78701-4039

(For Third Party Requester)

In re Csore et al.
Inter Partes Reexamination Proceeding
Control No. 95/001,040
Filed: April 28, 2008
For: U.S. Patent No. 7,363,167 B2

: **DECISION**
: **DISMISSING PETITION**
: **UNDER 37 C.F.R. § 1.182**

This is a decision on the December 14, 2009 patent owner petition entitled "PETITION UNDER 37 CFR 1.182 REQUEST FOR CONTINUED REEXAMINATION."

The petition is before the Office of Patent Legal Administration.

For the reasons set forth below, the petition is **dismissed.**

BACKGROUND

- On April 22, 2008, a request for *inter partes* reexamination was filed by the third party requester, and the resulting reexamination proceeding was assigned control number 95/001,040 ("the '1040 proceeding"), with a filing date of April 28, 2008, the date that the filing requirements of 37 C.F.R. § 1.915 were received.

- Prosecution progressed until, on September 30, 2009, an Action Closing Prosecution (ACP) was issued.

- On October 16, 2009, and on November 30, 2009, the Office issued decisions granting patent owner requests for extension of time for response to the Office action dated September 30, 2009, extending the period for response set forth in 37 CFR 1.951(a) until December 14, 2009.

- On December 14, 2009 patent owner filed the following papers:
    - A paper entitled "AMENDMENT AND RESPONSE TO ACTION CLOSING PROSECUTION."
    - The instant petition entitled "PETITION UNDER 37 C.F.R. § 1.182 REQUEST FOR CONTINUED REEXAMINATION," requesting entry of the amendment and remarks filed on the same date.
    - A petition entitled "PETITION UNDER 37 C.F.R. § 1.181 – REQUEST TO ENTER AMENDMENTS AFTER ACTION CLOSING PROSECUTION," requesting entry of an amendment and remarks filed on the same date.

RELEVANT STATUTES, REGULATIONS, AND EXAMINING PROCEDURE

37 CFR 1.182 provides:

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

37 CFR 1.951(a) provides:

> After an Office action closing prosecution in an inter partes reexamination, the patent owner may once file comments limited to the issues raised in the Office action closing prosecution. The comments can include a proposed amendment to the claims, which amendment will be subject to the criteria of § 1.116 as to whether or not it shall be admitted. The comments must be filed within the time set for response in the Office action closing prosecution.

DECISION

In March of 2005, the Office issued a Notice titled "Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While an Earlier Filed Reexamination is Pending."[1] Notice was provided therein that a patent owner could file a petition under 37 C.F.R. § 1.182 requesting continued prosecution on the merits in the reexamination proceeding to seek entry of an amendment and/or evidence that was denied entry after a final rejection in an *ex parte* reexamination proceeding, or after an action closing prosecution in an *inter partes* reexamination proceeding.

---

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

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

37 C.F.R. § 1.182 addresses only those situations not otherwise provided for in the regulations. Where a situation exists such that relief is specifically provided for elsewhere in the regulations, 37 C.F.R. § 1.182 is not, according to the terms of the regulation, the appropriate mechanism for relief. 37 C.F.R. § 1.951(a) provides for the entry of comments and amendment after an ACP during the 1 month time period set for response in the ACP, subject to the criteria of 37 C.F.R. § 1.116.

The December 14, 2009, patent owner petition is filed under 37 C.F.R. § 1.182 requesting entry of amendments and remarks submitted on the same date therewith. As of the time of filing the petition under 37 C.F.R. § 1.182, the Office had not yet rendered a decision on the entry of the submission under 37 C.F.R. § 1.951(a), under 37 C.F.R. § 1.181, or under any other applicable section. Since the Office has not denied entry of the submission, the request for continuation of prosecution fails "to seek entry of an amendment and/or evidence that was denied entry . . . after an action closing prosecution," as required for the procedure set forth in the March 2005 Notice.

Furthermore, although filed under 37 C.F.R. § 1.182 requesting entry of amendment and remarks submitted on December 14, 2009, the December 14, 2009 patent owner petition has been filed within the time period set forth for response in the ACP. During this period, 37 C.F.R. § 1.951(a) specifically provides for the consideration of the comments and amendment, subject to the criteria of 37 C.F.R. § 1.116. Since patent owner's submission may be addressed through 37 C.F.R. § 1.951, consideration of the present petition under 37 C.F.R. §1.182 is premature.

To accommodate the need for statutory special dispatch in reexamination, jurisdiction is being forwarded to the Central Reexamination Unit to process the December 14, 2009 patent owner amendment and remarks (filed with the petition) as a submission under 37 C.F.R. §1.951(a), and for the examiner to treat it as such. Patent owner retains the option of filing a renewed petition under 37 C.F.R. § 1.182, if at some future date, relief has not been granted under 37 C.F.R. §1.951, 37 C.F.R. § 1.181, or through another section. Until such time, the issue presented in the instant petition under 37 C.F.R. § 1.182 is not ripe for consideration by the Office.

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

CONCLUSION

1. The petition under 37 C.F.R. § 1.182 is dismissed.

2. Prosecution is not being reopened by this decision.

3. Jurisdiction is being forwarded to the Central Reexamination Unit to process the December

14, 2009 patent owner "Amendment and Response to Action Closing Prosecution" (filed on the same date as the petition) as a submission under 37 C.F.R. § 1.951(a), and for the examiner to treat it as such.

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

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

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

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

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

5. Telephone inquiries related to this decision should be directed to Michael Cygan, Legal Advisor, at (571) 272-7700.

Kenneth Schor,
Senior Legal Advisor
Office of Patent Legal Administration

January 7, 2010
C:\Kiva\Kenpet7\RCR\IPreex\

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.
95/001,042	04/29/2008	6,926,609	8157.008.RXUS00	8185

23446 7590 08/31/2009

MCANDREWS HELD & MALLOY, LTD
500 WEST MADISON STREET
SUITE 3400
CHICAGO, IL 60661

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 08/31/2009

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
NOVAK DRUCE & QUIGG, LLP
1000 LOUISIANA STREET
FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date:

MAILED

AUG 3 1 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001042
PATENT NO. : 6926609
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

James P Murphy
MCANDREWS HELD & MALLOY, LTD
500 WEST MADISON STREET
SUITE 3400
CHICAGO IL 60661

(For Patent Owner)

MAILED

AUG 3 12009

CENTRAL REEXAMINATION UNIT

Tracy W Druce
NOVAK DRUCE & QUIGG, LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET
FIFTY-THIRD FLOOR
HOUSTON, TX 77002

(For Third Party Requester)

In re: John R Martin
Inter Partes Reexamination Proceeding
Control No. 95/001,042
Deposited on: 29 April 2008
For: US Patent No. 6,926,609

DECISION
GRANTING IN PART
PETITION FOR EXTENSION
OF TIME
[37 CFR §§ 1.956 & 1.181

This is a decision on the 19 August 2009, "Request for Extension of Time Pursuant to 37 CFR 1.956" requesting that the time for responding to the non-Final Office action mailed 10 August 2009, be extended by forty-four (44) days. The petition was timely filed.

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

The petition is granted-in-part for the reasons set forth below.

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 10 August 2009, which set a one (1) month time for filing a response thereto. The petition for extension of time was timely filed on 19 August 2009, together with electronic fee transmittal for the $200.00 petition fee as required by 37 CFR § 1.956 and 37 CFR § 1.17 (g). A certificate of service was provided with the petition.

The request is granted-in-part

> **37 CFR § 1.956. Patent owner extensions of time in inter partes reexamination.** *The time for taking any action by a patent owner in an inter partes reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified. Any request for such extension must be filed on or before the day on which action by the patent owner is due, but in no case will the mere filing of a request effect any extension. Any request for such extension must be accompanied by the petition set forth in § 1.17(g). See § 1.304(a) for extensions of time for filing a notice of appeal to the U.S. Court of Appeals for the Federal Circuit.*

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

> As noted above, a request for extension of time under 37 CFR § 1.956 will be granted only for sufficient cause, ...
>
> Evaluation of whether "sufficient cause" has been shown for an extension must be made by **balancing** the desire to provide the patent owner with a fair opportunity to respond, **against** the requirement of the statute, 35 U.S.C. § 314(c), that the proceedings be conducted with special dispatch. ...

Any petition request must include the required petition fee as set forth according to 37 CFR § 1.17 (g) and 37 CFR § 1.956.

MPEP § 2665 Extension of Time for Patent Owner Response (in-part)

> Requests for an extension of time in an inter partes reexamination proceeding will be considered only after the first Office action on the merits in the reexamination is mailed. Any request for an extension of time filed prior to the first action will be denied.

The certificate of mailing and the certificate of transmission procedures (37 CFR § 1.8), and the "Express Mail" mailing procedure (37 CFR § 1.10), may be used to file a request for extension of time, as well as any other paper in an existing *inter partes* reexamination proceeding (see MPEP § 2666).

As noted above, a request for extension of time under 37 CFR § 1.956 will be granted only for sufficient cause, and the request must be filed on or before the day on which action by the patent owner is due. In no case, will the mere filing of a request for extension of time automatically effect any extension, because the showing of cause may be insufficient or incomplete. In the prosecution of an *ex parte* reexamination, an automatic 1-month extension of time to take further action is granted upon filing a first timely response to a final Office action (see MPEP § 2272). The automatic extension given in *ex parte* reexamination does not apply to the first response to an Action Closing Prosecution (ACP) in an inter partes reexamination. The reason is that in *inter partes* reexamination, parties do not file an appeal in response to an ACP, and a further Office action (Right of Appeal Notice) will issue even if the parties make no response at all. Thus, there is no time period to appeal running against the parties after the ACP is issued, unlike ex parte reexamination where an appeal is due after final rejection and the time is thus automatically extended one month to provide time for the patent owner to review the Office's response to the amendment before deciding whether to appeal.

Evaluation of whether "sufficient cause" has been shown for an extension must be made by balancing the desire to provide the patent owner with a fair opportunity to respond, against the requirement of the statute, 35 U.S.C. § 314(c), that the proceedings be conducted with special dispatch.

Decision

The patent owner's representative petitions under 37 CFR § 1.956 to extend the period for response by adding forty-four (44) days to the period for response. The decision to extend the period for response is evaluated based upon a showing of "sufficient cause." There is always the consideration to balance the need for the patent owner to have a fair opportunity to respond to the Office action between the need for special dispatch.

The non-final Office action was mailed 10 August 2009. The patent owner submitted a timely filed the petition on 19 August 2009 with the appropriate fee and certificate of service.

The petition dated 19 August 2009 cites the complexity of the lengthy Office action with its many rejections as well as the lengthy 231 pages incorporated by reference into the Office action.. The requester further states that they require additional time for proper KSR analysis of the rejections of record. 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-in-part

CONCLUSION

1. The patent owner's petition for extension for forty-four (44) days time in which to file a response to the non-final Office action dated 10 August 2009 is hereby **granted-in-part.**

2. The period for response is extended by one (1) month.

3. The Patent Owner's response is due **10 October 2009.**

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

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

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

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

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

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

/Mark Reinhart/
for

Gregory Morse,
Director,
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,047	05/30/2008	7069235	8332.003.235	3487

33438 7590 05/27/2009

HAMILTON & TERRILE, LLP
P.O. BOX 203518
AUSTIN, TX 78720

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 05/27/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States 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.
95/001047	05/30/08	7069235	8332.003.235

EXAMINER
ENGLISH, PETER

ART UNIT	PAPER
3993	

NOVAK, DRUCE & QUIGG, LLP
ATTN: TRACY W. DRUCE
1000 LOUISIANA AVENUE
WELLS FARGO PLAZA
53th FLOOR
HOUSTON, TX 77002

DATE MAILED:

05/27/09

INTER PARTES REEXAMINATION COMMUNICATION

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/001047	05/30/08	7069235	8332.003.235

EXAMINER
ENGLISH, PETER

ART UNIT	PAPER
3993	

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WELLS FARGO PLAZA
53th FLOOR
HOUSTON, TX 77002

DATE MAILED:

INTER PARTES REEXAMINATION COMMUNICATION

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Kent. B. Chambers
HAMILTON & TERRILE, LLP
P.O. BOX 203518
AUSTIN, TX 78720

(For Patent Owner)

Tracy W. Druce
NOVAK DRUCE & QUIGG, LLP
1000 LOUISIANA AVENUE
WELLS FARGO PLAZA, 53RD FLOOR
HOUSTON, TX 77002

(For Third Party Requester)

MAILED

MAY 27 2009

CENTRAL REEXAMINATION UNIT

In re Postelnik *et al.*
Inter Partes Reexamination Proceeding
Control No.: 95/001,047
Filed: May 30, 2008
For: U.S. Patent No. 7,069,235

DECISION DISMISSING PETITION

This is a decision on the patent owner's "PETITION UNDER 37 CFR 1.183 TO WAIVE 37 CFR 1.52(e) FOR INFORMATION DISCLOSURE SUBMISSION" filed on April 13, 2009, requesting waiver of the rule to permit submission of non-patent literature documents in the form of files stored on compact disks.

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

The petition fee of $400.00 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183 was charged to patent owner's Deposit Account No. 502264, as authorized on page three of the petition.

The petition is dismissed.

REVIEW OF FACTS

1. U.S. Patent No. 7,069,235 ("the '235 patent") issued on June 27, 2006.

2. On May 30, 2008, a third party requester filed a request for *inter partes* reexamination, which proceeding was assigned Control No. 95/001,047 ("the '1047 proceeding").

3. On July 12, 2008, the Office mailed an Order granting the request for *inter partes* re-examination, accompanied by a non-final Office action.

4. Patent owner filed a response to the non-final Office action on September 12, 2008, and the third party requestor filed a corresponding comments paper on March 24, 2009.

5. On April 13, 2009, patent owner filed an Information Disclosure Statement, with a 112-page PTO Form SB/08 and 24 compact disks, and the subject petition under 37 CFR 1.183 to waive 37 CFR 1.52(e) to permit submission of the non-patent literature on the compact disks. This petition is the subject of the present decision.

DECISION

I. RELEVANT STATUTES, REGULATIONS, AND EXAMINING PROCEDURE

I. Pertinent Regulations

A. Relief Requested

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).

B. Electronic Documents

A CD is an electronic document. Submission of electronic documents is governed by 37 CFR 1.52(e).

37 CFR 1.52(e) provides in pertinent part:

> (e) *Electronic documents that are to become part of the permanent United States Patent and Trademark Office records in the file of a patent application or reexamination proceeding.*
>
> (1) The following documents may be submitted to the Office on a compact disc in compliance with this paragraph:
>
> (i) A computer program listing (see § 1.96);
>
> (ii) A "Sequence Listing" (submitted under § 1.821(c)); or
>
> (iii) Any individual table (see § 1.58) if the table is more than 50 pages in length, or if the total number of pages of all of the tables in an application exceeds 100 pages in length, where a table page is a page printed on paper in conformance with paragraph (b) of this section and § 1.58(c).
>
> (2) A compact disc as used in this part means a Compact Disc-Read Only Memory (CD-ROM) or a Compact Disc-Recordable (CD-R) in compliance with this paragraph. A CD-ROM is a "read-only" medium on which the data is pressed into the disc so that it cannot be changed or erased. A CD-R is a "write once" medium on which once the data is recorded, it is permanent and cannot be changed or erased.

(3)(i) Each compact disc must conform to the International Standards Organization (ISO) 9660 standard, and the contents of each compact disc must be in compliance with the American Standard Code for Information Interchange (ASCII). CD-R discs must be finalized so that they are closed to further writing to the CD-R.

(ii) Each compact disc must be enclosed in a hard compact disc case within an unsealed padded and protective mailing envelope and accompanied by a transmittal letter on paper in accordance with paragraph (a) of this section. The transmittal letter must list for each compact disc the machine format (e.g., IBM-PC, Macintosh), the operating system compatibility (e.g., MS-DOS, MS-Windows, Macintosh, Unix), a list of files contained on the compact disc including their names, sizes in bytes, and dates of creation, plus any other special information that is necessary to identify, maintain, and interpret (e.g., tables in landscape orientation should be identified as landscape orientation or be identified when inquired about) the information on the compact disc. Compact discs submitted to the Office will not be returned to the applicant.

(4) Any compact disc must be submitted in duplicate unless it contains only the "Sequence Listing" in computer readable form required by § 1.821(e). The compact disc and duplicate copy must be labeled "Copy 1" and "Copy 2," respectively. The transmittal letter which accompanies the compact disc must include a statement that the two compact discs are identical. In the event that the two compact discs are not identical, the Office will use the compact disc labeled "Copy 1" for further processing. Any amendment to the information on a compact disc must be by way of a replacement compact disc in compliance with this paragraph containing the substitute information, and must be accompanied by a statement that the replacement compact disc contains no new matter. The compact disc and copy must be labeled "COPY 1 REPLACEMENT MM/DD/YYYY" (with the month, day and year of creation indicated), and "COPY 2 REPLACEMENT MM/DD/YYYY," respectively.

(5) The specification must contain an incorporation-by-reference of the material on the compact disc in a separate paragraph (§ 1.77(b)(5)), identifying each compact disc by the names of the files contained on each of the compact discs, their date of creation and their sizes in bytes. The Office may require applicant to amend the specification to include in the paper portion any part of the specification previously submitted on compact disc.

(6) A compact disc must also be labeled with the following information:

(i) The name of each inventor (if known);

(ii) Title of the invention;

(iii) The docket number, or application number if known, used by the person filing the application to identify the application; and

(iv) A creation date of the compact disc.

(v) If multiple compact discs are submitted, the label shall indicate their order (e.g. "1 of X").

(vi) An indication that the disk is "Copy 1" or "Copy 2" of the submission. See paragraph (b)(4) of this section.

(7) If a file is unreadable on both copies of the disc, the unreadable file will be treated as not having been submitted. A file is unreadable if, for example, it is of a format that does not comply with the requirements of paragraph (e)(3) of this section, it is corrupted by a computer virus, or it is written onto a defective compact disc.

C. Material Information

Information submitted for consideration during a reexamination proceeding is submitted in accordance with the provisions of 37 CFR 1.555 - Information material to patentability in *ex parte* reexamination and *inter partes* reexamination proceedings.

37 CFR 1.555(a) provides in its last sentence:

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 provides:

(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.

(1) A list of all patents, publications, applications, or other information submitted for consideration by the Office. U.S. patents and U.S. patent application publications must be listed in a section separately from citations of other documents. Each page of the list must include:

(i) The application number of the application in which the information disclosure statement is being submitted;

(ii) A column that provides a space, next to each document to be considered, for the examiner's initials; and

(iii) A heading that clearly indicates that the list is an information disclosure statement.

(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.

(3)(i) A concise explanation of the relevance, as it is presently understood by the individual designated in § 1.56(c) most knowledgeable about the content of the information, of each patent, publication, or other information listed that is not in the English language. The concise explanation may be either separate from applicant's specification or incorporated therein.

(ii) A copy of the translation if a written English-language translation of a non-English-language document, or portion thereof, is within the possession, custody, or control of, or is readily available to any individual designated in § 1.56(c).

(b)(1) Each U.S. patent listed in an information disclosure statement must be identified by inventor, patent number, and issue date.

(2) Each U.S. patent application publication listed in an information disclosure statement shall be identified by applicant, patent application publication number, and publication date.

(3) Each U.S. application listed in an information disclosure statement must be identified by the inventor, application number, and filing date.

(4) Each foreign patent or published foreign patent application listed in an information disclosure statement must be identified by the country or patent office which issued the patent or published the application, an appropriate document number, and the publication date indicated on the patent or published application.

(5) Each publication listed in an information disclosure statement must be identified by publisher, author (if any), title, relevant pages of the publication, date, and place of publication.

(c) When the disclosures of two or more patents or publications listed in an information disclosure statement are substantively cumulative, a copy of one of the patents or publications as specified in paragraph (a) of this section may be submitted without copies of the other patents or publications, provided that it is stated that these other patents or publications are cumulative.

(d) A copy of any patent, publication, pending U.S. application or other information, as specified in paragraph (a) of this section, listed in an information disclosure statement is required to be provided, even if the patent, publication, pending U.S. application or other information was previously submitted to, or cited by, the Office in an earlier application, unless:

(1) The earlier application is properly identified

in the information disclosure statement and is relied on for an earlier effective filing date under 35 U.S.C. 120; and

(2) The information disclosure statement submitted in the earlier application complies with paragraphs (a) through (c) of this section.

II. Findings and Analysis

37 CFR 1.52(e) governs the submission of electronic documents that are to become part of the permanent record in a reexamination proceeding. The rule allows for submission of limited material on either CD-R or CD-ROM. None of the information presently proposed to be filed on CD-ROM falls into any of the categories listed in 37 CFR 1.52(e)(1). Accordingly, the submission of files to the Office on a compact disk as proposed is prohibited, absent a waiver of the rule.

In filing a petition under 37 CFR 1.183, petitioner must show that the present situation should be deemed an "extraordinary" situation where "justice requires" that the rules be waived to permit entry of a CD-ROM containing copies of documents for an information disclosure statement into the record of the reexamination proceeding. In support of this position, petitioner states that (a) the patent owner has received in excess of 2,350 documents from the third party requestor and/or SAP AG, (b) the non-patent literature documents are in PDF form on CDs, (c) the PDF format allows the documents to be directly electronically copied into the Office's document system, (d) uploading the references via EFS Web is unworkable due to the number and size of the documents, and (e) the location of each document on the CDs is straightforward.

As a general rule, waiver of a rule in the interest of justice is not available when there is recourse within the rules of practice. In this instance, patent owner requests a waiver of the rules governing submission of documents to the Office based upon the difficulties petitioner anticipates in filing the documents electronically.

1. The fact that petitioner *anticipates* that using EFS-Web will be "unworkable" is not persuasive. Patent owner may submit the documents on paper. Office systems as currently configured do not have the capability of directly uploading files from a CD into the IFW system. If the Office were to accept the twenty-four CDs, the burden would be shifted on to the Office to print out all the documents contained in the CDs to then scan them into the IFW, *along with the logistics of insuring that each document is accurate and complete and that all documents are properly included.*

2. In addition, a review of the CDs reveals that the CDs are not in compliance with the relevant portions of 37 CFR 1.52. Rather, the files are in PDF format and are thus not ASCII data files as required by 37 CFR 1.52(e)(3)(i). Additionally, the CDs were not submitted in the appropriate case accompanied with a transmittal letter as required under 37 CFR 1.52(e)(3)(ii). The CDs were not submitted in duplicate or labeled appropriately, as required in 1.52(e)(4), (5) and (6). Since the CDs do not conform to the requirements for submission of electronic documents, the CDs are not proper for entry into the record, and there is no reason why these provisions of 37 CFR 1.52 would be waived. For these additional reasons, the petition is not grantable.

3. Finally, it is to be noted that the duty to disclose under 37 CFR 1.555 is limited to "information material to patentability" as defined in 37 CFR 555(b), which specifically excludes material which is "cumulative to information of record or being made of record." Patent owner appears to be submitting a bulk of information obtained from third parties and has not indicated how these documents are material to the patentability of the claims under reexamination. Patent owner has not stated that patent owner reviewed all of the proffered information, and found it to be material. It has not been shown that, if the submission were limited to only the documents that patent owner found material to patentability, there would be an undue burden to submit the in paper form or by EFS. The Office will not consider an extraordinary remedy when the rules already provide an avenue for obtaining the relief sought. See *Cantello v. Rasmussen*, 220 USPQ 664 (Comm'r Pat. 1982). In this instance, patent owner has not shown the difficulty of submitting, in paper form or via EFS, only the documents found to be material.

For the reasons stated above, patent owner has not demonstrated an entitlement to relief under 37 CFR 1.183. Accordingly, no waiver of the rule is appropriate.

CONCLUSION

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

2. The CDs submitted with the petition will not be entered into the record of the '1047 proceeding. The twenty four (24) CDs are being returned to patent owner.

3. Jurisdiction of the '1047 proceeding is being returned to the Central Reexamination Unit for further handling consistent with this decision.

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

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration
kms
5/26/09

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.
95/001,047	05/30/2008	7069235	8332.003.235	3487

33438 7590 06/11/2009

HAMILTON & TERRILE, LLP
P.O. BOX 203518
AUSTIN, TX 78720

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/11/2009

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/001047	05/30/08	7069235	8332.003.235

EXAMINER
ENGLISH, PETER

ART UNIT	PAPER
3993	

NOVAK, DRUCE & QUIGG, LLP
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1000 LOUISIANA AVENUE
WELLS FARGO PLAZA
53th FLOOR
HOUSTON, TX 77002

DATE MAILED:
MAILED
JUN 11 2009
CENTRAL REEXAMINATION UNIT

INTER PARTES REEXAMINATION COMMUNICATION

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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HAMILTON & TERRILE, LLP
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(For Patent Owner)

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ATTN: Tracy W. Druce
1000 Louisiana Avenue
Wells Fargo Plaza, 53rd Floor
Houston, TX 77002

(For Third Party Requester)

MAILED

JUN 11 2009

CENTRAL REEXAMINATION UNIT

In re Postelnik *et al.*
Inter Partes Reexamination Proceeding
Control No.: 95/001,047
Filed: May 30, 2008
For: U.S. Patent No.: 7,069,235

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

This is a decision on the April 2, 2009 third party requester petition entitled "PETITION UNDER 37 C.F.R. § 1.182 TO PROVISIONALLY SEAL CONCURRENTLY FILED WRITTEN COMMENTS, AND TO PERMANENTLY SEAL THE CONCURRENTLY FILED WRITTEN COMMENTS IF THE OFFICE ACCEPTS AND ENTERS THE WRITTEN COMMENTS AND ADDITIONAL MATERIALS FILED ON MARCH 24, 2009".

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

The petition to seal written comments filed April 2, 2009, is granted.

FEES

The requisite petition fee for a petition under 37 CFR 1.183 is $400.00 pursuant to 37 CFR 1.17(f), and the $400.00 fee will be charged to petitioner's Deposit Account No. 14-1437 as authorized in the April 2, 2009 petition. Petitioner did not include payment of the petition upon efs-web submission.

BACKGROUND

1. On June 27, 2006 the Office issued U.S. Patent No. 7, 069,235 to Postelnik *et al.*

2. On May 30, 2008, a request for *inter partes* reexamination was filed, which was assigned reexamination proceeding control no. 95/001,047 ("the '1047 proceeding"), by a third party requester.

3. On July 12, 2008, the Office issued an order granting the request for *inter partes* reexamination. Concurrently the Office issued a first Office action on the merits, setting a two month time period for patent owner to respond.

4. On September 12, 2008, patent owner filed a response to the July 12, 2008 Office action.

5. On September 25, 2008, third party requester filed a petition requesting vacatur of patent owner's September 12, 2008 response to the July 12, 2008 Office action.

6. On October 6, 2008, the Office issued a decision dismissing third party requester's September 25, 2008 petition and set a 30 day time period starting September 24, 2008 for third party requester to submit comments to patent owner's September 12, 2008 response.

7. On October 24, 2008, third party requester filed comments to patent owner's September 12, 2008 response. The third party requester comments consisted of a forty-one (41) page remarks section, two declarations totaling 105 pages and ten (10) exhibits totaling 783 pages.

8. On March 18, 2009, the Office issued a notice of defective papers determining that third party requester's October 24, 2008 comments exceeded the fifty (50) page limit requirement of 37 CFR 1.943(b), due to improper substantive argument content in the declarations and exhibits. The notice set a fifteen day time period from the date of the notice to submit either redrafted or redacted comments conforming to the fifty page limit or submit a petition to waive the fifty (50) page limit.

9. On March 24, 2009, third party requester submitted revised comments consisting of a thirty-two (32) page remarks section, two declarations totaling twenty-one (21) pages and five (5) exhibits totaling forty-nine (49) pages for a total of 102 pages.

10. On April 2, 2009, third party requester submitted a second set of revised comments consisting of a twenty-seven (27) page remarks section, two declarations totaling eighteen (18) pages and a single five (5) page exhibit for a total of fifty (50) pages.

11. Also on April 2, 2009, third party requester submitted a petition entitled "PETITION UNDER 37 C.F.R. § 1.182 TO PROVISIONALLY SEAL CONCURRENTLY FILED WRITTEN COMMENTS, AND TO PERMANENTLY SEAL THE CONCURRENTLY FILED WRITTEN COMMENTS IF THE OFFICE ACCEPTS AND ENTERS THE WRITTEN COMMENTS AND ADDITIONAL MATERIALS FILED ON MARCH 24, 2009," which is the subject of this decision.

RELEVANT RULE AND GUIDANCE

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 1.957 states:

> ***(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.*** [Emphasis added]
>
> (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.*** [Emphasis added]

MPEP 2667 (I)(A)(2) states:

> Where the length of the patent owner submission exceeds that permitted by 37 CFR 1.943, the submission is improper. Accordingly, pursuant to 37 CFR 1.957(d), a Notice will be mailed to the patent owner. The Notice will be issued by the examiner and will permit the patent owner to exercise one of the following two options:
>
> (A) Submit a re-drafted response that does not exceed the page limit set by 37 CFR 1.943; or
>
> (B) File a copy of the supplemental response with pages redacted to satisfy the 37 CFR 1.943 page limit requirement.
>
> The Notice will set a period of 15 days from the date of the notice to respond. If no response is received, the improper patent owner submission will not be considered. If the submission was necessary to respond to an outstanding Office action, the prosecution of the reexamination proceeding is either terminated pursuant to 37 CFR 1.957(b) or limited pursuant to 37 CFR 1.957(c). Any previously submitted third party comments in response to this improper patent owner submission would also not be considered, as being moot, since the patent owner did not in fact respond to the Office action in accordance with the rules.
>
> If a response to the Notice is received, then under 37 CFR 1.947, the third party requester may once file written comments, limited to issues raised by the Office action or the patent owner's response to the Notice, within 30 days from the date of service of the patent owner's response to the Notice.
>
> With respect to the length of the papers, the following additional information is to be noted. Similar to the Federal Rules of Appellate Procedure, the provisions of 37 CFR 1.943(c) are waived to the extent that the table of contents pages, the table of case law pages, and the pages of the claims (but not claim charts applying the art to the claims) are excluded from the thirty (30) page limit required by 37 CFR 1.943(c).
>
> Any affidavit or declaration (or a clearly defined portion thereof) that contains opinions(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) states:

> Where the length of the third party requester submission exceeds that permitted by 37 CFR 1.943, the submission is improper. Accordingly, a Notice will be issued by the examiner and mailed to the third party requester permitting the third party requester to exercise one of the following two options:
>
> (A) Submit a re-drafted response that does not exceed the page limit set by 37 CFR 1.943; or
>
> (B) File a copy of the supplemental response with pages redacted to satisfy the 37 CFR 1.943 page limit requirement.
>
> The Notice will set a period of 15 days from the date of the notice to respond. If no response is received, the improper third party requester submission will not be considered.
>
> For additional information with respect to the length of the papers, see subsection I.A.2. above.

DECISION

On March 18, 2009, the Office issued a notice of defective papers addressing third party requester's October 24, 2008 submission of comments. The March 18, 2009 notice stated that the third party requester comments exceeded the page length limits of 37 CFR 1.947(b), and it gave third party fifteen (15) days to resubmit third party requester comments. On March 24, 2009, third party requester submitted redrafted third party requester comments that were shorter in length. The March 24, 2009 comments facially complied with the page limit requirements of 37 CFR 1.947(b), but the comments, declarations and evidentiary exhibits *in toto* are 102 pages. On April 2, 2009, third party requester submitted another set of third party requester comment papers also in response to the March 18, 2009 notice of defective papers. The April 2, 2009 comments complies both facially and when combined with all declarations and evidentiary exhibits with the page limit requirements of 37 CFR 1.947(b). Both sets of third party requester comments were submitted within the fifteen (15) day time period set by the March 18, 2009 notice of defective papers.

The present petition requests the sealing the April 2, 2009 third party requester comments. The relevant rules and guidance preclude the submission of more than one set of third party comments, unless the Office issues a notice of defective papers which in effect finds the defective third party comments to constitute a *bona fide* attempt to advance prosecution as a substantially complete response. The Office has not yet made a determination regarding the propriety of third party requester's March 24, 2009 comments. Therefore, currently there is no need for third party requester to submit a new replacement set of comments, and in accordance

with 37 CFR 1.947 it is improper to submit third party comments more than once. Accordingly, the April 2, 2009 comments are **sealed**.

However, in the interests of the statutorily mandated special dispatch in reexamination, if the Office determines that the March 24, 2009 comments are improper, but constitute a *bona fide* attempt to advance prosecution that is substantially complete, the April 2, 2009 comments will be unsealed and considered instead of issuance of a notice of defective papers.

CONCLUSION

1. The petition to seal the April 2, 2009 third party comments is **granted**.

2. The April 2, 2009 third party comments are **sealed.**

3. The Central Reexamination Unit is directed to unseal and consider the April 2, 2009 third party comments ONLY if the March 24, 2009 third party comments are found defective and third party requester would otherwise be granted an opportunity to resubmit comments.

4. The Central Reexamination Unit is not to unseal and consider the April 2, 2009 comments, if the March 24, 2009 third party comments are entered into the record OR if the March 24, 2009 comments are not entered AND third party requester is found not to merit another opportunity to submit comments. In the event the April 2, 2009 comments are not unsealed, they will be deemed expunged from the record, and not a part of the record.

5. Jurisdiction over the '1047 proceeding is returned to the Central Reexamination Unit for action not inconsistent with this decision.

6. Telephone inquiries related to this decision should be directed to Joseph F. Weiss, Jr., Legal Advisor, at (571) 272-7759.

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

6-9-09

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,047	05/30/2008	7069235	8332.003.235	3487

33438 7590 07/06/2009

HAMILTON & TERRILE, LLP
P.O. BOX 203518
AUSTIN, TX 78720

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 07/06/2009

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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
JUL 06 2009
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001047
PATENT NO. : 7069235
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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HAMILTON & TERRILE, LLP
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(For Patent Owner)

NOVAK, DRUCE & QUIGG, LLP
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1000 Louisiana Avenue
Wells Fargo Plaza, 53rd Floor
Houston, TX 77002

(For Third Party Requester)

MAILED

JUL 06 2009

CENTRAL REEXAMINATION UNIT

In re Postelnik *et al.*
Inter Partes Reexamination Proceeding
Control No.: 95/001,047
Filed: May 30, 2008
For: U.S. Patent No.: 7,069,235

DECISION DISMISSING PETITION

This is a decision on the May 18, 2009 patent owner petition entitled "PETITION UNDER 37 C.F.R. § 1.181 AND 1.183 TO DENY ENTRY OF THIRD PARTY REQUESTER COMMENTS AND IMPOSE OTHER SANCTIONS AS DEEMED APPROPRIATE BY THE USPTO," which is effectively seeking supervisory review of the October 6, 2008 Office decision giving third party requester additional time to submit responsive comments.

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

The petition is dismissed.

BACKGROUND

1. On June 27, 2006 the Office issued U.S. Patent No. 7, 069,235 to Postelnik *et al.*

2. On May 30, 2008, a third party request for *inter partes* reexamination was filed, which was assigned reexamination proceeding control no. 95/001,047 ("the '1047 proceeding").

3. On July 12, 2008, the Office issued an order granting the request for *inter partes* reexamination. Concurrently the Office issued a first Office action on the merits, setting a two month time period for patent owner to respond.

4. On September 12, 2008, patent owner filed a response to the July 12, 2008 Office action.

5. On September 25, 2008, third party requester filed a petition requesting the striking of patent owner's September 12, 2008 response to the July 12, 2008 Office action.

6. On October 6, 2008, the Office issued a decision dismissing third party requester's September 25, 2008 petition and setting a 30 day time period starting September 24, 2008 for third party requester to submit comments to patent owner's September 12, 2008 response.

7. On October 24, 2008, third party requester filed comments to patent owner's September 12, 2008 response. The third party requester comments consisted of a forty-one (41) page remarks section, two declarations totaling 105 pages and ten (10) exhibits totaling 783 pages.

8. On March 18, 2009, the Office issued a notice of defective papers determining that third party requester's October 24, 2008 comments exceeded the fifty (50) page limit requirement of 37 CFR 1.943(b), due to substantive argument content in the declarations and exhibits being included in the 37 CFR 1.943(b) page count. The notice set a fifteen day time period from the date of the notice to submit either redrafted or redacted comments conforming to the fifty page limit or submit a petition to waive the fifty (50) page limit.

9. On March 24, 2009, third party requester submitted revised comments consisting of a thirty-two (32) page remarks section, two declarations totaling twenty-one (21) pages and five (5) exhibits totaling forty-nine (49) pages for a total of 102 pages.

10. On April 2, 2009, third party requester submitted a second set of revised comments consisting of a twenty-seven (27) page remarks section, two declarations totaling eighteen (18) pages and a single five (5) page exhibit for a total of fifty (50) pages.

11. On May 18, 2009, patent owner submitted a petition entitled "PETITION UNDER 37 C.F.R. § 1.181 AND 1.183 TO DENY ENTRY OF THIRD PARTY REQUESTER COMMENTS AND IMPOSE OTHER SANCTIONS AS DEEMED APPROPRIATE BY THE USPTO," which is the subject of this decision.

RELEVANT RULE AND GUIDANCE

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 1.181(f) states:

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

DECISION

37 CFR 1.181(f) provides that any petition submitted under 37 CFR Part 1that is not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely. The present petition is challenging the propriety of the October 6, 2008 Office decision to start the thirty day time period for third party requester comments on

September 24, 2008 instead of the patent owner service date of September 12, 2008. This October 6, 2008 Office decision effectively gave third party requester until October 24, 2008 to submit responsive comments under 37 CFR 1.947. Patent owner's present May 18, 2009 petition requesting supervisory review of the October 6, 2008 decision was submitted well over two months after notification of the decision; therefore the petition is untimely. Accordingly, the petition under 37 C.F.R. §1.181 is DISMISSED as untimely.

ADDITIONAL DISCUSSION

The Office notes that the October 6, 2008 decision was based upon the fact that patent owner's September 12, 2008 was not proper, due to patent owner's defective proof of service. Patent owner's September 12, 2008 response was not rendered a proper response to be commented upon until the issuance of the October 6, 2008 Office decision. The Office decision of October 6, 2008, out of equity, cured patent owner's improper response as of the date of that decision, as well as setting the third party time period for filing comments.

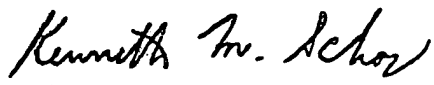
Finally, it is noted that patent owner did not oppose the third party requester's September 25, 2008 petition that resulted in the 37 CFR 1.947 comment period being extended to October 24, 2008.

Accordingly, even if this petition had been timely filed, it could not be granted.

CONCLUSION

1. Patent owner's May 18, 2009 petition is **dismissed**.

2. Telephone inquiries related to this decision should be directed to Joseph F. Weiss, Jr., Legal Advisor, at (571) 272-7759.



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

Kenpet7\IP\
7-1-09

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UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,693	10/05/2007	7,216,651	0101-P00636US8	4961

110 7590 10/14/2008

DANN, DORFMAN, HERRELL & SKILLMAN
1601 MARKET STREET
SUITE 2400
PHILADELPHIA, PA 19103-2307

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 10/14/2008

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United States Patents and Trademark Office
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Susan G.L. Glovsky
Hamilton, Brook, Smith & Reynolds, P.C.
530 Virginia Road, P.O. Box 9133
Concord, MA 01742

Date:

MAILED

OCT 14 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008693
PATENT NO. : 7216651
ART UNIT : 3900

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

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,048	05/30/2008	7216651	0101-P00636US10	5005

110 7590 10/14/2008

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SUITE 2400
PHILADELPHIA, PA 19103-2307

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 10/14/2008

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Date:
MAILED

OCT 14 2008

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001048
PATENT NO. : 7216651
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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OCT 14 2008

CENTRAL REEXAMINATION UNIT

DANN, DORFMAN, HERRELL & SKILLMAN
1601 MARKET STREET
SUITE 2400
PHILADELPHIA, PA 19103-2307

(For Patent Owner)

SUSAN G. L. GLOVSKY
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(For *Ex Parte* Requester)

SABING H. LEE
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(For *Inter Partes* Requester)

Ex parte Reexamination Proceeding
Control No. 90/008,693
Filed: October 5, 2007
For: U.S. Patent No. 7,216,651

Inter Partes Reexamination Proceeding
Control No. 95/001,048
Filed: May 30, 2008
For: U.S. Patent No. 7,216,651

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. 7,216,651 (the '651 patent) issued to Argenta *et al.* on May 15, 2007.

2. A request for *ex parte* reexamination of claims 1-13, 16-42, 44-51, 54-93, 95-98, 100-103, 105-109 and 111-125 of the '651 patent was filed on October 5, 2007, by third party requester

Susan G. L. Glovsky, and the request was assigned control number 90/008,693 (the '8693 *ex parte* proceeding).

3. On November 26, 2007, *ex parte* reexamination was ordered for claims 1-13, 16-42, 44-51, 54-93, 95-98, 100-103, 105-109 and 111-125 of the '651 patent based on the examiner's determination that the October 5, 2007 request raised a substantial new question of patentability affecting these claims.

4. On February 28, 2008, a non-final Office action was mailed in the '8693 *ex parte* proceeding, rejecting claims 1-13, 16-42, 44-51, 54-93, 95-98, 100-103, 105-109 and 111-125 of the '651 patent.

5. On April 28, 2008, patent owner filed a response to the February 28, 2008 Office action, requesting reconsideration of the rejections of the claims and proposing an amendment to claim 54.

6. A request for *inter partes* reexamination of claims 1-125 of the '651 patent was filed on May 30, 2008, by third party requester Sabing H. Lee, in which BlueSky Medical Group, Inc. and Smith & Nephew, Inc. were identified as the real parties in interest, and the request was assigned control number 95/001,048 (the '1048 *inter partes* proceeding).

7. On June 3, 2008, an examiner interview was conducted at the Office with the patent owner in the '8693 *ex parte* proceeding.

8. On August 4, 2008, *inter partes* reexamination was ordered for claims 1-125 of the '651 patent based on the examiner's determination that the May 30, 2008 request raised a substantial new question of patentability affecting these claims.

9. There has been no further Office action in the '1048 *inter partes* proceeding, and the time for filing a patent owner's statement pursuant to 37 CFR 1.530 in the '8693 *ex parte* proceeding expired after January 26, 2008. [1]

DECISION

I. MERGER OF PROCEEDINGS

Reexamination has been ordered in two proceedings for the same claims of the same patent. One of the proceedings (the '1048 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.

[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.

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.

In accordance with 37 CFR 1.989(a), the 90/008,693 and 95/001,048 proceedings are merged. The merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

1. Patent owner is required to maintain the same claims (and specification) in both files throughout the merged proceeding. Since an amendment to claim 54 has been proposed in the '8693 *ex parte* proceeding, the claims are not currently the same in both files and a "housekeeping amendment" is needed to place the same amendment in both proceedings.

2. Patent owner is required to submit an appropriate "housekeeping amendment" within one month of this decision placing the same amendment in both files. The paper should be strictly limited to the bare presentation of the amendment. 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.

3. 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 claim 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]

---

[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 housekeeping 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.

4. In the event that the required housekeeping amendment (to place identical amendments in all (both) files) is not timely submitted, any claim that does not contain identical text in both of the merged proceedings is to be rejected under 35 U.S.C. 112, paragraph 2, as being indefinite as to the content of the claim, and thus failing to particularly point out the invention.

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

The present decision merges an *ex parte* reexamination proceeding with an *inter partes* reexamination proceeding. Pursuant to 37 CFR 1.989(b), the merged proceeding is governed by 37 CFR 1.902 through 1.997, except that the rights of the third party requester of the *ex parte* reexamination are governed by 37 CFR 1.510 through 1.560.

It is noted that reexamination was ordered for claims 1-13, 16-42, 44-51, 54-93, 95-98, 100-103, 105-109 and 111-125 of the '651 patent in the '8693 *ex parte* proceeding, while reexamination was ordered for claims 1-125 of the '651 patent in the '1048 *inter partes* proceeding. The examiner will conduct reexamination in the merged proceeding for claims 1-125 of the '651 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

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 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

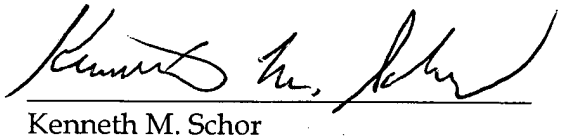
1. *Inter partes* Reexamination Control No. 95/001,048 and *ex parte* Reexamination Control No. 90/008,693 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

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 amendment in both files 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 amendment in both files, or (b) the expiration of the ONE MONTH period from the mailing of this decision for filing the housekeeping amendment.

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



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

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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P.O. Box 1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,048	05/30/2008	7216651	0101-P00636US10	5005

110 7590 06/30/2009

DANN, DORFMAN, HERRELL & SKILLMAN
1601 MARKET STREET
SUITE 2400
PHILADELPHIA, PA 19103-2307

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/30/2009

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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2040 MAIN STREET 14TH FLOOR
IRVINE, CA 92614

Date:

MAILED

JUN 30 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001048
PATENT NO. : 7216651
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.
90/008,693	10/05/2007	7,216,651	0101-P00636US8	4961

110 7590 06/30/2009

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EXAMINER	
ART UNIT	PAPER NUMBER

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Susan G.L. Glovsky
Hamilton, Brook, Smith & Reynolds, P.C.
530 Virginia Road, P.O. Box 9133
Concord, MA 01742

Date:

MAILED

JUN 30 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008693
PATENT NO. : 7216651
ART UNIT : 3900

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

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

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JUN 30 2009

CENTRAL REEXAMINATION UNIT

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Ex Parte Reexamination Proceeding
Control No. 90/008,693
Filed: October 5, 2007
For: U.S. Patent No. 7,216,651

Inter Partes Reexamination Proceeding
Control No. 95/001,048
Filed: May 30, 2008
For: U.S. Patent No. 7,216,651

DECISION DISMISSING PETITION

This is a decision addressing *inter partes* third party requester's May 12, 2009 petition paper entitled "THIRD PARTY REQUESTOR'S PETITION PURSUANT TO 37 C.F.R. § 1.183 FOR WAIVER OF 37 C.F.R. § 1.943(B) REQUIREMENT."

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

DISCUSSION

On May 12, 2009, *inter partes* third party requester (hereinafter "requester") filed "THIRD PARTY COMMENTS ADDRESSING ISSUES RAISED BY THE FEBRUARY 12, 2009 OFFICE ACTION AND THE APRIL 13, 2009 PATENT OWNER'S REPLY" with accompanying exhibits and declarations. Concurrently, on May 12, 2009, requester filed the instant petition, requesting "the PTO pursuant to 37 C.F.R. § 1.183 to accept and consider all pages of the concurrently filed Comments with accompanying exhibits and declarations" only

"to the extent that the PTO may determine that Third Party Requestor has exceeded the 50-page limit set forth in 37 C.F.R. § 1.943(b)."[1]

Facially, *inter partes* requester's May 12, 2009 comments appear compliant with respect to the 50-page limit of 37 CFR 1.943(b), and currently there are no official notices of non-compliance from the Office of record in the instant merged reexamination proceeding, which would be in need of waiver.[2] The necessity of requester's request for relief is conditioned on the Office first determining that requester's May 12, 2009 comments in fact exceed the 50-page limit of 37 CFR 1.943(b), because of considerations not facially apparent. Accordingly, because requester'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 would cause such relief to become necessary; however, such renewed petition would not hold in abeyance any time periods for response that may be running against the parties in the instant merged reexamination proceeding.

FEES

The petition fee of $400 for the petition under 37 CFR 1.183 pursuant to 37 CFR 1.17(f) was charged to *inter partes* requester's credit card on May 13, 2009. In the event requester files a renewed petition, no additional fee need be submitted.

CONCLUSION

1. *Inter partes* requester's May 12, 2009 petition under 37 CFR 1.183 to waive the page limit requirement of 37 CFR 1.943(b) is **dismissed** as premature.

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

3. Telephone inquiries with regard to this decision should be directed to Nicole Dretar, Legal Advisor, Office of Patent Legal Administration, at (571) 272-7717.

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

Kenpet7\IP\length 6-29-09

[1] *See* petition at page 1.

[2] *Inter partes* requester's May 12, 2009 comments are 47 pages long, which facially appears to be in compliance with the rule. Moreover, *inter partes* requester states on page 1 of the petition, "The exhibits included with the Comments, including the supporting declarations, contain only factual information and do not include arguments." Thus, it does not facially appear that pages of the attached exhibits, including supporting declarations, would be subject to the page limit requirements of 37 CFR 1.943 pursuant to MPEP 2667(I)(A)(2), though the Central Reexamination Unit may subsequently determine to the contrary.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,048 ; 90/008,693	05/30/2008	7216651	0101-P00636US10	5005

110 7590 09/09/2009

EXAMINER

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ART UNIT	PAPER NUMBER

DATE MAILED: 09/09/2009

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CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001048 ; 90/008,693
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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.

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

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

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(For Patent Owner)

MAILED

SEP 09 2009

CENTRAL REEXAMINATION UNIT

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(For *Ex Parte* Requester)

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(For *Inter Partes* Requester)

Ex Parte Reexamination Proceeding
Control No. 90/008,693
Filed: October 5, 2007
For: U.S. Patent No. 7,216,651

Inter Partes Reexamination Proceeding
Control No. 95/001,048
Filed: May 30, 2008
For: U.S. Patent No. 7,216,651

DECISION DISMISSING PETITION

This is a decision on *inter partes* third party requester's August 24, 2009 petition paper entitled "PETITION TO THE DIRECTOR UNDER 37 C.F.R. § 1.183" (hereinafter "petition under 37 CFR 1.183").

The petition under 37 CFR 1.183 is before the Office of Patent Legal Administration for consideration. The petition fee of $400 for the petition under 37 CFR 1.183 pursuant to 37 CFR 1.17(f) was charged to *inter partes* third party requester's credit card on August 25, 2009, as authorized on page one of the petition under 37 CFR 1.183.

The petition under 37 CFR 1.183 is dismissed, for the reasons set forth herein.

REVIEW OF THE RELEVANT FACTS

1. United States Patent Number 7,216,651 (the '651 patent) issued on May 15, 2007.

2. On October 5, 2007, a request for *ex parte* reexamination of the '651 patent was filed by a third party requester and assigned Reexamination Control No. 90/008,693 (the '8693 proceeding).

3. On November 26, 2007, the Office issued an order granting *ex parte* reexamination in the '8693 proceeding.

4. On May 30, 2008, a request for *inter partes* reexamination of the '651 patent was filed by a third party requester and assigned Reexamination Control No. 95/001,048 (the '1048 proceeding).

5. On August 4, 2008, the Office issued an order granting *inter partes* reexamination in the '1048 proceeding.

6. On October 14, 2008, the Office mailed a decision merging the '8693 *ex parte* and '1048 *inter partes* reexamination proceedings ("the merged proceeding").

7. Prosecution in the merged proceeding progressed to the point where, on July 22, 2009, the Office mailed an Action Closing Prosecution ("ACP").

8. On August 21, 2009, patent owner filed a "STATEMENT UNDER 37 CFR 1.951(a)" in the merged proceeding.

9. On August 24, 2009, *inter partes* third party requester (hereinafter "requester") filed the instant "PETITION TO THE DIRECTOR UNDER 37 C.F.R. § 1.183" ("petition under 37 CFR 1.183") in the merged proceeding.

10. Concurrently on August 24, 2009, requester filed a "PETITION TO THE DIRECTOR UNDER 37 C.F.R. § 1.181" ("petition under 37 CFR 1.181") in the merged proceeding.

DISCUSSION

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 1.183 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).

On August 24, 2009, requester filed a petition under 37 CFR 1.181, asserting that the ACP, mailed on July 22, 2009, "does not present a clear record for appeal."[1] Concurrently, on August 24, 2009, requester filed the instant petition under 37 CFR 1.183 requesting entry and consideration of the petition under 37 CFR 1.181.[2] 37 CFR 1.181(a) provides that "[p]etition may be taken to the Director: (1) From any action or requirement of any examiner ... in *ex parte* or *inter partes* prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court." Thus, suspension or waiver of the rules pursuant to 37 CFR 1.183 is unnecessary to obtain consideration of a petition under 37 CFR 1.181, as 37 CFR 1.181 applies to any party challenging any action of any examiner in a reexamination proceeding not subject to appeal. In this instance, requester is challenging an action of the examiner (*i.e.*, in the issued ACP) in a merged reexamination proceeding not subject to appeal.

Because requester's August 24, 2009 petition under 37 CFR 1.183, requesting entry and consideration of the concurrently filed petition under 37 CFR 1.181, is unnecessary, the petition is **dismissed**. Requester is reminded that the mere filing of a petition will not stay any period for reply that may be running in the proceeding.[3]

CONCLUSION

1. *Inter partes* requester's August 24, 2009 "PETITION TO THE DIRECTOR UNDER 37 C.F.R. § 1.183" to waive the rules for entry and consideration of the concurrently filed "PETITION TO THE DIRECTOR UNDER 37 C.F.R. § 1.181" is **dismissed** as unnecessary.

---

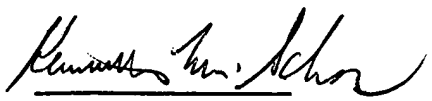
[1] *See* petition under 37 CFR 1.183 at page 1 (stating, "Specifically, the ACP is ambiguous whether the Examiner entered the Petitioner's Proposed Further Grounds of Rejection but declined to adopt those Proposed Grounds for rejection, or whether the Examiner refused to enter the Proposed Grounds. ").

[2] *See* id.

[3] 37 CFR 1.181(f). The time period for filing responsive comments under 37 CFR 1.951(b) is still running against requester and will expire on September 21, 2009.

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

3. Telephone inquiries with regard to this decision should be directed to Nicole Dretar, Legal Advisor, Office of Patent Legal Administration, at (571) 272-7717.



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

Kenpet7/IP
9-9-09

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.
95/001,048	05/30/2008	7216651	0101-P00636US10	5005

110 7590 11/18/2009

DANN, DORFMAN, HERRELL & SKILLMAN
1601 MARKET STREET
SUITE 2400
PHILADELPHIA, PA 19103-2307

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 11/18/2009

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

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2040 MAIN STREET 14TH FLOOR
IRVINE, CA 92614

Date:

MAILED

NOV 18 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001048
PATENT NO. : 7216651
TECHNOLOGY CENTER : 3999
ART UNIT : 3993

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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.
90/008,693	10/05/2007	7,216,651	0101-P00636US8	4961

110 7590 11/18/2009

DANN, DORFMAN, HERRELL & SKILLMAN
1601 MARKET STREET
SUITE 2400
PHILADELPHIA, PA 19103-2307

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 11/18/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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Date:
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NOV 18 2009
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008693
PATENT NO. : 7216651
ART UNIT : 3900

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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(For Patent Owner)

MAILED

NOV 18 2009

CENTRAL REEXAMINATION UNIT

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(For *Inter Partes* Requester)

Ex Parte Reexamination Proceeding
Control No. 90/008,693
Filed: October 5, 2007
For: U.S. Patent No. 7,216,651

Inter Partes Reexamination Proceeding
Control No. 95/001,048
Filed: May 30, 2008
For: U.S. Patent No. 7,216,651

DECISION ON PETITION UNDER 37 CFR 1.181

This is a decision on *inter partes* third party requester's August 24, 2009 petition paper entitled "PETITION TO THE DIRECTOR UNDER 37 C.F.R. § 1.181" (hereinafter "petition").

The petition under 37 CFR 1.181 is before the Director of the Central Reexamination Unit for consideration as to whether the Action Closing Prosecution, mailed on July 22, 2009, is proper.

The petition under 37 CFR 1.181 is granted, for the reasons set forth herein, to the extent that the third party requester comments, dated May 12, 2009, does not comply with 37 CFR 1.947 and 1.948, and therefore, should not have been entered into the record and considered by the examiner in the Action Closing Prosecution.

REVIEW OF THE RELEVANT FACTS

1. United States Patent Number 7,216,651 (the '651 patent) issued on May 15, 2007.

2. On October 5, 2007, a request for *ex parte* reexamination of the '651 patent was filed by a third party requester and assigned Reexamination Control No. 90/008,693 (the '8693 proceeding).

3. On November 26, 2007, the Office issued an order granting *ex parte* reexamination in the '8693 proceeding.

4. On May 30, 2008, a request for *inter partes* reexamination of the '651 patent was filed by a third party requester and assigned Reexamination Control No. 95/001,048 (the '1048 proceeding).

5. On August 4, 2008, the Office issued an order granting *inter partes* reexamination in the '1048 proceeding.

6. On October 14, 2008, the Office mailed a decision merging the '8693 *ex parte* and '1048 *inter partes* reexamination proceedings ("the merged proceeding").

7. Prosecution in the merged proceeding progressed to the point where, on July 22, 2009, the Office mailed an Action Closing Prosecution ("ACP").

8. On August 21, 2009, patent owner filed a "STATEMENT UNDER 37 CFR 1.951(a)" in the merged proceeding.

9. On August 24, 2009, *inter partes* third party requester (hereinafter "requester") filed the instant "PETITION TO THE DIRECTOR UNDER 37 C.F.R. § 1.183" ("petition under 37 CFR 1.183") in the merged proceeding.

10. Concurrently on August 24, 2009, requester filed a "PETITION TO THE DIRECTOR UNDER 37 C.F.R. § 1.181" ("petition under 37 CFR 1.181") in the merged proceeding.

11. On September 21, 2009, third party requester filed a paper titled "THIRD PARTY COMMENTS UNDER 37 C.F.R. § 1.951(b) ADDRESSING ISSUES RAISED BY THE JULY 22, 2009 ACTION CLOSING PROSECUTION AND THE AUGUST 21, 2009 PATENT OWNER'S STATEMENT".

DISCUSSION

The third party requester (petitioner) states that the requester is seeking the director's review under 37 CFR 1.181 of the examiner's treatment of the new proposed rejections introduced in the third party requester's comments dated May 12, 2009. The petitioner contends the new proposed rejections should given full consideration by the examiner because:

(1) there is no requirement to establish a substantial new question of patentability for the new proposed rejections;

(2) the comments dated May 12, 2009 did discuss the pertinency of each reference applied in the new proposed rejections;

(3) the explanation of the new proposed rejection provided at least one basis for combining the references and a statement of why the claims would have been obvious; and
(4) if the comments dated May 12, 2009 were improper, the third party requester should have been notified and given 15 days to rectify and refile the comments.

See pages 4-5 of the petition.

Legal Authority Citations:

37 CFR 1.181 states, in part:

(a) Petition may be taken to the Director:

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

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

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

37 CFR 1.947 states:

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

37 CFR 1.948 states, in part:

(a) After the inter partes reexamination order, the third party requester may only cite additional prior art as defined under § 1.501 if it is filed as part of a comments submission under § 1.947 or § 1.951(b) and is limited to prior art:
(1) which is necessary to rebut a finding of fact by the examiner;
(2) which is necessary to rebut a response of the patent owner; or
(3) which for the first time became known or available to the third party requester after the filing of the request for inter partes reexamination proceeding. Prior art submitted under paragraph (a)(3) of this section must be accompanied by a statement as to when the prior art first became known or available to the third party requester and must include a discussion of the pertinency of each reference to the patentability of at least one claim.

MPEP 2666.05 states, in part:

Third party requester comments are limited to issues covered by the Office action or the patent owner's response. New prior art can be submitted with the comments **only** where the prior art (A) is

necessary to rebut a finding of fact by the examiner, (B) is necessary to rebut a response of the patent owner, or (C) for the first time became known or available to the third party requester after the filing of the request for *inter partes* reexamination.

As to item (A) above, 37 CFR 1.948(a)(1) permits the requester to provide new prior art rebutting the examiner's interpretation/finding of what the art of record shows. However, a statement in an Office action that a particular claimed feature is not shown by the prior art of record (which includes references that were cited by requester) does NOT permit the requester to then cite new art to replace the art originally advanced by requester. Such a substitution of a new art for the art of record is not a rebuttal of the examiner's finding that a feature in question is not taught by the art of record. Rather, such a substitution would amount to a rebuttal of a finding that a feature in question is not taught by any art in existence. A finding that the feature in question is not taught by any art in existence could not realistically be made for the reexamination proceeding, since the proceeding does not include a comprehensive validity search, and such was not envisioned by Congress as evidenced by the 35 U.S.C. 314(c) mandate that reexamination proceedings are to be conducted in the Office with special dispatch.

As to item (B) above, 37 CFR 1.948(a)(2) permits the requester to provide a new proposed rejection, where such new proposed rejection is necessitated by patent owner's amendment of the claims.

As to item (C) above, prior art submitted under 37 CFR 1.948(a)(3) must be accompanied by a statement that explains the circumstances as to when the prior art first became known or available to the third party requester, including the date and manner that the art became known or available, and why it was not available earlier. The submission must also include a discussion of the pertinency of each reference to the patentability of at least one claim.

As to items (A) - (C) above where a newly proposed rejection is based on the newly presented prior patents and printed publications (art), the third party requester must present the newly proposed rejection in compliance with the guidelines set forth in MPEP § 2617, since any such new proposed rejection stands on the same footing as a proposed rejection presented with the request for reexamination, and is treated the same way as to future Office actions and any appeal. See MPEP § 2617 as to the required discussion of the pertinency of each reference to the patentability of at least one claim presented for the newly submitted prior art. An explanation pursuant to the requirements of 35 U.S.C. 311 of how the art is applied is no less important at this stage of the prosecution, than it is when filing the request.

Where the third party requester written comments are directed to matters other than issues and points covered by the Office action or the patent owner's response, or where the prior art submitted with the comments does not satisfy at least one of (A) - (C) above, the written comments are improper.

Analysis:

Turning to the facts in this merged proceeding, the new proposed rejections were not included in the request for reexamination and are based on references, newly cited in the comments of May 12, 2009. Instead, these proposed rejections were not mentioned until the third party requester comments submitted after the first Office action on the merits. See, e.g., pages 32-33 of the May 12, 2009 comments.

37 CFR 1.947 requires that a third party requester's comments must be limited to issues covered by the Office action or the patent owner's response. 37 CFR 1.948(a)(2) and MPEP 2666.05

only permits a third party requester to introduce new proposed rejections if necessitated by the patent owner's amendment to the claims. See MPEP 2666.05.

The new proposed rejections in the comments of May 12, 2009 were not caused by the patent owner amendment in the paper of April 13, 2009 because the patent owner did not make any amendments to the claims. Therefore, the comments dated May 12, 2009 improperly included new proposed rejections and did not have a right of entry under 37 CFR 1.947 and 1.948. In the Action Closing Prosecution (ACP), the examiner correctly stated that the new proposed rejections are not entitled to consideration. See pages 11-12 in the ACP, mailed July 22, 2009. However, under the facts present in this proceeding, the ACP is improperly issued because it treated the entire third party requester's comments dated May 12, 2009 on the merits, including the new proposed rejections. See page 13 of the Office Action in which the examiner stated that the primary references in the proposed rejection fail to teach certain claim limitations. Therefore, the record indicates that the examiner did give consideration to some extent to the improperly raised new proposed rejections.

Accordingly, the petition is granted to the extent that the comments dated May 12, 2009 will be closed and returned to the third party requester. 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. The present decision will, however, be made of record in the merged reexamination proceeding. See also MPEP 2267.

The third party requester is given fifteen (15) days from the mailing date of this decision to rectify and refile the comments. If, upon the second submission, the comments are still not proper, the comments will be returned to third party requester with an explanation of what is not proper, and at that point the comments can no longer be resubmitted. Any replacement comments submitted in response to the notification must be strictly limited to (i.e., must not go beyond) the comments in the original (returned) comments submission. No comments that add to those in the returned paper will be considered for entry.

In addition, the ACP, mailed July 22, 2009, is hereby vacated.

Accordingly, the patent owner's response, dated August 21, 2009, to the July 22, 2009 ACP, and the third party requester's comments filed September 21, 2009, directed to patent owner's response of August 21, 2009, are moot due to the vacatur of the ACP. The papers will be closed in the record pending resolution of compliance with 37 CFR 1.947 and 1.948 for the third party comments and the issuance of a new Office action, at which point it will be determined which papers will be opened. This decision will remain of record.

CONCLUSION

1. The August 24, 2009, the third party requester petition under 37 CFR 1.181 seeking the Director's review of the July 22, 2009 ACP is **granted to the extent of finding** that the ACP may have incorrectly considered improperly raised new proposed rejection and is being vacated.

2. The third party requester comments, dated May 12, 2009, are improper papers and are being expunged from the record, as indicated above. The third party requester has fifteen (15) days from the mailing date of this decision to rectify and refile the comments.

3. The examiner will issue a new Office action, as appropriate, after the filing of any rectified third party comments filed.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,048	05/30/2008	7216651	0101-P00636US10	5005

110 7590 12/22/2009

DANN, DORFMAN, HERRELL & SKILLMAN
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PHILADELPHIA, PA 19103-2307

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 12/22/2009

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,693	10/05/2007	7,216,651	0101-P00636US8	4961

110 7590 12/22/2009

DANN, DORFMAN, HERRELL & SKILLMAN
1601 MARKET STREET
SUITE 2400
PHILADELPHIA, PA 19103-2307

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 12/22/2009

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IRVINE, CA 92614

Date:

MAILED

DEC 22 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001048
PATENT NO. : 7216651
TECHNOLOGY CENTER : 3999
ART UNIT : 3993

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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Date:
MAILED
DEC 22 2009
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008693
PATENT NO. : 7216651
ART UNIT : 3900

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

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

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DEC 22 2009

CENTRAL REEXAMINATION UNIT

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(For *Inter Partes* Requester)

Ex Parte Reexamination Proceeding
Control No. 90/008,693
Filed: October 5, 2007
For: U.S. Patent No. 7,216,651

Inter Partes Reexamination Proceeding
Control No. 95/001,048
Filed: May 30, 2008
For: U.S. Patent No. 7,216,651

DECISION ON PETITION UNDER 37 CFR 1.181

This is a decision on *inter partes* third party requester's December 3, 2009 petition paper entitled "PETITION TO THE DIRECTOR UNDER 37 C.F.R. § 1.181(a)(3)" (hereinafter "petition"), which is requesting reconsideration of the decision mailed on November 18, 2009.

The petition under 37 CFR 1.181 is before the Director of Technology Center 1600, who oversees the Central Reexamination Unit, for reconsideration of the November 18, 2009 decision.

The request for reconsideration petition under 37 CFR 1.181 is denied, for the reasons set forth herein.

REVIEW OF THE RELEVANT FACTS

1. United States Patent Number 7,216,651 (the '651 patent) issued on May 15, 2007.

2. On October 5, 2007, a request for *ex parte* reexamination of the '651 patent was filed by a third party requester and assigned Reexamination Control No. 90/008,693 (the '8693 proceeding).

3. On November 26, 2007, the Office issued an order granting *ex parte* reexamination in the '8693 proceeding.

4. On May 30, 2008, a request for *inter partes* reexamination of the '651 patent was filed by a third party requester and assigned Reexamination Control No. 95/001,048 (the '1048 proceeding).

5. On August 4, 2008, the Office issued an order granting *inter partes* reexamination in the '1048 proceeding.

6. On October 14, 2008, the Office mailed a decision merging the '8693 *ex parte* and '1048 *inter partes* reexamination proceedings ("the merged proceeding").

7. Prosecution in the merged proceeding progressed to the point where, on July 22, 2009, the Office mailed an Action Closing Prosecution ("ACP").

8. On August 21, 2009, patent owner filed a "STATEMENT UNDER 37 CFR 1.951(a)" in the merged proceeding.

9. On August 24, 2009, *inter partes* third party requester (hereinafter "requester") filed a "PETITION TO THE DIRECTOR UNDER 37 C.F.R. § 1.183" ("petition under 37 CFR 1.183") in the merged proceeding.

10. Concurrently on August 24, 2009, requester filed a "PETITION TO THE DIRECTOR UNDER 37 C.F.R. § 1.181" ("petition under 37 CFR 1.181") in the merged proceeding.

11. On November 18, 2009, a decision granting the petition under 37 CFR 1.181 to the extent that the requester was given fifteen days to correct their comments was mailed. The decision also vacated the ACP.

12. On December 3, 2009, the requester filed corrected comments and a petition requesting reconsideration of the November 18, 2009 decision.

DISCUSSION

The third party requester (petitioner) states that the requester is seeking the director's review under 37 CFR 1.181 of November 18, 2009 decision ("decision"). The petitioner contends the decision improperly applied the requirements of 37 CFR 1.947 and 1.948 because:

(1) Petitioner was permitted to submit new proposed rejections if the newly cited prior art satisfied the requirements of any one of 37 CFR 1.948(a)(1), (2), or (3);

(2) The new proposed rejections based on the Solovev references were properly introduced pursuant to 37 CFR 1.947 and 1.948(a)(2);
(3) The new proposed rejections based on the Bagautidinov II reference was properly introduced pursuant to 37 CFR 1.947 and 1.948(a)(1); and
(4) All of the new proposed rejections were properly introduced pursuant to 37 CFR 1.947 and 1.948(a)(3).

See pages 4-5 of the petition.

Legal Authority Citations:

37 CFR 1.181 states, in part:

> (a) Petition may be taken to the Director:
>
> (1) From any action or requirement of any examiner in the *ex parte* prosecution of an application, or in *ex parte* or *inter partes* prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;
>
> (2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and
>
> (3) To invoke the supervisory authority of the Director in appropriate circumstances. For petitions involving action of the Board of Patent Appeals and Interferences, see § 41.3 of this title.

37 CFR 1.947 states:

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

37 CFR 1.948 states, in part:

> (a) After the inter partes reexamination order, the third party requester may only cite additional prior art as defined under § 1.501 if it is filed as part of a comments submission under § 1.947 or § 1.951(b) and is limited to prior art:
>
> (1) which is necessary to rebut a finding of fact by the examiner;
> (2) which is necessary to rebut a response of the patent owner; or
> (3) which for the first time became known or available to the third party requester after the filing of the request for inter partes reexamination proceeding. Prior art submitted under paragraph (a)(3) of this section must be accompanied by a statement as to when the prior art first became known or available to the third party requester and must include a discussion of the pertinency of each reference to the patentability of at least one claim.

MPEP 2666.05 states, in part:

> Third party requester comments are limited to issues covered by the Office action or the patent owner's response. New prior art can be submitted with the comments **only** where the prior art (A) is necessary to rebut a finding of fact by the examiner, (B) is necessary to rebut a response of the patent owner, or (C) for the first time became known or available to the third party requester after the filing of the request for *inter partes* reexamination.
>
> **As to item (A) above, 37 CFR 1.948(a)(1)** permits the requester to provide new prior art rebutting the examiner's interpretation/finding of what the art of record shows. **However, a statement in an Office action that a particular claimed feature is not shown by the prior art of record (which includes references that were cited by requester) does NOT permit the requester to then cite new art to replace the art originally advanced by requester.** Such a substitution of a new art for the art of record is not a rebuttal of the examiner's finding that a feature in question is not taught by the art of record. Rather, such a substitution would amount to a rebuttal of a finding that a feature in question is not taught by any art in existence. A finding that the feature in question is not taught by any art in existence could not realistically be made for the reexamination proceeding, since the proceeding does not include a comprehensive validity search, and such was not envisioned by Congress as evidenced by the 35 U.S.C. 314(c) mandate that reexamination proceedings are to be conducted in the Office with special dispatch.
>
> As to item (B) above, **37 CFR 1.948(a)(2) permits the requester to provide a new proposed rejection, where such new proposed rejection is necessitated by patent owner's amendment of the claims.**
>
> As to item (C) above, prior art submitted under **37 CFR 1.948(a)(3)** must be accompanied by a statement that explains the circumstances as to when the prior art first became known or available to the third party requester, including the date and manner that the art became known or available, and why it was not available earlier. The submission **must also include a discussion of the pertinency of each reference to the patentability of at least one claim**.
>
> As to items (A) - (C) above where a newly proposed rejection is based on the newly presented prior patents and printed publications (art), the third party requester must present the newly proposed rejection in compliance with the guidelines set forth in MPEP § 2617, since any such new proposed rejection stands on the same footing as a proposed rejection presented with the request for reexamination, and is treated the same way as to future Office actions and any appeal. See MPEP § 2617 as to the required discussion of the pertinency of each reference to the patentability of at least one claim presented for the newly submitted prior art. An explanation pursuant to the requirements of 35 U.S.C. 311 of how the art is applied is no less important at this stage of the prosecution, than it is when filing the request.
>
> Where the third party requester written comments are directed to matters other than issues and points covered by the Office action or the patent owner's response, or where the prior art submitted with the comments does not satisfy at least one of (A) - (C) above, the written comments are improper.

Analysis:

Turning to the facts in this merged proceeding, the new proposed rejections were not included in the request for reexamination and are based on references, newly cited in the comments of May 12, 2009. These proposed rejections were first mentioned in the third party requester comments submitted after the first Office action on the merits. See, e.g., pages 32-33 of the May 12, 2009 comments.

37 CFR 1.947 requires that a third party requester's comments must be limited to issues covered by the Office action or the patent owner's response. 37 CFR 1.948(a)(2) and MPEP 2666.05 only permits a third party requester to introduce new proposed rejections if necessitated by the patent owner's amendment to the claims. See MPEP 2666.05.

The new proposed rejections in the comments of May 12, 2009 were not caused by the patent owner amendment in the paper of April 13, 2009 because the patent owner did not make any amendments to the claims. Therefore, the comments dated May 12, 2009 improperly included newly proposed rejections, and therefore, did not have a right of entry under 37 CFR 1.947 and 1.948. In the Action Closing Prosecution (ACP), the examiner correctly stated that the newly proposed rejections are not entitled to consideration. See pages 11-12 in the ACP, mailed July 22, 2009. However, under the facts present in this proceeding, the ACP was determined to be improperly issued because it treated the third party requester's comments dated May 12, 2009 on the merits, including some consideration of the newly proposed rejections. See page 13 of the Office Action in which the examiner stated that the primary references in the newly proposed rejection fail to teach certain claim limitations. Therefore, the record indicates that the examiner did give consideration to some extent to the improperly raised newly proposed rejections.

In summary, the November 18, 2009 decision determined that the May 12, 2009 comments were improper papers because the papers raised new grounds of rejection, which were not authorized by 37 CFR 1.947 and 1.948. Accordingly, the decision granted the August 24, 2009 petition to the extent that the third party requester was given fifteen (15) days to rectify and file replacement comments. The decision also stated that as the May 12, 2009 comments have been entered into the electronic Image File Wrapper (IFW) record, the comments will be "returned" by closing the paper in the IFW, and marking the paper nonpublic to expunge it from the record.

On December 3, 2009, the third party requester filed replacement comments and a petition requesting reconsideration of the November 18, 2009 decision. This reconsideration petition raises four issues, each will be addressed below.

(1) Petitioner was permitted to submit new proposed rejections if the newly cited prior art satisfied the requirements of any one of 37 CFR 1.948(a)(1), (2), or (3)

Petitioner argues that new proposed rejections are authorized under each subsection of 37 CFR 1.948(a). See page 5 of the petition. Specifically, petitioner points to the following statement in MPEP 2666.05, subsection II, for support of their position that each subsection of 37 CFR 1.948(a)(1)-(3) authorizes newly proposed rejections:

"As to items (A) - (C) above where a newly proposed rejection is based on the newly presented prior patents and printed publications (art), the third party requester must present the newly proposed rejection in compliance with the guidelines set forth in MPEP § 2617..."

However, when MPEP 2666.05, subsection II, is read as a whole, it is clear that only 37 CFR 1.948(a)(2) authorizes the third party requester to provide newly proposed rejections when the newly proposed rejections are necessitated by an amendment to the claims. See the bolded text in the text above-quoted from MPEP 2666.05, subsection II. Specifically, MPEP 2666.05 states that 37 CFR 1.948(a)(2) permits newly proposed rejections only if necessitated by patent owner's amendments. In contrast, 37 CFR 1.948(a)(1) and (3)

permit a statement of relevancy to the examiner's interpretation/finding, or the patentability of at least one claim, respectively. To allow newly proposed rejections under each of 37 CFR 1.948(a)(1), (2), and (3) would allow the introduction of new issues of patentability in response to every examiner's finding, every patent owner's amendment, and every discovery of new art. Such would result in an unwieldy proceeding, 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. Therefore, the statements in MPEP 2666.05 that only permit newly proposed rejections under 37 CFR 1.948(a)(2) are wholly consistent with the spirit and letter of 35 U.S.C. 314(c).

(2) The new proposed rejections based on the Solovev references were properly introduced pursuant to 37 CFR 1.947 and 1.948(a)(2)

Petitioner states that the newly proposed rejections based on the Solovev references were made in accordance with the requirements of 37 CFR 1.947 and 1.948(a)(2) because the Solovev references rebut the patent owner's position that it is not obvious to modify Jeter to use foam. See pages 6-7 of the petition.

As explained above, MPEP 2666.05 clearly states that "... 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). The record is clear that patent owner did not amend the claims. Furthermore, patent owner's arguments regarding the obviousness of modifying the Jeter reference does not, by itself, authorize newly proposed rejections under 37 CFR 1.948(a)(2) for the same reasons as an examiner's finding of patentability does not authorize newly proposed rejections under 37 CFR 1.948(a)(1). See MPEP 2666.05, which states for 37 CFR 1.948(a)(1), that:

> "**.... a statement in an Office action that a particular claimed feature is not shown by the prior art of record (which includes references that were cited by requester) does NOT permit the requester to then cite new art to replace the art originally advanced by requester.** 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).

Therefore, while 37 CFR 1.947 and 1.948(a)(2) may authorize[1] the citation of the Solovev references to rebut the position taken by the patent owner in April 13, 2009 response, MPEP 2666.05 is clear that 37 CFR 1.947 and 1.948(a)(2) do not authorize newly presented proposed rejections, which are not necessitated by an amendment to the patent claims.

[1] The examiner will make the determination of whether the citation of the Solovev references comply with 37 CFR 1.947 and 1.948 in the next Office action.

(3) The new proposed rejections based on the Bagautidinov II reference was properly introduced pursuant to 37 CFR 1.947 and 1.948(a)(1)

Petitioner states that the newly proposed rejections based on the Bagautidinov II reference were made in accordance with the requirements of 37 CFR 1.947 and 1.948(a)(1) because the Bagautidinov II reference rebuts the examiner's finding that Bagautidinov does not maintain negative pressure on a wound. See page 7 of the petition.

As explained above, MPEP 2666.05 clearly states for 37 CFR 1.948(a)(1), that:

> **".... a statement in an Office action that a particular claimed feature is not shown by the prior art of record (which includes references that were cited by requester) does NOT permit the requester to then cite new art to replace the art originally advanced by requester.** 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).

Petitioner states that the newly presented proposed rejections based on Bagautidinov II are not "replacement" proposed rejections. The record, however, does not support this statement by the petitioner. In other words, the record is clear that the third party requester is presenting newly proposed rejections based on the newly cited Bagautidinov II reference in response to the examiner's finding in the first Office action. This exact situation is addressed in MPEP 2666.05, subsection II, which is quoted above. Therefore, while 37 CFR 1.947 and 1.948(a)(1) may authorize[2] the citation of the Bagautidinov II reference to rebut the position taken by the examiner in the first Office action, MPEP 2666.05 is clear that 37 CFR 1.947 and 1.948(a)(1) do not authorize newly presented proposed rejections to rebut a finding by the examiner. In other words, the comments must be limited to how Bagautidinov II rebuts the examiner's finding in the first Office action, in accordance with the requirements of 37 CFR 1.947 and 1.948(a)(1), to support the original proposed rejection based on Bagautidinov.

(4) All of the new proposed rejections were properly introduced pursuant to 37 CFR 1.947 and 1.948(a)(3)

Petitioner states that the newly proposed rejections were made in accordance with the requirements of 37 CFR 1.947 and 1.948(a)(3) because all the references satisfy the requirements of 37 CFR 1.948(a)(3). See pages 7-8 of the petition. Petitioner points to statements made in the Federal Register publication of the institution of 37 CFR 1.948(a)(3) to support their position. In addition, petitioner argues that the requirements of 37 CFR 1.948(a)(3) trumps any more restrictive requirements of 37 CFR 1.947.

---

[2] The examiner will make the determination of whether the citation of the Bagautidinov II reference complies with 37 CFR 1.947 and 1.948 in the next Office action.

As explained above, MPEP 2666.05 clearly states the requirements for 37 CFR 1.948(a)(3) "... include a discussion of the pertinency of each reference to the patentability of at least one claim." MPEP 2666.05 does not state that newly presented rejections based on newly cited art under 37 CFR 1.948(a)(3) is permitted. As explained above, only 37 CFR 1.948(a)(2) authorizes newly presented proposed rejection that are necessitated by a patent owner's amendment of the claims. Therefore, while 37 CFR 1.947 and 1.948(a)(3) may authorize[3] the citation of the references and permit an explanation of the relevancy of the references to at least one patent claim, MPEP 2666.05 is clear that 37 CFR 1.947 and 1.948(a)(3) do not authorize newly presented proposed rejections upon meeting the requirements of 37 CFR 1.948(a)(3). The comments from the Federal Register notice are not persuasive because the notice does not explicitly authorize newly presented proposed rejections, and do not make any explicit statements inconsistent with MPEP 2666.05. In regard to petitioner's argument that 37 CFR 1.948(a)(3) must control 37 CFR 1.947 to the extent that there is any conflict, this argument is not fully understood as there does not appear to be any conflict between 37 CFR 1.948(a)(3) and 1.947. In conclusion, petitioner's arguments pertaining to 37 CFR 1.48(a)(3) are not persuasive in light of the clear statutory requirement of special dispatch and the guidance provided in MPEP 2666.05.

For all the reasons discussed above, the petition for reconsideration is **denied**.

In summary:

- The May 12, 2009 third party comments is closed and expunged from the record;
- The ACP, mailed July 22, 2009, is vacated; and
- The patent owner's response, dated August 21, 2009, to the July 22, 2009 ACP is moot due to the vacatur of the ACP.

The papers will be closed in the record pending resolution of compliance with 37 CFR 1.947 and 1.948 for the third party comments dated December 3, 2009 and the issuance of a new Office action, at which point it will be determined which papers will be opened. This decision will remain of record.

REQUESTER'S RECOURSE

The third party requester has the following possible courses of action if the third party requester desires to bring the newly presented proposed rejections before the Office:

1. Initiate an *ex parte* reexamination of the '651 patent based on the newly cited Solovev and Bagautidinov II references by filing a new and complete request for *ex parte* reexamination. This decision is without prejudice to the right of the requester to file a new request for reexamination. The request must set forth a substantial new question of patentability that is different from the substantial new question of patentability set forth in the previous examination.
2. Initiate an *inter partes* reexamination of the '651 patent based on the newly cited Solovev and Bagautidinov II references by filing a new and complete request for *inter partes*

[3] The examiner will make the determination of whether the citation of the references comply with 37 CFR 1.947 and 1.948 in the next Office action.

reexamination, if a showing can be made that the newly cited art was unavailable at the time of filing the request in this proceeding, in accordance with the requirements of 35 U.S.C. 317(b) and 37 CFR 1.907. The request must set forth a substantial new question of patentability that is different from the substantial new question of patentability set forth in the previous examination.

3. File a petition under 35 U.S.C. 317(a) to authorize the filing of a new *inter partes* reexamination of the '651 patent based on the newly cited Solovev and Bagautidinov II references. If granted, the request must set forth a substantial new question of patentability that is different from the substantial new question of patentability set forth in the previous examination.

CONCLUSION

1. The third party requester petition under 37 CFR 1.181 seeking the Director's review of the November 18, 2009 decision is **denied**.

2. The third party requester comments, dated May 12, 2009, are improper papers and are expunged from the record, as indicated in the November 19, 2009 decision. This decision makes no determination as to whether the third party requester's replacement comments, dated December 3, 2009, comply with 37 CFR 1.947 and 1.948.

3. The proceedings will be forwarded to the examiner, who will issue a new Office action, as appropriate, in due course. The examiner will determine if the replacement comments, dated December 3, 2009, fully comply with the requirements of 37 CFR 1.947 and 1.948. If the December 3, 2009 comments fail to comply with 37 CFR 1.947 and 1.948, the examiner shall state that such comments are improper papers and that the comments will be expunged from the record in the new Office action. No additional time will be given to file replacement comments.

4. Telephone inquiries related to this decision should be directed to Supervisory Patent Examiner Andy Kashnikow, at (571) 272-4361, or in his absence, to Gregory Morse, Director of the CRU, at (571) 272-3838.

Irem Yucel, Director
Technology Center 1600

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,048	05/30/2008	7216651	0101-P00636US10	5005

110 7590 06/30/2010

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/30/2010

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

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Date:

MAILED

JUN 3 0 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001048 ₹90/008,693
PATENT NO. : 7216651
TECHNOLOGY CENTER : 3999
ART UNIT : 3993

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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KNOBBE MARTENS OLSON & BEAR LLP
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Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NUMBER *95/001,048*.

PATENT NUMBER *7,216,651*.

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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Ex Parte Reexamination Proceeding :
Control No. 90/008,693 :
Filed: October 5, 2007 :
For: U.S. Patent No. 7,216,651 : **DECISION**
: **DISMISSING**
Inter Partes Reexamination Proceeding : **PETITION**
Control No. 95/001,048 :
Filed: May 30, 2008 :
For: U.S. Patent No. 7,216,651

This is a decision on *inter partes* requester's December 3, 2009 petition paper entitled "PETITION TO THE DIRECTOR UNDER 37 C.F.R. § 1.183" (hereinafter "petition under 37 CFR 1.183").

The 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 processed on December 4, 2009.

The petition is **dismissed**, for the reasons set forth herein.

BACKGROUND

1. United States Patent Number 7,216,651 (the '651 patent) issued on May 15, 2007.

2. On October 5, 2007, a request for *ex parte* reexamination of the '651 patent was filed by a first third party requester and assigned Reexamination Control No. 90/008,693 (the '8693 proceeding).

3. On November 26, 2007, the Office issued an order granting *ex parte* reexamination in the '8693 proceeding.

4. On May 30, 2008, a request for *inter partes* reexamination of the '651 patent was filed by a second third party requester and assigned Reexamination Control No. 95/001,048 (the '1048 proceeding).

5. On August 4, 2008, the Office issued an order granting *inter partes* reexamination in the '1048 proceeding.

6. On October 14, 2008, the Office mailed a decision merging the '8693 *ex parte* and '1048 *inter partes* reexamination proceedings ("the merged proceeding").

7. On February 12, 2009, the Office mailed a non-final Office action in the merged proceeding.

8. On April 13, 2009, patent owner filed a response to the February 12, 2009 Office action. In the response, patent owner did not amend the claims subject to reexamination.

9. On May 12, 2009, *inter partes* requester filed "THIRD PARTY COMMENTS ADDRESSING ISSUES RAISED BY THE FEBRUARY 12, 2009 OFFICE ACTION AND THE APRIL 13, 2009 PATENT OWNER'S REPLY" ("the May 12, 2009 comments submission"), presenting new proposed rejections based on newly submitted prior art.

10. On July 22, 2009, the Office mailed an Action Closing Prosecution ("ACP").

11. On August 21, 2009, patent owner filed a "STATEMENT UNDER 37 CFR 1.951(a)," responsive to the July 22, 2009 ACP.

12. On August 24, 2009, *inter partes* requester filed a "PETITION TO THE DIRECTOR UNDER 37 C.F.R. § 1.181" ("the August 24, 2009 petition under 37 CFR 1.181"), seeking the Director's review of the July 22, 2009 ACP.

13. On September 21, 2009, *inter partes* requester filed "THIRD PARTY COMMENTS UNDER 37 C.F.R. § 1.951(b) ADDRESSING ISSUES RAISED BY THE JULY 22, 2009 ACTION CLOSING PROSECUTION AND THE AUGUST 21, 2009 PATENT OWNER'S STATEMENT" ("the September 21, 2009 comments submission").

14. On November 18, 2009, the Office mailed a decision granting the August 24, 2009 petition under 37 CFR 1.181, seeking the Director's review of the July 22, 2009 ACP "to the extent of finding that the ACP may have incorrectly considered improperly raised new proposed rejection and is being vacated."[1] The Office closed and expunged the requester's May 12, 2009 comments submission from the record of the merged proceeding, and set a time period of 15 days for *inter partes* requester to submit corrected comments.

15. On December 3, 2009, *inter partes* requester filed a "PETITION TO THE DIRECTOR UNDER 37 C.F.R. § 1.181(a)(3)" ("the December 3, 2009 petition under 37 CFR 1.181"), requesting reconsideration of the November 18, 2009 decision.

16. Concurrently, on December 3, 2009, *inter partes* requester filed the instant "PETITION TO THE DIRECTOR UNDER 37 C.F.R. § 1.183" ("the petition under 37 CFR 1.183").

17. Also on December 3, 2009, *inter partes* requester filed a paper entitled "REFILED THIRD PARTY COMMENTS ADDRESSING ISSUES RAISED BY THE FEBRUARY 12, 2009 OFFICE ACTION AND THE APRIL 13, 2009 PATENT OWNER'S REPLY."

18. On December 22, 2009, the Office mailed a decision denying the December 3, 2009 petition under 37 CFR 1.181.

19. On January 15, 2010, the Office mailed an ACP, confirming all of the claims subject to reexamination (*i.e.*, claims 1-125). In the ACP, the examiner stated that patent owner's April 13, 2009 response has been entered and made of record, and that requester's December 3, 2009 comments has been entered and made of record.[2]

20. On March 12, 2010, the Office mailed a Right of Appeal Notice ("RAN").

21. On April 12, 2010, *inter partes* requester filed a Notice of Appeal.

22. On June 14, 2010, *inter partes* requester filed an appeal brief.

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.

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[1] November 18, 2009 decision at page 6.
[2] January 15, 2010 ACP at page 2.

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 1.181 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. 947 provides, 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. These comments shall be limited to issues raised by the Office action or the patent owner's response.

37 CFR 1. 948 provides, in pertinent part:

> (a) After the *inter partes* reexamination order, the third party requester may only cite additional prior art as defined under § 1.501 if it is filed as part of a comments submission under § 1.947 or § 1.951(b) and is limited to prior art:
> (1) which is necessary to rebut a finding of fact by the examiner;
> (2) which is necessary to rebut a response of the patent owner; or
> (3) which for the first time became known or available to the third party requester after the filing of the request for inter partes reexamination proceeding. Prior art submitted under paragraph (a)(3) of this section must be accompanied by a statement as to when the prior art first became known or available to the third party requester and must include a discussion of the pertinency of each reference to the patentability of at least one claim.

DECISION

In the December 3, 2009 petition under 37 CFR 1.183, *inter partes* requester (hereinafter "requester") requests waiver of 37 CFR §§ 1.947 and/or 1.948 to permit entry and consideration of its May 12, 2009 comments submission. The December 3, 2009 petition under 37 CFR 1.183 was filed concurrently with a petition under 37 CFR 1.181, requesting reconsideration of the Office's November 18, 2009 decision.

The November 18, 2009 decision granted the requester's August 24, 2009 petition under 37 CFR 1.181, seeking review of the July 22, 2009 ACP, to the extent of vacating the July 22, 2009 ACP. The November 18, 2009 decision also found requester's May 12, 2009 comments submission improper for introducing new proposed grounds of rejection based on newly submitted prior art. In particular, the Office found that "[t]he new proposed rejections in the comments of May 12, 2009 were not caused by the patent owner amendment in the paper of April 13, 2009 because the patent owner did not make any amendments to the claims. Therefore, the comments dated May 12, 2009 improperly included new proposed rejections and did not have a right of entry under 37 CFR 1.947 and 1.948."[3] The Office closed and expunged requester's May 12, 2009 comments submission from the record of the merged proceeding.

Subsequently, in the December 22, 2009 decision, the Office denied requester's December 3, 2009 petition under 37 CFR 1.181, requesting reconsideration of the Office's November 18, 2009 decision. In the December 22, 2009 decision, the Office reaffirmed its position that requester's May 12, 2009 comments submission improperly included new proposed rejections not necessitated by an amendment to the patent claims and, therefore, did not have a right of entry under 37 CFR 1.947 and 1.948.[4]

In the present petition under 37 CFR 1.183, requester asserts that "based on the Office's present reading of 37 C.F.R. §§ 1.947 and 1.948 that new proposed rejections can only be made if caused by the patent owner's amendment to the claims, Petitioner petitions for suspension of 37 C.F.R. § 1.947 and/or § 1.948 to permit entry and consideration of the Comments filed May 12, 2009." [5] In support of waiver of the rules, requester submits the following arguments:

(1) The MPEP explicitly provides for new proposed rejections under any one of 37 CFR 1.948(a)(1), (a)(2) or (a)(3);
(2) 37 CFR 1.948(a)(3) requires an explanation of the pertinency of the new art to the reexamined claims and all of the new proposed rejections in the May 12, 2009 comments submission were submitted to explain the pertinency of the new art to the patentability of at least one claim; and
(3) Purported inconsistencies between 37 CFR 1.947, 1.948 and MPEP 2666.05 provides good cause to suspend the rules and allow entry of the new proposed rejections. [6]

Further in support of waiver of the rules, requester asserts in the petition under 37 CFR 1.183:

> [A]llowing the entry and consideration of the New Proposed Rejections in the current proceeding will conserve the resources of the parties and the Office by obviating the need for the Petitioner to request a separate reexamination proceeding based on the New Art. As noted above, obviating the need for additional reexamination proceedings is an express policy goal of the Release Notes accompanying the implementation of the inter partes reexamination proceedings. 65 Fed. Reg. at 76,767. Allowing the entry of the New Proposed

[3] November 18, 2009 decision at page 5.
[4] December 22, 2009 decision at pages 5-8.
[5] The petition under 37 CFR 1.183 at page 4.
[6] *See*, the petition under 37 CFR 1.183 at pages 4-6 for requester's detailed discussion of these arguments.

> Rejections will also present a consolidated record for appeal and hasten the resolution of the parties' dispute, thus promoting the interests of justice. [7]

Analysis and Findings

1. 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.

Addressing the instant petition under 37 CFR 1.183, it is pointed out that the extraordinary relief of waiving a rule is not granted if the rules provide an alternative avenue for obtaining the relief sought. *See, Cantello v. Rasmussen*, 220 USPQ 664 (Comr. 1982). In this instance, the December 20, 2009 decision explicitly identified several alternative avenues for obtaining the relief sought by requester in the instant petition under 37 CFR 1.183. In particular, the December 22, 2009 decision set forth the following three alternative avenues if requester desires to bring the newly presented proposed rejections before the Office:

1. Initiate an *ex parte* reexamination of: the '651 patent based on the newly cited Solovev and Bagautidinov II references by filing a new and complete request for *ex parte* reexamination. The request must set forth a substantial new question of patentability that is different from the substantial new question of patentability set forth in the previous examination.

2. Initiate an *inter partes* reexamination of the '651 patent based on the newly cited Solovev and Bagautidinov II references by filing a new and complete request for *inter partes* reexamination, if a showing can be made that the newly cited art was unavailable at the time of filing the request in this proceeding, in accordance with the requirements of 35 U.S.C. 317(b) and 37 CFR 1.907. The request must set forth a substantial new question of patentability that is different from the substantial new question of patentability set forth in the previous examination.

3. File a petition under 35 U.S.C. 317(a) to authorize the filing of a new *inter partes* reexamination of the '651 patent based on the newly cited Solovev and Bagautidinov II references. If granted, the request must set forth a substantial new question of patentability that is different from the substantial new question of patentability set forth in the previous examination. [8]

Moreover, requester could have sought reconsideration of the December 22, 2009 decision, denying requester's December 3, 2009 petition under 37 CFR 1.181, but no such petition requesting reconsideration of the December 22, 2009 decision was timely filed by requester.

---

[7] The petition under 37 CFR 1.183 at page 6.
[8] December 22, 2009 decision at pages 8-9.

2. Even if 37 CFR 1.948 is shown to be satisfied or waived, such would not necessarily permit requester to propose a new ground of rejection based on additional art, as 37 CFR 1.947 must be satisfied in order for requester to be permitted to propose a new ground of rejection. And, 37 CFR 1.947 cannot be waived to the extent that it promulgates a requirement of the statute – in this instance, 35 U.S.C. 314(b)(2).

35 U.S.C. 314(b)(2) limits the content of requester's comments to "addressing issues raised by the action of the Office or the patent owner's response thereto." When new prior art is necessary to rebut a finding of fact by the examiner or a patent owner response, then a proposed new ground of rejection is limited to modification of the existing rejection by adding the new art that provides the rebuttal as per 37 CFR 1.948(a) or (b). An entirely new proposed new ground of rejection, however, is not permitted by 35 U.S.C. 314(b)(2), as such would not address "issues raised by the action of the Office or the patent owner's response," but rather would be adding a new rejection as a substitute for the originally proposed rejection.

If the proposed new ground of rejection is not limited to a rebuttal pursuant to 37 CFR 1.948(a) or (b), then there can be no 37 CFR 1.183 relief, because introduction of the proposed rejection in the reexamination proceeding is barred by 35 U.S.C. 314(b)(2) as not addressing "issues raised by the action of the Office or the patent owner's response," and the statute cannot be waived. If, on the other hand, the proposed new ground of rejection is limited to a rebuttal as per 37 CFR 1.948(a) or (b), then there is no need for 37 CFR 1.183 relief, since the proposed new ground of rejection has an entry right.

In this instance, requester's December 3, 2009 37 CFR 1.181 petition requested reconsideration of the November 18, 2009 decision finding that the proposed new ground of rejection lacked an entry right. The December 3, 2009 reconsideration petition was denied on December 22, 2009. The denial is a finding that the entry of the proposed new ground of rejection is barred by 35 U.S.C. 314(b)(2), as discussed above. Requester's remedy was to file a petition under 37 CFR 1.181(a)(3) for review of the denial decision by a higher official by January 22, 2009 (see 37 CFR 1.181(f), 2nd sentence). Requester did not do so. Thus, the finding that the proposed new ground of rejection is barred by 35 U.S.C. 314(b)(2) remains in place, and cannot be waived.

3. For the foregoing reasons, the instant petition under 37 CFR 1.183, requesting waiver of the rules for entry of requester's May 12, 2009 comments submission, **is dismissed**.

CONCLUSION

1. The *inter partes* requester's December 3, 2009 petition under 37 CFR 1.183 is **dismissed**.

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

3. 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

6-29-10
Kenpet8/IP

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,049	06/03/2008	7231363	WAL55.001	7753

63973 7590 05/06/2009

KEITH D. NOWAK
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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 05/06/2009

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:

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MAY 0 6 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001049
PATENT NO. : 7231363
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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MAY 0 6 2009

CENTRAL REEXAMINATION UNIT

James M. Denaro
Morrison & Foerster LLP
1650 Tysons Boulevard, Suite 400
McLean, Virginia 2210?

(For Third Party Requester)

In re Webster Hughes et al.	:	DECISION DISMISSING
Inter Partes Reexamination Proceeding	:	PETITION FOR
Control No.: 95/001,049	:	MERGER OF
Filed: June 3, 2008	:	REEXAMINATION
For: U.S. Patent No. 7,231,363	:	(37 CFR 1.182)

This is a decision on patent owner's "Petition To Merge *Inter Partes* Reexamination Control No. 95/001,049 with Reissue 12/256,212 Under 37 CFR 1.182 and to Waive the Restriction on Interviews" filed April 24, 2009.

The petition and the *inter partes* reexamination proceeding are before the Office of Patent Legal Administration for decision.

FEES

Petitioner patent owner has authorized a charge against Deposit Account No. 50-2499 for the $400.00 petition fee under 37 CFR 1.17(f) for filing the present 37 CFR 1.182 petition.

The petition is dismissed as being premature.

REVIEW OF SALIENT FACTS

1. U.S. Patent No. 7,231,3636 (the '363 patent) issued on June 12, 2007.

2. A request for *inter partes* reexamination was filed by a third party requester ("Bondesk")on June 3, 2008, and assigned control No. 95/001,049 (the "'1049 proceeding").

3. Reexamination was ordered in the '1049 reexamination proceeding on August 22, 2008. A non-final Office action was mailed in the '1049 reexamination concurrently therewith.

4. A timely response by the patent owner to the non-final Office action was received in the Office on October 22, 2008, and it was entered into the record.

5. Patent owner filed an application for reissue of the '363 patent on October 22, 2008. This application was assigned serial no. 12/256,212 (the '212 reissue).

6. A Notice to File Missing Parts was mailed in the '212 reissue application on May 6, 2009.

7. Third party requester Bondesk timely filed comments under 37 CFR 1.947 on November 21, 2008, which were entered into the record.

8. A Notice pursuant to 37 CFR 1.985 was filed by third party requester on April 8, 2009. In this notice, the third party requester notified the Office "that they will not further participate in the re-examination" of the '363 patent.

9. On April 24, 2009, patent owner filed the present petition for merger. The petition indicates that patent owner has deposited an application to reissue the '363 patent.

DECISION

A. Relevant Statutes, Regulations and Practice

35 U.S.C. § 305 provides, in part:

> All reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office.

37 CFR 1.903 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.

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:

> 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). ...
>
> A decision whether or not to merge the examination of a reissue application and an *inter partes* reexamination proceeding, or to stay one of the two, will not be made prior to the mailing of an order to reexamine the patent pursuant to 37 CFR 1.931. Until such time as reexamination is ordered, the examination of the reissue application will proceed. ...
>
> The decision on whether to merge the reissue application examination and reexamination proceeding, or stay one of them, will be made on a case-by-case basis. ...
>
> Where 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.

MPEP § 201.03(II)(B) provides, in part:

> An oath or declaration under 37 CFR 1.63 by each actual inventor must be presented. While each inventor need not execute the same oath or declaration, each oath or declaration executed by an inventor must contain a complete listing of all inventors so as to clearly indicate what each inventor believes to be the appropriate inventive entity. Where individual declarations are executed, they must be submitted as individual declarations rather than combined into one declaration.

MPEP § 605.04(a)(I) provides, in part:

> An oath or declaration under 37 CFR 1.63 by each actual inventor must be presented. While each inventor need not execute the same oath or declaration, each oath or declaration executed by an inventor must contain a complete listing of all inventors so as to clearly indicate what each inventor believes to be the appropriate inventive entity. Where individual declarations are executed, they must be submitted as individual declarations rather than combined into one declaration (by combining the signature ages).

B. Findings and Analysis

A review of the '212 application to reissue the '363 patent reveals that there is no proper declaration in the application. The Declaration forms submitted by applicant on February 11, 2009, are improper because each Declaration does not include a complete listing of the inventors. When multiple Declarations are submitted, each Declaration must be complete and contain a complete listing of all the inventors. (See MPEP 201.03(II)(B) and MPEP 605.04(a)) The 2-page declaration signed by Webster Hughes is not signed by the second inventor, Charles Fefferman. As filed, the additional page containing the signature of Charles Fefferman contains no indication that it is associated with the application to reissue the '363 patent and appears to be a printed portion of a web-page. A Notice to File Missing Parts requiring a properly signed declaration was mailed on May 6, 2009.

In accordance with MPEP § 2686.03, merger of the '1049 reexamination proceeding and the reissue application for the '363 patent will not be considered until the reissue application reaches the Technology Center. In the absence of a reissue application that has been (a) accepted as being complete and ready for examination and (b) forwarded to the Technology Center, consideration of the question of merger is premature. Accordingly, no consideration will be given to the presently requested merger.

It would be premature to consider merging the '1049 reexamination proceeding, which must be treated by the Office with special dispatch as required by 35 U.S.C. § 305, since examination of the reissue application for the '363 patent will be delayed because of the lack of a proper declaration and the application has not been forwarded to the Technology Center.

ADDITIONAL DISCUSSION

I. Reissue Oath in 12/256,212

Patent owner is advised that the oath as filed does not adequately identify an error that would support reexamination. Merely stating that the amended claim 1 "may be construed as being broader than the scope of claim 1 of the patent in at least one respect" does not unambiguously allege error and does not specify precisely where the

error lies. A proper error would require stating that the claim is broader and explaining in what respect the claim is broader.

II. Participation of third party requester Bondesk

In view of third party requester Bondesk's statement notifying the Office "that they will not further participate in the re-examination of U.S. Patent No. 7,231,363," the third party requester is deemed to have waived all its rights to participate further in the '1049 reexamination proceeding. Accordingly, no further participation communications by third party requester will be entered into the record.

III. Special Dispatch

In the interest of special dispatch mandated by 35 U.S.C. 305 and in light of third party requester Bondesk's statement that "they will not further participate in the re-examination," henceforth the proceeding will be forwarded to the examiner for action after patent owner provides its response without incurring the unnecessary delay of waiting upon the expiry of the period for the third party requester response (which will not be forthcoming).

IV. Service of Papers

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, as such is not a third party requester participation in the proceeding.

V. Request to Waive the 37 CFR 1.955 Prohibition of Interviews

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.

VI. Recourse

At the point in time when an application to reissue the '363 patent is determined by the Office to be complete, and is forwarded to the Technology Center for examination, a renewed petition for merger may be filed without additional fee. Any such renewed petition must explain, in detail, why merger is necessary.

CONCLUSION

1. The present patent owner petition is dismissed as being premature.

2. Patent owner may file a renewed petition requesting merger of an application to reissue the '363 with the '1049 reexamination proceeding, only after a reissue application for the '363 patent has been forwarded to the Technology Center for examination.

3. Telephone inquiries relating to this decision should be directed to Pinchus M. Laufer, Legal Advisor, at (571) 272-7726.

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

May 6, 2009
C:\Kiva\Kenpetmerger\ 1049_1.182 merge with reissue dismissed.doc

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,049	06/03/2008	7231363	WAL55.001	7753

63973 7590 09/17/2009

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ART UNIT	PAPER NUMBER

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Date: MAILED
SEP 17 2009
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001049
PATENT NO. : 7231363
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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SEP 17 2009

CENTRAL REEXAMINATION UNIT

James M. Denaro
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(For Third Party Requester)

In re Webster Hughes et al.
Inter Partes Reexamination Proceeding
Control No.: 95/001,049
Filed: June 3, 2008
For: U.S. Patent No. 7,231,363

DECISION DISMISSING RENEWED PETITION FOR FOR MERGER OF REISSUE AND *INTER PARTES* REEXAMINATION

This is a decision on patent owner's "RENEWED PETITION TO MERGE *INTER PARTES* REEXAMINATION CONTROL NO. 95/001,049 WITH REISSUE 12/256,212 UNDER 37 C.F.R. §§1.182 AND 1.183 AND TO WAIVE THE RESTRICTION ON INTERVIEWS" filed June 3, 2009.

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

The petition is dismissed, for the reasons set forth herein.

As both *inter partes* reexamination proceeding control no. 95/001,049 and reissue application serial no. 12/256,212 are public records, a copy of the instant decision for the 95/001,049 reexamination proceeding will be placed in the image file wrapper (IFW) of the 12/256,212 reissue application for subsequent consideration of suspension of action in the reissue application for the reasons set forth herein.

FEES

Pursuant to the Office's May 6, 2009 decision in the 95/001,049 reexamination proceeding entitled "DECISION DISMISSING PETITION FOR MERGER OF REEXAMINATION (37 CFR 1.182)," no additional fee is required for patent owner's June 3, 2009 renewed petition under 37 CFR 1.182 and 37 CFR 1.183.

REVIEW OF SALIENT FACTS

1. U.S. Patent No. 7,231,363 (the '363 patent) issued on June 12, 2007.

2. A request for *inter partes* reexamination was filed by a third party requester on June 3, 2008, which request was assigned control no. 95/001,049 (the '1049 reexamination proceeding).

3. Reexamination was ordered in the '1049 reexamination proceeding on August 22, 2008. A non-final Office action was mailed in the '1049 reexamination proceeding concurrently therewith.

4. A timely response by the patent owner to the non-final Office action was received in the Office on October 22, 2008, and it was entered into the record in the '1049 reexamination proceeding.

5. Also on October 22, 2008, patent owner filed an application for reissue of the '363 patent. This application was assigned serial no. 12/256,212 (the '212 reissue application).

6. Third party requester timely filed comments under 37 CFR 1.947 on November 21, 2008, which were entered into the record in the '1049 reexamination proceeding.

7. On December 2, 2008, notice of the '212 reissue application was published in the *Official Gazette*.

8. On April 8, 2009, the Office received a third party requester paper entitled "THIRD-PARTY NOTICE PURSUANT TO 37 C.F.R. 1.985 OF SETTLEMENT OF CO-PENDING LITIGATION" (notice under 37 CFR 1.985) in the '1049 reexamination proceeding, notifying the Office "that they will not further participate in the re-examination" of the '363 patent.

9. On April 24, 2009, the Office received a patent owner paper entitled "PETITION TO MERGE *INTER PARTES* REEXAMINATION CONTROL NO. 95/001,049 WITH REISSUE 12/256,212 UNDER 37 CFR §1.182 AND TO WAIVE THE RESTRICTION ON INTERVIEWS" (request for merger) in the '1049 reexamination proceeding, requesting merger of the '1049 reexamination proceeding with the '212 reissue.

10. A Notice to File Missing Parts was mailed in the '212 reissue application on May 6, 2009.

11. Also, on May 6, 2009, the Office mailed, in the '1049 reexamination proceeding, a "DECISION DISMISSING PETITION FOR MERGER OF REEXAMINATION (37 CFR 1.182)," dismissing patent owner's April 24, 2009 petition for merger as premature in view of the outstanding May 6, 2009 Notice to File Missing Parts in the '212 reissue application.

12. On May 15, 2009, the Office mailed an Action Closing Prosecution in the '1049 reexamination proceeding.

13. On May 19, 2009, a timely response by patent owner entitled "RESPONSE TO FILE MISSING PARTS OF REISSUE APPLICATION" was received by the Office in the '212 reissue application.

14. On June 3, 2009, the Office received the instant patent owner petition entitled "RENEWED PETITION TO MERGE *INTER PARTES* REEXAMINATION CONTROL NO. 95/001,049 WITH REISSUE 12/256,212 UNDER 37 C.F.R. §§1.182 AND 1.183 AND TO WAIVE THE RESTRICTION ON INTERVIEWS" (renewed request for merger) in the '1049 reexamination proceeding.

15. On June 15, 2009, a timely § 1.951(a) submission after the May 15, 2009 Action Closing Prosecution by patent owner entitled "AMENDMENT AND RESPONSE" was received by the Office in the '1049 reexamination proceeding.

16. On June 25, 2009, the '212 reissue application was docketed to the examiner in the Technology Center for examination.

17. On September 16, 2009, a non-final Office action was mailed in the '212 reissue application.

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.
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> (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.
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> 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. Renewed Request under 37 CFR 1.182 for Merger

The '212 reissue application and the '1049 reexamination proceedings are currently pending for the same patent. The order has been mailed pursuant to 37 CFR 1.931 for the '1049 reexamination proceeding, and the '212 reissue application has been announced in the *Official Gazette* more than two months ago, it is complete and ready for examination, and has been forwarded to the Technology Center. Accordingly, consideration of patent owner's June 3, 2009 renewed request for merger of the '212 reissue application and the '1049 reexamination

proceedings is appropriate at this time.[1]

In support of its renewed request for merger of the '1049 reexamination proceeding and the '212 reissue application, patent owner notes that it is the "sole participant" in the '1049 reexamination proceeding and in the '212 reissue application, as third party requester has withdrawn from the '1049 reexamination proceeding pursuant to third party requester's April 8, 2009 notice under 37 CFR 1.985.[2]

Further in support of its renewed request for merger of the '1049 reexamination proceeding and the '212 reissue application, patent owner "submits that the failure to merge the two proceedings at this time could result in possible inconsistent and conflicting results."[3] In particular, patent owner notes that the '212 reissue application and '1049 reexamination proceeding are at different stages of examination, with a second non-final Office action having been issued in the '1049 reexamination proceeding on May 15, 2009 and the '212 reissue application having yet to be examined.[4] Moreover, patent owner submits that "[t]he claims rejected in the second non-final action dated May 15, 2009, which issued in the *inter partes* reexamination are identical to the claims submitted for examination in the reissue proceeding" and that "the failure to merge the two proceedings could result in inconsistent results as two different Examiners, in two different departments of the Patent Office, would be examining the same set of claims, potentially leading to two different versions of allowable subject matter. Also, if the two proceedings are not merged, both the Patent Owner-Wall and the Patent Office will have to expend unnecessary resources in order to examine a single set of claims."[5]

Additionally, patent owner distinguishes a "DECISION DISMISSING A PETITION TO MERGE REISSUE AND *INTER PARTES* REEXAMINATION PROCEEDINGS," issued in *inter partes* reexamination control no. 95/000,408 on May 7, 2009 (referred to by patent owner in the renewed request for merger as "*Devecka*"). Patent owner asserts, "[t]he sole similarity between *Devecka* and the present Renewed Petition is that a possible broadening reissue proceeding is co-pending with a reexamination proceeding. The remaining facts surrounding *Devecka* are clearly distinguishable from the present Renewed Petition."[6] In particular, among other differences, patent owner distinguishes the request for merger in *Devecka* from the instant renewed request for merger in the '1049 reexamination proceeding on the basis that a third party requester filed the request for merger in *Devecka*, whereas patent owner filed the instant renewed request for merger in the '1049 reexamination proceeding, and third party requester was "actively involved" in *Devecka*, whereas third party requester has withdrawn from participation in the '1049 reexamination proceeding.[7]

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[1] Patent owner's April 24, 2009 request for merger was dismissed as premature, because the '212 reissue application had not yet been forwarded to the Technology Center for examination. On December 2, 2008, notice of the '212 reissue application was published in the *Official Gazette*.

[2] *See* renewed request for merger at page 3.

[3] *Id.* at page 4.

[4] *See id.*

[5] *Id.* Note that, as discussed in Section C.2 of this decision, the claims are no longer identical in the '1049 proceeding and the '212 reissue application.

[6] *Id.* at page 5.

[7] *Id.* at pages 5-6.

C. Status of Proceedings and Claims of Record

On June 15, 2009, patent owner timely filed in the '1049 reexamination proceeding an "AMENDMENT AND RESPONSE" to the May 15, 2009 Action Closing Prosecution.[8] On June 25, 2009, the '212 reissue application was docketed to the examiner in the Technology Center for examination. No Office action has been mailed in the '212 reissue application.

Claims 1-15 are pending in the '1049 reexamination proceeding. Original claims 1, 8, 9 and 13 have been amended. New claims 16-26 were added in the reexamination proceeding, but an amendment after ACP filed June 15, 2009 directs their cancellation.[9] Claims 1-26 are pending in the '212 reissue application. Original claims 1, 8 and 9 have been amended in the reissue application to be identical to amended claims 1, 8 and 9 in the '1049 reexamination proceeding.[10] New claims 16-26 have been added in the reissue, while patent owner has submitted an amendment canceling claims 16-26 in the reexamination. Thus, the claims of the '212 reissue application and the '1049 reexamination proceeding are no longer identical.

D. Analysis and Findings

In considering patent owner's instant renewed request for merger, the following options have been evaluated: (1) merging the '212 reissue application and '1049 reexamination proceedings, (2) conducting the '212 reissue application and '1049 reexamination proceedings separately and at the same time, and (3) suspending one of the '212 reissue application and '1049 reexamination proceedings.

1. The Merger Option

In making a decision on whether or not to merge the reissue application examination and the reexamination proceeding, consideration is given as to the status of the two proceedings and 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.[11] While it is noted that third party requester's withdrawal from participation in the '1049 reexamination proceeding would likewise preclude third party requester from participating in a merged proceeding, in this instance, it is not deemed beneficial to merge the '212 reissue application and '1049 reexamination proceedings for the foregoing reasons.

When Congress legislated the *inter partes* reexamination statute, Congress provided, in 35 U.S.C. § 314(a), the following unambiguous limitation:

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[8] No responsive comments under 37 CFR 1.951(b) were filed by third party requester in view of requester's withdrawal from participation in the '1049 proceeding.

[9] Admission of an amendment after ACP is subject to the criteria of 37 CFR 1.116. The amendment directed solely to cancellation of claims 16-26 would appear to be entitled to entry. However, the amendment as presented does not conform to 37 CFR 1.530 and thus may be subject to refusal.

[10] With the exception of claim 13, at the time patent owner filed the instant renewed request for merger, the claims in the '212 reissue application and in the '1049 reexamination proceeding were identical. *See* "NOTICE OF CONCURRENT PROCEEDING" filed by patent owner in the '212 reissue application on October 22, 2008.

[11] *See* MPEP 2686.03.

> "In any *inter partes* reexamination proceeding under this chapter, the patent owner shall be permitted to propose any amendment to the patent and a new claim or claims, **except that no proposed amended or new claim enlarging the scope of the claims of the patent shall be permitted.**" [Emphasis added]

The '212 reissue application was filed within two years of the '363 patent issue date so, even if broadening claims are not presently included in the '212 reissue application, applicant/patent owner could provide broadening claims at some future point in the prosecution. Thus, a decision to merge the '212 reissue application and '1049 reexamination proceedings would include, within the merged proceeding, any such broadened claims that may be subsequently added.[12] The addition of such broadened claims would require further consideration as to support for the broadened scope, and it might require a further search and the application of new art, which would severely retard the '1049 reexamination proceeding in contradiction to the statutory mandate of 35 U.S.C. § 314(c) for special dispatch. Even if the claims are not broadened, the examiner must (a) consider grounds of rejection of the patent claims other than those based solely on prior patents and printed publications and (b) evaluate the adequacy and propriety of the reissue declaration, which will further retard the prompt resolution of the reexamination proceeding in contradiction to the statutory mandate of 35 U.S.C. § 314(c) for special dispatch.

It is to be noted that the statutory mandate of 35 U.S.C. § 314(c) is based upon the public interest in providing certainty and finality in resolving the question of patentability raised by the request for reexamination - with special dispatch. The public interest continues on, even if the third party requester elects not to participate in the reexamination proceeding. In this case, the patent owner did not complete the reissue application until May 19, 2009, at which point the prosecution in the reexamination proceeding had already advanced to the late stage where an Action Closing Prosecution (ACP) had already been issued. It would not be appropriate to reopen that closed prosecution to address the above-described issues that would be presented by inclusion of the reissue application. Such a reopening would severely retard resolution of the question of patentability raised by the request, contrary to the public's interest.

It is also to be observed that since the '1049 reexamination proceeding is currently after ACP, the next action anticipated in the '1049 proceeding is the issuance of a Right of Appeal Notice. If the proceedings were merged at this stage, and a Right of Appeal Notice (RAN) or a RAN-equivalent action was issued despite all the issues added by the reissue, Office practice is that any request for continued examination (RCE) under 37 CFR 1.114 would automatically sever the merged proceeding. Thus, even if proceedings were merged at this stage and prosecution were not reopened based on the reissue issues, the merger may very well be an extra step that simply would be undone.

In view of the foregoing considerations, it is not deemed beneficial to consolidate the '212 reissue application and '1049 reexamination proceedings within the Office. Accordingly, patent owner's renewed request under 37 CFR 1.182 for merger of the '212 reissue application and the '1049 reexamination proceedings is dismissed.

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[12] In fact, the reissue declaration submitted May 19, 2009 identifies the error to be corrected as "The original claim 1 ... and thus is less than what the Patent Owner is permitted to claim", which is a clear statement of an intent to broaden.

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.[13] 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 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 '212 reissue application and the '1049 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 '212 reissue application and the '1049 reexamination proceeding will not be merged and will not be conducted separately and at the same time, for the 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 '1049 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 this instance, a significant amount of prosecution has taken place in the '1049 reexamination proceeding. An order granting reexamination was issued on August 22, 2008, accompanied by a non-final Office action rejecting the original claims of the '363 patent. A patent owner response to the Office action was filed on October 22, 2008, amending original claims 1, 8, 9 and 13 and adding new claims 16-26, and third party requester comments were filed on November 21, 2008 in response to the patent owner's response. Additionally, an Action Closing Prosecution was issued on May 15, 2009, rejecting pending claims 1-26, and a patent owner response to the Action Closing Prosecution has been filed, canceling claims 16-26. In contrast, the '212 reissue application was not filed until October 22, 2008, and the '212 reissue application was not forwarded to the Technology Center and docketed for examination until June 25, 2009. A first Office action on the merits has very recently been issued for the '212 reissue application. Thus, a suspension of the '212 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 '1049 reexamination proceeding would result in such a delay, contrary to the statutory mandate for special dispatch in reexamination.

Finally, the '212 reissue application was filed prior to the expiration of the statutory period for

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[13] *See* MPEP 2686.03.

broadening the patent claims; *i.e.*, two years from the date of patent grant, and the reissue declaration submitted May 19, 2009 evidences an intent to broaden.[14] A suspension of the '212 reissue proceeding will not interfere with that purpose, since the patent owner's right to have the broadened claims considered by the Office will be preserved.

Thus, it is appropriate to suspend action in the reissue application. The Office will not suspend action at this point in time, because - if a reply by applicant to an Office action is outstanding, 37 CFR 1.103(a) dictates that action is not suspended. However, based on the foregoing analysis, action in the '212 reissue application will be suspended pursuant to 37 CFR 1.103(e) in favor of the '1049 reexamination proceeding following receipt of reissue applicant's response to the outstanding September 15, 2009 Office action in the '212 reissue application, unless the time period for response expires without a timely response, in which case the reissue application will become abandoned. The '212 reissue application suspension would remain in effect until the conclusion of the '1049 *inter partes* reexamination proceeding by the issuance of the reexamination certificate.

E. Renewed Petition under 37 CFR 1.183 to Waive the Prohibition of Interviews

In the instant renewed petition under 37 CFR 1.183, patent owner has requested waiver of the prohibition against interviews under 37 CFR 1.955 for a one-time interview in the merged proceeding.[15] In support of its request, patent owner notes that patent owner will be the sole participant in the '212 reissue application and '1049 reexamination proceedings in view of third party requester's withdrawal from participation in the '1049 reexamination proceeding.[16] Additionally, patent owner states "[t]he need for an interview is also paramount as the pending Office Action in the reexamination proceeding is 27 pages long and addresses a host of issues" and that "an interview with the Examiner is the most efficient means to deal with the outstanding issues, while at the same time providing assistance to the Examiner in reaching a fair and reasonable decision on allowable subject matter."[17]

In this instance, the facts set forth by patent owner do not give rise to an extraordinary situation in which justice requires suspension of 37 CFR 1.955, as patent owner has since filed a submission after the May 15, 2009 Action Closing Prosecution in the '1049 reexamination proceeding. 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 renews this petition under 37 CFR 1.183 for a one-time waiver of 37 CFR 1.955, no additional petition fee would be required to be submitted. However, patent owner would be required to show extraordinary circumstances as to why the one-time 37 CFR 1.957(a) limitation should be waived to permit any further response that the requested interview might generate, as well as a discussion of the specific issues that would be addressed.

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[14] The reissue declaration submitted May 19, 2009 identifies the error to be corrected as "The original claim 1 ... and thus is less than what the Patent Owner is permitted to claim", which is a clear statement of an intent to broaden.
[15] *See* renewed request for merger at page 6.
[16] *Id.*
[17] *Id.* at pages 6-7.

CONCLUSION

1. Patent owner's June 3, 2009 "RENEWED PETITION TO MERGE *INTER PARTES* REEXAMINATION CONTROL NO. 95/001,049 WITH REISSUE 12/256,212 UNDER 37 C.F.R. §§1.182 AND 1.183 AND TO WAIVE THE RESTRICTION ON INTERVIEWS" is dismissed.

2. Action in the 12/256,212 reissue application is to be suspended by the Technology Center pursuant to 37 CFR 1.103(e) following receipt of a timely reply (by reissue applicant) to the outstanding September 15, 2009 Office action in the '212 reissue application. Such suspension of the '212 reissue application would remain in effect until the completion of the *inter partes* reexamination proceeding control number 95/001,049 by the issuance and publication of the reexamination certificate. After the reexamination certificate for the '1049 reexamination proceeding has issued and published, an Office action would be mailed for the '212 reissue application.

3. As both *inter partes* reexamination proceeding control no. 95/001,049 and reissue application serial no. 12/256,212 are public records, a copy of the instant decision for the 95/001,049 reexamination proceeding is being placed in the image file wrapper (IFW) of the 12/256,212 reissue application.

4. At the time that a reexamination certificate is issued and published for the '1049 reexamination proceeding, patent owner is advised, in the event the reissue application is still pending, to bring the issuance and publication of the certificate to the attention of the Office, and to request a resumption of examination of the '212 reissue application. Patent owner may include an amendment of the '212 reissue application claims at that time, if it is deemed appropriate to amend based upon the results of the '1049 reexamination proceeding. If all patent claims should be cancelled by the certificate, a petition under 37 CFR 1.183 would be required to waive 37 CFR 1.997(d).

5. Telephone inquiries relating to the examination of the '212 reissue application should be directed to the primary examiner, Jagdish Patel, at (571) 272-6748.

6. Telephone inquiries relating to this decision should be directed to Nicole Dretar, Legal Advisor, at (571) 272-7717 or Pinchus M. Laufer, Legal Advisor, at (571) 272-7726.

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

9-16-09

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,049	06/03/2008	7231363	WAL55.001	7753

63973 7590 12/22/2009

KEITH D. NOWAK
CARTER LEDYARD & MILBURN LLP
2 WALL STREET
NEW YORK, NY 10005

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 12/22/2009

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
MORRISON & FOERSTER
1650 TYSONS BOULEVARD
SUITE 400
MCLEAN, VA 22102

Date:
MAILED
DEC 2 2 2009
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001049
PATENT NO. : 7231363
TECHNOLOGY CENTER : 3999
ART UNIT : 3993

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

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

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

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

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(For Patent Owner)

MAILED

DEC 22 2009

CENTRAL REEXAMINATION UNIT

JAMES M. DENARO
MORRISON & FOERSTER LLP
1650 TYSONS BOULEVARD, SUITE 400
MCLEAN, VIRGINIA 22102

(For Third Party Requester)

In re Webster Hughes et al.
Inter Partes Reexamination Proceeding
Control No.: 95/001,049
Filed: June 3, 2008
For: U.S. Patent No. 7,231,363

DECISION GRANTING RENEWED PETITION UNDER 37 CFR 1.183 FOR WAIVER OF 37 CFR 1.955

This is a decision on patent owner's "RENEWED PETITION UNDER 37 CFR § 1.183 FOR A ONE-TIME WAIVER OF 37 CFR § 1.955," filed on October 20, 2009.

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

The petition is granted to the extent set forth herein.

FEES

Pursuant to the Office's September 17, 2009 decision in the 95/001,049 reexamination proceeding entitled "DECISION DISMISSING RENEWED PETITION FOR MERGER OF REISSUE AND *INTER PARTES* REEXAMINATION," no additional fee is required for patent owner's October 20, 2009 renewed petition under 37 CFR 1.183.

BACKGROUND

1. U.S. Patent No. 7,231,363 (the '363 patent) issued on June 12, 2007.

2. A request for *inter partes* reexamination was filed by a third party requester on June 3, 2008, which request was assigned control no. 95/001,049 (the '1049 proceeding).

3. Reexamination was ordered in the '1049 proceeding on August 22, 2008. A non-final Office action was mailed in the '1049 proceeding concurrently therewith.

4. A timely response by the patent owner to the non-final Office action was received in the Office on October 22, 2008, and it was entered into the record in the '1049 proceeding.

5. Third party requester timely filed comments under 37 CFR 1.947 on November 21, 2008, which were entered into the record in the '1049 proceeding.

6. On April 8, 2009, the Office received a third party requester paper entitled "THIRD-PARTY NOTICE PURSUANT TO 37 C.F.R. 1.985 OF SETTLEMENT OF CO-PENDING LITIGATION" in the '1049 proceeding, notifying the Office "that they will not further participate in the re-examination" of the '363 patent.

7. On April 24, 2009, the Office received, in the present '1049 proceeding, a patent owner paper entitled "PETITION TO MERGE *INTER PARTES* REEXAMINATION CONTROL NO. 95/001,049 WITH REISSUE 12/256,212 UNDER 37 CFR §1.182 AND TO WAIVE THE RESTRICTION ON INTERVIEWS" (a petition for merger and waiver of restriction on interviews).

8. Also, on May 6, 2009, the Office mailed, in the '1049 proceeding, a "DECISION DISMISSING PETITION FOR MERGER OF REEXAMINATION (37 CFR 1.182)," dismissing patent owner's April 24, 2009 petition for merger and waiver of restriction on interviews.

9. On May 15, 2009, the Office mailed an Action Closing Prosecution (ACP) in the '1049 proceeding.

10. On June 3, 2009, the Office received, in the present '1049 proceeding, patent owner's petition paper entitled "RENEWED PETITION TO MERGE *INTER PARTES* REEXAMINATION CONTROL NO. 95/001,049 WITH REISSUE 12/256,212 UNDER 37 C.F.R. §§1.182 AND 1.183 AND TO WAIVE THE RESTRICTION ON INTERVIEWS" (renewed request for merger and waiver of restriction on interviews).

11. On June 15, 2009, a timely § 1.951(a) submission after the May 15, 2009 ACP by patent owner entitled "AMENDMENT AND RESPONSE" was received by the Office in the '1049 proceeding.

12. On September 17, 2009, a "DECISION DISMISSING RENEWED PETITION FOR MERGER OF REISSUE AND *INTER PARTES* REEXAMINATION" was mailed in the '1049 proceeding, dismissing patent owner's June 3, 2009 renewed petition for merger and waiver of restriction on interviews.

13. On September 19, 2009, patent owner submitted a petition paper in the '1049 proceeding entitled "RENEWED PETITION UNDER 37 CFR § 1.183 FOR A ONE-TIME WAIVER OF 37 CFR § 1.955," which was not accompanied by a certificate of service.

14. On September 20, 2009, patent owner filed a petition paper in the '1049 proceeding, identical to the September 19, 2009 petition paper, and accompanied it by a certificate of service (renewed petition under 37 CFR 1.183).

15. On November 3, 2009, the Office mailed a Right of Appeal Notice in the '1049 proceeding.

16. On December 3, 2009, patent owner filed a "NOTICE OF APPEAL UNDER 35 USC §134(b), 37 CFR 1.959 AND 37 CFR 41.61" in the '1049 proceeding.

DECISION

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.
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> (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 1.955 provides:

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

Patent Owner's Renewed Petition under 37 CFR 1.183

In the instant petition under 37 CFR 1.183, patent owner requests a one-time waiver of the prohibition of interviews in the '1049 proceeding. 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 support of its request for waiver of 37 CFR 1.955 to conduct a single interview with the Office, patent owner asserts two bases: (1) the fact that patent owner is now the sole participant

in the '1049 proceeding, and (2) the complexity and length of the May 15, 2009 ACP "includes issues that can be best addressed by the named inventors at an interview with the Examiner, thereby allowing the Examiner to fully address all questions and issues relating to patentability."[1]

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 had 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. 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." Thus, the key 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 '1049 *inter partes* reexamination proceeding.[2] Thus, only a single party (patent owner) will now participate in the '1049 proceeding, and any interview that might be permitted in the proceeding. Accordingly, patent owner asserts in the instant petition under 37 CFR 1.183 that "the withdrawal of the Third Party Requestor removes any concern that an interview would interfere with the Office's ability to conduct the proceeding with special dispatch...."[3]

Further, in the instant petition under 37 CFR 1.183, patent owner sets forth, with specificity, five issues patent owner believes should be addressed at the interview, in addition to a description of the inventors' qualifications.[4] Additionally, patent owner asserts that "[t]he complexity of the ACP required an in depth analysis of the grounds for rejection and extensive consultation with the named inventors. It is stated that it became clear, after consultation with the inventors, that an interview with the Examiner would be the best and most expeditious approach for addressing the numerous issues raised in the ACP, correcting certain incorrect statements made on behalf of the Third Party Requestor, and addressing the differences between the invention and the prior art."[5] Patent owner further points out that "[u]pon receiving no response to its [June 3, 2009] Petition, the Patent Owner had no choice but to respond to the ACP on June 15, 2009, the last possible day to respond within the one month deadline. Therefore the Patent Owner was required to respond to the ACP while its Petition for a Waiver of 37 CFR§ 1.955 was pending as no other course of action was available in order to timely respond to the ACP."[6] Accordingly,

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[1] Renewed petition under 37 CFR 1.183 at page 2.

[2] See April 8, 2009 "THIRD-PARTY NOTICE PURSUANT TO 37 C.F.R. 1.985 OF SETTLEMENT OF CO-PENDING LITIGATION" (stating "On March 27, 2009, the BondDesk Parties and Wall Corp. settled all patent-related disputes between them.... The BondDesk Parties hereby notify the PTO, including Examiner Graham, that they will not further participate in the re-examination of U.S. Patent No. 7,231,363, and that they do not object to the re-examination being converted to an ex- parte re-examination proceeding.")

[3] Renewed petition under 37 CFR 1.183 at page 6,

[4] See renewed petition under 37 CFR 1.183 at pages 2-3.

[5] Renewed petition under 37 CFR 1.183 at page 5.

[6] Renewed petition under 37 CFR 1.183 at page 6.

patent owner asserts that "an interview with the Examiner will unquestionably shorten the proceedings as the Examiner will be able to address any questions or concerns directly to the two inventors who are experts in their fields."[7]

Based on the present facts and circumstances, it is found that permitting an interview to be conducted at this point in the '1049 *inter partes* proceeding is not anticipated to potentially hinder the ability of the Office to conduct the '1049 proceeding with special dispatch, but rather may well assist the Office in expeditiously resolving the proceeding. Accordingly, in view of the particular facts and circumstances set forth herein, in this instance and at this point, the record in the '1049 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 proceeding, 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.

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.

[7] Renewed petition under 37 CFR 1.183 at page 6.

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 interview will not be permitted at any other time or place, without the authority of the Director.

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 also free to extend the interview, at the examiner's sole discretion.

3. The interview should be attended by the conferees who signed the November 3, 2009 Right of Appeal Notice, 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, taking into account that the present proceeding is an *inter partes* reexamination proceeding. A copy of the interview summary form is to 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 of the form is to 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 as a separate paper filed within one month from the date of the interview.

2. All papers filed by patent owner in the '1049 *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 October 20, 2009 renewed petition under 37 CFR 1.183 to waive the provisions of 37 CFR 1.955 is granted to the extent that a single interview will be permitted, upon compliance with the Preliminary Requirements set forth above.

2. The provisions of 37 CFR 1.955 are waived solely on the present facts and circumstances, and solely for the purposes of conducting one interview with respect to the November 3, 2009 Right of Appeal Notice.

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 '1049 *inter partes* reexamination proceeding is returned to Art Unit 3993 of the Central Reexamination Unit for action not inconsistent with this Decision.

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

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

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.
95/001,050	06/12/2008	6850130	RYMSA.004RX	9517

23117 7590 07/21/2008

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 07/21/2008

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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Date:
MAILED

JUL 21 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 95001050
PATENT NO. : 6850130
ART UNIT : 3992

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

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

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(For Patent Owner)

MAILED

JUL 21 2008

CENTRAL REEXAMINATION UNIT

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2040 Main Street, 14th Floor
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(For Requester)

In re Gottl et al.
Inter Partes Reexamination Proceeding
Control No. 95/001,050
Filed: June 12, 2008
For: U.S. Patent No. 6,850,130

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

This is a decision on the petition filed by the third party requester on June 26, 2008, under 37 CFR 1.182 and 1.183, to waive 37 CFR 1.939 in order to submit a supplemental paper providing materials from co-pending litigation. This decision also addresses the supplemental petition filed by third party requester on July 8, 2008 under 37 CFR 1.182 and 37 1.183, to also waive 37 CFR 1.939 with respect to an additional document from the co-pending litigation.

The petitions and reexamination control number 95/001,050 are before the Office of Patent Legal Administration for consideration.

For the reasons set forth below, the patent owner petitions are dismissed. However, the litigation documents filed with the petitions will be entered, pursuant to 37 CFR 1.985.

FEES

The patent owner has remitted a $400.00 petition fee under 37 CFR 1.17(f) as required by 37 CFR 1.182 and 1.183 for each of the petitions.

REVIEW OF SALIENT FACTS

1. U.S. Patent No. 6,850,130 (the '130 patent) issued on February 1, 2005.

2. A request for *inter partes* reexamination of the '130 patent was filed on June 4, 2008 and assigned control number 95/001,050 (the '1050 *inter partes* reexamination proceeding).

3. On June 5, 2008, a Notice of Failure to Comply With *Inter Partes* Reexamination Request Filing Requirements (37 CFR 1.915(d)) ("June 5, 2008 Notice") was mailed to the reexamination requester ("third party requester").

4. On June 12, 2008, third party requester filed papers addressing the June 5, 2008 Notice.

5. The June 12, 2008 papers filed by third party requester also included documents from co-pending litigation on the '130 patent (Kathrein-Werke KG v. Radiación y Microondas S.A., Civil Action No. 1:07-CV-2921).

6. On June 16, 2008, patent owner and third party requester were notified that the June 12, 2008 papers were acceptable, and that the '1050 *inter partes* reexamination proceeding had been accorded a filing date of June 12, 2008.

7. On June 26, 2008, third party requester also filed an additional document from the co-pending litigation and one of the present petitions requesting waiver of the rules for entry of the litigation related document.

8. On July 8, 2008, third party requester filed the second of the present petitions, and an additional litigation document.

APPLICABLE REGULATIONS AND PRACTICE

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 1.985 (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."

MPEP § 2686 provides, in part:

> "It is important for the Office to be aware of any prior or concurrent proceedings in which a patent undergoing *inter partes* reexamination is or was involved, such as interferences, reissues, reexaminations or litigations, and any results of such proceedings. In accordance with 37 CFR 1.985, 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, while an *inter partes* reexamination proceeding is pending, third party submissions filed after the date of the order are not entered into the reexamination file or the patent file, unless the third party is a third party reexamination requester. 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. 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 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. Any proper submission pursuant to 37 CFR 1.985 will be promptly entered into the record of the reexamination file."

DECISION

On June 12, 2008, June 26, 2008 and July 8, 2008, third party requester filed certain documents in the '1050 *inter partes* reexamination proceeding. These documents are stated to be documents that are part of the record in copending litigation involving the '130 patent. 37 CFR 1.939(b) precludes the submission of papers (other than the request for *inter partes* reexamination) by either party to an *inter partes* reexamination proceeding prior to the mailing by the Office of the first action on the merits (i.e. claim patentability) in the proceeding. The Office has not yet acted on the request for *inter partes* reexamination to determine whether the request establishes one or more substantial new questions of patentability, or mailed a first Office action on the patentability of any of the '130 patent claims. Therefore, third party requester has filed two petitions requesting waiver of the provisions of 37 CFR 1.939(b) to permit entry and consideration of the litigation documents.

However, 37 CFR 1.985(b) expressly permits any person at any time to file a paper in an *inter partes* reexamination proceeding if that paper notifies the Office of a prior or concurrent litigation proceeding involving the patent that is the subject of such *inter partes* reexamination proceeding. MPEP § 2686 discusses the submission of such documents in detail, and states that "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." Further such submission must be limited to "bare notice," i.e., no discussion based on the submitted documents is permitted.

A review of the submitted documents shows that they in fact constitute "bare notice" of the concurrent litigation involving the '130 patent. Therefore, the litigation documents are entitled to entry under 37 CFR 1.985(b), and the petitions to waive 37 CFR 1.939 are considered to be moot.

CONCLUSION

1. The petitions filed on June 26, 2008 and July 8, 2008 to waive the provisions of 37 CFR 1.939 are dismissed as being moot.

2. The litigation papers filed on June 12, 2008, June 26, 2008 and July 8,2008 have been entered into the record for such consideration as may be appropriate.

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

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

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,050	06/12/2008	6850130	RYMSA.004RX	9517

23117 7590 07/21/2008

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 07/21/2008

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Date MAILED

JUL 21 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 95001050
PATENT NO. : 6850130
ART UNIT : 3992

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

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

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JUL 21 2009

CENTRAL REEXAMINATION UNIT

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(For Requester)

In re Gottl et al.
Inter Partes Reexamination Proceeding
Control No. 95/001,050
Filed: June 12, 2008
For: U.S. Patent No. 6,850,130

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

This is a decision on the third party requester's "PETITION UNDER 37 CFR 1.182 AND 1.183 TO WAIVE 37 CFR 1.939 AND SUBMIT CORRECTED EXHIBIT 10," filed June 19, 2008. The petition is taken as a petition under 37 CFR 1.182 and 1.183 to seal an originally filed paper, and to substitute a corrected version of that paper.

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

For the reasons set forth below, the patent owner petition is granted.

FEES

The patent owner has paid the $400.00 petition fee under 37 CFR 1.17(f) as required by 37 CFR 1.182 and 1.183.

REVIEW OF SALIENT FACTS

1. U.S. Patent No. 6,850,130 (the '130 patent) issued on February 1, 2005.

2. A request for *inter partes* reexamination of the '130 patent was filed on June 4, 2008 and assigned control number 95/001,050 (the '1050 *inter partes* reexamination proceeding).

3. Exhibit 10, which was submitted along with the request for *inter partes* reexamination on June 4, 2008, was referred to in Footnote 1 in the request as "a copy of German Patent Application No. 199 38 862.8 and an English translation thereof."

4. On June 19, 2008, the requester filed the present petition, noting that the wrong German document was submitted on June 4, 2008, but that the English translation document was a translation of the German document that was intended to have been submitted, i.e., the "correct" German document. Enclosed along with this present petition is a copy of the corrected Exhibit 10.

APPLICABLE REGULATIONS AND PRACTICE

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 1.939 (b) provides:

> "Unless otherwise authorized, no paper shall be filed prior to the initial Office action on the merits of the *inter partes* reexamination."

DECISION

As filed, the present '1050 *inter partes* reexamination proceeding included Exhibit 10. Exhibit 10 was stated to be a copy of a German patent application, and an English language translation thereof. Instead, a copy of the German patent that issued from the German patent application was included in Exhibit 10, although the accompanying English language translation was of the German patent application. On June 19, 2008, requester filed a petition for entry of a corrected Exhibit 10. Corrected Exhibit 10 consists of a copy of the German patent application and a copy of the English language translation thereof.

Corrected Exhibit 10 is accepted to complete the incomplete, (i.e., ambiguous) '1050 reexamination request. On these specific facts, it is in each party's interest to accept the corrected Exhibit 10 in order to complete the reexamination request by curing the ambiguity in Exhibit 10 as originally submitted. It is noted that the incorrect German document was accompanied by an English language translation of the correct German document, so that there is no possible prejudice to patent owner by permitting requester to now clarify and

correct the ambiguity in originally submitted Exhibit 10 by including a copy of the German patent application that is the subject of the English language translation.

The German patent document submitted on June 4, 2008 is hereby expunged from the record by marking it as a paper that is "closed" and "non-public" so that the document is sealed. The German patent application document enclosed along with the present petition on June 19, 2008 is accepted as the document that is the subject of the originally filed English language translation.

CONCLUSION

1. The petition to waive 37 CFR 1.939 to submit a correct copy of the German patent application in Exhibit 10 is granted.

2. The German patent submitted on June 4, 2008 as part of Exhibit 10, will be permanently sealed by "closing" the document in the Image File Wrapper (IFW) and marking it "non-public."

3. The permanently sealed, German patent application that was submitted on June 4, 2008 will not form part of the record in the '1050 *inter partes* reexamination proceeding.

4. The German patent application, submitted along with the present petition on June 19, 2008, will replace the permanently sealed, German patent that was submitted on June 4, 2008 as part of the record in the '1050 *inter partes* reexamination proceeding.

3. Jurisdiction over the '1050 *inter partes* reexamination proceeding is being returned to the Central Reexamination Unit.

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

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,050	06/12/2008	6850130	RYMSA.004RX	9517

23117 7590 02/19/2009

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 02/19/2009

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Date: FEB 19 2009

CENTRAL REEXAMINATION UNIT

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Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001050
PATENT NO. : 6850130
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

FEB 19 2009

CENTRAL REEXAMINATION UNIT

Lee W. Henderson
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IRVINE, CA 92614

(For Third Party Requester)

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

In re: Gottl *et alia*
Inter Partes Reexamination Proceeding
Control No. 95/001,050
Deposited on: 12 June 2008
For: US Patent No. 6,850,130

This is a decision on the 4 February 2009, patent owner "Reexamination-Request for Extension of Time Pursuant to 37 CFR Section 1.956" requesting that the time for responding to the Office action mailed 19 December 2008 to be extended by one (1) month.

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

The petition is granted for the reasons set forth below.

STATEMENT OF RELEVENT FACTS

1. On 1 February 2005 US Patent No. 6,850,130 was granted.

2. On 12 June 2008 a request for reexamination was filed by a third party requester for *Inter Partes* Reexamination with the Office.

3. On 15 July 2008 an Order Granting Request for *Inter Partes* Reexamination was mailed.

4. On 19 December 2008 a non-final Office action was mailed setting a time for response of two (2) months.

5. On 4 February 2009 a petition for a one (1) month 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 requesting a one (1) month extension of time was timely filed on 4 February 2009. The petition authorizes payment by a deposit account for the $200 petition fee pursuant to 37 CFR §1.17 (g).

The request is granted.

> **37 CFR § 1.956. Patent owner extensions of time in inter partes reexamination.** *The time for taking any action by a patent owner in an inter partes reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified. Any request for such extension must be filed on or before the day on which action by the patent owner is due, but in no case will the mere filing of a request effect any extension. Any request for such extension must be accompanied by the petition set forth in § 1.17(g). See § 1.304(a) for extensions of time for filing a notice of appeal to the U.S. Court of Appeals for the Federal Circuit.*

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

> As noted above, a request for extension of time under 37 CFR § 1.956 will be granted only for sufficient cause, ...
>
> Evaluation of whether "sufficient cause" has been shown for an extension must be made by **balancing** the desire to provide the patent owner with a fair opportunity to respond, **against** the requirement of the statute, 35 U.S.C. § 314(c), that the proceedings be conducted with special dispatch. ...

Any petition request must include the required petition fee as set forth according to 37 CFR § 1.17 (g) and 37 CFR § 1.956.

DECISION

The petition requests an extension of one (1) month time in which to reply to the outstanding Office action. The action is a non-final action. The petitioner notes that the Office action is lengthy and the applied references length is extensive. Further the patent owner is assessing the need for technical experts to prepare a complete response.

The standard for which extensions of time are to be granted in reexamination proceedings is the "sufficient cause" standard. In consideration of the balance between a fair opportunity for the patent owner to respond to the outstanding Office action and the need for special dispatch, there is "sufficient cause" to grant the petition for extension of time.

The petition request is hereby granted.

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.**

2. A **one-month** extension of time is hereby granted.

3. The office action mailed set a two-months response time for which to respond, with the granting of this extension of time, the period will end on **19 March 2009**.

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

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

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

By Hand: Customer Service Window
Randolph Building
401 Dulany Street

Alexandria, VA 22314

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

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

/Mark Reinhart/
for

Gregory Morse,
Director,
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,050	06/12/2008	6850130	265-235	9517

23117 7590 05/12/2009

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 05/12/2009

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 Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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NIXON & VANDERHYE, PC
901 NORTH GLEBE ROAD, 11TH FLOOR
ARLINGTON, VA 22203

(For Patent Owner)

MAILED

MAY 12 2009

LEE W. HENDERSON
KNOBBE, MARTENS & OLSON & BEAR, LLP
2040 MAIN ST. 14 FLOOR
IRVINE, CA 92614

(For *Inter Partes* Requester)

CENTRAL REEXAMINATION UNIT

Inter Partes Reexamination Proceeding
Control No. 95/001,050
Filed: June 12, 2008
For: U.S. Patent No. 6,850,130

DECISION DISMISSING PETITION

This is a decision addressing patent owner's March 19, 2009 petition paper entitled "PETITION TO EXCEED PAGE LIMIT."

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

DISCUSSION

On March 19, 2009, patent owner filed a "RESPONSE AND PROPOSED AMENDMENT IN INTER PARTES REEXAMINATION" with accompanying declarations. Concurrently, on March 19, 2009, patent owner filed the instant "PETITION TO EXCEED PAGE LIMIT," requesting "the PTO to accept and consider all pages of the concurrently-filed response with accompanying declarations" only "to the extent (if any) that the PTO determines that Patent Owner has exceeded the 50-page limit in its response in *inter partes* reexamination."[1] Thus, the necessity of patent owner's request for relief is conditioned on the Office first determining that patent owner's March 19, 2009 response in fact exceeds the 50-page limit of 37 CFR 1.943(b). Facially, patent owner's March 19, 2009 response appears compliant, and currently there is no official notice of non-compliance from the Office of record in the 95/001,050 reexamination proceeding, which would be in need of waiver.[2] Accordingly, because patent owner's request

[1] *See* petition at page 1.
[2] The remarks/arguments section of patent owner's March 19, 2009 response is only 35 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).

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 once 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 95/001,050 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] Using this guidance, patent owner can determine how many pages in excess of 50 are necessary to prepare its response and make a request for waiver of the rule as to a specific number of pages.

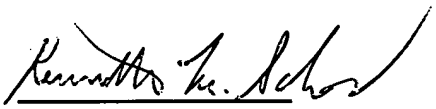
FEES

It is noted that patent owner paid a petition fee of $130 by credit card on March 20, 2009. However, the correct petition fee for a petition under 37 CFR 1.183 is $400 pursuant to 37 CFR 1.17(f); thus, the petition was not accompanied by sufficient payment. In the event patent owner files a renewed petition, an additional $270 fee must be submitted.

CONCLUSION

1. The March 19, 2009 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 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

[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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Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,050	06/12/2008	6850130	265-235	9517

23117 7590 05/12/2009

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 05/12/2009

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UNITED STATES PATENT AND TRADEMARK OFFICE

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

(For Patent Owner)

LEE W. HENDERSON
KNOBBE, MARTENS & OLSON & BEAR, LLP
2040 MAIN ST. 14 FLOOR
IRVINE, CA 92614

(For *Inter Partes* Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,050
Filed: June 12, 2008
For: U.S. Patent No. 6,850,130

DECISION DISMISSING PETITION

This is a decision addressing third party requester's April 20, 2009 petition paper entitled "THIRD PARTY REQUESTOR'S PETITION PURSUANT TO 37 C.F.R. § 1.183 FOR WAIVER OF 37 C.F.R. § 1.943(B) REQUIREMENT."

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

DISCUSSION

On April 20, 2009, third party requester filed "THIRD PARTY REQUESTOR'S REDACTED COMMENTS ON PATENT OWNER'S MARCH 19, 2009 RESPONSE TO OFFICE ACTION" with accompanying appendices, exhibits and declarations. Concurrently, on April 20, 2009, third party requester filed the instant petition, requesting "the PTO pursuant to 37 C.F.R. § 1.183 to accept and consider all pages of the concurrently filed response with accompanying appendices, exhibits and declarations" only "to the extent that the PTO may determine that Third Party Requestor has exceeded the 50-page limit set forth in 37 C.F.R. § 1.943(b) by submission of its COMMENTS ON PATENT OWNER'S MARCH 19, 2009 RESPONSE TO OFFICE ACTION, supporting declarations, appendices, and exhibits."[1] Thus, the necessity of third party requester's request for relief is conditioned on the Office first determining that third party requester's April 20, 2009 comments in fact exceed the 50-page limit of 37 CFR 1.943(b). Facially, third party requester's April 20, 2009 comments appear compliant, and currently there is no official notice of non-compliance from the Office of record in the 95/001,050 reexamination proceeding, which would be in need of waiver.[2] Accordingly, because third party

[1] *See* petition at pages 1-2.
[2] Third party requester's April 20, 2009 comments are 50 pages long, which is in compliance with the rule. It appears the accompanying appendices, exhibits and declarations have not been evaluated in accordance with MPEP 2667(I)(A)(2).

requester'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 once 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 95/001,050 reexamination proceeding. Further, third party requester 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] Using this guidance, third party requester can determine how many pages in excess of 50 are necessary to prepare its comments and make a request for waiver of the rule as to a specific number of pages.

FEES

Third party requester paid the petition fee of $400 for the petition under 37 CFR 1.183 pursuant to 37 CFR 1.17(f) by credit card on April 21, 2009. In the event patent owner files a renewed petition, no additional fee need be submitted.

CONCLUSION

1. The April 20, 2009 petition to waive the page limit requirement of 37 CFR 1.943(b) is **dismissed** as premature.

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

3. Telephone inquiries with regard to this decision should be directed to Nicole Dretar, Legal Advisor, Office of Patent Legal Administration, at (571) 272-7717.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examining Policy

[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, or by the third party requester, and is subject to the page limit requirements of 37 CFR 1.943."

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,050	06/12/2008	6850130	265-235	9517

23117 7590 06/05/2009

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/05/2009

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United States Patents and Trademark Office
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
LEE W. HENDERSON
KNOBBE, MARTENS, OLSON & BEAR, LLP
2040 MAIN STREET, 14TH FLOOR
IRVINE, CA 92614

Date:

MAILED

JUN 0 5 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001050
PATENT NO. : 6850130
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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Robert W Faris
NIXON & VANDERHYE, PC
901 NORTH GLEBE ROAD
11TH FLOOR
ARLINGTON VA 22203

(For Patent Owner)

MAILED

JUN 0 5 2009

CENTRAL REEXAMINATION UNIT

Lee W Henderson
KNOBBE, MARTENS, OLSEN &
BEAR, LLP
2040 MAIN STREET
14TH FLOOR
IRVINE, CA 92614

(For Third Party Requester)

DECISION
DISMISSING AS
PREMATURE
PETITION UNDER
37 CFR § 1.59 (b) TO
EXPUNGE INFORMATION

In re: Göttl *et alia*
Ex Parte Reexamination Proceeding
Control Number 95/001,050
Deposited on: 12 June 2008
For U.S. Patent No. 6,850,130

This is a decision on the 20 April 2009, third party requester petition titled "Third Party Requester's Petition Pursuant to 37 CFR § 1.59(b) & MPEP § 724.05 Re: the Unredacted and Protective Order Materials Filed in Conjunction with Third Party Requester's Comments on Patent Owner's March 19, 2009 Response to Office Action."

This petition considers under 37 CFR § 1.59 (b) a request to expunge materials submitted by the third party requester on 24 April 2009.

The petition was filed with the authorization for the appropriate fee from a deposit account pursuant to 37 CFR § 1.17 (g) .

The petition is dismissed as premature since the patent owner's response dated 19 March

2009 is improper. As such the papers are premature and are closed from the file wrapper. Should the third party wish to re-petition timely filing following a proper patent owner submission, the petition may be filed without the need for an additional fee by dismissing the instant petition.

REVIEW OF RELEVENT FACTS

1. US Patent No 6,850,130 was granted on 01 February 2005.

2. On 12 June 2008 a third party requester requested *inter partes* reexamination of US Patent No. 6,850,130 which is identified under control no. 95/001,050.

3. On 15 July 2008 the Order was granted for *inter partes* reexamination.

4. On 19 December 2008 a non-final Office action was mailed in the proceeding.

5. On 19 March 2009 the patent owner responded to the Office action with an improper response.

6. On 20 April 2009 the third party requester timely submitted redacted comments via EFS.

7. On 20 April 2009 the third party requester timely filed the instant petition via EFS.

8. On 24 April 2009 the third party requester submitted unredacted documents.

CITATION OF APPROPRIATE PROCEDURE

37 CFR § 1.939. Unauthorized papers in inter partes reexamination.

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

(b) Unless otherwise authorized, no paper shall be filed prior to the initial Office action on the merits of the *inter partes* reexamination.

MPEP § 2667 Handling of Inappropriate or Untimely Filed Papers (in-part)

The return of certain inappropriate submissions, not being considered, reduces the amount of paper which would ultimately have to be scanned into the record. Where 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 the paper does not appear in the active IFW record with the other active papers that comprise the public record of the reexamination proceeding.

...

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.** (emphasis added)

37 CFR § 1.59 (in-part)

Expungement of information or copy of papers in application file.

(a)
(1) Information in an application will not be expunged, except as provided in paragraph (b) of this section or § 41.7(a) of this title.
(2) Information forming part of the original disclosure (i.e., written specification including the claims, drawings, and any preliminary amendment specifically incorporated into an executed oath or declaration under §§ 1.63 and 1.175) will not be expunged from the application file.
(b) An applicant may request that the Office expunge information, other than what is excluded by paragraph (a)(2) of this section, by filing a petition under this paragraph. Any petition to expunge information from an application must include the fee set forth in § 1.17(g) and establish to the satisfaction of the Director that the expungement of the information is appropriate in which case a notice granting the petition for expungement will be provided.

....

MPEP § 724.02 (in-part) **Method of Submitting Trade Secret, Proprietary, and/or Protective Order Materials**

Information which is considered by the party submitting the same to be either trade secret material or proprietary material, and any material subject to a protective order, must be clearly labeled as such and be filed in a sealed, clearly labeled, envelope or container. Each document or item must be clearly labeled as a "Trade Secret"

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

....

The envelope or container must be accompanied by a transmittal letter which also contains the same identifying information as the envelope or container. The transmittal letter must also state that the materials in the envelope or container are considered trade secrets or proprietary, or are subject to a protective order, and are being submitted for consideration under MPEP § 724. (emphasis added) A petition under 37 CFR § 1.59 and fee therefor (37 CFR § 1.17(g)) to expunge the information, if found not to be material to patentability, should accompany the envelope or container.

DECISION

This is a response to the petition under 37 CFR § 1.59(b), filed 20 April 2009, to expunge information from the above identified proceeding.

Since this is in response to the improper response from the patent owner dated 19 March 2009, the paper is returned as premature per MPEP § 2667 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.

It is further noted that the third party submission does not fully comply with the requirements of MPEP § 724.02 which directs the handling of papers. MPEP 724.02 in-part "The transmittal letter **must** also state that the materials in the envelope or container are considered trade secrets or proprietary, or are subject to a protective order, and are being submitted for consideration under MPEP § 724." If the third party requester wishes to resubmit when timely, the requester is reminded of the requirements of MPEP § 724.

Since the 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 the paper does not appear in the active IFW record with the other active papers that comprise the public record of the reexamination proceeding.

The third party submission is hereby dismissed as premature and is hereby returned.

CONCLUSION

1. The petition to expunge documents submitted by the patent owner under seal on 20 April 2009 is hereby **dismissed** as premature

2. The papers submitted are treated as improper papers and are hereby expunged from the record.

3. The proceeding is hereby returned to the examiner for further prosecution.

FUTURE CORRESPONDENCE

Correspondence to the Central Reexamination Unit should be directed as follows:

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

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

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

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

4. Telephone inquiries with regard to this decision should be directed to Mark Reinhart, at (571) 272-1611, 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 3999

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.
95/001,050	06/12/2008	6850130	265-235	9517

23117 7590 08/28/2009

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 08/28/2009

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
LEE W. HENDERSON
KNOBBE, MARTENS, OLSON & BEAR, LLP
2040 MAIN STREET, 14TH FLOOR
IRVINE, CA 92614

Date: MAILED

AUG 28 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001050
PATENT NO. : 6850130
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)

MAILED

AUG 2 8 2009

CENTRAL REEXAMINATION UNIT

Inter Partes Reexamination Proceeding
Control No. 95/001,050
Filed: June 12, 2008
For: U.S. Patent No. 6,850,130

DECISION GRANTING PETITIONS

This is a decision on patent owner's petition paper entitled "RENEWED PETITION TO ENLARGE PAGE LIMIT IN *INTER PARTES* REEXAMINATION," filed on June 12, 2009, and on third party requester's petition paper entitled "THIRD PARTY REQUESTOR'S RENEWED PETITION PURSUANT TO 37 C.F.R. § 1.183 FOR WAIVER OF 37 C.F.R. § 1.943(b) REQUIREMENT," filed on July 13, 2009.

The renewed petitions under 37 CFR 1.183 are before the Office of Patent Legal Administration for consideration.

Both patent owner's and third party requester's renewed petitions under 37 CFR 1.183 are granted to the extent set forth herein.

FEES

The petition fee of $400 for patent owner's petition under 37 CFR 1.183 pursuant to 37 CFR 1.17(f) was charged to patent owner's Deposit Account No. 14-1140 on June 15, 2009.[1] Third party requester paid the petition fee of $400 for third party requester's petition under 37 CFR 1.183 pursuant to 37 CFR 1.17(f) by credit card on April 21, 2009.[2]

[1] The decision mailed on May 12, 2009, dismissing patent owner's March 19, 2009 petition under 37 CFR 1.183, indicated that the petition was not accompanied by sufficient payment and that an additional $270 fee must be submitted in the event patent owner files a renewed petition. The previously paid petition fee of $130 was credited on June 15, 2009, and the correct petition fee of $400 was charged to patent owner's Deposit Account pursuant to the authorization on page 16 of the patent owner's renewed petition under 37 CFR 1.183.

[2] The decision mailed on May 12, 2009, dismissing third party requester's April 20, 2009 petition under 37 CFR 1.183, indicated that no additional fee need be submitted in the event a renewed petition is filed.

REVIEW OF THE RELEVANT FACTS

1. On February 1, 2005, United States Patent Number 6,850,130 (the '130 patent) issued.

2. On June 12, 2008, a request for *inter partes* reexamination of the '130 patent, assigned Reexamination Control No. 95/001,050 (the '1050 proceeding), was filed by a third party requester.

3. On July 15, 2008, the Office issued an order granting *inter partes* reexamination in the '1050 proceeding.

4. On December 19, 2008, the Office mailed an Office action in the '1050 proceeding.

5. On February 4, 2009, patent owner filed a paper entitled "REEXAMINATION - REQUEST FOR EXTENSION OF TIME PURSUANT TO 37 C.F.R. SECTION 1.956" (petition for extension of time).

6. On February 19, 2009, the Office mailed a decision granting patent owner's February 4, 2009 petition for extension of time, extending the time period for response to the December 19, 2008 Office action by one month.

7. On March 19, 2009, patent owner filed a "RESPONSE AND PROPOSED AMENDMENT IN INTER PARTES REEXAMINATION."

8. Concurrently on March 19, 2009, patent owner filed a petition paper entitled "PETITION TO EXCEED PAGE LIMIT" (patent owner's petition under 37 CFR 1.183).

9. On April 20, 2009, third party requester filed "THIRD PARTY REQUESTOR'S REDACTED COMMENTS ON PATENT OWNER'S MARCH 19, 2009 RESPONSE TO OFFICE ACTION."

10. Concurrently, on April 20, 2009, third party requester filed a petition paper entitled "THIRD PARTY REQUESTOR'S PETITION PURSUANT TO 37 C.F.R. § 1.183 FOR WAIVER OF 37 C.F.R. § 1.943(B) REQUIREMENT" (third party requester's petition under 37 CFR 1.183).

11. On April 24, 2009, third party requester filed "THIRD PARTY REQUESTOR'S *UNREDACTED* COMMENTS ON PATENT OWNER'S MARCH 19, 2009 RESPONSE TO OFFICE ACTION."

12. On May 12, 2009, the Office mailed a decision dismissing patent owner's March 19, 2009 petition under 37 CFR 1.183.

13. Concurrently, on May 12, 2009, the Office mailed a decision dismissing third party requester's April 20, 2009 petition under 37 CFR 1.183.

14. On May 28, 2009, the Office mailed a notice of improper patent owner submission pertaining to patent owner's March 19, 2009 response (notice of improper patent owner submission).

15. Concurrently, on May 28, 2009, the Office mailed a notice of improper third party requester submission pertaining to requester's April 20, 2009 and April 24, 2009 comments (notice of improper third party requester submission).

16. On June 12, 2009, patent owner filed a petition paper entitled "RENEWED PETITION TO ENLARGE PAGE LIMIT IN INTER PARTES REEXAMINATION" (patent owner's renewed petition under 37 CFR 1.183).

17. Concurrently, on June 12, 2009, patent owner filed "PATENT OWNER'S RESPONSE TO 5/28/09 NOTICE," resubmitting its March 19, 2009 "RESPONSE AND PROPOSED AMENDMENT IN INTER PARTES REEXAMINATION" and submitting a redacted version of the evidentiary declarations that accompanied the March 19, 2009 response.

18. On July 13, 2009, requester filed a petition paper entitled "THIRD PARTY REQUESTOR'S RENEWED PETITION PURSUANT TO 37 C.F.R. § 1.183 FOR WAIVER OF 37 C.F.R. § 1.943(b) REQUIREMENT" (third party requester's renewed petition under 37 CFR 1.183).

19. Concurrently, on July 13, 2009, requester filed "THIRD PARTY REQUESTOR'S *REDACTED* COMMENTS ON PATENT OWNER'S MARCH 19, 2009 RESPONSE TO OFFICE ACTION (WHICH RESPONSE WAS RE-SUBMITTED JUNE 12, 2009)."

20. Concurrently, on July 13, 2009, requester also filed a petition paper entitled "CORRECTED THIRD PARTY REQUESTOR'S RENEWED PETITION PURSUANT TO 37 C.F.R. § 1.59(b) & M.P.E.P. § 724.05 RE: THE UNREDACTED AND PROTECTIVE ORDER MATERIALS FILED IN CONJUNCTION WITH THIRD PARTY REQUESTOR'S COMMENTS ON PATENT OWNER'S MARCH 19, 2009 RESPONSE TO OFFICE ACTION (WHICH RESPONSE WAS RE-SUBMITTED JUNE 12, 2009)" (petition under 37 CFR 1.59 to expunge information).

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 2666.50 provides (in-part):

> Where the length of the patent owner submission exceeds that permitted by 37 CFR 1.943, the submission is improper. Accordingly, pursuant to 37 CFR 1.957(d), a Notice will be mailed to the patent owner. The Notice will be issued by the examiner and will permit the patent owner to exercise one of the following two options:
>
> (A) Submit a re-drafted response that does not exceed the page limit set by 37 CFR 1.943; or
>
> (B)File a copy of the supplemental response with pages redacted to satisfy the 37 CFR 1.943 page limit requirement.
>
> The Notice will set a period of 15 days from the date of the notice to respond. If no response is received, the improper patent owner submission will not be considered. If the submission was necessary to respond to an outstanding Office action, the prosecution of the reexamination proceeding is either terminated pursuant to 37 CFR 1.957(b) or limited pursuant to 37 CFR 1.957(c). Any previously submitted third party comments in response to this improper patent owner submission would also not be considered, as being moot, since the patent owner did not in fact respond to the Office action in accordance with the rules.
>
> If a response to the Notice is received, then under 37 CFR 1.947, the third party requester may once file written comments, limited to issues raised by the Office action or the patent owner's response to the Notice, within 30 days from the date of service of the patent owner's response to the Notice.

Patent Owner's Renewed Petition under 37 CFR 1.183

On May 12, 2009, the Office mailed a decision dismissing, as premature, patent owner's March 19, 2009 petition under 37 CFR 1.183 for waiver of the 50-page limit of 37 CFR 1.948(b) for the patent owner's response submitted concurrently with that petition, as there was no official notice of non-compliance from the Office of record in the '1050 reexamination proceeding, which would be in need of waiver. On May 28, 2009, the Office mailed a notice of improper patent owner submission, stating that the 35-page remarks portion of patent owner's March 19, 2009 response and the arguments/remarks portions of the accompanying declarations (Exhibits KA,

KB and KC) and appendices (Appendix A claim charts), exceed the 50-page limit of 37 CFR 1.943.[3]

In patent owner's renewed petition under 37 CFR 1.183, waiver of the 50-page limit of 37 CFR 1.943(b) for the three evidentiary declarations (Exhibits KA, KB and KC), which accompanied the March 19, 2009 response, is requested.[4] Patent owner has withdrawn Appendices A and B.[5] Patent owner asserts that the 35 pages of remarks in the March 19, 2009 response, in addition to 72 pages of arguments in the three accompanying declarations are needed to fully respond to the December 19, 2008 Office action.[6] As patent owner asserts, the combined arguments portions of patent owner's March 19, 2009 response and accompanying declarations exceed the 50-page limit set forth in 37 CFR 1.943(b) by 57 pages.[7]

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. Further, in patent owner's renewed petition under 37 CFR 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.[8]

Based on the specific facts set forth in patent owner's 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. In particular, the 50-page limit of 37 CFR 1.943(b) is waived to the extent that the portions of patent owner's May 19, 2009 response and accompanying declarations that are included in the regulatory page count exceed the 50-page limit by 57 pages. No pages of Appendices A and B, which accompanied patent owner's March 19, 2009 response, will be included in the regulatory page count because patent owner has since withdrawn the appendices.[9]

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[3] *See* May 28, 2009 notice of improper patent owner submission (stating "The response of 03/19/09 contains remarks of 35 pages, declarations which contain arguments, Exhibit KA, KB and KC and an Appendix A claim charts with remarks. Which in total far exceed the 50 page limit.")

[4] *See* patent owner's renewed petition under 37 CFR 1.183 at page 8 (noting that the 35-page March 19, 2009 response, itself, complies with the 50-page limit). It is noted that patent owner submitted a redacted version of the evidentiary declarations with the renewed petition under 37 CFR 1.183 on June 12, 2009. The page limit count is based on the unredacted version of the evidentiary declarations that patent owner submitted on March 19, 2009.

[5] *See* patent owner's renewed petition under 37 CFR 1.183 at FN 1, page 2 and page 8.

[6] *See* patent owner's renewed petition under 37 CFR 1.183 at page 2.

[7] Only those pages of patent owner's response and accompanying declarations upon which arguments appear will be included against the page limit count. *See* MPEP 2667(I)(A)(2). The March 19, 2009 patent owner response submission included claim amendments, remarks, declarations in Exhibits KA-KH, and claim charts with remarks thereon in Appendices A and B. The May 28, 2009 notice identified the remarks portion of the March 19, 2009 patent owner response, the arguments portions of Exhibits KA, KB and KC, and the remarks portions of Appendix A claim charts as being included against and exceeding the page limit count.

[8] *See* patent owner's renewed petition under 37 CFR 1.183 at pages 1-2 and 7-10 (discussing such factors as the effective length of the December 19, 2008 Office action, including the extensive use of incorporation by reference from the request for *inter partes* reexamination, as well as the importance of the evidentiary declarations in view of the nature of the claim rejections, among other reasons).

[9] *See* patent owner's renewed petition under 37 CFR 1.183 at FN 1, page 2 and page 8.

(Withdrawn Appendices A and B are being expunged, as not part of the record, by closing them from public view.) Accordingly, patent owner's petition under 37 CFR 1.183 is granted to the extent that the page limit of 37 CFR 1.943(b) is waived as to 57 pages of the portions of patent owner's May 19, 2009 response and accompanying declarations that are included in the regulatory page count exceed the 50-page limit.

Third Party Requester's Renewed Petition under 37 CFR 1.183

On May 12, 2009, the Office mailed a decision dismissing, as premature, requester's April 20, 2009 petition under 37 CFR 1.183 for waiver of the 50-page limit of 37 CFR 1.948(b) for the requester's comments submitted concurrently with that petition, as there was no official notice of non-compliance from the Office of record in the '1050 reexamination proceeding, which would be in need of waiver. On May 28, 2009, the Office mailed a notice of improper third party requester submission stating, "[t]he third party requester's response exceeds the page limit when considering the redacted remarks of 04/20/09, the unredacted comments of 04/24/09 and the declarations of Arderiu, Tardon and Pozar which argue the merits of the rejections."

In third party requester's renewed petition under 37 CFR 1.183, waiver of the 50-page limit of 37 CFR 1.943(b) for the concurrently filed comments, including accompanying declarations, a 37 CFR 1.948 statement, and supplemental appendices, is requested.[10] More specifically, on page three of third party requester's renewed petition under 37 CFR 1.183, requester set forth three options regarding the number of pages for which it seeks waiver.[11]

As requester has asserted, the combined arguments portions of requester's comments, declarations and 37 CFR 1.948 statement exceed the 50-page limit set forth in 37 CFR 1.943(b) by 45 pages.[12] Additionally, pursuant to MPEP 2667(I)(A)(2), claim charts applying the art to the claims are not excluded even from the appeal brief 30-page limit required by 37 CFR 1.943(c). Clearly, such claim charts applying the art to the claims are not excluded from the 50-page limit required by 37 CFR 1.943(b). As requester has asserted, 65 pages of supplemental

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[10] *See* third party requester's renewed petition under 37 CFR 1.183 at page 2. It is noted that redacted and unredacted versions of third party requester's comments were submitted July 13, 2009. The page limit count is based on the unredacted version of third party requester's July 13, 2009 comments, as the examiner must review the unredacted version of the comments to determine whether any information contained therein is material for purposes of third party requester's July 13, 2009 petition under 37 CFR 1.59 to expunge information.

[11] Requester labeled as "Option A" - entry of 160 pages of the arguments portions of the comments, declarations and 37 CFR 1.948 statement and all pages of the supplemental claim charts appendices (i.e., waiver of 110 pages), as "Option B" - entry of 37 pages of arguments from the comments, 3 pages of arguments from the Anderiu declaration, 22 pages of arguments from the Pozar declaration, 23 pages of arguments from the Tardon declaration, and 10 pages of arguments from the 37 CFR 1.948 statement (i.e., waiver of 45 pages), and as "Option C" - entry of 37 pages of arguments from the comments, 3 pages of arguments from the Anderiu declaration, 6 pages of arguments from the Pozar declaration, 4 pages of arguments from the Tardon declaration, and 10 pages of arguments from the 37 CFR 1.948 statement (i.e., waiver of 10 pages).

[12] Only those pages of third party requester's July 13, 2009 comments, declarations, and 37 CFR 1.948 statement upon which arguments appear will be included against the page limit count. *See* MPEP 2667(I)(A)(2). In the Table on page 2 of third party requester's renewed petition under 37 CFR 1.183, requester asserts that 37 pages from the comments, 48 pages from the Arderiu, Pozar and Tardon declarations and 10 pages from the 37 CFR 1.948 statement contain arguments, for a total of 95 pages of arguments.

claim chart appendices accompanied the July 13, 2009 comments.[13] Thus, the combined portions of requester's comments, declarations, 37 CFR 1.948 statement and supplemental claim chart appendices that are included in the regulatory page count exceed the 50-page limit set forth in 37 CFR 1.943(b) by 110 pages.

In support of its petition for waiver of the 50-page limit, requester asserts, "it would be manifestly unfair and prejudicial to Third Party Requester RYMSA for the PTO to permit Patent Owner Kathrein to exceed the 50-page limit (with a 107-page RESPONSE), and to not reciprocally permit Third Party Requester RYMSA to also exceed the 50-page limit (with a comparable 95-page COMMENTS plus 65 pages of supplemental Appendices)."[14] Additionally, requester asserts that "allowing Third Party Requester RYMSA to exceed the 50-page limit with its COMMENTS and declarations will permit the Examiner to conduct a more detailed and thorough analysis of the issues and arguments presented in the *inter partes* reexamination proceeding," and that the supplemental claim charts appendices addressing the amended and newly added claims "provide a more comprehensive and methodical explanation ... of the involved claims, which would be of considerable value to the Examiner in his analysis."[15]

In the interest of equity, and given that patent owner's renewed petition under 37 CFR 1.183 has been granted to the extent set forth herein, it is deemed equitable, in this case, to grant third party requester's renewed petition under 37 CFR 1.183 as to 45 pages of the portions of third party requester's July 13, 2009 comments, accompanying declarations and 37 CFR 1.948 statement that are included in the regulatory page count exceed the 50-page limit.[16] As to the supplemental claim chart appendices, it appears that requester has included the most relevant portions thereof into the comments document, rendering those portions of the claim charts redundant. Moreover, it is suggested that requester could have chosen the most relevant proposed rejections and explained them with respect to the amended and newly added claims, rather than applying multiple references to the extent that the regulatory page limit has been unduly exceeded by inclusion of the claim charts. (The supplemental claim chart appendices are being expunged, as not part of the record, by closing them from public view.)

CONCLUSION

1. Patent owner's renewed petition under 37 CFR 1.183 is granted to the extent that the page length of the May 19, 2009 patent owner "RESPONSE AND PROPOSED AMENDMENT IN INTER PARTES REEXAMINATION," including Exhibits KA-KH, will be accepted.

2. Patent owner has withdrawn Appendices A and B that accompanied patent owner's May 19, 2009 "RESPONSE AND PROPOSED AMENDMENT IN INTER PARTES

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[13] In the Table on page 2 of third party requester's renewed petition under 37 CFR 1.183, requester asserts that the supplemental claim chart appendices (A'-D', J' and K') include 65 pages. Thus, the combined portions of requester's comments, declarations, 37 CFR 1.948 statement and supplemental claim chart appendices that are included in the regulatory page count total 160 pages.

[14] Id.

[15] Id.

[16] Requester's "Option B" pursuant to page 3 of third party requester's renewed petition under 37 CFR 1.183.

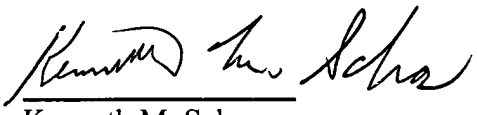
REEXAMINATION." This will be carried out by closing the Appendices (document) in the IFW of the '1050 proceeding and marking the paper "closed" and "non-public."

3. Third party requester's renewed petition under 37 CFR 1.183 is granted to the extent that the page length of third party requester's July 13, 2009 comments, including the Arderiu, Pozar and Tardon declarations and the 37 CFR 1.948 statement will be accepted.

4. Supplemental Appendices A'-D', J' and K' that accompanied third party requester's July 13, 2009 comments will be closed in the IFW of the '1050 proceeding and marked "closed" and "non-public."

5. Jurisdiction for the '1050 reexamination proceeding is returned to the Central Reexamination Unit (CRU).

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



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kenpet7/IP/length
8-27-09

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,061	07/07/2008	6446045	23373-004RX1	8249

7590 03/31/2010

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ART UNIT	PAPER NUMBER

DATE MAILED: 03/31/2010

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

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MAR 31 2010

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(Courtesy Copy)

In re Lucinda Stone et al.
Inter Partes Reexamination Proceeding
Control No. 95/001,061
Filed: July 7, 2008
For: U.S. Patent No. 6,446,045

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

This is a decision on the January 20, 2010 patent owner petition under 37 CFR 1.137(b) to accept patent owner's late a submission pursuant to 37 CFR 1.951(a) in the above-identified reexamination proceeding ("the January 20, 2010 patent owner petition").

The January 20, 2010 patent owner petition is before the Office of Patent Legal Administration (OPLA) for consideration.

Patent owner has been charged the petition fee of $1,620.00 set forth in 37 CFR 1.17(m) for the January 20, 2010 patent owner petition.

The January 20, 2010 patent owner petition is **dismissed**.

STATUTES, LEGISLATIVE HISTORY, REGULATIONS, AND PATENT EXAMINING PROCEDURES

35 U.S.C. 41(a)(7), as amended by the AIPA of 1999 to include reexamination, provides (emphasis added):

REVIVAL FEES. — On filing each petition for the revival of an unintentionally abandoned application for a patent, for the unintentionally delayed payment of the fee for issuing each patent, or for an unintentionally delayed ***response*** by the patent owner in any reexamination proceeding, $1,500, unless the petition is filed under section 133 or 151 of this title, in which case the fee shall be $500.

The legislative history on the 1999 AIPA amendment to 35 U.S.C. 41(a)(7) provides (emphasis added):

Sec. 4605. Conforming amendments

Section 4605 makes the following conforming amendments to the Patent Act:

A patent owner must pay a fee of $1,210 for each petition in connection with an unintentionally abandoned application, delayed payment, or delayed ***response*** by the patent owner during any reexamination.

[145 Cong. Rec. S14,708, 14,720 (1999) (daily ed. Nov. 17, 1999)]

As to unavoidable delay, 35 U.S.C. 133 provides (emphasis added):

Upon ***failure of the applicant to prosecute*** the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Director in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Director that such delay was unavoidable.

37 CFR 1.137. Revival of abandoned application, terminated reexamination proceeding, or lapsed patent.

(a) *Unavoidable.* If the delay in ***reply by*** applicant or ***patent owner*** was unavoidable, a petition may be filed pursuant to this paragraph ***to revive*** an abandoned application, ***a reexamination prosecution terminated under §§ 1.550(d) or 1.957(b) or limited under § 1.957(c)***, or a lapsed patent. 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;

*

*

*

(b) *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 prosecution 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;

[Bold and italicized emphasis added; italicized emphasis in the original.]

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

(a) After an Office action closing prosecution in an *inter partes* reexamination, the patent owner may once file ***comments*** limited to the issues raised in the Office action closing prosecution. The ***comments can include a proposed amendment to the claims***, which amendment will be subject to the criteria of § 1.116 as to whether or not it shall be admitted. The comments must be filed within the time set for response in the Office action closing prosecution.

[Bold and italicized emphasis added; italicized emphasis in the original.]

37 CFR 1.957. Failure to file a timely, appropriate or complete response or comment in *inter partes* reexamination.

*

(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.

[Bold and italicized emphasis added; italicized emphasis in the original.]

37 CFR 1.958. Petition to *revive inter partes* reexamination prosecution *terminated for lack of patent owner response.*

> (a) If ***a response*** by the patent owner is not timely filed in the Office, the delay in filing such response may be excused if it is shown to the satisfaction of the Director that the delay was unavoidable. A grantable petition to accept an unavoidably delayed ***response*** must be filed in compliance with § 1.137(a).
>
> (b) Any ***response*** by the patent owner not timely filed in the Office may be accepted if the delay was unintentional. A grantable petition to accept an unintentionally delayed ***response*** must be filed in compliance with § 1.137(b).
>
> [Emphasis added.]

MPEP 2672, part II provides (emphasis added):

> The patent owner ***submission under 37 CFR 1.951(a) of comments and/or proposed amendment*** must be filed within the time period set for response to the ACP. Normally, the ACP will set a period of 30 days or one month (whichever is longer) from the mailing date of the ACP.
>
> An extension of the time period for filing the patent owner's submission under 37 CFR 1.951(a) may be requested under 37 CFR 1.956. The time period may not, however, be extended to run past 6 months from the date of the ACP.

MPEP 2672, part V is titled Patent Owner Does Not Make Submission After ACP and provides (emphasis added):

> 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***.

DECISION

The Petition Under 37 CFR 1.137(b) is Dismissed

On November 6, 2009, the Office issued an Action Closing Prosecution (37 CFR 1.949) ("the November 6, 2009 ACP") in the instant reexamination proceeding. The November 6, 2009 ACP sets on its cover sheet a two month period for patent owner to file a submission pursuant to 37 CFR 1.951(a). The November 6, 2009 ACP sets in its

body a one month period for patent owner to file a submission pursuant to 37 CFR 1.951(a). On November 13, 2009, the Office issued a letter clarifying that the correct period for making a submission pursuant to 37 CFR 1.951(a) on the November 6, 2009 ACP was one month, to run from November 13, 2009.

Patent owner requested on November 25, 2009, and was granted on December 2, 2009, a one month extension of time, moving the deadline for making a submission pursuant to 37 CFR 1.951(a) on the November 6, 2009 ACP to January 13, 2010.

Patent owner, however, did not file a 1.951(a) submission by January 13, 2010. Instead, patent owner filed a paper titled "Response" on January 14, 2010.

37 CFR 1.958(b) provides that an *inter partes* reexamination prosecution ***terminated*** for the lack of a patent owner ***response*** may be revived by filing a petition in compliance with 37 CFR 1.137(b), if patent owner's delay in filing the ***response*** was unintentional.

However, the instant reexamination proceeding is ***not terminated***.[1] In this regard, MPEP 2672, part V, states that "where the patent owner chooses not to file a submission pursuant to 37 CFR 1.951(a), no rights of appeal are lost." Accordingly, the consequences of 37 CFR 1.957(b) and (c) do not apply where the patent owner does not file a timely 1.951(a) submission. Thus, the present reexamination proceeding is not terminated as to any of the claims based on patent owner's failure to file a timely 1.951(a) submission after the November 6, 2009 ACP, and 37 CFR §§ 1.958(b) and 1.137 do not apply to this situation.

In addition, patent owner's January 14, 2010 Response is ***not a response***. 37 CFR 1.951(a) states that after an ACP, the patent owner may once file ***comments***, which may include a proposed amendment to the claims, limited to the issues raised in the ACP. Therefore, patent owner's January 14, 2010 Response is properly a "comment" on the November 6, 2009 ACP, despite it being designated as a "response" by patent owner.

In view of the above, no regulatory or statutory provision supports the availability of 1.137 for relief as to late comments filed pursuant to 1.951(a) after an *inter partes* reexamination action closing prosecution.

For the foregoing reasons, the January 20, 2010 patent owner petition is **dismissed**.

---

[1] With respect to patent owner's statement at page 2 of the January 20, 2010 petition that, during a telephone call with the Office, the Office informed patent owner that the reexamination had been abandoned, patent owner is reminded of 37 CFR 1.2.

A 37 CFR 1.183 petition would be the only vehicle for relief possible here, if the fact-situation met the standard of 1.183 for relief. However, to obtain relief, the situation would need to be shown to be "an extraordinary situation, when justice requires, any requirement of the regulations ... which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee ... subject to such other requirements as may be imposed."

PATENT OWNER'S ADDRESS

The current correspondence address of record for the patent file is the proper patent owner address for reexamination mailings, pursuant to 37 CFR 1.33(c). The current correspondence address of record for the 6,446,045 patent file is that of Henry Croskell, 6817 Cliffbrook, Dallas, TX 75240.

As a courtesy, this decision is being mailed to the address Heim, Payne & Chorush, LLP, 600 Travis Street, Suite 6710, Houston, TX 77002, in view of the October 14, 2008 Power of Attorney in the file of the '1061 reexamination proceeding.

The address of Henry Croskell, 6817 Cliffbrook, Dallas, TX 75240, will be the sole patent owner correspondence address used in future correspondence, until a change in correspondence address in the '045 patent file is made in accordance with 37 CFR 1.33(c).

CONCLUSION

1. The January 20, 2010 patent owner petition under 37 CFR 1.137(b) to accept patent owner's unintentionally delayed submission pursuant to 37 CFR 1.951(a) is **dismissed**.

2. Given that the January 20, 2010 patent owner petition is being dismissed, patent owner's January 14, 2010 Response is not being considered, and such paper has been sealed by closing it in the Image File Wrapper (IFW) for the '1061 *inter partes* reexamination proceeding and marking it "not public." It will not constitute part of the record of the present reexamination proceeding.

3. A copy of this decision will be made of record in the '1061 reexamination file.

4. The address of Henry Croskell, 6817 Cliffbrook, Dallas, TX 75240, will be the sole patent owner correspondence address used in future correspondence, until a change in correspondence address in the '045 patent file is made in accordance with 37 CFR 1.33(c).

5. Jurisdiction over the present reexamination proceeding is being forwarded to the Central Reexamination Unit.

6. Any inquiry concerning this decision should be directed to the undersigned at (571) 272-7728.

Raul Tamayo
Legal Advisor
Office of Patent Legal Administration

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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SEP 22 2009

CENTRAL REEXAMINATION UNIT

Wood, Herron, & Evans, LLP (SOLTA)
441 Vine Street
2700 Carew Tower
Cincinnati, OH 45202

For Patent Owner

Hugh A. Abrams
Sidley Austin LLP
One South Dearborn
Chicago, IL 60603

For 3rd Party Requester

Inter Partes Reexamination Proceeding
Control No. 95/001,062
Filed: July 9, 2008
For: US Patent No. 7,229,436

DECISION ON
PETITION TO
CORRECT INVENTORSHIP
[37 CFR 1.324]

This is a decision on the petition filed November 26, 2008, to correct inventorship under 37 CFR 1.324 in US Patent No. 7,229,436, the patent that is subject to the instant reexamination proceeding. The petition seeks to add Edward W. Knowlton as an inventor and to delete Mitchell Levinson as an inventor.

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

Decision

37 CFR 1.324 states, in part:

> (a) Whenever through error a person is named in an issued patent as the inventor, or through error an inventor is not named in an issued patent and such error arose without any deceptive intention on his or her part, the Director, pursuant to 35 U.S.C. 256, may, on application of all parties and assignees,...issue a certificate naming only the actual inventor or inventors...
> (b) Any request to correct inventorship of a patent pursuant to paragraph (a) of this section must be accompanied by:
>
> > (1) Where one or more persons are being added, a statement from each person who is being added as an inventor that the inventorship arose without any deceptive intention on his or her part;

(2) A statement from the current named inventors who have not submitted a statement under paragraph (b)(1) of this section either agreeing to the change of inventorship or stating that they have no disagreement in regard to the requested change;
(3) A statement from all assignees of the parties submitting a statement under paragraphs (b)(1) and (b)(2) of this section agreeing to the change of inventorship in the patent, which statement must comply with the requirements of § 3.73(b) of this chapter; and
(4) The fee set forth in § 1.2-0(b)."

The submitted petition lacked items (1)-(3) required by 37 CFR 1.324. That is, the petition did not include: the statement required by 37 CFR 1.324(b)(1) from Mr. Knowlton, the added inventor; the statement required by 37 CFR 1.324(b)(2) from the currently named inventors, namely, Messrs. Stern, Levinson, and Weber; and the statement required by 37 CFR1.324(b)(3).

In view of the omissions indicated above, the request to correct inventorship in US Patent No. 7,229,436 is **dismissed**.

Any inquiries concerning this communication should be directed to Andres Kashnikow, Supervisory Patent Examiner, at telephone number (571) 272-4361.

Any renewed petition to correct the inventorship of the patent that is the subject of the instant reexamination should be promptly filed.

Upon the mailing of this decision, the proceeding will be forwarded to the examiner for consideration of patent owner's reply filed November 26, 2008 and third party requester's comments filed December 26, 2008.

All correspondence relating to this *inter partes* reexamination should be directed as follows:

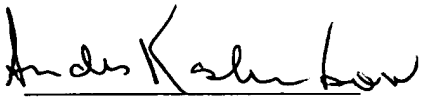
By EFS: See 37 CFR 1.8(a)(C)(ii)

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



Andres Kashnikow
SPE, CRU 3993
Central Reexamination Unit

United States Patent and Trademark Office

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ALEXANDRIA, VA 22313-1450
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WOOD, HERRON & EVANS, LLP
2700 CAREW TOWER
441 VINE STREET
CINCINNATI OH 45202

(For Patent Owner)

MAILED

DEC 01 2009

CENTRAL REEXAMINATION UNIT

HUGH A. ABRAMS
SIDLEY AUSTIN LLP
ONE SOUTH DEARBORN
CHICAGO, IL 60603

(For Requester)

In re Stern et al.
Inter Partes Reexamination Proceeding
Control No. 95/001,062
Filed: July 9, 2008
For: U.S. Patent No. 7,229,436 B2

DECISION
DISMISSING PETITION
UNDER 1.182 AND
REFUSING ENTRY OF
OPPOSITION PAPER

This is a decision on the October 8, 2009 patent owner petition entitled "PETITION UNDER 37 CFR § 1.182 REQUEST FOR CONTINUED REEXAMINATION," and the October 19, 2009 third party requester petition entitled "THIRD PARTY REQUESTER'S OPPOSTION TO PETITIONS BY PATENT OWNER UNDER 37 CFR § 1.181 AND § 1.182 TO REOPEN PROSECUTION AND/OR CONTINUED REEXAMINATION."

The patent owner petition and third party requester opposition paper are before the Office of Patent Legal Administration.

The patent owner petition is **dismissed**.

The third party requester opposition paper is an improper paper and has been **expunged** from the record.

BACKGROUND

- On July 9, 2008, a request for *inter partes* reexamination was filed by the third party requester, and the resulting reexamination proceeding was assigned control number 95/001,062 (the '1062 proceeding").

- On September 26, 2008, reexamination was ordered, and a non-final action was issued by the Office.

- On November 26, 2008, patent owner filed a response to the August 26, 2008 Office action. This response included a petition under 37 CFR 1.324 to correct inventorship.

- On December 26, 2008, third party requester filed written comments pursuant to 37 CFR 1.947.

- On September 22, 2009, the Office mailed a decision dismissing the November 26, 2008 petition under 1.324 to correct inventorship. The decision stated "[a]ny renewed petition to correct the inventorship of the patent that is the subject of the instant reexamination should be promptly filed."

- On September 29, 2009, the Office mailed an Action Closing Prosecution, rejecting all claims under reexamination.

- Also on September 29, 2009, patent owner filed a petition under 37 CFR 1.324 to correct inventorship. This petition was characterized by patent owner as a renewed petition under 37 CFR 1.324. This petition remains outstanding.

- On October 8, 2009, patent owner filed the instant petition under 37 CFR 1.182 seeking continued reexamination.

- On October 9, 2009, patent owner filed a petition under §1.181, or alternately, under §1.182, to reopen prosecution.

- On October 19, 2009, third party requester filed an opposition to the October 8th and October 9th petitions.

- On October 29, 2009, patent owner filed comments after the Action Closing Prosecution pursuant to 37 CFR 1.951(a).

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 CFR 1.182 provides:

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

37 CFR 1.181 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 1.951(a) provides:

After an Office action closing prosecution in an inter partes reexamination, the patent owner may once file comments limited to the issues raised in the Office action closing prosecution. The comments can include a proposed amendment to the claims, which amendment will be subject to the criteria of § 1.116 as to whether or not it shall be admitted. The comments must be filed within the time set for response in the Office action closing prosecution.

DECISION

A Petition Under 37 CFR 1.182 Will Not Be Granted Where Another Rule Applies

In this instance, the patent owner has concurrently pursued alternative relief, through both a petition under 37 CFR 1.324 and a petition under 37 CFR 1.181, requesting correction of inventorship. Since the concurrently filed September 29, 2009, and October 9, 2009 petitions have not been decided, the situation will be addressed under §§ 1.181 and § 1.324. Thus the situation is not one which is "not specifically provided for in the regulations" at this time, as required by § 1.182. Furthermore, any supervisory review of a dismissal of a petition is properly addressed through § 1.181, and not § 1.182. Accordingly, the present § 1.182 petition to request continued reexamination filed to seek correction of inventorship fails to meet the requirements of § 1.182.

In addition, the relief requested in the petition under 37 CFR 1.182 would be moot, should relief be granted under § 1.181 or through § 1.324. Patent owner retains the option of filing a renewed petition under § 1.182, if, at some future date, relief has not been granted under the § 1.181 and § 1.324 avenues pursued or through another section of the rules. Until such time, the issue is not ripe for consideration by the Office under § 1.182.

Should patent owner, at some future date, file a renewed petition for continuation of the reexamination proceeding under 37 CFR 1.182, such a submission would need to be in compliance with the procedure published by the Office. In March of 2005, the Office issued a Notice titled "Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While an Earlier Filed Reexamination is Pending."[1] Notice was provided therein that a patent owner could file a petition under 37 CFR

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

1.182 requesting continued prosecution on the merits in the reexamination proceeding to seek entry of an amendment and/or evidence that was denied entry after an action closing prosecution in an *inter partes* reexamination proceeding. A petition under this procedure must show how granting the petition would further the prosecution of the reexamination proceeding, by better defining the issues for appeal, or by placing the claims in condition for the issuance of a reexamination certificate. A petition under this procedure is to set forth reasons why it was not apparent until the issuance of the action closing prosecution (based on an issue raised for the first time at the action closing prosecution) that the specifics of the proffered submission would do so.

In view of the above, the petition is **dismissed**.

The Opposition Paper Has No Right Of Entry

With respect to the October 19, 2009 requester paper opposing patent owner's petition under 37 CFR 1.182, 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 to request continuing reexamination. A request for continued reexamination 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 equities as to the "special dispatch" requirement and 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 not expressly provided for by the rules. 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 continuing reexamination. No mechanism has been provided for the third party requester to file a paper, such as the present 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 continuing reexamination is a paper that is not permitted by the statute governing *inter partes* reexamination proceedings, and accordingly it was not provided for (i.e., was not permitted) in the regulations that implemented the *inter partes* reexamination statute. The paper is also not permitted as a submission of written comments to a patent owner's response to an Office action, since such third party written comments are the subject of a separate paper. Third party requester's opposition to patent owner's petition for continued reexamination 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,[2] the consideration of a request for continued reexamination (including a limited reopening) is clearly within the Office's jurisdiction,[3] and the Office may exercise its discretion to grant such relief to provide a limited reopening of prosecution. Therefore, the requester's opposition to patent owner's request for continued reexamination 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 opposition, filed on October 19, 2009 to the patent owner's petition for continuing reexamination filed on October 8, 2009 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 for revival will be 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. The October 8, 2009 petition for continued reexamination is **dismissed**.

2. The October 19, 2009 requester opposition petition paper is **refused entry**, as it is an improper paper. The opposition petition paper is not enterable into the record of the present reexamination proceeding, because such a submission is not authorized by the reexamination statute or the regulations promulgated under the statute.

---

[2] Compare the discussion in MPEP § 2646 regarding an opposition to a petition to vacate an order granting a request for reexamination on the grounds that the order granting reexamination was an *ultra vires* act. Such a jurisdictional issue is deemed to go to the merits, since it can result in the vacating or terminating a reexamination proceeding.

[3] As to a patent owner's petition requesting continuing reexamination being a matter within the jurisdiction of the Office, 35 U.S.C. § 314(a) provides that reexamination will be conducted "according to the procedures established for initial examination under the provisions of sections 132 and 133." The Office clearly has the authority to reopen prosecution, in exercising its discretion.

3. Because the opposition petition paper was previously incorporated into the IFW for the present proceeding before discovery of its impropriety, the opposition paper is being expunged by closing the paper in the Image File Wrapper (IFW) for the proceeding and marking it "not public." It 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 reexamination file.

5. The Central Reexamination Unit will consider the June 29, 2009 patent owner petitions under 37 CFR 1.181 and 37 CFR 1.324 in due course.

6. Any inquiry concerning this decision should be directed to Michael Cygan, Legal Advisor, at (571) 272-7700, or in his absence, Pinchus M. Laufer at (571) 272-7726.

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

Kenpet7/RCR/IP/
Kimpropa/opposition/
November 30, 2009

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.
95/001,063	07/28/2008	7318892	18196-020RX7	1912

29200 7590 05/20/2009

BAXTER HEALTHCARE CORPORATION
1 BAXTER PARKWAY
DF2-2E
DEERFIELD, IL 60015

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 05/20/2009

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
FISH & RICHARDSON, PC
P.O. BOX 1022
MINNEAPOLISH, MN 55440-1022

Date:

MAILED

MAY 202009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001063
PATENT NO. : 7318892
TECHNOLOGY CENTER : 3999
ART UNIT : 3991

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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Baxter Healthcare Corporation
1 Baxter Parkway
DF2-2E
Deerfield, IL 60015

(For Patent Owner)

MAILED

MAY 202009

CENTRAL REEXAMINATION UNIT

John C. Phillips
Fish & Richardson P.C.
12390 El Camino Real
San Diego, CA 92130

(For Third Party Requester)

In re Connell *et al.*
Inter Partes Reexamination Proceeding
Control No. 95/001,063
Filed: July 28, 2008
For: U.S. Patent No. 7,318,892

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

This is a decision on the March 13, 2009, supplemented on April 21, 2009, patent owner petition entitled "PETITION UNDER 35 CFR § 1.183 REGARDING SUBMISSION DATED FEBRUARY 25, 2009 BY THIRD PARTY REQUESTER IN *INTER PARTES* REEXAMINATION PROCEEDING."

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

The petition is dismissed.

FEES

In regards to present petition under 37 CFR 1.183, a petition fee of $400.00 under 37 CFR 1.17(f) is being charged to petitioner patent owner's Deposit Account No. 08-0219 as authorized in the March 13, 2009 petition.

BACKGROUND

1. On January 15, 2008, the Office issued U.S. patent No. 7,318,892 ("the '892 patent") to Connell *et al.*

2. On July 9, 2008, third party requester deposited an incomplete request for *inter partes* reexamination of the '892 patent assigned reexamination proceeding Control Number 95/001,063 (the '1063 proceeding).

3. On July 28, 2008, the third party requester supplemented the July 9, 2008 deposit of papers completing the request for reexamination in accordance with 37 CFR 1.915.

4. On October 15, 2008 the Office issued an order granting *inter partes* reexamination of the '1063 patent.

5. On November 26, 2008, the Office issued a first Office action on the merits in the '1063 proceeding, giving patent owner sixty days to respond.

6. On January 26, 2009, patent owner timely filed a response to the outstanding Office action of record.

7. On February 25, 2009, third party requester timely filed comments.

8. On the March 13, 2009, patent owner filed a petition entitled "PETITION UNDER 35 CFR § 1.183 REGARDING SUBMISSION DATED FEBRUARY 25, 2009 BY THIRD PARTY REQUESTER IN *INTER PARTES* REEXAMINATION PROCEEDING."

9. Concurrent with the March 13, 2009 petition, patent owner filed a document entitled, "REMARKS ACCOMPNAYING PETITION UNDER 37 CFR § 1.183 AND REGARDING SUBMISSION DATED FEBRUARY 25, 2009 BY THIRD PARTY REQUESTOR IN *INTER PARTES* REEXAMINATION."

10. On April 2, 2009, third party requester filed a petition entitled "THIRD PARTY REQUESTER'S PETITION UNDER 37 C.F.R. § 1.182 REGARDING PATENT OWNER'S PETITION UNDER 37 C.F.R. § 1.183 DATED MARCH 13, 2009," in opposition to patent owner's March 13, 2009 petition.

11. On April 21, 2009, patent owner filed a paper entitled, "SUPPLEMENT TO PETITION UNDER 37 C.F.R. §1.183 FILED BY PATENT OWNER ON MARCH 13, 2009."

12. This decision addresses patent owner's March 13, 2009 petition, as supplemented on April 21, 2009. Third party requester's April 2, 2009 opposition petition is addressed in a separate, concurrently issued decision.

DECISION

I. Relevant Authority

35 USC 314(b) (2) states:

Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.

§ 1.943 states:

(a) The form of responses, written comments, briefs, appendices, and other papers must be in accordance with the requirements of § 1.52.

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

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

37 CFR 1.945 states in pertinent part:

(b) Any supplemental response to the Office action will be entered only where the supplemental response is accompanied by a showing of sufficient cause why the supplemental response should be entered. The showing of sufficient cause must include:

(1) An explanation of how the requirements of § 1.111(a)(2)(i) are satisfied;

(2) An explanation of why the supplemental response was not presented together with the original response to the Office action; and

(3) A compelling reason to enter the supplemental response.

37 CFR 1.947 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. [Emphasis added]

MPEP § 2258(I) provides in pertinent part:

E. Affidavits or Declarations or Other Written Evidence

Affidavits or declarations or other written evidence which explain the contents or pertinent dates of prior art patents or printed publications in more detail may be considered in reexamination, but any rejection must be based upon the prior art patents or printed publications as explained by the affidavits or declarations or other written evidence. The rejection in such circumstances cannot be based on the affidavits or declarations or other written evidence as such, but must be based on the prior art patents or printed publications.

MPEP 2616 provides in pertinent part:

Affidavits or declarations which explain the contents or pertinent dates of prior art patents or printed publications in more detail may be considered in reexamination. See MPEP § 2258.

MPEP 2617 provides in pertinent part:

II. AFFIDAVITS/DECLARATIONS/OTHER WRITTEN EVIDENCE

Affidavits or declarations or other written evidence which explain the contents or pertinent dates of prior art patents or printed publications in more detail may be considered in any reexamination. See MPEP § 2258.

MPEP § 2658(IV) provides in pertinent part:

G. Affidavits in Reexamination

Affidavits under 37 CFR 1.131 and 1.132 may be utilized in a reexamination proceeding. Note, however, that an affidavit under 37 CFR 1.131 may not be used to "swear back" of a reference patent if the reference patent is claiming the same invention as the patent undergoing reexamination. In such a situation, the patent owner may, if appropriate, seek to raise this issue via an affidavit under 37 CFR 1.130 (see MPEP § 718) or in an interference proceeding via an appropriate reissue application if such a reissue application may be filed (see MPEP § 1449.02). [Emphasis added]

37 CFR 1.111 provides in pertinent part:

(2) *Supplemental replies.* (i) A reply that is supplemental to a reply that is in compliance with § 1.111(b) will not be entered as a matter of right except as provided in paragraph (a)(2)(ii) of this section. The Office may enter a supplemental reply if the supplemental reply is clearly limited to:

(A) Cancellation of a claim(s);

(B) Adoption of the examiner suggestion(s);

(C) Placement of the application in condition for allowance;

(D) Reply to an Office requirement made after the first reply was filed;

(E) Correction of informalities (e.g., typographical errors); or

(F) Simplification of issues for appeal.

MPEP 2666 provides in pertinent part:

III. SUPPLEMENTAL RESPONSE TO OFFICE ACTION

Pursuant to 37 CFR 1.945(b), any supplemental response to the Office action in an inter partes reexamination proceeding must be accompanied by a showing of sufficient cause why the supplemental response should be entered. If such a showing is not provided, the supplemental response will not be entered, and may be sealed from public view in the Image File Wrapper (IFW), if it has already been scanned into the IFW for the proceeding.

The showing of sufficient cause why the supplemental response should be entered must include:

(A) an explanation of how the requirements of 37 CFR 1.111(a)(2)(i) are satisfied;

(B) an explanation of why the supplemental response was not presented together with the original response to the Office action; and

(C) a compelling reason to enter the supplemental response.

II. Background and Relief Requested

A review of the record shows that in both the order and the first Office action dated the examiner concluded that the reference cited in appendix D could not be relied upon to establish a Substantial New Question of patentability (SNQ) nor serve as a basis for rejection as the reference lacked any evidence of a publication date. The third party requester's written comments now attempt to respond and address this finding of fact by the examiner in the third party's comments with the use of a declaration.

Patent owner alleges in the present petition that the examiner's evidentiary findings of a lack of a publication date is not an issue the third party requester had a right to comment on as it falls outside the scope of 37 CFR 1.947. Patent owner's rationale is that because the examiner's finding that the appendix D reference did not serve as a basis for rejection the matter falls outside the scope third party requester's right to comment as defined by 37 CFR 1.947. Patent owner also alleges that the use of a declaration by the third party requester in their comments is improper and precluded in *inter partes* reexamination. Patent owner also makes several arguments as to the sufficiency and credibility of the evidence presented in the declaration as well as the sufficiency of the evidence disclosed in the appendix D reference to serve as a basis to derogate the patentability of the claims at issue in the '1063 proceeding.

Patent owner requests that the third party requester's comments be stricken, or in the alternative, that patent owner be afforded an opportunity to supplement its response to the Office action to include arguments in response to the third party requester comments.

III. Analysis and Findings

A. Petition to Strike

1. Scope of Third Party Right to Comment under 37 CFR 1.947

The rules that govern *inter partes* reexamination procedure, see 37 CFR 1.947, permit a third party requester to "once" file written comments limited to issues raised in an Office action and the patent owner's response to such Office action. The declaration is plainly directed to the issue of explaining the pertinent date of the alleged prior art contained in Appendix D raised by the examiner in the Office action dated November 26, 2008.[1] Patent owner contends the third party requester cannot comment on the pertinent date for a reference, because the examiner's finding of a lack of publication date evidence did not serve as a basis of rejection to trigger a third party requester right to comment. Patent owner cites 37 CFR 1.947 in support of their rationale as to why third party requester does not have a right to comment on the examiner's finding of a lack of publication date evidence for the appendix D reference. Patent owner's rationale is in error. 37 CFR 1.947 states in pertinent part:

> "These [third party] comments shall be limited to ***issues*** raised by the Office action or the patent owner's response."

The standard that triggers a third party right to comment is the raising of an issue in the Office action or patent owner's response, and not that the issue was raised through a basis of rejection. The issue of adequate indicia of a publication date for the appendix D reference was raised by the examiner in the Office action. Further, the failure to adopt the proposed rejections using appendix reference D inherently included consideration of the examiner's finding of record that the appendix D reference did not have a prior art date. The only two proposed rejections in the '1063 proceeding were substantially adopted as proposed, with the only modification by the examiner being the removal of the appendix D reference, because of the reference's lack of indicia to evidence a prior art publication date. Thus, in accordance with 37 CFR 1.947, the third party requester has a right to comment on the issue of indicia of a prior art publication date regarding the appendix D reference.

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[1] See the paragraph 5 of the November 26, 2008 Office action, the text of which bridges pages 2-3 of the Office action.

2. Affidavit and Declaration Practice for *inter partes* Reexamination Proceedings

Patent owner also contends that the third party requester's attempt to establish a date of publication for the appendix D reference by way of declaration is impermissible under *inter partes* reexamination "rules".[2] Patent owner notes the difference in language between *ex parte* reexamination MPEP section 2258(I)(E) and *inter partes* reexamination MPEP section 2658 (IV)(G) and from the differences in the language between these MPEP guideline sections, concludes that declaration or affidavit practice to establish a publication date of a reference is an impermissible practice for *inter partes* reexamination. Patent owner is in error. *Inter partes* reexamination MPEP sections 2616 and 2617 (II) both state that affidavits or declarations maybe used during *inter partes* reexamination proceedings the pertinent dates of patents or printed publications. Both of these MPEP sections cite *ex parte* reexamination MPEP section 2258 for further guidance for the use of affidavits to explain the pertinent dates of patents or printed publications. The *inter partes* reexamination section patent owner cites, MPEP section 2658(IV)(G) does not disavow the use of affidavits for establishing pertinent dates for patents or printed publications. MPEP section 2658(IV)(G) broadly reaffirms the availability of affidavit practice in accordance with 37 CFR 1.131 and 1.132 and merely makes note of the fact that a 37 CFR 1.131 "swear back" affidavit cannot be used to antedate a reference patent that claims the same patentable invention, i.e. 102(g) interfering prior art. In accordance with the case law and current Office policy, practice and procedure as outlined by the MPEP reexamination chapters, MPEP Chapters 2200 and 2600, the third party requester can utilize declaration and affidavit practice in order to explain the pertinent dates of the appendix D reference.

3. Issues of Fact Regarding Third Party Requester's Evidentiary Showing

Patent owner contends that the third party requester's declaratory evidence is insufficient and lacks credibility to establish a prior art publication date. Patent owner also contends that even if the reference of appendix D is established to have a publication date that qualifies it as prior art, the reference does not evidence unpatentability of the claims under *inter partes* reexamination. As such matters of fact fall under the jurisdiction of the fact finder, i.e. the examiner of record, the arguments are improper for presentation in the present petition, and they have not been considered or addressed in regards to this decision on petition.

As patent owner has not established a basis for striking the declaration, the petition is dismissed.

B. Supplementation of Patent Owner Response

MPEP § 2666 (III), citing 37 CFR 1.945(b), provides that 37 CFR 1.111(2)(i) applies in *inter partes* reexamination practice, and that a supplemental amendment paper, i.e., a second or additional amendment paper, cannot be filed as a matter of right. A patent owner attempting to supplement a previous response must establish sufficient cause for entry of the supplemental response. Sufficient cause is established by satisfying the following three prong test of 37 CFR 1.945(b):

(A) an explanation of how the requirements of 37 CFR 1.111(a)(2)(i) are satisfied;

---

[2] The MPEP is a set of non-binding guidelines for use by the examination corps to assist the corps in the examination of applications and is not a set of binding rules.

(B) an explanation of why the supplemental response was not presented together with the original response to the Office action; and

(C) a compelling reason to enter the supplemental response.

Patent owner, in the petition to strike and the accompanying remarks document in support of the petition to strike requests that, in the alternative that the examiner consider the arguments of the petition and the supporting remarks document, i.e. patent owner is attempting to supplement the January 26, 2009 patent owner response. Patent owner has made no attempt to explain how the requirements of 37 CFR 1.111(a)(2)(i) are satisfied. Patent owner has not provided a compelling reason to enter the supplemental response, and a desire to respond to requester's comments will not serve as such a compelling reason. Accordingly, as patent owner has not established a basis for entering the petition and remarks as a supplemental response.

CONCLUSION

1. Patent owner's March 13, 2009 petition and remarks, as supplemented on April 21, 2009, is dismissed.

2. Patent owner's March 13, 2009 petition and remarks, as supplemented on April 21, 2009, will not be treated as a supplemental response.

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

4. Telephone inquiries with regard to this decision should be directed to Joseph F. Weiss, Jr., Legal Advisor, at (571) 272-7759, or to the undersigned at (571) 272-7710.

Kenneth Schor
Senior Legal Advisor
Office of Patent Legal Administration

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,070	07/21/2008	6519629	008458.G008	3890

21839 7590 06/05/2009

BUCHANAN, INGERSOLL & ROONEY PC
POST OFFICE BOX 1404
ALEXANDRIA, VA 22313-1404

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/05/2009

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CENTRAL REEXAMINATION UNIT

BUCHANAN, INGERSOLL & ROONEY PC (For Patent Owner)
POST OFFICE BOX 1404
ALEXANDRIA VA 22313-1404

BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP (For Requester)
1279 OAKMEAD PARKWAY
SUNNYVALE, CA 94085-4040

In re Harvey *et alia*
Reexamination Proceeding
Control No. 95/001,070
Request Deposited: July 21, 2008
For: U.S. Patent No. 6,519,629

: ORDER PROVISIONALLY
: SEALING PAPERS

This is an Order provisionally sealing a paper filed in the above identified *inter partes* reexamination proceeding. The paper identified below will be provisionally sealed for a period of THIRTY (30) DAYS pending statements from any interested party, including patent owner and third party requester, explaining why the papers should be permanently sealed. Any such statements must not address the patentability merits of the present proceeding.

BACKGROUND

1. U.S. Patent No. 6,519,629 (hereinafter, the '629 patent), issued to Harvey *et alia* on February 11, 2003.

2. The '629 patent is the subject of litigation styled *Cross Atlantic Capital Partners, Inc. v. Facebook, Inc. and Thefacebook, LLC* Civil Action No. 07-CV-2768 JP (E.D. PA).

3. On January 16, 2008, an Order Approving Protective Order was signed by the court, in the litigation.

4. On July 21, 2008, a third party deposited a request for *inter partes* reexamination of the '629 patent. The deposited reexamination request was assigned Control No. 95/001,070 (hereinafter, the '1070 proceeding).

5. On October 16, 2008, an order granting the request for reexamination of all 32 claims of the '629 patent was mailed.

6. On October 31, 2008, a non-final office action was mailed rejecting all 32 claims.

7. On December 15, 2008, patent owner filed a response amending claims 8, 9, 16, and 32, and adding new claims 33-75. The response also referenced and attached a document entitled "Plaintiff's Brief in Support of Its Opposition to Defendant's Motion for Summary Judgment of Inequitable Conduct, July 14, 2008." The entire document was electronically submitted to the office and made part of the public record. There was no indication that the document was under seal.

8. On January 14, 2009, third party requester filed comments to patent owner's response.

9. On February 10, 2009, a notice regarding defective paper was mailed stating that the patent owner's December 15, 2008 paper did not comply with 37 CFR 1.943(b) and that the response lacked a signature.

10. On March 12, 2009, a revised response was filed by patent owner. The response again referenced the document entitled "Plaintiff's Brief in Support of Its Opposition to Defendant's Motion for Summary Judgment of Inequitable Conduct, July 14, 2008."

11. On March 31, 2009, third party requester filed a paper entitled PETITION UNDER 37 C.F.R. §1.182 TO STRIKE THE REVISED RESPONSE AND ACCOMPANYING LETTER. Said paper states, for the first time in the record, that the document entitled "Plaintiff's Brief in Support of Its Opposition to Defendant's Motion for Summary Judgment of Inequitable Conduct, July 14, 2008" is under seal. The paper requests that the March 12, 2009 patent owner response be stricken because the multiple references to the document "cause the revised response to exceed the 50 page limit" and "incorporate an inappropriate submission."

12. On April 9, 2009, third party requester filed comments to patent owner's March 12, 2009 response.

13. On April 22, 2009, patent owner filed a paper entitled PETITION UNDER 37 C.F.R. 1.182 TO DENY THIRD PARTY REQUESTER'S PETITION TO STRIKE THE REVISED RESPONSE AND ACCOMPANYING LETTER IN *INTER PARTES* REEXAMINATION. Regarding the Plaintiff's Brief, said paper states, "it is respectfully submitted that Patent Owner filed the Brief under seal and the cited pages include no confidential information."

ORDER PROVISIONALLY SEALING PAPERS

As pointed out above, the Office was notified (for the first time) by third party requester on March 31, 2009, that the document entitled "Plaintiff's Brief in Support of Its Opposition to Defendant's Motion for Summary Judgment of Inequitable Conduct, July 14, 2008" filed by patent owner on December 15, 2008, was under seal. However, third party requester does not identify what causes the document to be under seal (i.e., does not provide the basis for requester's allegation) and whether the document was under seal in accordance with the protective order of January 16, 2008 or some other protective order. As the submitted document contains no markings indicating that it is subject to a protective order, it appeared facially to be a public document, and was entered as such. Therefore, it is incumbent on third party requester to provide specificity as to its allegation that the document is under seal.

If this document is, or was, subject to the January 16, 2008 protective order (or some other protective order), the record contains no indication that the protective order has expired, or has been modified or terminated by order of the court. Accordingly, in an abundance of caution, the Office has provisionally sealed the document entitled "Plaintiff's Brief in Support of Its Opposition to Defendant's Motion for Summary Judgment of Inequitable Conduct, July 14, 2008" by marking this document as "closed" and "non-public."

THIRTY (30) DAYS from the date of mailing or issuance of the present Order, the Office intends to unseal the provisionally sealed document, unless any interested party advises the Office of the basis for the document being protected by court order, that the January 16, 2008 protective order (or other court order) continues to be in effect and to apply to the subject document or has been superseded by a Protective Order that applies to the subject document.

Patent Owner may file a petition under 37 CFR 1.182 during the time period requesting expungement of the document subject to the court order, in a similar manner to a 37 CFR 1.59 petition as set forth in MPEP § 724. If such a petition is filed, it is to be accompanied by an explanation of why the procedures set forth in MPEP § 724 were not followed if any of the submitted documents were covered by the Protective Order.

Inquiries regarding the present Order may be directed to Eric Keasel, Supervisory Patent Examiner, at (571) 272-4929, or in his absence, to Legal Advisor, Pinchus M. Laufer at (571) 272-7726.

Kenneth M. Schor

Kenneth M Schor
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,070	07/21/2008	6519629	008458.G008	3890

21839 7590 06/25/2009

BUCHANAN, INGERSOLL & ROONEY PC
POST OFFICE BOX 1404
ALEXANDRIA, VA 22313-1404

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/25/2009

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

DANIEL M. DEVOS
1279 OAKMEAD PARKWAY
SUNNYVALE, CA 94085-4040

Date: MAILED

JUN 25 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001070
PATENT NO. : 6519629
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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BUCHANAN, INGERSOLL & ROONEY PC
POST OFFICE BOX 1404
ALEXANDRIA VA 22313-1404

(For Patent Owner)

MAILED

JUN 25 2009

BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP
1279 OAKMEAD PARKWAY
SUNNYVALE, CA 94085-4040

(For Requester) CENTRAL REEXAMINATION UNIT

In re Harvey *et alia*
Reexamination Proceeding
Control No. 95/001,070
Request Deposited: July 21, 2008
For: U.S. Patent No. 6,519,629

: DECISION

This decision addresses various papers filed in the above identified *inter partes* reexamination proceeding after the non-final office action was mailed on October 31, 2008. Although the petitions are styled under 37 CFR 1.182, they are considered pursuant to 37 CFR 1.181.

The notice regarding defective paper mailed February 10, 2009 is **vacated**.

The patent owner response of December 15, 2008 is found to be **defective**.

The petitions of March 31, 2009 and April 22, 2009 are **dismissed as moot**.

BACKGROUND

1. U.S. Patent No. 6,519,629 (hereinafter, the '629 patent), issued to Harvey *et alia* on February 11, 2003.

2. The '629 patent is the subject of litigation styled *Cross Atlantic Capital Partners, Inc. v. Facebook, Inc. and Thefacebook, LLC* Civil Action No. 07-CV-2768 JP (E.D. PA).

3. On January 16, 2008, an Order Approving Protective Order was signed in the litigation.

4. On July 21, 2008, a third party deposited a request for *inter partes* reexamination of the '629 patent. The deposited reexamination request was assigned Control No. 95/001,070 (hereinafter, the '1070 proceeding).

5. On October 16, 2008, an order granting the request for reexamination of all 32 claims of the '629 patent was mailed.

6. On October 31, 2008, a non-final office action was mailed rejecting all 32 claims.

7. On December 15, 2008, patent owner filed a response amending claims 8, 9, 16, and 32, and adding new claims 33-75. The response did not include an explanation of the support in the disclosure of the patent for the changes to the claims made by the amendment paper (the following from page 24 does not adequately provide support for 43 new claims, "New claims 33-75 are based on claims 1-32 and are no broader in scope than patent claims 1-32. Additional support for the subject matter of claims 33-75 can be found in the specification of the '669 Patent [sic, presumably the '629 Patent] at, for example, column 6, line 50 to column 7, line 51."). The response also referenced and attached a document entitled "Plaintiff's Brief in Support of Its Opposition to Defendant's Motion for Summary Judgment of Inequitable Conduct, July 14, 2008". The entire document was electronically submitted to the office and made part of the public record. There was no indication that the document was under seal.

8. On January 14, 2009, third party requester filed comments to patent owner's response.

9. On February 10, 2009, a notice regarding defective paper was mailed indicating that the patent owner paper of December 15, 2008 did not comply with 37 CFR 1.943(b) and that the response lacked a signature.

10. On March 12, 2009, a revised response was filed by patent owner. The response did not include an explanation of the support in the disclosure of the patent for the changes to the claims made by the amendment paper and the response again referenced the document entitled "Plaintiff's Brief in Support of Its Opposition to Defendant's Motion for Summary Judgment of Inequitable Conduct, July 14, 2008".

11. On March 31, 2009, third party requester filed a paper entitled PETITION UNDER 37 C.F.R. §1.182 TO STRIKE THE REVISED RESPONSE AND ACCOMPANYING LETTER. Said paper states, for the first time in the record, that the document entitled "Plaintiff's Brief in Support of Its Opposition to Defendant's Motion for Summary Judgment of Inequitable Conduct, July 14, 2008" is under seal. The paper requests that the March 12, 2009 patent owner response be stricken because the multiple references to the document "cause the revised response to exceed the 50 page limit" and "incorporate an inappropriate submission".

12. On April 9, 2009, third party requester filed comment to patent owner's March 12, 2009 response.

13. On April 22, 2009, patent owner filed a paper entitled PETITION UNDER 37 C.F.R. 1.182 TO DENY THIRD PARTY REQUESTER'S PETITION TO STRIKE THE REVISED RESPONSE AND ACCOMPANYING LETTER IN *INTER PARTES* REEXAMINATION. Regarding the Plaintiff's Brief, said paper states, "it is respectfully submitted that Patent Owner filed the Brief under seal and the cited pages include no confidential information."

ANALYSIS AND FINDINGS

Initially, it is noted that the patent owner response filed December 15, 2008 is non-compliant for reasons other than those set forth in the notice regarding defective paper mailed February 10, 2009. Specifically, 37 CFR §1.941 requires

"Amendments by patent owner in inter partes reexamination proceedings are made by filing a paper in compliance with §§ 1.530(d)-(k) and 1.943."

37 CFR 1.530(e) states:
"(e) Status of claims and support for claim changes. Whenever there is an amendment to the claims pursuant to paragraph (d) of this section, there must also be supplied, on pages separate from the pages containing the changes, the status (i.e., pending or canceled), as of the date of the amendment, of all patent claims and of all added claims, and an explanation of the support in the disclosure of the patent for the changes to the claims made by the amendment paper."

The amendment of December 15, 2008 amended claims 8, 9, 16, and 32, and added new claims 33-75. The response did not include an explanation of the support in the disclosure of the patent for the changes to the claims made by the amendment paper. The only passage in the response concerning the explanation of support appears on page 24:

"New claims 33-75 are based on claims 1-32 and are no broader in scope than patent claims 1-32. Additional support for the subject matter of claims 33-75 can be found in the specification of the '669 Patent [sic, presumably the '629 Patent] at, for example, column 6, line 50 to column 7, line 51."

This is not an explanation of support, but merely an invitation for the office to try to find support for the amended and new material.

However, the notice regarding defective paper mailed February 10, 2009 did not address this defect. The letter of February 10, 2009 stated that the submission of December 15, 2008 was not signed and exceeded the 50-page limit. A review of the response indicates that the response was signed and the response was within the 50-page limit (the claims do not count against the 50-page limit).

Accordingly, the notice regarding defective paper mailed February 10, 2009 was in error and is herby **vacated**. The follow-on responses of March 12, 2009 and April 9, 2009, which address the vacated notice and revised patent owner response are accordingly expunged from the file.

Since the patent owner submission of December 15, 2008 was a *bona fide* attempt to respond and the office did not identify the omission of the explanation of support in the paper of February 10, 2009, patent owner will be given 30 days or one month from the mail date of this decision to **provide a complete response** to the non-final office action mailed October 31, 2008.

It is noted that the document entitled "Plaintiff's Brief in Support of Its Opposition to Defendant's Motion for Summary Judgment of Inequitable Conduct, July 14, 2008" appears to be under seal. The status of said paper is being addressed in a separate paper. It is also noted that third party requester states (in the petition of April 22, 2009) that the four pages of the

document entitled "Plaintiff's Brief in Support of Its Opposition to Defendant's Motion for Summary Judgment of Inequitable Conduct, July 14, 2008" that were incorporated into the response of December 15, 2008 did not contain any confidential information. If patent owner wishes to present any non-confidential facts or arguments into their response, they can simply include them in the response and not refer to a confidential document that is under seal. Patent Owner is reminded that the response must comply with the pertinent rules and regulations, including the 50-page limit.

With the response of December 15, 2008 found non-compliant for other reasons and the status of the document entitled "Plaintiff's Brief in Support of Its Opposition to Defendant's Motion for Summary Judgment of Inequitable Conduct, July 14, 2008" being addressed separately, the petitions of March 31, 2009 and April 22, 2009 are **dismissed as moot**.

CONCLUSION

1. The patent owner response of December 15, 2008 is found to be **defective** for the reasons set forth above.

2. Patent Owner is given 30 days or one month from the mail date of this decision to **provide a complete response** to the non-final office action mailed October 31, 2008. Third Party will be given 30 days to file comments from the date of service of patent owner's response.

3. The petitions of March 31, 2009 and April 22, 2009 are **dismissed as moot**.

4. Inquiries regarding this decision may be directed to Eric Keasel, Supervisory Patent Examiner, at (571) 272-4929, or in his absence, to Legal Advisor, Pinchus M. Laufer at (571) 272-7726.

5. This decision is not a final agency decision and is without prejudice to request reconsideration or higher-level review.

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.
95/001,073	07/30/2008	7240025 B2	23373-007RX1	4124

7590 12/15/2008

EXAMINER	

MICHAEL F. HELM
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600 TRAVIS STREET
SUITE 6710
HOUSTON, TX 77002

ART UNIT	PAPER NUMBER

DATE MAILED: 12/15/2008

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

John C. Phillips
Fish & Richardson P.C.
12390 El Camino Real
San Diego, CA 92130

MAILED

DEC 15 2008

CENTRAL REEXAMINATION UNIT

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

REEXAMINATION CONTROL NUMBER *95/001,073*.

PATENT NUMBER *7,240,025 B2*.

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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12390 EL CAMINO REAL
SAN DIEGO, CA 92130

(For Third Party Requester)

[Enclosure – Copy of Patent Owner Petition filed on December 2, 2008]

In re Function Media, LLC :
Inter Partes Reexamination Proceeding : **DECISION**
Control No.: 95/001,073 : **GRANTING**
Filed: July 30, 2008 : **PETITION**
For: U.S. Patent No. 7,240,005 B2 :

MAILED

DEC 15 2008

CENTRAL REEXAMINATION UNIT

This is a decision on the patent owner petition December 2, 2008 entitled "Petition For Additional Pages to Respond to Office Action."

The petition and the above-captioned *inter partes* reexamination proceeding are before the Office of Patent Legal Administration for consideration.

For the reasons set forth below, patent owner's petition, taken as a 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.

The petition under 37 CFR 1.183 is granted to the extent that the page limit for the concurrently field patent owner response is extended to not exceed 100 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

PETITION FEE

37 CFR 1.183 requires payment of the petition fee under 37 CFR 1.17(f), which is $400.00. Therefore, an additional $400.00 will be charged to patent owner's Deposit Account No. 504592, as authorized in concluding paragraph of the present petition.

REVIEW OF SALIENT FACTS

1. U.S Patent number 7,240,025 ("the '025 patent") issued to Lucinda Stone *et al* on July 3, 2007, from an application filed on September 30, 2004, and is assigned to Function Media, LLC.

2. On July 30, 2008, a request for *inter partes* reexamination of the '250 patent was filed by a third party requester, and assigned control number 95/001,073 ("the '1073 *inter partes* reexamination proceeding").

3. The '1073 *inter partes* reexamination proceeding was subsequently accorded a filing date of July 30, 2008.

4. An Order Granting *Inter Partes* Reexamination was mailed in the '1073 *inter partes* reexamination proceeding on October 24, 2008.

5. On November 21, 2008, a non-final Office action was mailed in which claims 1, 6, 7, 11-17, 20, 23, 24, 28-32, 36-39, 45-47, 50-52, 62, 63, 79, 81, 90, 91, 140, 141, 148, 179, 185, 186, 190-196, 199, 202, 203, 207-211, 215-218, 224-226, 229- 231, 241, 242, 258, 260, 269, 270, 319, 320, and 327 of the '749 patent were rejected.

6. On December 2, 2008, patent owner filed the present patent owner petition.

DECISION

I. Applicable Regulatory Provisions

37 CFR 1.183 provides:

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

37 CFR 1.943(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. Findings and Analysis

The record shows that on December 2, 2008, the patent owner filed the present petition, in which patent owner requests a waiver of the requirements of 37 CFR 1.943(b) to permit the response to exceed the 50-page limitation set by that regulation for a patent owner's response.

In the present petition, patent owner specifically requests that the 37 CFR 1.943(b) 50-page limitation on the length of a patent owner response be waived. Patent owner states that the non-final Office action dated November 21, 2008 comprises 504 pages and adopts 538 grounds of rejection proposed by the Requester.

Under the facts and circumstances currently of record in the '1073 *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 100 pages in length is appropriate in the interest of justice.

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 100 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 with regard to this decision should be directed to Michael Cygan, Legal Advisor, at (571) 272-7700, or, in his absence, to the undersigned at (571) 272-7710.

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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CENTRAL REEXAMINATION UNIT

WOOD , HERRON & EVANS, LLP (SOLTA) (For Patent Owner)
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441 VINE STREET
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HUGH A. ABRAMS (For Third Party Requester)
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In re Knowlton
Inter Partes Reexamination Proceeding
Control No. 95/001,075
Filed: November, 26, 2008
For: U.S. Patent No. 6,749,624

DECISION
GRANTING-IN-PART
PETITION

This is a decision on the October 30, 2009 patent owner petition entitled "PETITION UNDER 37 C.F.R. § 1.183 -REQUEST TO WAIVE THE PAGE LIMIT FOR PATENT OWNER'S COMMENTS AFTER ACP." The petition requests waiver of the requirement of 37 CFR 1.943(b) that the response by patent owner not exceed fifty (50) pages in length, and requests that the page limit be extended to 101 pages in order to fully respond to the September 30, 2009 Action Closing Prosecution (ACP). Patent owner concurrently filed a timely 37 CFR 1.951(a) submission after ACP with the petition.

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

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 55 pages in length, excluding amendments, 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 petition under 37 CFR 1.183 was charged to patent owner's Deposit Account No. 23-3000 on November 4, 2009.

REVIEW OF THE RELEVANT FACTS

1. On June 15, 2004, United States Patent Number 6,749,624 (the '624 patent) issued.

2. On July 31, 2008, a request for *inter partes* reexamination of the '624 patent was deposited by a third party requester, which request was assigned Reexamination Control No. 95/001,075 ("the '1075 proceeding").

3. On November 26, 2008, a corrected request for *inter partes* reexamination of the '624 patent was filed by the third party requester in the '1075 proceeding.

4. On February 25, 2009, the Office issued an order granting *inter partes* reexamination in the '1075 proceeding, with an accompanying Office action on the merits.

5. Prosecution in the '1075 proceeding progressed to the point where, on September 30, 2009, an Action Closing Prosecution (ACP) was mailed.

6. On September 30, 2009, patent owner filed the instant petition in a paper entitled "PETITION UNDER 37 C.F.R. § 1.183 -REQUEST TO WAIVE THE PAGE LIMIT FOR PATENT OWNER'S COMMENTS AFTER ACP." Patent owner concurrently filed a timely 37 CFR 1.951(a) submission with the petition.

7. On November 23, 2009, third party requester filed 37 CFR 1.951(b) comments on patent owner's 37 CFR 1.951(a) submission.

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 of October 30, 2009

In the instant petition, patent owner requests waiver 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 September 30, 2009 Action Closing Prosecution not to exceed 101 pages in length (excluding any amendments, appendices of the claims, and reference materials. Pet. at 2. In support of waiver of the rule, patent owner asserts that "[t]he ACP is sixty-six (66) pages in length and, on page 63 of the ACP, incorporates by reference the May 22, 2009 response by the Requestor. The May 22, 2009 response by the Requestor is thirty-five (35) pages in length. The total length for the ACP is effectively hundred and one (101) pages in length." Pet. at 2. Patent owner further asserts that "[c]onsidering the one hundred and one (101) page length of the ACP, the presentation of a full and complete response will require more pages than the limit set forth in 37 C.F.R. 1.943(b)." Pet. at 2.

Analysis and Findings

The instant petition under 37 CFR 1.183 has been fully considered. The September 30, 2009 ACP is 58 pages (excluding 3 cover sheets, 1 signature page, and 6 pages of 6 grounds of rejection not adopted by the examiner) and incorporates by reference the May 22, 2009 response by the Requestor. The May 22, 2009 response by the Requestor is 34 pages (excluding 1 cover sheet, 1 exhibit list page, and 1 correspondence information page). Thus, the ACP is effectively substantively 92 pages in length.

In this instance, petitioner has made a showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft a patent owner's response in compliance with the 50-page limit, and submitting the resulting response, which is in excess of 50 pages, concurrently with the instant petition for waiver of 37 CFR 1.943(b) with respect to the submitted response. Patent owner asserts that it "has attempted in good faith to limit its comments on the ACP in accordance with the fifty (50) page limit set by 37 C.F.R. 1.943(b)." Pet. at 2. The patent owner response is 55 pages (excluding 1 signature page).

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 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 (c) 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 October 30, 2009 response, which exceeds the 50-page limit by 5 pages.

Accordingly, patent owner's October 30 2009 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 **5 pages** of the portions of patent owner's October 30, 2009 response, which are included in the regulatory page count, that exceed the 50-page limit.

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 patent owner's 37 CFR 1.951(a) submission after the September 30, 2009 ACP is not to exceed 55 pages in length, excluding appendices of claims and reference materials, such as prior art references. This waiver makes the patent owner's 37 CFR 1.951(a) submission after the September 30, 2009 ACP page-length compliant.

2. Jurisdiction for the '1075 reexamination proceeding is returned to the Central Reexamination Unit (CRU).

3. 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

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2-19-10

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In re Imanishi et al. :
Inter partes Reexamination Proceeding : Decisions on Reexamination Petitions
Control No. 95/001,076 :
Filed: November 12, 2008 :
For: U.S. Patent No. 6,770,748

This decision in response to numerous petition papers. This decision is in response to (1) patent owner's April 13, 2009 petition titled "PETITION TO SUSPEND THE RULES UNDER 37 CFR § 1.183 TO EXPUNGE THIRD PARTY REQUESTER'S SUPPLEMENTAL RESPONSE FILED MARCH 30, 2009; (2) requester's April 24, 2009 petition titled "THIRD PARTY REQUESTER PETITION TO EXPUNGE INFORMATION IN TPR'S COMMENTS UNDER 37 CFR 37 CFR § 1.59 AND MPEP § 724.05" ; (3) patent owner's June 8, 2009 "PETITION UNDER 37 CFR 1.181 AND 1.182 TO MAINTAIN UNDER SEAL PATENT OWNER'S PETITION TO DENY THE THIRD PARTY REQUESTER'S PETITION TO EXPUNGE TPR'S COMMENTS AND TO MAKE AVAILABLE FOR THE PUBLIC RECORD, ONLY IF NECESSARY, THE REDACTED VERSION OF THE PATENT OWNER'S PETITION TO DENY THE THIRD PARTY REQUESTER PETITION INFORMATION IN TPR'S COMMENTS"; AND (4) the July 6, 2009 "THIRD PARTY REQUESTER'S COMMENTS ON PATENTEES'S FILING AND PETITION UNDER 37 CFR 1.182 AND 1.183 TO SUSPEND RULES."

(1). Patent Owner's petition filed April 13, 2009, to suspend the rules and expunge the redacted exhibit filed March 30, 2007is **DISMISSED**.

(2) Requesters' petition filed April 24, 2009, under 37 CFR 1.59 to expunge information in comments filed March 27, 2009, is being taken as a petition under 37 CFR 1.182 to seal the information, with the decision to whether to permanently seal the information being **HELD IN ABEYANCE** until such time as prosecution on the merits is closed and the Office has made a determination as to whether such information is considered material to determining the patentability of such claims.

(3) Patent Owner's petition filed June 8, 2009, to maintain under seal the patent owner's request to deny the requester's petition to expunge the comments is **DISMISSED AS PREMATURE**.

(4) Requester's reply filed on July 6, 2009 is EXPUNGED.

The Office assessed the $400.00 fee to requester for the submission of the petition under 37 CFR 1.182. Because the petition is considered under 37 CFR 1.182 the proper fee is $400.00 pursuant to 37 CFR 1.17(f) rather than expungement fee of $200.00 under 37 CFR 1.17(g).

BACKGROUND

1. U.S. Patent No. 6,700,748 (the '748 patent) issued on August 3, 2004.

2. A request for reexamination of the '748 patent was filed on August 22, 2008. The request was assigned control No. 95/001,076 (the '1076 reexamination proceeding).

3. On October 15, 2008, the Office vacated the filing date of August 22, 2008, because the request failed to comply with the requirements of 37 CFR 1.915(b)(3). The decision provided requester one month to respond to the notice to vacate.

4. On November 3, 2008, requester responded to the vacatur amending the request, however, requester failed to provide a certificate of service with the request. On November 12, 2008, the request papers met the requirements and was granted a filing date of November 12, 2008.

5. On December 31, 2008, the Office ordered that the patent be reexamined, finding that requester had raised a substantial new question of patentability as to claims 1-5 of '748 patent. The order was 23 pages in length. Concurrently, the Office also mailed an Office action. The Office action was 27 pages in length.

5. On February 27, 2009, patent owner filed a response to the December 31, 2008 Office action. The response to the Office action included a declaration by Dr. Jesper Wengel and a declaration

by Dr. Nanna Allback. *Curriculum vitae* were also included.

6. On March 27, 2009, the requester filed comments after patent owner's response. The comments paper was 34 pages and included 33 additional exhibits. Exhibit #2 contained material that has been asserted to be considered privileged under the attorney-client privilege.

7. On March 30, 2009, requester filed a replacement of Exhibit 2, redacting five pages that were asserted to be considered privileged. Requester provided a redacted declaration to replace the declaration containing the asserted privileged information.

8. On April 13, the patent owner filed a petition titled "PETITION TO SUSPEND THE RULES under 37 CFR 1.183 and EXPUNGE THIRD PARTY REQUESTER'S SUPPLEMENTAL RESPONSE." Patent owner requested that the Office suspend 37 CFR 1.939 to facilitate the requested relief under 37 CFR 1.182. Patent Owner requested that the supplemental paper filed on March 30, 2007, including corrected declaration #2 be expunged for being improper under 37 CFR 1.915(b)(3) and 37 CFR 1.947.

9. On April 13, 2009, patent owner also filed a petition under 37 CFR 1.183 to request waiver of 37 CFR 1.939. Patent Owner requested that the requester's comments filed on March 27, 2009 also be expunged from the record as being improper under 37 CFR 1.947.

10. On April 23 2009, the requester submitted a petition opposing patent owner's request for expungement of comments on March 27, 2009. Requester's petition also included an exhibit outlining request's comments and how such comment correlate with rules 37 CFR 1.947 and 1.948.

11. On April 24, 2009, the requester petitioned under 37 CFR 1.59 and MPEP 724.05 to expunge from the record pages 1-5 of exhibit 2 of Dr. Seth, because those pages are privileged attorney and client information and were inadvertently and unintentionally disclosed in exhibit 2.

12. On June 8, 2009, the patent owner filed a petition under 37 CFR 1.181 or 1.182 to maintain under seal patent owner's petition to deny the requester's petition to expunge information in requester's comments and to make available in the public record, only if necessary, redacted version of patent owner's petition to deny the requester's petition to expunge the requester's comments.

13. On July 6, 2009, requester submitted a reply to the patent owner's petition to deny expungement.

RELEVANT LAW AND REGULATIONS

37 CFR 1.59 provides:

Expungement of information or copy of papers in application file.

1. (a)

(1) Information in an application will not be expunged, except as provided in paragraph (b) of this section or § 41.7(a) of this title.

(2) Information forming part of the original disclosure (*i.e.*, written specification including the claims, drawings, and any preliminary amendment specifically incorporated into an executed oath or declaration under §§ 1.63 and 1.175) will not be expunged from the application file.

(b) An applicant may request that the Office expunge information, other than what is excluded by paragraph (a)(2) of this section, by filing a petition under this paragraph. Any petition to expunge information from an application must include the fee set forth in § 1.17(g) and establish to the satisfaction of the Director that the expungement of the information is appropriate in which case a notice granting the petition for expungement will be provided.

(c) Upon request by an applicant and payment of the fee specified in § 1.19(b), the Office will furnish copies of an application, unless the application has been disposed of (*see* §§ 1.53(e), (f) and (g)). The Office cannot provide or certify copies of an application that has been disposed of.

37 CFR 1.181 provides:

Petition may be taken to the Director:

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

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

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

(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.

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 1.939 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.

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.

35 USC 314(b)(2) provides

b) RESPONSE.-

(2) Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.

PATENT OWNER'S ARGUMENTS

1. Patent Owner asserts that the requester comments paper submission was beyond the 30-day limit of 37 CFR 1.947.

2. Patent Owner asserts that the submission was the second submission by requester which is a violation of the rule 37 CFR 1.947.

REQUESTER'S ARGUMENTS

1. Requester's inadvertently submitted material that is considered a privileged communication between an attorney and his client.

ANALYSIS AND FINDINGS

1. Patent Owner's petition to expunge requester's redacted submission March 30, 2009.

Pursuant to 35 U.S.C.314(b), the third-party requester has 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. In this proceeding, requester submitted comments on March 27, 2009 that included 33 exhibits. Having discovered that one of the exhibits (#2) contained information that may be deemed confidential under the attorney-client privilege, requester mailed a redacted copy exhibit #2. Under the facts of the proceeding, the Office deems the redacted version of the same exhibit as a replacement-for-the-record *version* of the initial submission of comments, addressing a confidentiality issue, and therefore not a violation of 35 USC 314(b) and 37 CFR 1.947. Since the comments submission occurred on March 27, 2009, the replacement-for-the-record *version* is not untimely, even thought it was filed after the 30-day period stated in 35 U.S.C.314(b); as pointed out, a redacted copy is not a supplement of the comments paper.

Accordingly, patent owner's request to expunge the redacted exhibit filed March 30, 2009 is **DISMISSED.**

2. Requester's petition to expunge information contained in Exhibit 2 of the March 27, 2009 comments.

The petition requests expungement under 37 CFR 1.59(b). However, the present record does not reflect that the materials submitted with the petition as proprietary were submitted in compliance with MPEP 724.02. Because the information was not submitted in conformance with MPEP 742.02, while the requester states that the information is proprietary, the information is being provisionally sealed with this decision, until such time as prosecution on the merits is closed and the Office has made a determination as to whether such information is considered material to determining the patentability of such claims.

Even if the information was initially submitted in compliance with MPEP 742.02, the petition for expungement of the information under 37 CR 1.59(b) would be premature, based on the following:

MPEP 724.04(c) sets forth the guidelines for a petition to expunge "Materials Submitted in Reexamination File Open to the Public Under 37 CFR 1.11(d)." When the reexamination proceeding is considered for action on the merits, the examiner (and/or other appropriate Office official responsible for considering the information) will review the sealed information, and will make a determination as to whether or not any portion or all of the information submitted is material. The examiner may issue a determination on the issue of materiality of the sealed information in the first Office action on the merits, or in an Office action issued any time thereafter that is appropriate, but, in no event, later than the close of prosecution. It would not appropriate to make, in this decision, a final determination of whether or not the information requested to be expunged is material. Rather, such a decision is issued by the examiner, and is issued no later than the close of prosecution. Thus, a decision on the petition to expunge would be premature and would need to be held in abeyance at this point in time.

The petition requests expungement under 37 CFR 1.59(b) is being taken as a petition to seal under 37 CFR 1.183, and the following relief is being provided.

The Office is provisionally sealing Exhibit #2 filed on March 27, 2009 so that the unredacted version will not be publically available. During prosecution on the merits, the examiner will determine whether or not the provisionally sealed information is considered to be "material." After the examiner has issued a determination on the issue of importance of the sealed information in an Office action on the merits, a petition to expunge (which would be proper, now that the information has been sealed) may be filed by patent owner.

3. Patent Owner's June 8, 2009 PETITION UNDER 37 CFR 1.181 AND 1.182 TO MAINTAIN UNDER SEAL PATENT OWNER'S PETITION TO DENY THE THIRD PARTY REQUESTER'S PETITION TO EXPUNGE TPR'S COMMENTS AND TO MAKE AVAILABLE FOR THE PUBLIC RECORD, ONLY IF NECESSARY, THE REDACTED VERSION OF THE PATENT OWNER'S PETITION TO DENY THE THIRD PARTY REQUESTER PETITION INFORMATION IN TPR'S COMMENTS;

Patent Owner's request to maintain under seal the opposition petition to expungement is provisionally granted. The Office will provisionally seal the opposition petition from public view until such time as a decision on the materiality is made, at which time patent owner may renew the petition to permanently seal the opposition petition.

The petition not to expunge is dismissed as premature at present, since a decision on the materiality has not been made. At such time as the materiality issue as to the unredacted Exhibit #2 is resolved, the Office will consider the merits of the opposition petition filed under 37 CFR

1.181 and 1.182 to deny the expungement of the Exhibit #2 of the comments filed March 27, 2009, only if the petition to unseal Exhibit #2 is seasonably re-filed. Should the information be found not to be material, at that time, patent owner must renew the petition to unseal Exhibit #2, in order to obtain a decision on the merits.

4. Requester's July 6, 2009 THIRD PARTY REQUESTOR REPLY COMMENTS ON PATENTEES' FILING AND PETITION UNDER 37 CFR §§ 1.182 AND 1.183 TO SUSPEND RULES.

Requester's comments on patent owner's petition filed on July 6, 2009 will not be considered and the Office will close such paper from public view. Accordingly, the closing of such paper will be considered as if the paper is returned. The Office notes that there must be a limitation on party iterations of input, especially given the statutory mandate of special mandate for special dispatch in reexamination. The Office notes that the filing of the request by patent owner on June 8, 2009 is a petition under 1.182 and 1.183 to consider patent owners input on the requester's requester for expungement which is a discretionary decision by the Office. Accordingly, the requester does not have a statutory right to challenge this discretionary procedural process in the reexamination proceeding. In the interest of special dispatch, the Office must provide limitations on input and will not consider the comments filed on July 6, 2009 by requester.

CONCLUSION

1. Patent owner's April 13, 2009 petition titled "PETITION TO SUSPEND THE RULES UNDER 37 CFR § 1.183 TO EXPUNGE THIRD PARTY REQUESTER'S SUPPLEMENTAL RESPONSE FILED MARCH 30, 2009 is DISMISSED.

2. Requesters' petition under 37 CFR 1.59 to expunge information in comments filed March 27, 2009, is being taken as a petition to seal. The petition is granted to the extent that the information is provisionally sealed, with the decision to whether to permanently seal the information being HELD IN ABEYANCE until such time as prosecution on the merits is closed and the Office has made a determination as to whether such information is considered material to determining the patentability of such claims. The Office will make such determination by the time a Notice of Intent to Issue Reexamination Certificate (NIRC) has been mailed. ***Requester is cautioned*** to ensure that a petition to expunge is submitted for consideration by the Office prior to the point at which the file is forwarded for issuance of the reexamination certificate. This may be done after the examiner has issued a determination on the

issue of importance of the sealed information in an Office action on the merits, and is to be done no later than immediately after the time a Notice of Intent to Issue Reexamination Certificate (NIRC) is issued. A failure to timely re-submit the petition to expunge prior to the point at which the file is forwarded for issuance of the reexamination certificate will result in the provisionally sealed Exhibit #2 information being unsealed and made of record in the reexamination file and thus becoming open to the public.

3. Patent owner's June 8, 2009 "PETITION UNDER 37 CFR 1.181 AND 1.182 TO MAINTAIN UNDER SEAL PATENT OWNER'S PETITION TO DENY THE THIRD PARTY REQUESTER'S PETITION TO EXPUNGE TPR'S COMMENTS AND TO MAKE AVAILABLE FOR THE PUBLIC RECORD, ONLY IF NECESSARY, THE REDACTED VERSION OF THE PATENT OWNER'S PETITION TO DENY THE THIRD PARTY REQUESTER PETITION INFORMATION IN TPR'S COMMENTS" is decided as follows. The request not to expunge is dismissed as premature at present. If the information at issue is found not to be material, at that time, patent owner must renew the petition to unseal Exhibit #2, should, in order to obtain a decision on the merits. The request to close to the petition from public view is provisionally granted, and such petition will remain under seal until a determination is made as to whether the information is material. ***Patent owner is cautioned*** to take this action prior to the point at which the file is forwarded for issuance of the reexamination certificate. This may be done after the examiner has issued a determination on the issue of importance of the sealed information in an Office action on the merits, and is to be done no later than immediately after the time a Notice of Intent to Issue Reexamination Certificate (NIRC) is issued. A failure to timely take action prior to the point at which the file is forwarded for issuance of the reexamination certificate will result in the provisionally sealed petition being unsealed and made of record in the reexamination file and thus becoming open to the public.

4. Requester's July 6, 2009 comments titled THIRD PARTY REQUESTOR REPLY COMMENTS ON PATENTEES' FILING AND PETITION UNDER 37 CFR §§ 1.182 AND 1.183 TO SUSPEND RULES is being expunged. The expungement will be accomplished by the closure of such comments from the file. The comments will not considered by the Office.

5. The Office will close from public view the unredacted version of exhibit #2 filed with the comments on March 27, 2009. The Office will maintain in public view the redacted submission of exhibit #2 filed on March 30, 2009.

6. The Office will close from public view the petition filed by patent owner on June 8, 2009 until such time as a decision is made on the requester's petition to expunge the unredacted version of exhibit #2 filed by requester on March 27, 2009.

7. The Office will close from public view the comments submitted by the requester on July 6, 2009.

7. The jurisdiction of the application is being transferred to the Central Reexamination Unit or examination in the proceeding.

8. The Office has assessed the proper petition fees in the amount of $400.00 for consideration of the petition. Because the petition is considered under 37 CFR 1.182 the proper fee is $400.00 pursuant to 37 CFR 1.17(f) rather than expungement fee of $200.00 under 37 CFR 1.17(g).

Any questions concerning this decision should be directed to Kery A. Fries, Senior Legal Advisor, Office of Patent Legal Administration, Office of Deputy Commissioner for Patent Examination Policy at 571-272-7757.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy

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CENTRAL REEXAMINATION UNIT

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Washington DC 20005-3934

(For Patent Owner)

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(For *Inter Partes* Requester)

In re Imanishi et al.
Inter partes Reexamination Proceeding
Control No. 95/001,076
Filed: November 12, 2008
For: U.S. Patent No. 6,770,748

: Decision on Petition under 37 CFR 1.183

This decision is in response to Patent Owner's petition filed on April 13, 2009 under 1.183 requesting waiver of 37 CFR 1.939 to permit submission of an accompanying reply to comments by the Requester and third party opposition filed April 23, 2009 opposing the 1.183 petition.

Patent Owner's petition is **DISMISSED** for (1) not providing a showing of extraordinary circumstances and (2) being premature as the Central Reexamination Unit has not determined the propriety of the comments under 37 CFR 1.947.

BACKGROUND

1. U.S. Patent No. 6,700,748 (the '748 patent) issued on August 3, 2004.

2. A request for reexamination of the '748 patent was filed on August 22, 2008. The request was

assigned control No. 95/001,076 (the '1076 reexamination proceeding).

3. On October 15, 2008, the Office vacated the filing date of August 22, 2008, because the request failed to comply with the requirements of 37 CFR 1.915(b)(3). The decision provided Requester one month to respond to the notice to vacate.

4. On November 3, 2008, Requester responded to the vacatur amending the request, however, requester failed to provide a certificate of service with the request. On November 12, 2008, the request papers met the requirements and was granted a filing date of November 12, 2008.

5. On December 31, 2008, the Office ordered that the patent be reexamined, finding that requester had raised a substantial new question of patentability as to claims 1-5 of '748 patent. The order was 23 pages in length. Concurrently, the Office also mailed an Office action. The Office action was 27 pages in length.

5. On February 27, 2009, Patent Owner filed a response to the December 31, 2008 Office action. The response to the Office action included a declaration by Dr. Jesper Wengel and a declaration by Dr. Nanna Allback. *Curriculum vitae* were also included.

6. On March 27, 2009, Requester filed comments after patent owner's response. The comments paper was 34 pages and included 33 additional exhibits. Exhibit #2 contained material that has been asserted in requester's petition to expunge filed on April 23, 2009 as being privileged communication under the attorney-client privilege.

7. On March 30, 2009, requester filed a replacement of exhibit # 2, redacting five pages that were asserted to be considered privileged. Requester provided a redacted declaration to replace the unredacted exhibit #2 filed on March 27, 2009.

8. On April 13, the patent owner filed a petition titled "PETITION TO SUSPEND THE RULES under 37 CFR 1.183 and EXPUNGE THIRD PARTY REQUESTER'S SUPPLEMENTAL RESPONSE." Patent Owner requested that the Office suspend 37 CFR 1.939 to facilitate the requested relief under 37 CFR 1.183. Patent Owner requested that the supplemental paper filed on March 30, 2007, including corrected declaration #2 be expunged for being improper under 37 CFR 1.915(b)(3) and 37 CFR 1.947.

9. On April 13, 2009, Patent Owner also filed a petition under 37 CFR 1.183 to request waiver of 37 CFR 1.939. Patent Owner requested that the requester's comments filed on March 27, 2009 be expunged from the record as being improper under 37 CFR 1.947.

10. On April 23 2009, the Requester submitted a petition opposing patent owner's petition under 37 CFR 1.183 to expunge Requester's redacted comments filed on March 27, 2009. Requester's petition included an exhibit outlining Requester's comments and how such comments correlate

with rules 37 CFR 1.947 and 1.948.

11. On April 24, 2009, the Requester petitioned under 37 CFR 1.59 and MPEP 724.05 to expunge from the record pages 1-5 of exhibit 2 of Dr. Seth, because those pages are privileged attorney and client information and were inadvertently and unintentionally disclosed in exhibit 2.

12. On June 8, 2009, the Patent Owner filed a petition under 37 CFR 1.181 or 1.182 to maintain under seal patent owner's petition to deny the requester's petition to expunge information in requester's comments and to make available in the public record, only if necessary, redacted version of patent owner's petition to deny the requester's petition to expunge the requester's comments.

13. On July 6, 2009, Requester submitted a reply to the patent owner's petition to deny expungement.

RELEVANT LAW AND REGULATIONS

37 CFR 1.59 provides:

Expungement of information or copy of papers in application file.

1. (a)

(1) Information in an application will not be expunged, except as provided in paragraph (b) of this section or § 41.7(a) of this title.

(2) Information forming part of the original disclosure (*i.e.*, written specification including the claims, drawings, and any preliminary amendment specifically incorporated into an executed oath or declaration under §§ 1.63 and 1.175) will not be expunged from the application file.

(b) An applicant may request that the Office expunge information, other than what is excluded by paragraph (a)(2) of this section, by filing a petition under this paragraph. Any petition to expunge information from an application must include the fee set forth in § 1.17(g) and establish to the satisfaction of the Director that the expungement of the information is appropriate in which case a notice granting the petition for expungement will be provided.

(c) Upon request by an applicant and payment of the fee specified in § 1.19(b), the Office will furnish copies of an application, unless the application has been disposed of (*see* §§ 1.53(e), (f) and (g)). The Office cannot provide or certify copies of an application that has been disposed of.

37 CFR 1.181 provides:

Petition may be taken to the Director:

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

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

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

(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.

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 1.939 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.

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.

35 USC 314(b)(2) provides

b) RESPONSE.-

(2) Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.

PATENT OWNER'S ARGUMENTS

1. Patent Owner asserts that waiver of 37 CFR 1.939 should be permitted to allow the Patent Owner to address the Requester's March 27, 2009 comments. Requester's comments were filed in response to Patent Owner's reply filed on February 27, 2009 which was in response to an Office action mailed December 31, 2008.

2. Patent Owner asserts that the requester's comments go beyond the scope and content provide for by 37 CFR 1.947.

3. Patent Owner asserts that the requester is initiating new grounds of rejection which only may be presented under 37 CFR 1.915(b)(3).

4. Patent Owner asserts that the requester's comments should be returned to the requester and expunged from the record for going beyond scope of 1.947.

REQUESTER'S ARGUMENTS

Requester asserts that its comments were proper and consistent with 35 USC 314, 37 CFR 1.948, and MPEP 2666.05.

ANALYSIS AND FINDINGS

This is a decision on the papers identified in background items 9 and 10 *supra*. Pursuant to 37 CFR 1.183, the Office may waive or suspend any rules in extraordinary situations when justice requires such waiver or suspension. In the present situation, patent owner fails to establish any authority for the filing of a response to requester's comments submitted under 37 CFR 1.947. Patent Owner acknowledges this lack of right to file a response to requester's comments by requesting waiver of submission of an unauthorized paper. Accordingly, patent owner attempts to have the response considered by the examiner by petitioning for a waiver of 37 CFR 1.939(a). Patent Owner does not submit arguments as to how the facts of the particular proceeding would support a finding of extraordinary situation in which justice may require a waiver or suspension.

Upon review, the facts of the proceeding do not warrant a finding of extraordinary situation requiring justice because: (1) the consideration is premature due to the fact that the central reexamination unit (CRU) examiner has not determined whether the comments were compliant with 37 CFR 1.947 and 1.948 at the time of the submission, and (2) if the central reexamination unit examiner (CRU) takes a position that is adverse to the position of patent owner, patent owner would have a remedy under the rules by submitting a petition pursuant to 37 CFR 1.181. The submission of the petition prematurely requires additional resources be expended by the Office to address matters that will be addressed by the examiner in due course. The patent

statute mandates that the Office conduct such reexamination proceedings with special dispatch, therefore the Office must put limitations on party iterations of input.

Accordingly, the patent owner's petition under 37 CFR 1.183 is DISMISSED.

CONCLUSION

1. Patent Owner's petition under 37 CFR 1.183 to suspend 37 CFR 1.939(a) is **DISMISSED**.

2. The Office will close from public view the petition under 37 CFR 1.183 filed by patent owner on April 13, 2009 requesting suspension of 37 CFR 1.939(a).

3. The Office will close from public view the comments submitted in opposition to the 37 CFR 1.183 petition on April 23, 2009 by requester.

4. The jurisdiction of the application is being transferred to the Central Reexamination Unit for examination in the proceeding.

5. The Office has assessed the proper petition fee in the amount of $400.00 for consideration of the petition.

Any questions concerning this decision should be directed to Kery A. Fries, Senior Legal Advisor, Office of Patent Legal Administration, Office of Deputy Commissioner for Patent Examination Policy at 571-272-7757.

Hiram H. Bernstein
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy

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CENTRAL REEXAMINATION UNIT

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For Patent Owner

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For Requester

Ex Parte Reexamination Proceeding
Control No. 95/001,076
Filed: November 12, 2008
For: US Patent No. 6,770,748

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

This is a decision on the petition filed October 14, 2009 to request a three-month extension of time pursuant to 37 CFR 1.956 for filing a response to the Office action mailed October 5, 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 October 5, 2009, which set a one-month date for filing a response thereto. The request is timely filed and includes authorization to debit a deposit account for the $200.00 petition fee as required by 37 CFR 1.17(g).

37 CFR 1.956 (c) states:

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

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

> Evaluation of whether "sufficient cause" has been shown for an extension must be made by **balancing** the desire to provide a fair opportunity to respond, **against** the requirement of the statute, 35 U.S.C. 314 (c), that the proceedings be conducted with special dispatch.
>
> Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor.

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

The petition for extension of time states that the Office action mailed October 5, 2009 is an Action Closing Prosecution containing twelve new rejections. In view of the multiple new grounds of rejection adopted for the first time by the examiner, patent owners request an extension of time in order to prepare a full and complete response.

Analysis and Findings

The Office action mailed on October 5, 2009 erroneously included an Action Closing Prosecution summary sheet. The action is actually a non-final Office action. Patent owner's response is due two (2) months from the mailing date of

this decision, that is December 21, 2009. Therefore, the request for an extension of time is dismissed as moot.

Conclusion

1. The Patent Owner's petition for extension of time in which to file a response to the Office action of October 5, 2009 is **dismissed**.

2. The Patent Owner's response is due December 21, 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
Randolph Building
401 Dulany Street
Alexandria, VA 22314

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

Deborah Jones, SPE Art Unit 3991
Central Reexamination Unit

Attached: 65 pages

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CENTRAL REEXAMINATION UNIT

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(For *Inter Partes* Requester)

In re Imanishi et al.
Inter partes Reexamination Proceeding
Control No. 95/001,076
Filed: November 12, 2008
For: U.S. Patent No. 6,770,748

: Decision on Petition
: under 37 CFR 1.181

This decision is in response to Patent Owner's petition filed on November 2, 2009 under 37 CFR 1.181 requesting expungement of the comments by the Requester, filed on March 27 & 20, 2009, and Requester's papers, filed November 19, 2009, opposing the 37 CFR 1.181 petition.

The petition and opposition are before the Director of the Central Reexamination Unit for decision.

Patent Owner's petition is **DISMISSED** for the reasons explained below.

STATEMENT OF RELEVANT FACTS

1. U.S. Patent No. 6,700,748 (the '748 patent) issued on August 3, 2004.

2. A request for reexamination of the '748 patent was filed on August 22, 2008. The request was assigned control No. 95/001,076 (the '1076 reexamination proceeding).

3. On October 15, 2008, the Office vacated the filing date of August 22, 2008, because the request failed to comply with the requirements of 37 CFR 1.915(b)(3). The decision provided Requester one month to respond to the notice to vacate.

4. On November 3, 2008, Requester responded to the vacatur amending the request, however, requester failed to provide a certificate of service with the request. On November 12, 2008, the request papers met the requirements and was granted a filing date of November 12, 2008.

5. On December 31, 2008, the Office ordered that the patent be reexamined, finding that requester had raised a substantial new question of patentability as to claims 1-5 of '748 patent. The order was 23 pages in length. Concurrently, the Office also mailed an Office action. The Office action was 27 pages in length.

5. On February 27, 2009, Patent Owner filed a response to the December 31, 2008 Office action. The response to the Office action included a declaration by Dr. Jesper Wengel and a declaration by Dr. Nanna Allback. *Curriculum vitae* were also included.

6. On March 27, 2009, Requester filed comments after patent owner's response. The comments paper was 34 pages and included 33 additional exhibits. Exhibit #2 contained material that has been asserted in requester's petition to expunge filed on April 23, 2009 as being privileged communication under the attorney-client privilege.

7. On March 30, 2009, requester filed a replacement of exhibit # 2, redacting five pages that were asserted to be considered privileged. Requester provided a redacted declaration to replace the unredacted exhibit #2 filed on March 27, 2009.

8. On April 13, the patent owner filed a petition titled "PETITION TO SUSPEND THE RULES under 37 CFR 1.183 and EXPUNGE THIRD PARTY REQUESTER'S SUPPLEMENTAL RESPONSE." Patent Owner requested that the Office suspend 37 CFR 1.939 to facilitate the requested relief under 37 CFR 1.183. Patent Owner requested that the supplemental paper filed on March 30, 2007,

including corrected declaration #2 be expunged for being improper under 37 CFR 1.915(b)(3) and 37 CFR 1.947.

9. On April 13, 2009, Patent Owner also filed a petition under 37 CFR 1.183 to request waiver of 37 CFR 1.939. Patent Owner requested that the requester's comments be expunged from the record as being improper under 37 CFR 1.947.

10. On April 23 2009, the Requester submitted a petition opposing patent owner's petition under 37 CFR 1.183 to expunge Requester's redacted comments filed on March 27, 2009. Requester's petition included an exhibit outlining Requester's comments and how such comments correlate with rules 37 CFR 1.947 and 1.948.

11. On April 24, 2009, the Requester petitioned under 37 CFR 1.59 and MPEP 724.05 to expunge from the record pages 1-5 of exhibit 2 of Dr. Seth, because those pages are privileged attorney and client information and were inadvertently and unintentionally disclosed in exhibit 2.

12. On June 8, 2009, the Patent Owner filed a petition under 37 CFR 1.181 or 1.182 to maintain under seal patent owner's petition to deny the requester's petition to expunge information in requester's comments and to make available in the public record, only if necessary, redacted version of patent owner's petition to deny the requester's petition to expunge the requester's comments.

13. On July 6, 2009, Requester submitted a reply to the patent owner's petition to deny expungement.

14. On August 21, 2009, the Office mailed a composite decision on the April 13 & 24, 2009 petitions, the June 8, 2009 petition, and the July 6, 2009 requester reply. The decision dismissed Patent Owner's April 13, 2009 petition, held in abeyance Requester's April 24, 2009 petition, dismissed as premature Patent Owner's June 8, 2009 petition, and expunged Requester's July 6, 2009 reply.

15. On September 1, 2009, the Office mailed a decision dismissing Patent Owner's April 13, 2009 petition under 37 CFR 1.183 to suspend the requirement in 37 CFR 1.939(a).

16. On October 21, 2009, the Office mailed a non-final Office action, which was responsive to the Requester's comments, dated March 27 & 30, 2009.

17. On November 2, 2009, Patent Owner filed the instant petition under 37 CFR 1.181 to request expungement of the Requester's comments, dated March 27 &

30, 2009.

18. On November 19, 2009, the Requester filed the instant opposition to Patent Owner's November 2, 2009 petition.

19. On December 21, 2009, the Patent Owner filed a response to the October 21, 2009 Office action.

20. On January 20, 2010, the Requester filed comments on the Patent Owner's response and the October 21, 2009 Office action.

RELEVANT LAW AND REGULATIONS

37 CFR 1.59 provides:

Expungement of information or copy of papers in application file.

1. (a)

(1) Information in an application will not be expunged, except as provided in paragraph (b) of this section or § 41.7(a) of this title.

(2) Information forming part of the original disclosure (*i.e.*, written specification including the claims, drawings, and any preliminary amendment specifically incorporated into an executed oath or declaration under §§ 1.63 and 1.175) will not be expunged from the application file.

(b) An applicant may request that the Office expunge information, other than what is excluded by paragraph (a)(2) of this section, by filing a petition under this paragraph. Any petition to expunge information from an application must include the fee set forth in § 1.17(g) and establish to the satisfaction of the Director that the expungement of the information is appropriate in which case a notice granting the petition for expungement will be provided.

(c) Upon request by an applicant and payment of the fee specified in § 1.19(b), the Office will furnish copies of an application, unless the application has been disposed of (*see* §§ 1.53(e), (f) and (g)). The Office cannot provide or certify copies of an application that has been disposed of.

37 CFR 1.181 provides:

Petition may be taken to the Director:

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

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

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

(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.

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.

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.

35 USC 314(b)(2) provides

(b) RESPONSE.-

(2) Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.

ANALYSIS AND FINDINGS

The patent owner (petitioner) states that they are seeking relief under 37 CFR 1.181 to have Requester's comments, dated March 27 & 29, 2009 (hereinafter "the Requester's comments), expunged because the comments violate 37 CFR 1.947. Patent owner specifically states the following reasons to support their request to expungement the comments:

1. The Requester's comments introduced a new theory of anticipation;
2. The Requester's comments introduced a new ground of rejection;
3. The Requester's comments make extensive new arguments regarding written description under 35 U.S.C. 112, first paragraph; and
4. The Requester's comments introduce a discussion regarding the publication date the Nielsen thesis.

See pages 5-6 of the petition. The Requester filed an opposition to Patent Owner's petition on November 19, 2009. The Requester's position in the opposition was considered.

Pursuant to 37 CFR 1.181(a)(3), a party may invoke the supervisory review of an examiner's action in certain circumstances. In the present situation, the decisions of August 21, 2009 and September 1, 2009 informed the Patent Owner that they could seek relief under 37 CFR 1.181 if the examiner takes an adverse position in an Office action regarding the Requester's comments. As stated above, the examiner entered and considered the Requester's comments in the October 21, 2009 Office action. Therefore, the Patent Owner is permitted to file a petition under 37 CFR 1.181 to seek supervisory review to determine if the examiner's decision to enter and consider the Requester's comments was in accordance with reexamination laws and policies.

In response to Patent Owner's arguments for expunging the Requester's comments in this reexamination proceeding, the Director finds there are not good and sufficient reasons to do so. First, 35 U.S.C. 314(c) requires that all *inter partes* reexamination proceedings to be acted upon with "special dispatch." The rules and procedures of the Office were established through notice and comment in order to achieve special dispatch in a reasonable manner. The Office rules and procedures encourage examiners to look at the facts involved in a particular proceeding and to weigh the equities before issuing an Office action. Specifically, MPEP 266.05 states that "... the comments should not be held defective if the examiner can ascertain that all of the comments filed by the third party requester are directed to the issues and points in the Office action and/or the patent owner's response." The petition states that the examiner failed to follow Office policies and procedures because the Requester's comments violated 37 CFR 1.947 for four reasons set forth in the petition.

The record shows that the Requester's comments did not violate the requirements set forth in 37 CFR 1.947. The Requester's comments did not introduce any new theories of anticipation or new grounds of rejection as alleged by the Patent Owner on pages 6-10 of the petition. Specifically, the comments regarding "inherent" anticipation are made in support of Requester's position that the Nielsen thesis is enabled and teaches the claimed invention as set forth in the request for reexamination. See pages 4-13 of the Requester's March 27, 2009 comments. See also pages 5-6 of the Requester's opposition, dated November 19, 2009, in which Requester states that they were not raising new grounds of rejection. Similarly, the comments pertaining to obviousness based upon the Nielsen reference are addressing the examiner's determination that Nielsen was non-enabled in the first Office action in order to convince the examiner to reconsider the proposed obviousness rejections based upon Nielsen in combination with the secondary references, as set forth in the request for reexamination. See page 14 of the Requester's March 27, 2009 comments. See also pages 6-7 of the Requester's opposition, dated November 19, 2009, in which Requester states that they were only addressing the proposed obviousness rejections made in the request for reexamination. Upon review of the Office action dated October 21, 2009, the examiner's treatment of the Requester's comments is consistent with Requester's

statements that no new grounds of rejections were raised, and nothing in the record shows that the examiner's interpretation was unreasonable or erroneous. The issues of enablement and obviousness were raised by the examiner in the first Office action. Therefore, the Requester is permitted, under 37 CFR 1.47, to respond to enablement and obviousness issues raised by the examiner in the first Office action.

In response to the written description and publication date of the Nielsen thesis, the record does not support petitioner's position that the Requester's comments must be expunged from the record. The record clearly shows that determination of the effective filing date of the claimed invention is an issue, and therefore, which references are prior art are also issues. See pages 4-5 in the first Office action. In fact, a substantial portion of the Patent Owner's response to the first Office action was devoted to the issue of the effective filing date for the claimed invention and whether references were prior art. See pages 2-25 of the February 27, 2009 response. Therefore, the record clearly shows that the determination of the effective filing date of the claimed invention was an issue raised by the examiner and the Patent Owner. In addition, it is reasonable that the Requester submit evidence to support the publication date of the Nielsen thesis in light of all the issues presented regarding the effective filing date of the claimed invention, in the interest of special dispatch. Accordingly, the Requester is permitted, under 37 CFR 1.47, to respond to issues pertaining to which references are prior art against the claimed invention, including the effective filing date of the claimed invention and the publication date of the references applied.

In summary, the record shows that the examiner appropriately followed Office rules and procedures in the determination to enter and address the Requester's comments, and to not categorically deprive the Requester of its statutory rights to present arguments and evidence relevant to issues raised by the examiner or the Patent Owner in this reexamination proceeding. In other words, the record does not support petitioner's allegation that the Requester's comments must be expunged from the record of this proceeding, which would result in denying the Requester their right to submit comments set forth in 35 U.S.C. 314(b)(2).

Accordingly, the patent owner's petition under 37 CFR 1.181 is DISMISSED.

CONCLUSION

1. Patent Owner's petition under 37 CFR 1.181, filed November 2, 2009, is dismissed for the reasons discussed above.

2. Telephone inquiries related to this decision should be directed to Deborah Jones,

Supervisory Patent Examiner, at (571) 272-1535, or in her absence to the undersigned at (571) 272-3838.

Gregory A. Morse
Director
Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,078	09/04/2008	7193562	PA2894REX	4648

22830 7590 07/10/2009

CARR & FERRELL LLP
2200 GENG ROAD
PALO ALTO, CA 94303

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 07/10/2009

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

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Date: MAILED

JUL 10 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001078
PATENT NO. : 7193562
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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(For Patent Owner)

MAILED

JUL 10 2009

CENTRAL REEXAMINATION UNIT

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(For Third Party Requester)

PETITION DECISION
DENYING
REQUEST TO ORDER
ADDITIONAL CLAIMS
[37 CFR § 1.181 & § 1.927]

In re Victor Strom *et alia*
Inter Partes Reexamination Proceeding
Control No. 95/001,078
Deposited on: 4 September 2008
For: U.S. Patent No. 7,193,562

This is a decision on the 17 December 2008 third party requester "Petition to Order Reexamination of Claims 1-10 and 18-36." The requester seeks review of the denial of reexamination of claims 1-10 and 18-36 by petitioning the Director under 37 CFR § 1.181 and § 1.927.

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

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

SUMMARY OF RELVANT FACTS

1. On 20 March 2007, US Patent No. 7,193,562 was granted to Victor Strom *et alia*.

2. On 4 September 2008 a request was deposited requesting *inter partes* reexamination of claims 1 to 36 of US Patent No. 7,193,562 by a third party requester.

3. On 28 November 2008 the Order granting *inter partes* reexamination of claims 11 to 17 was mailed.

4. On 17 December 2008 a petition was submitted by the requester seeking review *de novo* of the denial of claims 1 to 10 and 18 to 36 for inter partes reexamination.

DISCUSSION

On 17 December 2008 the requester petitioned the USPTO to review the denial of examination of claims 1 to 10 and 18 to 36 in the Order granting *inter partes* reexamination for the reexamination proceeding identified by control number 95/001,078. The petition is before the director of the Central Reexamination. The petition was filed within one month of the action taken by the examiner and as such is timely filed. The petition fee was electronically filed.

The requester petitions for review of the following issues:

I The Refusal to Reexamine Claims 1-10 and 18-36 Was Based on a Clear Factual Error in the Analysis of the Kaluzni Reference.

(a) "A skilled artisan with a basic understanding of printed antenna operation would readily recognize that Kaluzni's printed monopole antennas 250A-B (FIG. 2) necessarily provide horizontally polarized radiation coverage in the plane of the circuit board. *(See* Ex. A, Jensen Declaration at ¶3.)"

(b) "The Requester specifically cited to Kaluzni's FIG. 2 as an illustrative example of such horizontally polarized printed antennas 250A-B (FIG. 2), but this was ignored by the Office Action. *(See* Request at pp. 15-17.)" (Petition; pg. 3, lines 10-15)

II The Refusal to Reexamine Claims 1-10 and 18-36 Was Based on a Legal Error in the Analysis of the Chuang Article

"The November 28, 2008 Office Action improperly interpreted the claim term "collectively" to mean "simultaneously" even though the '562 patent specification provides no clear definition for such a limited interpretation. (Office Action at p. 9.)" (Petition, pg. 5)

III-IV The Refusal to Reexamine Claims 1-10 and 18-36 Was Based on a Legal Error in the Analysis of the Hikuma Reference. (§ III-IV of the Petition are combined here)

III "The November 28, 2008 Office Action concluded that the Hikuma reference *alone* fails to raise a SNQ as to claims 1-10 and 18-36. (Office Action at pp. 10-11.) Not a single

sentence of analysis on pages 10-11 of the Office Action contemplates that the resulting combination of Hikuma and Yao (as proposed in the Request) would actually provide the purportedly missing features. The Requester submits this was a legal error." (Petition pgs 6-7; last and first two lines, respectively)

IV "A skilled artisan with a basic understanding of RF antenna operation would readily understand that Hikuma's printed 101 and 102 are (FIGS. 1 and 5A-B) necessarily horizontally polarized in the plane of the circuit board (See Ex. A, Jensen Declaration ¶4)" (Petition, pg. 8, 14-16).

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.

...

(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Briefs or memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declarations (and exhibits, if any) must accompany the petition.

(c) When a petition is taken from an action or requirement of an examiner in the *ex parte* prosecution of an application, or in the ex parte or inter partes prosecution of a reexamination proceeding, it may be required that there have been a proper request for reconsideration (§ 1.111) and a repeated action by the examiner. The examiner may be directed by the Director to furnish a written statement, within a specified time, setting forth the reasons for his or her decision upon the matters averred in the petition, supplying a copy to the petitioner.

(d) Where a fee is required for a petition to the Director the appropriate section of this part will so indicate. If any required fee does not accompany the petition, the petition will be dismissed.

...

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

(g) The Director may delegate to appropriate Patent and Trademark Office officials the determination of petitions.

37 CFR § 1.927 Petition to review refusal to order inter partes reexamination.

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

MPEP § 2648 Petition From Denial of Request

PROCESSING OF PETITION UNDER 37 CFR § 1.927

Once a request for inter partes reexamination has been denied, jurisdiction over the reexamination proceeding is retained by the Central Reexamination Unit (CRU) to await any petition seeking review of the examiner's determination refusing reexamination. If no petition is filed within one (1) month, the CRU will process the reexamination as a concluded reexamination file. See MPEP § 2647 and § 2694. If a petition is timely filed, the petition (together with the reexamination file) is forwarded to the office of the CRU Director for decision. The CRU Director will then review the examiner's determination that a substantial new question of patentability has not been raised. The CRU Director's review will be *de novo*.

DECISION

With respect to issue I (a) raised by the requester, the Jensen Declaration (Exhibit A) has been reviewed. A patent search revealed evidence that one of ordinary skill in the art would not readily recognize that Kaluzni's printed monopole antennas necessarily provide horizontally polarized radiation. For example, Crawford (US2002/0101377 published Aug. 1, 2002)

> "A card-based diversity antenna structure includes a card and at least two antenna elements. The card has active circuitry attached thereto and connectors located at a first end thereof configured for engagement with an interface slot. The at least two antenna elements are attached to the card at a second end thereof and are coupled to the active circuitry. At least two antenna elements are sufficiently spaced apart so as to achieve spatial diversity. The polarizations of two of the at least two antenna elements may be orthogonal to each other so as to achieve polarization diversity." (Abstract, emphasis added; also note figure 5)

Accordingly, at least Crawford provides an example wherein one of ordinary skill in the art would not readily recognize the printed antennas of Kaluzni as necessarily providing "substantially omnidirectional and horizontally polarized radiation coverage." In addition, the citations provided by the Declarant (re: Kaluzni, col.6:14-34, Abstract, and col.3:1-3) are not a part of the request.

With regard to argument I (b), pages 15-17 of requester's original request for *inter partes* reexamination was thoroughly re-examined in response to this petition. The citation to figure 2 of Kaluzni on page 15 of the Request contains no references to horizontally polarized radiation coverage. Further, the requester mentions "horizontally polarized radiation" only once in pages 15-17 of the Request, merely noting that the claim element, "substantially omnidirectional and horizontally polarized radiation coverage" is not clearly explained in the '562 specification. (Request, pg. 17, lines 2-3). In pages 15-17 the requester does not address the how Kalzuni meets the claim limitation of "substantially omnidirectional *and horizontally polarized radiation coverage*."

In addition, requester's assertion that the said claim is not enabled is not within the scope of reexamination. 37 CFR § 1.552(c). Accordingly, the enablement issue will not be addressed.

Further, it is noted that requester attempts to cure the deficiency of the Request by reproducing figure 2 of Kaluzni with electrical field lines (which were absent in the Request) in the instant petition. CFR § 1.510(b)(2) states that a Request for reexamination must include an "identification of every claim for which reexamination is requested, *and a detailed explanation of the pertinency and manner of applying the cited prior art to every claim for which reexamination is requested.*" (emphasis added) Here, requester failed to provide a detailed explanation of the pertinency and manner of applying Kalzuni to the claim element of "substantially omnidirectional *and horizontally polarized radiation coverage"* because requester did not explain the pertinency and manner of applying Kalzuni to the claim element of "substantially omnidirectional *and horizontally polarized radiation coverage*." the, argument in I (b) is unpersuasive.

The petitioner's arguments with respect to the II argument has been considered. The petitioner asserts that the Office action improperly interpreted "collectively" to mean simultaneously." Review of the Order mailed 28 November 2008 indicates that at no pont did the examiner use the term "simultaneously." The denial of the request asserting a substantial new question as to claims 1-10 and 18-36 over Chuang is reproduced below. (see Page 9 of the Order mailed 11/28/08)

> "It is not agreed that the consideration of Chuang raises a SNQ as to claims 1-10 and 18-36 of the Shtrom patent because Chuang does not disclose that "the first and second antenna elements collectively produce substantially omnidirectional and horizontally polarized radiation coverage that is substantially in the plane of the circuit board", as the Examiner expressly stated as a reason for allowance of the independent claims.
>
> Requester alleges that this feature is disclosed by Chuang at figures 8-9, page 521 and page 59. (see Request, pg. 47, 3rd text box). However, nowhere in the Chuang reference is there a mention of first and second antenna elements collectively producing substantially omnidirectional and horizontally polarized radiation.
>
> *Rather, the citations provided by 3PR pertain to the selection of either a vertical polarization of one antenna or the horizontal polarization of the other antenna, in the alternative. These antennae are not disclosed as collectively producing a substantially horizontal polarization. Please note Chuang's disclosure on pg. 57 wherein it states, "...two orthogonal printed dipole antennas with a polarization switched PIN diode circuit ..... Hence, either the vertical or horizontal printed dipole can be selected and connected to the transceiver." (emphasis added).*
>
> Accordingly, there is not a substantial likelihood that a reasonable examiner would consider the teachings of Chuang important in deciding whether claims 1-10 and 18-36 of the Shtrom patent are patentable." (emphasis added)

Accordingly, the argument that the examiner interpreted the term "collectively" to mean "simultaneously" is not supported and not persuasive. Further, it is clear from the Examiner explanation that "either the vertical or horizontal printed dipole can be selected and connected to the transceiver." As the Examiner expressly stated above, *either* the vertical dipole produces the radiation OR the horizontal dipole produces the radiation. Therefore, both antennae cannot *collectively* produce the radiation because only one antenna radiates at a time. The argument that the

term "collectively" was meant to mean "simultaneously" by the examiner in the analysis of the claims with respect to the raising of a substantial new question is unfounded.

With regard to the petitioner's argument with respect to the legal analysis of the Hikuma reference in § III & § IV that the examiner failed to consider the resulting combination first with Yao (§ III) and second with Hikuma raising a substantial new question with respect to certain elements (§ IV). Review of the Order mailed 28 November 2008 reveals that it is agreed that the Examiner failed to consider whether the teaching of Yao as to "electronic circuitry which receives and/or transmits RF signals mounted on the circuit board" (Yao; col. 2:61-67). However, this omission is not persuasive because the Examiner presented two reasons as to why the Hikuma reference alone or in combination with Yao fails to present an SNQ. The second reason is addressed in the response to argument § IV which follows.

Argument § IV addresses whether the Examiner erred in denying reexamination of claims 1-10 and 18-36 over the Hikuma reference alone. For consideration, a portion of the Examiner's statement regarding the Hikuma reference is reproduced below.

> "It is not agreed that the consideration of Hikuma raises a SNQ as to claims 1-10 and 18-36 of the Shtrom patent because Hikuma does not disclose a first or second antenna element configured to produce a first directional radiation pattern. The invention of Hikuma is a diversity antenna circuit *for a receiver* (e.g., see Abstract). A *receiving* antenna does not produce a directional radiation pattern because a *receiving* antenna does not produce radiation.
>
> In addition, Hikuma does not discloses that "the first and second antenna elements collectively produce substantially omnidirectional and horizontally polarized radiation coverage that is substantially in the plane of the circuit board", as the Examiner expressly stated as a reason for allowance of the independent claims. 3PR alleges that this feature is disclosed by Hikuma in figures 3A, 4A, and 5A-5B. (see Request, pg. 120, 3rd text box). However, nowhere in the Hikuma reference is there a mention of horizontally polarized radiation coverage that is substantially in the plane of the circuit board. Figures 3A and 4A of Hikuma are merely field strength patterns of the signal of the respective individual antennae. (e.g. see col.6:60-col.7:25). Accordingly, there is not a substantial likelihood that a reasonable examiner would consider the teachings of Hikuma important in deciding whether claims 1-10 and 18-36 of the Shtrom patent are patentable." (Order, pgs 10-11)

The petitioner's arguments with respect to § IV of the petition is unpersuasive because the express disclosure of Hikuma contradicts petitioner's assertion. Hikuma is replete with references to the first antenna producing a *horizontal polarization* and a second antenna producing a *vertical polarization*. (e.g., see Hikuma, figs. 3A-3B, 4A-4B, col. 7:1-5, col. 7:17-22; col. 9:45-55). Further, as was noted in the order, the antenna of Hikuma do not radiate. Last, the "T" pattern in figure 4A of illustrates the collective *electric field patterns* (not radiation) from both antennae. In the petition, the requester asserts that the patterns disclosed in figure 4A of Hikuma, *alone*, illustrate the antennae 'radiation patterns.' (e.g. Petition, pg. 9, last paragraph and diagram). These alleged 'radiation' patterns of Hikuma are clearly disclosed as electrical field strengths (e.g. col.7:20-22) and not radiation patterns because the device of Hikuma does not radiate.

In addition, the Declarant notably states, "Indeed, Hikuma specifically illustrates the "radiated" electric field strength..." (the emphasis on "radiated" is original; Declaration, pg. 3, line 2).

Accordingly, Declarant does not assert that Hikuma *necessarily* radiates the disclosed electrical field strengths. Rather, Declarant asserts that Hikuma *modified by the transceiver of Yao* would radiate the electrical field strengths and "necessarily provide horizontally polarized radiation coverage that is substantially in the plane of the circuit board." (Declaration, pg. 3, lines 4-6). To support this position, the Declarant relies on radiation lines inserted by the Declarant himself, into figure 5A of Hikuma, which expressly contradict the teachings of Hikuma (e.g., see Hikuma, figs. 3A-3B, 4A-4B, col. 7:1-5, col. 7:17-22; col. 9:45-55)

Further, Hikuma as modified by the transceiver teaching of Yao does not disclose that "the *first and second antenna elements collectively* produce substantially omnidirectional and *horizontally polarized radiation coverage that is substantially in the plane of the circuit board*" because Hikuma expressly discloses that the first antenna element is horizontally polarized and the second antenna element is vertically polarized (e.g., see Hikuma, figs. 3A-3B, 4A-4B, col. 7:1-5, col. 7:17-22; col. 9:45-55). One of ordinary skill in the art would readily understand that a horizontal polarization *and* a vertical polarization can not *collectively* provide a horizontal polarization. Therefore, arguments presented by the petitioner in § III & § IV are not persuasive.

Consideration of the petition submitted 17 December 2008 to Order reexamination of claims 1 to 10 and 18 to 36 has been fully considered. The arguments presented by the petitioner have been determined to be unpersuasive. The Order Granting Request for *Inter Partes* Reexamination identified as 95/001,078 mailed on 28 November 2008 stands. The claims under *inter partes* reexamination are 11 to 17.

This decision is final and nonappealable pursuant to 35 U.S.C. § 312(c) and 37 CFR §1.927. No further communication on this matter will be acknowledged or considered.

The petition submitted 17 December 2008 is hereby denied.

CONCLUSION

1. The requester's petition dated 17 December 2008 to grant *inter partes* reexamination of claims 1 to 10 and 18 to 36 is hereby **denied.**

2. This decision is final and nonappealable. See 35 U.S.C. 312(c) and 37 CFR 1.927. No further communication on this matter will be acknowledged or considered.

3. All other correspondence may be submitted as follows:

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/Deborah Jones SPE 3991/

Gregory Morse
Director,
Central Reexamination Unit 3999

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,080	09/09/2008	7321783	RIK107440	9118

40401 7590 05/05/2009

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 05/05/2009

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MAILED
MAY 05 2009
CENTRAL REEXAMINATION UNIT

InterPartes Reexamination Proceeding : **DECISION**
Control No. 95/001,080 : **GRANTING**
Filed: September 8, 2008 : **PETITION**
For: US Patent No. 7,321,783 :

This is a decision on the paper entitled "Patent Owner's Petition Under 37 CFR 1.183 to Waive the Page Limit Provisions of 37 CFR 1.943(b)," filed on April 24, 2009. The requisite fee of $400.00 mandated by the 37 CFR 1.17(f) has been posted to the reexamination proceeding.

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

The petition is granted to the extent that the page limit for the response to the February 24, 2009 first Office action is waived to accept the April 24, 2004 response submitted by patent owner.

REVIEW OF THE RELEVANT FACTS

1. United States Patent Number 7,321,783 (the '783 patent) issued on January 22, 2008.

2. On September 9, 2008, a request for *inter partes* reexamination of the '783 patent was filed by a third party requester, and assigned Reexamination Control No. 95/001,080 (the '1080 proceeding).

3. On November 29, 2008, the Office issued an order granting *inter partes* reexamination in the '1080 proceeding.

4. On February 24, 2009, the Office mailed a non-final first Office action in the '1080 proceeding.

5. On April 24, 2009, patent owner filed the instant petition paper entitled, "Patent Owner's Petition Under 37 CFR 1.183 to Waive the Page Limit Provisions of 37 CFR 1.943(b)."

6. Concurrently on April 24, 2009, patent owner filed a response to the February 24, 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.

As noted above, on April 24, 2009, patent owner concurrently filed with the instant petition a response to the February 24, 2009 Office action. The response exceeds the 50-page limit set forth in 37 CFR 1.943(b) by 53 pages (the response is a total of 120 pages - 1 page of identification information, 1 page table of contents[1], 1 page setting out the status of the claims, 11 pages of claim amendments, 2 pages setting out the support for the claim amendments, 103 pages of arguments and a signature page).[2] In the instant petition, patent owner requests waiver of the 50-page limit of 37 CFR 1.943(b) with respect to the April 24, 2009 response.

In support of waiver of the rule, patent owner indicates that the February 24, 2009 Action "is 977 pages long because the Examiner incorporated the request including the claim charts into the Office action"[3] and that the 61 claims under reexamination were subjected to multiple rejections "based on 34 combinations of 9 different prior art references."[4] Patent owner asserts that "[i]t is impossible to articulate specifically, clearly and persuasively Patent Owner's arguments within 50 pages traversing the Examiner's assertions included in the voluminous Office Action which is 977 pages long."[5]

The record reveals that the Office action mailed on February 24, 2009, adopts multiple grounds of rejection using 34 combinations of references in 120 pages of text and specifically

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[1] Note the corrected table of contents that properly lists page numbers of the response from 1-120.
[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] Petition bridging pages 1-2.
[4] Petition at pages 2-3.
[5] Petition at page 2.

incorporates by reference a significant part of the request for reexamination – approximately 265 pages of text and hundreds of pages of claim charts.

In this instance, petitioner has made a showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) and submitted a proposed response, which is in excess of 50 pages, concurrently with the April 24, 2009 petition for waiver of 37 CFR 1.943(b) with respect to the submitted response. Upon cursory review of the submitted response for economizing, extraneous material, and arrangement, without repetition of information already of record, it appears that the pages of arguments in excess of 50 required to complete the patent owner's response are not unreasonable in this instance.

Based upon the above facts and the individual facts and circumstances of this proceeding, it is deemed equitable to allow the entry of the April 24, 2009 response by the patent owner (that is approximately 103 pages in length) to address the Office action mailed on February 24, 2009.

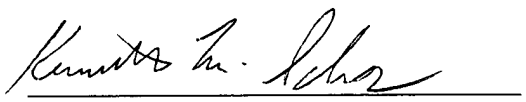
Accordingly, the patent owner petition under 37 CFR 1.183 is **granted** to the extent that the page limit of 37 CFR 1.943(b) is waived to accept the response as filed on April 24, 2009.

CONCLUSION

1. The patent owner petition under 37 CFR 1.183 is granted to the extent that the page limit of 37 CFR 1.943(b) is waived to accept the response as filed on April 24, 2009.

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 Pinchus M. Laufer, Legal Advisor, at 571-272-7726.



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

Ken/pet7/IP/length/ 95_1080 Grant Pg Length Waiver.doc
May 3, 2009

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,080	09/09/2008	7321783	RIK107440A	9118

40401 7590 07/07/2009

Hershkovitz & Associates, LLC
2845 Duke Street
Alexandria, VA 22314

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 07/07/2009

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Hershkovitz & Associates, LLC
2845 Duke Street
Alexandria, Virginia 22314

(For Patent Owner)

MAILED

JUL 0 7 2009

CENTRAL REEXAMINATION UNIT

Novak, Druce & Quigg LLP
1000 Louisiana Avenue
53rd Floor
Houston, Texas 77002

(For *Inter Partes* Requester)

InterPartes Reexamination Proceeding : **DECISION**
Control No. 95/001,080 : **GRANTING**
Filed: September 8, 2008 : **PETITION**
For: US Patent No. 7,321,783 :

This is a decision on the paper entitled "PETITION UNDER 37 C.F.R. §§ 1.183 TO WAIVE THE PROVISIONS OF 37 C.F.R. § 1.943(b) TO INCREASE THE NUMBER OF PAGES PERMITTED FOR REQUESTER'S WRITTEN COMMENTS BEYOND THE 50 PAGE LIMITATION," filed on June 4, 2009. The requisite fee of $400.00 mandated by the 37 CFR 1.17(f) has been posted to the reexamination proceeding.

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

The petition is granted to the extent that the page limit for the comments by the third party requester is waived to accept the June 4, 2009 submission by requester.

REVIEW OF THE RELEVANT FACTS

1. United States Patent Number 7,321,783 (the '783 patent) issued on January 22, 2008.

2. On September 9, 2008, a request for *inter partes* reexamination of the '783 patent was filed by a third party requester, and assigned Reexamination Control No. 95/001,080 (the '1080 proceeding).

3. On November 29, 2008, the Office issued an order granting *inter partes* reexamination in the '1080 proceeding.

4. On February 24, 2009, the Office mailed a non-final first Office action in the '1080 proceeding.

5. On April 24, 2009, patent owner filed a response to the February 24, 2009 Office action, together with a paper entitled, "Patent Owner's Petition Under 37 CFR 1.183 to Waive the Page Limit Provisions of 37 CFR 1.943(b)."

6. On May 5, 2009, the Office granted patent owner's petition accepting the April 24, 2009 response to the Office action.

7. On June 4, 2009, requester filed comments under 37 CFR 1.943(b) in response to the February 24, 2009 Office action and patent owner's April 24 ,2009 response thereto, together with a concurrently filed petition to waive the page limitations of 37 CFR 1.943(b) and to accept the comments as filed.

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 June 4, 2009 the third party requester filed the instant petition concurrently with a "COMMENT RE: RESPONSE TO PATENT OWNER AMENDMENT IN *INTER PARTES* REEXAMINATION OF US PATENT 7,321,783".

In support of waiver of the rule, third party requesters asserts that the length of the office action and the length of patent owner's response warrant a waiver of the page 50 page limit of 37 CFR 1.943(b) to include a response of 118 pages.[1] The requester asserts that the patent owner's response is 101 pages in length; therefore the requester's relief should be, at minimum, 51 pages over the 50-page limit for a total of 101 pages. [2]

Additionally, the requester points out that the patent owner presented 25 new claims in only 2 pages of arguments directed to the new claims (half of page 118, all of page 119 and half of page 120 of the patent owner's response).[3] Requester argues that MPEP § 2666.05(II) requires that the requester:

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[1] Petition on page 2.
[2] Petition on page 3.
[3] Petition on page 3.

must do more than merely present a brief arguments that new claims 125-150 are unpatentable. Instead, requester must present proposed rejections of the newly added claims and a detailed discussion of the grounds of rejection proposed for the newly added 25 claims. [4]

The comments filed concurrently on June 4, 2009 by the requester comprise 123 pages, wherein 5 pages include an introduction and a table of contents for a total of 118 pages of arguments - 68 pages over the limit allowed in 37 CFR 1.943(b). However, the comments contain 28 pages (pages 91-118) explicating rejections proposed against newly presented claims 125-150.

In this instance, petitioner has made a showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) and submitted proposed comments, in excess of 50 pages, concurrently with the June 4, 2009 petition for waiver of 37 CFR 1.943(b) with respect to the submitted comments. Upon cursory review of the submitted response for economizing, extraneous material, and arrangement, without repetition of information already of record, and the proposed rejections with respect to the newly added claims, it appears that the pages of arguments in excess of 50 required to complete the requester's comments are not unreasonable in this instance.

Based upon the above facts and the individual facts and circumstances of this proceeding, it is deemed equitable to waive the page limit. Accordingly, the petition under 37 CFR 1.183 is **granted** to the extent that the page limit of 37 CFR 1.943(b) is waived to accept the requester's comments as filed on June 4, 2009. [5]

CONCLUSION

1. The 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 to accept the comments as filed on June 4, 2009.

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 Pinchus M. Laufer, Legal Advisor, at 571-272-7726.

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

Kenpet7/95_1080 Grant 3pr page length waiver

[4] Petition on page 4.

[5] This decision does not take a position on whether the scope and content of the comments or any other deficiency may render the comments unacceptable for entry.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,080	09/09/2008	7321783	RIK107440A	9118

40401 7590 12/30/2009

Hershkovitz & Associates, LLC
2845 Duke Street
Alexandria, VA 22314

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 12/30/2009

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,183	04/29/2009	7321783	RIK107440B	7201

40401 7590 12/30/2009

Hershkovitz & Associates, LLC
2845 Duke Street
Alexandria, VA 22314

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 12/30/2009

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,623	07/28/2009	7321783	R107440C	2837

40401 7590 12/30/2009

Hershkovitz & Associates, LLC
2845 Duke Street
Alexandria, VA 22314

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 12/30/2009

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
NOVAK DRUCE & QUIGG, LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date MAILED

DEC 30 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001080
PATENT NO. : 7321783
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
AKIN GUMP STRAUSS HAUER & FELD, LLP
P.O. BOX 688
DALLAS, TX 75313-0688

Date: MAILED
DEC 30 2009
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001183
PATENT NO. : 7321783
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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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 the communication enclosed with this transmittal.

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Hershkovitz & Associates, LLC
2845 Duke Street
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(For Patent Owner)

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DEC 30 2009

CENTRAL REEXAMINATION UNIT

Novak, Druce & Quigg LLP
1000 Louisiana Avenue
53rd Floor
Houston, TX 77002

(For first *Inter Partes* & *ex parte* Requester)

Akin, Gump, Strauss, Hauer & Feld LLP
1700 Pacific Avenue, Suite 4100
Dallas, TX 75201-4675

(For second *Inter Partes* Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,080
Filed: September 9, 2008
For: U.S. Patent No. 7,321,783

Inter Partes Reexamination Proceeding
Control No. 95/001,183
Filed: April 29, 2009
For: U.S. Patent No. 7,321,783

Ex Parte Reexamination Proceeding
Control No. 90/010,623
Filed: July 28, 2009
For: U.S. Patent No. 7,321,783

DECISION, *SUA SPONTE*, TO MERGE REEXAMINATION PROCEEDINGS

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

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 7,321,783 (the '783 patent) issued to Ki Il Kim on January 22, 2008.

2. On September 9, 2008, a first request for *inter partes* reexamination of the '783 patent, on claims 1-5, 7-8, 10, 13-17, 19-20, 27-28, 29(/27), 30 (/27), 32, 39, 43, 46, 55, 57 (/1, /2), 58 (/27, /39, /55), 70, 76-78, 79 (/27, /55, /70, /76, /77, /78), 80 (/1, /2, /76), 83, 85 (/32), 87 (/1, /2), 89 (/1, /2, /76) 106-107, 111, 118, 119 (/70, /118), and 120-123, was filed by third party requester and real party in interest, Apple Inc. The request was assigned control number 95/001,080 (the '1080 proceeding).

3. On November 29, 2008, *inter partes* reexamination was ordered on the claims requested in the '1080 proceeding based on the examiner's determination that the September 9, 2008 request raised a substantial new question of patentability.

4. On February 24, 2009, a non-final Office action was mailed in the '1080 proceeding, rejecting claims 1-5, 7-8, 10, 13-17, 19-20, 27-28, 29(/27), 30 (/27), 32, 39, 43, 46, 55, 57 (/1, /2), 58 (/27, /39, /55), 70, 76-78, 79 (/27, /55, /70, /76, /77, /78), 80 (/1, /2, /76), 83, 85 (/32), 87 (/1, /2), 89 (/1, /2, /76) 106-107, 111, 118, 119 (/70, /118), and 120-123 of the '783 patent.

5. On April 23, 2009, patent owner timely filed in the '1080 proceeding an amendment and response to the February 24, 2009 Office action, presenting new claims 126-150. No claims were amended or canceled.

6. On April 29, 2009, a second request for *inter partes* reexamination of the '783 patent, on claims 1-5, 7-8, 10-21, 27-31, 43, 45 (/43), 46, 48 (/46), 49, 51, 53, 55, 56, 57 (/1, /2, /27, /43, /46, /51, /56), 58 (/27, /43, /46, /51, /55), 59-78, 79 (/27, /43, /46, /55, /56, /61, /64, /66, /70, /74, /76, /77, /78), 80 (/1, /2, /27, /46, /51, /55, /61, /66, /72, /73, /74, /77), 81(/51, /74, /76, /77, /78), 83, 85 (/51), 86, 87 (/1, /2, /51, /73, /74, /77), 88 (/51), 89 (/1, /2, /27, /43, /46, /55, /56, /61, /64, /66, /70, /72, /73, /74, /76, /77, /78), 90-101, 106-107, 111, 114-119 and 121-125, was filed by third party requester and real party in interest, ALLTEL Communications, LLC. The request was assigned control number 95/001,183 (the '1183 proceeding).

7. On June 4, 2009, third party requester Apple, Inc., timely filed in the '1080 proceeding written comments.[1]

8. On July 21, 2009, *inter partes* reexamination was ordered on the claims requested in the '1183 proceeding, based on the examiner's determination that the April 29, 2009 request raised a substantial new question of patentability.

9. On July 28, 2009, an *ex parte* request for reexamination of the '783 patent, on claims 18 (/16, /1), 18 (/16, /2), 33(/32), 34 (/33, /32), 35 (/32), 36 (/32), 40 (/39), 42, 48 (/46), 50, 52 (/50), 54 (/50), 82 (/1, /2, /55, /76), 84 (/50), 88 (/50), 102 (/42), 103 (/42), 104, 105 (/104), 108 (106), 109 (/106), 110 (/108), 110 (/109), and 112-113, was filed by the first *inter partes* requester, Apple Inc. The request was assigned control number 90/010,623 (the '10623 proceeding).

10. On August 28, 2009, *ex parte* reexamination was ordered on the claims requested in the '10623 proceeding, based on the examiner's determination that the July 28, 2009 request raised a substantial new question of patentability.

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[1] Third party requester's comments are considered timely as patent owner's April 23, 2009 response was non-compliant with regards to 37 CFR 1.943 page limit requirements until May 5, 2009 when the Office issued a waiver of the page limit requirement.

11. To date, no Office action has issued in the '1183 *inter partes* proceeding, nor in the '10623 *ex parte* proceeding, and there has been no further Office action than stated above in the '1080 proceeding.

DECISION

I. MERGER OF PROCEEDINGS

Reexamination has been ordered in three proceedings for the same patent regarding different, overlapping sets of claims.[2] Two of the proceedings are *inter partes* reexamination proceedings and one is an *ex parte* proceeding initiated by one of the *inter partes* requesters. All proceedings are still pending, and have not been terminated. Therefore, consideration of merger pursuant to 37 CFR 1.989 is ripe at this point in time.

37 CFR 1.989(a) provides:

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

In accordance with 37 CFR 1.989(a), the 95/001,080, 95/001,183 *inter partes* proceedings and the 90/010,623 *ex parte* proceedings are merged.

Claims 1-5, 7-8, 10-21, 27-32, 33(/32), 34 (/33, /32), 35 (/32), 36 (/32), 39, 40 (/39), 42-43, 45 (/43), 46, 48 (/46), 49-51, 52 (/50), 53, 54 (/50), 55-56, 57 (/1, /2, /27, /43, /46, /51, /56), 58 (/27, /39, /43, /46, /51, /55), 59-78, 79 (/27,/43, /46, /55,/56, /61, /64, /66,/70,/74, /76, /77, /78), 80 (/1, /2, /27, /46, /51, /55, /61, /66, /72, /73, /74, /76,/77), 81(/51, /74, /76, /77, /78), 82 (/1, /2, /55, /76), 83, 84 (/50), 85 (/32, /51), 86, 87 (/1, /2, /51, /73, /74, /77), 88 (/50, /51), 89 (/1, /2, /76), 89 (/1, /2, /27, /43, /46, /55, /56, /61, /64, /66, /70, /72, /73, /74, /76, /77, /78), 90-101, 102 (/42), 103 (/42), 104, 105 (/104), 106-107, 108 (106), 109 (/106), 110 (/108), 110 (/109), 111-125 and 126-150 are before the Office in this merged reexamination proceeding, which will be conducted in accordance with the guidelines and requirements that follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

1. Patent owner is required to maintain the same claims (and specification) in all files throughout the merged proceeding. Claims 126-150 have been newly presented in the '1080 proceeding, but they are not present in either the '1183 or '10623 proceedings. Therefore, the claims are not currently the same in all three proceedings. Accordingly, an amendment is needed to place the same claims in all three proceedings.

---

[2] See paragraphs 2, 6 and 9 of the "Review of the Relevant Facts" section of this decision.

2. Claims 126-150 **are rejected under 35 U.S.C. 112, paragraph 2, as being indefinite** as to the content of the claims, and thus fail to particularly point out the invention, because claims 126-150 are not in all three proceedings.

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

4. This merger decision provides **an Office action on the merits** pursuant to 35 U.S.C. 314(b)(2), and patent owner's amendment response goes to the merits of the proceeding, to address the above rejection under 35 U.S.C. 112. In order that the response be considered to be a complete response pursuant to 35 U.S.C. 314(b)(2), patent owner must include the remarks that set forth the basis for having presented new claims 126-150 in the '1080 proceeding. Failure to include the remarks that set forth the basis for having presented new claims 126-150 in patent owner's response will result in a holding that the amendment is non-responsive and non-enterable, leading to cancellation of claims 126-150 from the merged reexamination proceeding.

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

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

The present decision merges two *inter partes* reexamination proceedings and an *ex parte* reexamination proceeding. Pursuant to 37 CFR 1.989(b), the merged proceeding is governed by 37 CFR 1.902 through 1.997, except that the rights of the third party requester of the '10623 *ex parte* reexamination are governed by 37 CFR 1.510 through 1.560. In this instance, however, the '10623 *ex parte* reexamination was requested by Apple, Inc., the same third party as in the '1080 *inter partes* reexamination proceeding. Therefore, Apple Inc. has full *inter partes* reexamination third party participation rights and the ex *parte* reexamination third party requester participation restrictions are not applicable. Accordingly, the merged proceeding is governed by 37 CFR 1.902 through 1.997.

B. *Inter partes* Third Party Requester Participation:

Upon merger of proceedings both *inter partes* requesters, Apple, Inc and ALLTEL Communications, LLC, can comment on all issues provided 35 U.S.C. 314(b)(2) is satisfied.[3]

[3] Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action

First, an *inter partes* requesters' rights to comment are contingent upon the patent owner responding. Second, the *inter partes* requesters' rights to comment are limited to issues raised in either the Office action or the Patent Owner's response to the action. Finally, the *inter partes* requesters' comments must be submitted within 30 days from the date of service of the patent owner's response. Therefore, in the merged proceeding, the two *inter partes* requesters, Apple, Inc. and ALLTEL Communications, LLC, both have a right to comment upon all issues raised in the relevant Office action and the patent owner's response to that action. Neither *inter partes* requester has a right to comment on any issue raised outside the confines of the statute, e.g. issues raised in any previous Office actions, any previous patent owner response papers, any previous comment papers from another requester, and the reexamination request papers. The statutory time period of 30 days from date of service of patent owner's response is applicable to both *inter partes* third party requesters.

C. Papers mailed/filed:

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

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

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

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

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

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

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

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of the Office or the patent owner's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.

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

D. Amendments:

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

37 CFR 1.121 does not apply to amendments in reexamination. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via markings pursuant to paragraph 37 CFR 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim. Pursuant to 37 CFR 1.530(i), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the request for reexamination. *Amendments are not to be made relative to previous amendments.* Thus, for all amendments, all words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets.

E. Fees:

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

F. Citation of Patents and Printed Publications:

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

CONCLUSION

1. *Inter partes* Reexamination Control Nos. 95/001,080 and 95/001,183 and *ex parte* Reexamination Control No. 90/010,623 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above in Part III of this decision.

2. An amendment must be filed, pursuant to Part II of this decision, within ONE MONTH of the mail date of this decision, placing the same claims in all three files of the present merged

proceeding, together with remarks as to the addition of the new claims included in the response (as discussed above).

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

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

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

6. Any questions concerning this communication should be directed to Joseph F. Weiss, Jr., Legal Advisor, at 571-272-7759.

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,083	10/01/2008	6991483	8157.013.RXUS00	1620

50659 7590 12/02/2009

BUTZEL LONG
IP DOCKETING DEPT
350 SOUTH MAIN STREET
SUITE 300
ANN ARBOR, MI 48104

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 12/02/2009

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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 0 2 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001083
PATENT NO. : 6991483
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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IP DOCKETING DEPT
350 SOUTH MAIN STREET
SUITE 300
ANN ARBOR, MI 48104

(For Patent Owner)

NOVAK DRUCE & QUIGG, LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET, FIFTY-THIRD FLOOR
HOUSTON, TX 77002

(For Requester)

In re Milan et al.
Inter Partes Reexamination Proceeding
Control No. 95/001,083
Filed: October 1, 2008
For: U.S. Patent No. 6,991,483

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

This is a decision on the October 23, 2009 patent owner petition entitled "PETITION UNDER 37 CFR 1.182 REQUESTING CONTINUED REEXAMINATION OR ENTRY OF AMENDMENT AFTER ACTION CLOSING PROSECUTION."

The petition is before the Office of Patent Legal Administration.

For the reasons set forth below, the petition is **dismissed.**

BACKGROUND

- On October 1, 2008, a request for *inter partes* reexamination was filed by the third party requester, and the resulting reexamination proceeding was assigned control number 95/001,083 ("the '1083 proceeding").

- Prosecution progressed until, on September 23, 2009, an Action Closing Prosecution (ACP) was issued.

- On October 23, 2009, patent owner filed the instant petition entitled "PETITION UNDER 37 CFR 1.182 REQUESTING CONTINUED REEXAMINATION OR ENTRY OF AMENDMENT AFTER ACTION CLOSING PROSECUTION," requesting

continued reexamination and entry of the concurrently filed amendment pursuant to 37 CFR 1.951(a) in response to the ACP.

RELEVANT STATUTES, REGULATIONS, AND EXAMINING PROCEDURE

37 CFR 1.182 provides:

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

37 CFR 1.951(a) provides:

> After an Office action closing prosecution in an inter partes reexamination, the patent owner may once file comments limited to the issues raised in the Office action closing prosecution. The comments can include a proposed amendment to the claims, which amendment will be subject to the criteria of § 1.116 as to whether or not it shall be admitted. The comments must be filed within the time set for response in the Office action closing prosecution.

DECISION

In March of 2005, the Office issued a Notice titled "Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While an Earlier Filed Reexamination is Pending."[1] Notice was provided therein that a patent owner could file a petition under 37 CFR 1.182 requesting continued prosecution on the merits in the reexamination proceeding to seek entry of an amendment and/or evidence that was denied entry after an action closing prosecution in an *inter partes* reexamination proceeding.

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

37 CFR 1.182 addresses only those situations not otherwise provided for in the regulations. Where a situation exists such that relief is specifically provided for elsewhere in the regulations,

---

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

37 CFR 1.182 is not, according to the terms of that regulation, the appropriate mechanism for relief. In this instance, 37 CFR 1.951(a) provides a vehicle for requesting the entry of comments and amendment after an ACP during the time period set for response in the ACP, subject to the criteria of 37 CFR 1.116.

The October 23, 2009 patent owner petition is filed under 37 CFR 1.182 requesting entry of the concurrently submitted amendment in response to the ACP. It is noted that declaration evidence under 37 CFR 1.132 was also included with the October 23, 2009 patent owner response, which patent owner did not specifically mention as part of the patent owner response in the present petition. As of the time of filing the petition under 37 CFR 1.182, the Office had not yet rendered a decision on the entry of the submissions under 37 CFR 1.951(a), or under any other applicable section. Since the Office has not denied entry of the submissions, the request for continuation of prosecution fails "to seek entry of an amendment and/or evidence that was denied entry . . . after an action closing prosecution," as required for the procedure set forth in the March 2005 Notice.

Furthermore, the October 23, 2009 patent owner petition, although filed under 37 CFR 1.182 requesting entry of the amendment submitted on October 23, 2009 was filed within the time period set forth for response in the ACP. During this period, 37 CFR 1.951(a) specifically provides for the consideration of the comments and amendments, subject to the criteria of 37 CFR 1.116. Since patent owner's submissions may be addressed through 37 CFR 1.951, consideration of the present petition under 37 CFR 1.182 is premature.

To accommodate the need for statutory special dispatch in reexamination, jurisdiction is being forwarded to the Central Reexamination Unit to process the October 23, 2009 patent owner amendment, evidence, and remarks (filed with the petition) as submissions under 37 CFR 1.951(a), and for the examiner to treat them as such. Patent owner retains the option of filing a renewed petition under 37 CFR 1.182, if at some future date, relief has not been granted under 37 CFR 1.951 or through another section. Until such time, the issue is not ripe for consideration by the Office.

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

CONCLUSION

1. The petition under 37 CFR 1.182 is dismissed.

2. Prosecution is not being reopened by this decision.

3. Jurisdiction over the reexamination proceeding is being forwarded to the Central Reexamination Unit to process the October 23, 2009 patent owner amendment, evidence, and remarks (filed with the petition) as submissions under 37 CFR 1.951(a), and for the examiner to treat them as such.

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

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

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

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

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

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

Kenneth M. Schor

Kenneth Schor,
Senior Legal Advisor
Office of Patent Legal Administration

Kenpet7
11-25-09

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,083	10/01/2008	6991483	8157.013.RXUS00	1620

50659 7590 04/26/2010

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/26/2010

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NOVAK DRUCE & QUIGG, LLP
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1000 LOUISIANA STREET, FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date:
MAILED

APR 26 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001083
PATENT NO. : 6991483
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

(For Requester)

NOVAK DRUCE & QUIGG, LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET
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HOUSTON, TX 77002

In re: Milan *et alia*
Reexamination Proceeding
Control No. 95/001,083
Request Deposited: October 1, 2008
For: U.S. Patent No. 6,991,483

: **DECISION DISMISSING**
: **PETITION and**
: **REFUSING ENTRY**
: **OF PAPER**
:

The *inter partes* reexamination is before the Director of the Central Reexamination Unit to address the patent owner petition filed March 17, 2010 entitled "RENEWED PETITION UNDER 37 CFR 1.181 REQUESTING ENTRY OF AMENDMENT" and a third-party paper filed March 31, 2010 entitled "THIRD PARTY REQUESTER'S OPPOSITION TO PATENT OWNER'S RENEWED PETITION UNDER 37 CFR §1.181 REQUESTING ENTRY OF AMENDMENT".

The patent owner petition is timely filed and considered pursuant to 37 CFR §1.181. 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.

BACKGROUND

The order granting reexamination (mailed November 28, 2008) of US Patent Number 6,991,483 (the '483 patent) found that a substantial new question (SNQ) of patentability affecting claims 1-5, 13, and 14 of the '483 patent was raised by in the request for reexamination (requester did not request reexamination for claims 6-12).

The non-final office action, mailed November 28, 2008, rejected claims 1-5, 13, and 14.

In response, patent owner did not amend any of the original claims and added new claims 15-17 (claim 15 being independent).

In the Action Closing Prosecution (ACP) mailed September 23, 2009, all claims subject to reexam (i.e. claims 1-5 and 13-17) were rejected based on prior art rejections. New claims 15-17 were also rejected as being indefinite under 35 USC 112 2nd.

In response to the ACP, patent owner proposed amending original claims 1-4 and 13 (and 14 due to its dependence on claim 13), canceling original claim 5 and new claims 15-17, and adding new claims 18-26.

The Right of Appeal Notice (RAN) mailed February 19, 2010 did not enter patent owner's proposed amendment citing to 37 CFR §§ 1.951 and 1.116. Specifically, the following reasons for not entering the amendment were stated on pages 4 and 5 of the RAN:

> 1. The amendment raises new issues that would require further search and consideration. Specifically, the additional requirement that the quick connector be integrally formed in the housing second end, the requirement that the quick connector include a receptacle for a plurality of exposed pins and the requirement that the first and second connectors be removable are new issues that would require further search and consideration.
>
> 2. The amendment adds new claims without cancelling a corresponding number of finally rejected claims.
>
> 3. The amendment is not deemed to place the proceeding in better form for appeal by materially reducing or simplifying the issues for appeal.

DECISION

Patent owner contends that the "amendment places the claims in better position for appeal, by narrowing the issues." The office disagrees. Although patent owner has proposed to narrow the scope of aspects of certain claims for the first time after prosecution has closed, the additional issues raised by the proposed amendments to original claims as well as the proposed addition of nine new claims would increase and complicate the issues for appeal.

Patent owner argues:

> "Claims 1-4 and 13 were amended to define over the cited art. Although new dependent claims 18-21 were added, these claims merely include features of dependent claim 3 and claims 6-12, which are not subject to reexamination. New claims 22-26 merely include the features of the claims, as amended, to further define the claims over the prior art and advance prosecution. Neither the amended claims nor the newly added claims incorporate new matter...because no new matter has been incorporated into the pending claims and the scope of the pending claims remain unchanged, no new issues are raised which require further search and consideration."

Initially, it is noted that the arguments are internally inconsistent. Specifically, "claims 1-4 and 13 were amended to define over the cited art" contradicts the contention that "the scope of the pending claims remain[s] unchanged". The scope of original claims 1-4 and 13 are proposed to be narrowed in some aspects (while broadened in other aspects) in the proposed amendment after ACP. For example, original claim 1, lines 4-6 recited

> "a quick connector mounted in said housing and having a plurality of pins exposed at said second end, said pins being configured for electrical connection to a..."

However, the proposed amendment would change the scope of that portion of claim 1 as follows:

> "a quick connector [mounted] integrally formed in said housing second end and permanently in electrical communication with said flash memory drive [and having] wherein the quick connector includes a receptacle for a plurality of [pins] exposed [at said second end, said] pins [being] configured for electrical connection to a..."

So, the original claim recited, "pins exposed at said second end" whereas the proposed amendment more broadly recites "exposed pins" (not necessarily exposed at said second end).

The original claim positively recited that the connector had a plurality of pins, but the amended claim recites a connector including a receptacle and the receptacle has an intended use of being "for a plurality of pins".

The original claim also recited the "connector mounted in said housing" whereas the proposed amendment recites the "connector integrally formed in said housing" ("integrally formed" does not appear to be a species of "mounting").

For at least these three limitations, entry of the after ACP amendment would require a new issue to be introduced in the proceeding. Specifically, at least claims 1-4 and proposed new claims 18-20 would have to be rejected under 35 USC 314 as the proposed amendment enlarges the scope of the claims of the patent. This would not place the proceeding in better condition for appeal as entry of the amendment would create new issues for appeal.

Petitioner's assertion that new dependent claims 18-21 "merely include features of dependent claim 3 and claims 6-12, which are not subject to reexamination" is incorrect. For example, the wiring schemes, the interfaces, and the transferring of data are not in original claims 3 and 6-12. *In arguendo*, had new claims 18-21 merely recited limitations that appeared in claims not subject to reexamination, entry of such claims would complicate issues for appeal because it would take issues that were not subject to reexam (thus not appealable) and make them appealable issues.

Finally, the proposed amendments to original claims 1-4 and proposed new claims 18-26 introduce numerous limitations that were not considered and/or searched before prosecution was closed. Entry of these amendments would create new issues, thus complicating and expanding the issues for appeal. Below are exemplary limitations that are only proposed to be added to the scope of this reexamination after prosecution was closed:

1. the quick connector permanently in electrical communication with said flash memory drive
2. the first and second connectors being removable
3. an isolator electrically and mechanically isolating the two rows of the three pins
4. the connector integrally formed in said housing
5. the flash memory storage device and female quick connector being integrally formed as one member
6. the details of the wiring schemes

Because entry of the proposed amendment after ACP would create multiple new issues including broadening rejections and additional search and/or consideration of newly proposed claim limitations, the examiner was correct in not entering the amendment after ACP. Therefore, the petition is **dismissed**.

Regarding the third-party paper filed March 31, 2010 entitled "THIRD PARTY REQUESTER'S OPPOSITION TO PATENT OWNER'S RENEWED PETITION UNDER 37 CFR §1.181 REQUESTING ENTRY OF AMENDMENT", 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 March 31, 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 entry of an amendment. 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 from an action of an examiner. No mechanism has been provided for the third party requester to file a paper, such as the March 31, 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 from an action of an examiner 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 to provide a limited reopening of prosecution. 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 for entry of an amendment 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 March 31, 2010 opposition to the patent owner's March 17, 2010 petition requesting entry of an amendment 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 for revival 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 enter the amendment after ACP of October 23, 2009 is **dismissed**.

2. The March 31, 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.

Gregory Morse
Director, Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,083	10/01/2008	6991483	8157.013.RXUS00	1620

50659 7590 05/14/2010

BUTZEL LONG
IP DOCKETING DEPT
350 SOUTH MAIN STREET
SUITE 300
ANN ARBOR, MI 48104

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 05/14/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

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(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET, FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date:

MAILED

MAY 14 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001083
PATENT NO. : 6991483
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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(For Patent Owner)

MAILED

MAY 14 2010

CENTRAL REEXAMINATION UNIT

NOVAK DRUCE & QUIGG, LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET
FIFTY-THIRD FLOOR
HOUSTON, TX 77002

(For Requester)

In re Milan et al.
Inter Partes Reexamination Proceeding
Control No. 95/001,083
Filed: October 1, 2008
For: U.S. Patent No. 6,991,483

DECISION
DISMISSING PETITION
UNDER 37 CFR 1.182

This is a decision on the March 17, 2010 patent owner petition entitled "RENEWED PETITION UNDER 37 CFR 1.182 REQUESTING CONTINUED REEXAMINATION."

The petition is before the Office of Patent Legal Administration.

For the reasons set forth below, the petition is **dismissed**.

FEES

The requisite petition fee for a petition under 37 CFR 1.182 is $400.00 pursuant to 37 CFR 1.17(f), and the $400.00 fee was electronically submitted on October 23, 2009, for the original petition under 37 CFR 1.182. A fee is not required for the present renewed petition.

BACKGROUND

1. On January 31, 2006, the Office issued U.S. Patent No. 6,991,483 (the '483 patent) to Milan et al.

2. On October 1, 2008, a request for *inter partes* reexamination of the '483 patent was filed by a third party requester. The resulting reexamination proceeding was assigned control number 95/001,083 (hereinafter '1083).

3. On October 8, 2008, the Office issued a notice of the filing of the '1083 *inter partes* reexamination with an assigned filing date of October 1, 2008.

4. On November 28, 2008, the Office issued an order granting the '1083 *inter partes* reexamination request, with an accompanying first Office action on the merits rejecting claims 1-5, 13, and 14. Reexamination was not requested for patent claims 6-12.

5. On December 29, 2008, patent owner filed a response retaining original claims 1-5, 13, and 14 as not amended and adding new claims 15-17.

6. On June 26, 2009, the Office mailed a Notice of Defective Paper. The Notice stated that the December 29, 2008 amendment did not comply with 37 CFR 1.530.

7. On July 27, 2009, patent owner filed a corrected amendment.

8. On August 26, 2009, third party requester timely filed comments under 37 CFR 1.947.

9. On September 23, 2009, the Office mailed an Action Closing Prosecution (ACP) rejecting original claims 1-5, 13, and 14 and newly added claims 15-17.

10. On October 23, 2009, patent owner filed a petition entitled "PETITION UNDER 37 CFR 1.182 REQUESTING CONTINUED REEXAMINATION OR ENTRY OF AMENDMENT AFTER ACTION CLOSING PROSECUTION," that was accompanied by a response to the ACP that included a proposed amendment amending claims 1-4, and 13, cancelling claims 5, and 15-17 and adding claims 18-26, and a declaration of Mr. Henry Milan and Mr. John C. Beard attached as Exhibit A.

11. On November 23, 2009, third party requester filed comments under 37 CFR 1.951.

12. On December 2, 2009, the Office mailed a decision dismissing the October 23, 2009 petition under 37 CFR 1.182 as being premature.

13. On February 19, 2010, the Office mailed a Right of Appeal Notice (RAN) denying entry of the October 23, 2009 proposed amendment. The RAN stated that (1) the amendment raised new issues that would require further search and consideration, (2) the amendment added new claims without cancelling a corresponding number of finally rejected claims, (3) the amendment was not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal, and (4) the declaration of Mr. Henry Milan and Mr. John C. Beard failed to provide a showing of good and sufficient reasons why the declaration was necessary and not earlier presented.

14. On March 17, 2010, patent owner filed a Notice of Appeal.

15. On March 17, 2010, patent owner filed a petition entitled "RENEWED PETITION UNDER 37 CFR 1.181 REQUESTING ENTRY OF AMENDMENT."

16. On March 17, 2010, patent owner filed a petition entitled "RENEWED PETITION UNDER 37 CFR 1.182 REQUESTING CONTINUED REEXAMINATION."

17. On April 26, 2010, the Office mailed a decision dismissing the March 17, 2010 petition under 37 CFR **1.181**.

RELEVANT REGULATIONS AND PROCEDURE

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 1.182 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).

MPEP 2672 states, in pertinent part:

> The examiner and all other parties to the reexamination should recognize that a reexamination proceeding may result in the final cancellation of claims from the patent **and** that the patent owner does not have the right to continue the proceeding by refiling under 37 CFR 1.53(b) or 1.53(d), nor by filing a Request for Continued Examination under 37 CFR 1.114, and the patent owner cannot file an *inter partes* reexamination request (see MPEP § 2612). Accordingly, the examiner and other parties should identify and develop all issues prior to the ACP, including the presentation of evidence under 37 CFR 1.131 and 1.132.

DECISION

In March 2005, the Office issued a Notice entitled "Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While an Earlier Filed Reexamination is Pending."[1] The Notice suggested that a patent owner could file a petition under 37 CFR 1.182 requesting continued prosecution on the merits in an *inter partes* reexamination proceeding to seek entry of an amendment and/or evidence that was denied entry after an action closing prosecution in the proceeding. By filing such a petition, the patent owner could obtain continued prosecution on the merits in the

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

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

The § 1.182 petition must further the prosecution of the reexamination proceeding, rather than delay it, and must provide a submission toward that end. This is critical in the reexamination setting, where 35 U.S.C. § 305 (for *ex parte* reexamination) and 35 U.S.C. § 314 (for *inter partes* reexamination) mandate that reexamination proceedings must be conducted "with special dispatch within the Office." Accordingly, the patent owner must make a *bona fide* effort, in the submission accompanying the § 1.182 petition, to define the issues for appeal, or the issuance of a reexamination certificate, since this is a key factor in reducing pendency of a reexamination proceeding. It thus follows that the petition is to clearly discuss the manner in which the entry of the submission would act to overcome a rejection or satisfy a requirement of form, or other reason why the proffered submission would result in the issues in the proceeding being better defined for appeal or issuance of a reexamination certificate. Furthermore, in keeping with the requirement of special dispatch, a petition for continuation of the reexamination prosecution should identify the issue which the submission is intended to address, and explain how the issue arose at a point of the prosecution such that patent owner had no earlier opportunity to address the issue.

In the present § 1.182 petition, patent owner requests that the Office grant continued reexamination of the above-captioned *inter partes* reexamination proceeding and enter the October 23, 2009 amendment after action closing prosecution (ACP). In the present petition, patent owner proffers the same arguments that were made in the March 17, 2010 renewed petition filed under 37 CFR 1.181 for entry of the proposed October 23, 2009 amendment.

In particular, the following identical arguments are made in the present petition:[2]

> Patent Owner has cancelled Claims 5, and 15-17, and claims 15-17 were the only claims rejected under 35 [sic, 25] U.S.C. 112. Claims 1-4 and 13 were amended to define over the cited art. Although new dependent claims 18-21 were added, these claims merely include features of dependent claim 3 and claims 6-12, which are not subject to reexamination. New claims 22-26 merely include the features of the claims, as amended, to further define the claims over the prior art and advance prosecution. Neither the amended claims nor the newly added claims incorporate new matter. . . because no new matter has been incorporated into the pending claims and the scope of the pending claims remain [sic, remains] unchanged, no new issues are raised which require further search and consideration.

The April 26, 2010 decision on the patent owner's § 1.181 petition addressed these arguments. As discussed in the April 26, 2010 decision, the Office disagreed with patent owner's contention that the proposed amendment would narrow the issues for appeal. The decision stated that

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[2] Renewed petition under 37 CFR 1.182 at page 3.

"[a]lthough patent owner has proposed to narrow the scope of aspects of certain claims for the first time after prosecution has closed, the additional issues raised by the proposed amendments to original claims as well as the proposed addition of nine new claims would increase and complicate the issues for appeal."[3] The April 26, 2010 decision also pointed out that patent owner's arguments were internally inconsistent. Specifically, "claims 1-4 and 13 were amended to define over the cited art" contradicted the assertion that "the scope of the pending claims remain[s] unchanged." As explained in the April 26, 2010 decision, the scope of original claims 1-4 and 13 was proposed to be narrowed in some respects (while *broadened* in other aspects) in the proposed amendment after ACP.[4] Furthermore, as discussed in the RAN at page 4 and in the April 26, 2010 decision at page 3, the proposed added limitations to the claims were new issues introduced into the proceeding. The April 26, 2010 decision pointed out that at least claims 1-4 and proposed new claims 18-20 would have to be rejected under 35 U.S.C. § 314, as the proposed amendment enlarged the scope of the claims of the patent. Finally, the April 26, 2010 decision stated that the proposed amendments to original claims 1-4 and proposed new claims 18-26 introduced numerous limitations that were not considered and/or searched before prosecution was closed. Therefore, the proposed amendment would not place the proceeding in better condition for appeal as entry of the amendment would create new issues that would complicate and expand the issues for appeal.

With respect to the requirement for special dispatch, the present petition does not explain how the proposed October 23, 2009 amendment addresses an issue that arose at a point of the prosecution such that patent owner had no earlier opportunity to address the issue. The petition states new dependent claims 18-21 were added to merely include features of dependent claim 3 and claims 6-12 *which are not subject to reexamination*, and that new claims 22-26 merely include the features of the claims, as amended, to further define the claims over the prior art and advance prosecution.[5] A review of the record reveals that original claims 1-5, 13, and 14 and newly added claims 15-17 were rejected in the ACP. The October 23, 2009 amendment proposes to cancel claims 5, and 15-17, amend original claims 1-4, and 14, and add new claims 18-26. The October 23, 2009 amendment indicates that proposed new claims 18-21 depend from proposed amended claim 1, proposed new independent claim 22 (from which claims 23-25 depend) incorporates the features of proposed claims 1 and 20, and proposed new independent claim 26 incorporate the features of proposed claims 1, 2, and 22. Yet, in the ACP, the examiner has set forth the same prior art rejections for claims 1-5, 13, and 14 as in the November 28, 2008 non-final Office action. Therefore, the October 23, 2009 amendment addresses issues first raised in the non-final action, and not issues that arose at a point of prosecution such that patent owner had no earlier opportunity to address them.

Finally, the present petition also does not mention the declaration of Mr. Henry Milan and Mr. John C. Beard attached as Exhibit A to the October 23, 2009 amendment. The October 23, 2009 patent owner remarks at page 16 stated that the declaration addresses an issue (regarding the interpretation of certain claim terms) raised in the November 28, 2008 *non-final* Office action. Therefore, the present petition fails to provide a showing of good and sufficient reasons why the declaration was necessary and not earlier presented.

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[3] April 26, 2010 Office decision dismissing the March 17, 2010 petition under 37 CFR 1.181 at page 2.
[4] April 26, 2010 decision at page 3.
[5] Renewed petition under 37 CFR 1.182 at page 3.

In this case, patent owner failed to submit the amendment and evidence at the earliest possible point, despite the clear notice in MPEP 2672 that all issues be identified and developed prior to the ACP, including evidence submissions and despite the statutory mandate for special dispatch in reexamination. As such, the petition fails for want of a persuasive explanation of why the patent owner did not consider and explore the need for the amendment and declaration earlier in the prosecution of the present reexamination proceeding, which would have led to an earlier submission of the amendment and evidence – to thereby adress the need for special dispatch in reexamination. In the instant proceeding, reopening of the prosecution to consider the October 23, 2009 amendment and declaration that were not submitted at the earliest possible point in the proceeding would be contrary to the statutory mandate for "special dispatch within the Office" in *inter partes* reexamination.

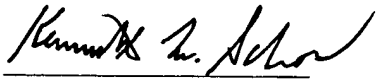
In view of the facts and circumstances of the present situation, the petition under 37 CFR 1.182 is **dismissed**.

CONCLUSION

1. The renewed patent owner petition under 37 CFR 1.182 for continued reexamination filed on March 17, 2010 is **dismissed**.

2 Jurisdiction for the instant *inter partes* reexamination proceeding is being transferred to the Central Reexamination Unit.

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



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

May 13, 2010
Kenpet8

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(For second *Inter Partes* Requester)

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

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

DECISION, *SUA SPONTE*, TO MERGE REEXAMINATION PROCEEDINGS

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

REVIEW OF RELEVANT FACTS

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

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

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

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

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

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

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

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

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

DECISION

I. MERGER OF PROCEEDINGS

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

37 CFR 1.989(a) provides:

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

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

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

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

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

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

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

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

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

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

B. Papers mailed/filed:

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

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

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

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

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

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

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

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

C. Amendments:

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

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

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

D. Fees:

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

E. Citation of Patents and Printed Publications:

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

IV. SUPPLEMENT TO THE DECEMBER 12, 2008 ORDER

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

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

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

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

CONCLUSION

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

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

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

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

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

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

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

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.
95/001,085	10/02/2008	7097719	A240 7002	1259

8840 7590 05/10/2010

INTELLECTUAL PROPERTY
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100 TECHNICAL DRIVE
ALCOA CENTER, PA 15069-0001

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 05/10/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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Atlanta, GA 30357-0037

Date:

MAILED

MAY 10 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001085
PATENT NO. : 7097719
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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For Patent Owner

MAILED

MAY 10 2010

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

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

For: US Patent No. 7,097,719

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

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

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

The petition is dismissed for the reasons set forth below.

Decision

The Patent Owner requests an extension of time in which to file a response to the Office action dated April 1, 2010, which set a two-month date for filing a response thereto. The Office action is a non-final Office action. The request is timely filed and includes authorization to debit a deposit account for the $200.00 petition fee as required by 37 CFR 1.17(g).

37 CFR 1.956 (c) states:

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

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

> Evaluation of whether "sufficient cause" has been shown for an extension must be made by **balancing** the desire to provide a fair opportunity to respond, **against** the requirement of the statute, 35 U.S.C. 314 (c), that the proceedings be conducted with special dispatch.
>
> Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor.

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

The petition for extension of time states that Patent Owner anticipates the need for additional time to obtain and prepare evidence for submission with its response to the Office action. An extension of time for one month is requested to provide Patent Owner with a fair opportunity to respond to the outstanding Office action.

Analysis and Findings

Patent Owner has failed to set forth a factual accounting that is deemed to establish reasonably diligent behavior by all those responsible for preparing a response within the statutory period. Any request for an extension of time must

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

Conclusion

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

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

3. Response may be submitted as follows:

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

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

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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MAILED

JUN 30 2010

CENTRAL REEXAMINATION UNIT

(For Patent Owner)

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(For first *Inter Partes* Requester)

SUSAN E. SHAW MCBEE
WOMBLE, CARLYLE, SANDRIDGE & RICE, PLLC
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ATLANTA, GA 30357-0037

(For second *Inter Partes* Requester)

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

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

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

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

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

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

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

FEES

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

REVIEW OF RELEVANT FACTS

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

DECISION

Relevant Statutes, Regulations and Procedures

37 CFR 1.183 provides:

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

37 CFR 1.943(b) provides:

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

Patent Owner's Petition under 37 CFR 1.183

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

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

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

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

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

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

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

Analysis and Findings

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

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

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

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

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

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

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

---

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

CONCLUSION

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

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

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

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

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

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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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

(For Patent Owner)

MAILED

APR 02 2009

CENTRAL REEXAMINATION UNIT

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HOUSTON, TX 77002

(For *Inter Partes* Requester)
(For first *Ex Parte* Requester)

HAYES AND BOONE, LLP
IP SECTION
2323 VICTORY AVENUE, SUITE 700
DALLAS, TX 75219

(For second *Ex Parte* Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,086
Filed: October 2, 2008
For: U.S. Patent No. 7,225,231

Ex Parte Reexamination Proceeding
Control No. 90/008,981
Filed: January 9, 2008
For: U.S. Patent No. 7,225,231

Ex Parte Reexamination Proceeding
Control No. 90/010,299
Filed: October 2, 2008
For: U.S. Patent No. 7,225,231

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. 7,225,231 (the '231 patent) issued to Mendez *et al.* on May 29, 2007.

2. A first request for *ex parte* reexamination of claims 1-6 of the '231 patent was filed on January 9, 2008, by third party requester Research In Motion Limited, and the request was assigned control number 90/008,981 (the '8981 *ex parte* proceeding).

3. On February 29, 2008, *ex parte* reexamination was ordered for the '8981 proceeding based on the examiner's determination that the January 9, 2008 request raised a substantial new question of patentability.

4. A second request for *ex parte* reexamination of claims 1-6 of the '231 patent was filed on October 2, 2008, by third party requester Wei Wei Jeang, Haynes and Boone, LLP, and the request was assigned control number 90/010,299 (the '10299 *ex parte* proceeding).

5. Concurrently, on October 2, 2008, a request for *inter partes* reexamination of claims 1-6 of the '231 patent was filed by third party requester Research In Motion Limited, and the request was assigned control number 95/001,086 (the '1086 *inter partes* proceeding).

6. On November 28, 2008, *inter partes* reexamination was ordered for the '1086 proceeding based on the examiner's determination that the October 2, 2008 request raised a substantial new question of patentability.

7. On November 29, 2008, *ex parte* reexamination was ordered for the '10299 proceeding based on the examiner's determination that the October 2, 2008 request raised a substantial new question of patentability.

8. There has been no Office action in the '1086 *inter partes* proceeding, and the time for filing a patent owner's statement pursuant to 37 CFR 1.530 expired in the '8981 *ex parte* proceeding after April 29, 2008 and expired in the '10299 *ex parte* proceeding after January 29, 2009. [1]

DECISION

I. MERGER OF PROCEEDINGS

Reexamination has been ordered in three proceedings for the same claims of the same patent. One of the proceedings (the '1086 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

[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.

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 95/001,086, 90/008,981 and 90/010,299 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 two *ex parte* reexamination proceedings 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 requesters of the *ex parte* reexamination proceedings are governed by 37 CFR 1.510 through 1.560. In this instance, however, the '8981 *ex parte* reexamination was requested by the same third party that requested the *inter partes* reexamination. And, that third party (Research In Motion) 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 all 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 all 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 triplicate, each bearing a signature and identifying data for all files, for entry into each file.

All papers filed by the patent owner and the third party requester(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. 95/001,086 and *ex parte* Reexamination Control Nos. 90/010,299 and 90/008,981 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

2. Jurisdiction over the merged reexamination files is being forwarded via the Director of the Central Reexamination Unit (CRU) to the examiner, for the preparation of an Office action, to be issued in due course.

3. Any questions concerning this communication should be directed to Nicole 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
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,088	10/10/2008	6188988	1911-001	2615

20792 7590 06/22/2010

MYERS BIGEL SIBLEY & SAJOVEC
PO BOX 37428
RALEIGH, NC 27627

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 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.
95/001,088	10/10/2008	6188988	1911-001

DECHERT LLP
P O BOX 390460
MOUNTAIN VIEW, CA 94039-0460

EXAMINER
HUGHES, DEANDRA

ART UNIT	PAPER
3992	

DATE MAILED:

06/22/10

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.
95/001,088	10/10/2008	6188988	1911-001

DECHERT LLP
P O BOX 390460
MOUNTAIN VIEW, CA 94039-0460

EXAMINER
HUGHES, DEANDRA

ART UNIT	PAPER
3992	

DATE MAILED:

INTER PARTES REEXAMINATION COMMUNICATION

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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GLEN ALLEN, VA 23060

MAILED

JUN 22 2010

CENTRAL REEXAMINATION UNIT

In re Barry *et al.*
Inter Partes Reexamination Proceeding
Control No.: 95/001,088
Filed: October 10, 2008
For: U.S. Patent No.: 6,188,988

In re Barry *et al.*
Ex Parte Reexamination Proceeding
Control No.: 90/009,213
Filed: October 14, 2008
For: U.S. Patent No.: 6,188,988

: DECISION
: DISMISSING
: PETITION

This is a decision on the April 12, 2010 patent owner petition, denominated "PETITION UNDER 37 C.F.R. § 1.183 – REQUEST FOR A WAIVER OF THE PROHIBITION OF AN EXTENSION OF TIME FOR FILING A RESPONDENT BRIEF UNDER 37 C.F.R. § 41.66(b) AND A REQUEST FOR AN EXTENSION OF TIME FOR FILING A RESPONDENT BRIEF.

The petition is before the Office of Patent Legal Administration.

The petition under 37 CFR 1.183 is dismissed as moot.

DECISION

37 CFR 1.183 states:

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

37 CFR 41.66(b) states:

> (b) Once an appellant's brief has been properly filed, any brief must be filed by respondent within one month from the date of service of the appellant's brief. The time for filing a respondent's brief or an amended respondent's brief may not be extended.

On April 12, 2010 patent owner filed the present petition, patent owner requests that the Office suspend the one month time period of 37 CFR 41.66(b) for filing a respondent brief until two other concurrently filed patent owner petitions are decided. However, on May 3, 2010, patent owner timely filed a respondent brief, thus rendering the April 12, 2010 petition for an extension of time to file a respondent brief moot. Accordingly, the present petition is DISMISSED AS MOOT.

CONCLUSION

1. The petition under 37 CFR 1.183 is **dismissed as moot**.

2. The reexamination proceeding is being forwarded to the Central Reexamination Unit for further handling and examination consistent with this decision.

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

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

6-21-10
Kenreexam/EOT

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,089	10/13/2008	7035281	29776.87	3676

7590 07/10/2009

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 07/10/2009

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
HAYES AND BOONE, LLP IP SECTION
2323 VICTORY AVENUE
SUITE 700
DALLAS, TX 75219

Date: MAILED

JUL 10 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001089
PATENT NO. : 7035281
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.

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
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(For Patent Owner)

MAILED

JUL 10 2009

CENTRAL REEXAMINATION UNIT

David L. McCombs
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IP SECTION
2323 VICTORY AVENUE
SUITE 700
DALLAS, TX 75219

(For Third Party Requester)

PETITION DECISION
DENYING
REQUEST TO ORDER
ADDITIONAL CLAIMS
[37 CFR § 1.181 & § 1.927]

In re: Spearman *et alia*
Inter Partes Reexamination Proceeding
Control No. 95/001,089
Deposited on: 13 October 2008
For: U.S. Patent No. 7,035,281

This is a decision on the 4 February 2009 third party requester "Petition Under 37 CFR §§ 1.927 and 1.181." The requester seeks review of the Order denying the *inter partes* reexamination of claims 4 to 7 and 11 to 32 for US Patent No. 7,035,281 by petitioning the Director under 37 CFR § 1.181 and § 1.927.

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

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

SUMMARY OF RELVANT FACTS

1. On 25 April 2006, US Patent No. 7,035,281 was granted to Spearman *et alia*.

2. On 13 October 2008 a request was deposited requesting *inter partes* reexamination of claims 1 to 36 of US Patent No. 7,035,281 by a third party requester.

3. On 12 January 2009 the Order granting *inter partes* reexamination of claims 1 to 3 and 8 to 10 was mailed.

4. On 4 February 2009 a petition was submitted by the requester seeking review *de novo* of the denial of claims 4 to 7 and 11 to 32 for *inter partes* reexamination.

DISCUSSION

On 4 February 2009 the requester petitioned the USPTO to review the denial of examination of claims 4 to 7 and 11 to 32 in the Order granting *inter partes* reexamination for the reexamination proceeding identified by control number 95/001,089. The petition is before the director of the Central Reexamination. The petition was filed within one month of the action taken by the examiner and as such is timely filed. The petition fee was electronically filed.

The requester petitions for review of the following issues:

The request does not present a substantial new question with respect to (a) the Transistor Article, (b) The How To Guide (alone or in combination with other references) and (c) Redlich (alone or in combination with other references).

(a)(i) The Transistor Article Characterization: The Transistor article explicitly discloses an operating system operably configured within the access point because figure 23 (pg. 49) of the Transistor article discloses an Elan SC400, which the Transistor article identifies as a central processing unit (CPU) on page 38. (Petition; pgs. 4-5; here, the crux of the arguments of the first and second points under Error 1 are combined)

(a) (ii) The Transistor Article Characterization: "Under the heading, 'Configuration of access points', the Transistor article notes that: "A 16-Mbyte DRAM is provided, and OS and firmware are stored in 8Mb flash memory connected to an IDE bus....Collectively, the disclosures of the Transistor article irrefutably support 3PR's "statement in the Request that 'the use of software for specific operation of the access point shows that the operating system-the LINUX Firmware-is operably configured in the chassis.' This is consistent with the analysis at pp. 18-20" (emphasis original; Petition; pgs. 5-6)

(b) (i) The How to Guide Characterization: The "How to Guide describes, in the section entitled 'Build your routers', how to build both an upstream router and a downstream router, where the upstream router uses one of the pair of PCs and the downstream router uses the other one of the pair of PCs. Further, the How to Guide illustrates that only one PC is used for each router by stating that "The arlan card is an ISA card, so nearly any old PC will do." (Petition; pg. 6, 4th ¶)

(b) (ii) The How to Guide Characterization: "Additionally, the ASCII diagram cited in the Request shows a single chassis. The diagram illustrates that "Everetts House" is the location of one

PC, device WAN0, and "Redwood Estates" is the location of a separate PC, device WAN1. WAN0 is also connected via ADSL to the internet. The two PCs communicate with one another wirelessly. For the Director's convenience, Requester has reproduced and labeled the diagram from the Request to visually illustrate the How to Guide's use of the pair of PCs." (Petition, pgs. 6-7)

(b) (iii) The How to Guide Characterization : The How to Guide explicitly states that the Linux operating system is run within the router without a hard disk. Specifically, the How to Guide states that "Since, at least in this how to, you will be using the LRP code, you don't even need a hard disk." This is consistent with the Linux Router Project ("LRP") which explicitly notes that the LRP code – the distribution of the Linux operating system utilized by the How to Guide – "is small enough to fit on a single 1.44 MB floppy disk" and that it may be stored on "1.44 Floppy, ZIP, LS-120, Flash RAM, Hard Drive or anything Linux can **boot** and mount." (emphasis original; Petition, pgs. 7-8; here, the crux of the arguments of the second and third points under Error 2 are combined)

(c) (i) The Redlich Characterization: "A 'general purpose digital computer equipped with software' in and of itself would appear to disclose or, at the very least, make obvious an operating system." (Petition, pg. 8, last two lines)

(c) (ii) The Redlich Characterization: "Redlich, however, goes further and explicitly discusses the functionality of the router's operating system: 'On an **Operating System** that supports the Berkeley Socket Programming Interface (sockets), as for example **Ling lsic] or other Unix-system**, it is possible that a user level process receives all ARP-requests ... By listening to all ARP-messages, this program can learn about the IP-addresses and corresponding HW-addresses of all machines ... If this program, **which is executed inside the intelligent router**, receives an ARP-request ...." (emphasis original; Redlich Col. 18:16-26; *Request p. 63*). That is, the program that is executed inside the intelligent router - the general purpose digital computer - runs on an operating system that supports sockets. Thus, Redlich clearly discloses the use of an operating system within the router; specifically, an operating system - such as Linux - that supports sockets. This is consistent with the analysis in the *Request, including the analysis at pp. 58-63*." (Petition, pg. 9, 1st ¶)

(c) (iii) The Redlich Characterization: "The Order also states that the tunnel server of Redlich is separate from the access router and, therefore, Redlich fails to disclose the use of the Linux operating system. While Redlich does disclose an embodiment where a tunnel server is separate from the access router, Redlich also discloses embodiments where the access router is a tunnel server. For example, as noted in the Request, Redlich discloses: "Setup of Tunnel: The IP tunnel is created between the **access router** and a machine outside the hosting network's corporate firewall ....The commands shown in FIG. 16 create a unidirectional tunnel from the machine with IP address 128.1.1.1 (**access router**) to the machine with the IP address 128.2.2.2 (outside router)." (Redlich, Col. 27:37-38 and 56-59 (emphasis added); Request p. 66)." (Petition, pg. 9, 2nd ¶)

(c) (iv) The Redlich Characterization: "Moreover, in describing how to establish the IP tunnel, Redlich notes that: "Several technologies are available for creating IP tunnels ....One IP tunneling technology with very little overhead (20 bytes more data, no data processing per packet) is IP-over-IP. On a **LINUX system**, the ifconfig command can be used for setting up such a tunnel." (Redlich, Col. 24:8-13 (emphasis added)). Thus, Redlich also discloses the use of the Linux operating system within the access router. This is consistent with the analysis in the Request, including the analysis at pp. 63-66. " (Petition, pg. 9, 2nd ¶)

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.

...

(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Briefs or memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declarations (and exhibits, if any) must accompany the petition.

(c) When a petition is taken from an action or requirement of an examiner in the *ex parte* prosecution of an application, or in the ex parte or inter partes prosecution of a reexamination proceeding, it may be required that there have been a proper request for reconsideration (§ 1.111) and a repeated action by the examiner. The examiner may be directed by the Director to furnish a written statement, within a specified time, setting forth the reasons for his or her decision upon the matters averred in the petition, supplying a copy to the petitioner.

(d) Where a fee is required for a petition to the Director the appropriate section of this part will so indicate. If any required fee does not accompany the petition, the petition will be dismissed.

...

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

(g) The Director may delegate to appropriate Patent and Trademark Office officials the determination of petitions.

37 CFR § 1.927 Petition to review refusal to order inter partes reexamination.

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

MPEP § 2648 Petition From Denial of Request

PROCESSING OF PETITION UNDER 37 CFR § 1.927
Once a request for inter partes reexamination has been denied, jurisdiction over the reexamination proceeding is retained by the Central Reexamination Unit (CRU) to await any petition seeking review of the examiner's determination refusing reexamination. If no petition is filed within one (1) month, the CRU will process the reexamination as a concluded reexamination file. See MPEP § 2647 and § 2694. If a petition is timely filed, the petition (together with the reexamination file) is forwarded to the office of the CRU Director for decision. The CRU Director will then review the examiner's determination that a substantial new question of patentability has not been raised. The CRU Director's review will be *de novo*.

35 U.S.C. § 312 Determination of issue by Director (in-part)

(c) FINAL DECISION. — A determination by the Director under subsection (a) shall be final and non-appealable. Upon a determination that no substantial new question of patentability has been raised, the Director may refund a portion of the *inter partes* reexamination fee required under § 311.

DECISION

Upon consideration of the Transistor Article to issues raised in (a) (i), it is agreed that figure 23 of page 49 discloses a processor within the access point because the Elan SC400 is a CPU disclosed as within the access point of figure 23 (microcontroller). However, the mere disclosure of a processor within an access point does not suggest an SNQ because a CPU within an access point is not "the operating system operably configured in the chassis." First a CPU does not inherently contain an operating system. It is well known to one of ordinary skill in the art that an operating system must be installed on a CPU and that a CPU does not inherently have an operating system installed thereon. For example, note Peirce (US Patent No 6,560,217), which was submitted in Request dated 13 October 2008 wherein it states, "the processing platform comprises a suitable central processing unit [CPU] and an operating system program implemented by the central processing unit...." (emphasis added; col. 8;lines 25-28). As a result, it is not agreed that CPU in the access point of the Transistor Article discloses "the operating system operably configured in the chassis." It is for this reason that the issue raised in (a) (i) is deemed to be not persuasive and a substantial new question is not raised by this argument with respect to the claims not so Ordered.

With regard to issue (a) (ii), it is not agreed that the disclosures of the Transistor Article irrefutably support "that the operating system-the LINUX Firmware-is operably configured in the chassis." (emphasis added). The petitioner cites Transistor Article's disclosure of "A 16-Mbyte DRAM is provided, and OS and firmware are stored in 8Mb flash memory connected to an IDE bus..." as support for the proposition that the Transistor Article discloses "the operating system operably configured in the chassis." This is inconsistent with requester's position as to issue (a) (i) wherein requester alleges that it would have been obvious to install the operating system on the Elan SC400 CPU. It is unclear why one of ordinary skill in the art would install an operating system on the Elan CPU if an operating system is already provided via the flash memory. Further, requester's allegation that "A 16-Mbyte DRAM is provided, and OS and firmware are stored in 8Mb flash memory connected to an IDE bus..." with the other teachings of Transistor collectively irrefutably support

3PR's statement that "...the operating system-the LINUX Firmware--is operably configured in the chassis" is unpersuasive because the citation to the said "16-Mbyte DRAM" teaching is notably absent in the Request. Accordingly, it is not agreed that the disclosures of the Transistor Article irrefutably support "that the operating system-the LINUX Firmware-is operably configured in the chassis."

In addition, the requester has not cited a teaching in the Transistor Article that supports the conclusion that the *access point is a chassis* and thus, the operating system is operably configured *in the chassis*. It is for these reasons that the issue raised in (a) (ii) is deemed to be not persuasive and a substantial new question is not raised by these arguments with respect to the claims not so Ordered.

In the Order mailed 12 January 2009, the Reexamination Examiner states three reasons why the Transistor Article fails to teach or disclose "the operating system operably configured *in the chassis*." (see page 8 of the order, points (2) and (3)). The Reexamination Examiner stated in point (3) on page 8, that the Reexamination Examiner can not identify any support for the conclusory statement, "the use of software for specific operation of the access point shows that the operating system-the LINUX Firmware-is operable configured *in the chassis*." (emphasis added) In the instant petition, requester has not addressed these grounds for finding that the Transistor Article does not raise a substantial new question as to claims 1-10 and 13 of the '281 patent. As a result, it is found that the Transistor Article does not raise a substantial new question with respect to claims 1-10 and 13 of the '281 patent.

With regard to argument (b) (i), MPEP §2617 states "requester should present *an explanation of how* the cited patents or printed publications are *applied* to all claims which the requester considers to merit reexamination based on patents or printed publications." First, the explanation provided in argument with respect to the issue raised in (b) (i) is not found in the Request filed 13 October 2008. The petitioner has not cited specific portions of the Request referencing the disclosure on "Build your routers." Notably, the Request is replete with the statement "[1.1a]: "a chassis" The Howto Guide teaches a chassis: "So get a pair of P75 or better PCs, with 16MB of ram, a network card or tow, and you're set....the arlan card is an ISA card, so nearly any old PC will do." (e.g., see Request, Exhibit C, pg. 2, 2nd section) However, the "Build Your Routers" teaching cited in the instant petition to support petitioner's argument is absent in the Request. It is for these reasons that the issue raised in (b) (i) is deemed to be not persuasive and a substantial new question is not raised by these arguments with respect to the claims not so Ordered.

Nonetheless, the "Build your Routers' teaching does not support the finding that the Howto Guide discloses a chassis comprising the claimed elements. The mere referencing a single chassis of a PC is insufficient to explain how the cited printed publication is applied to the claim limitation of *a chassis* containing the claimed elements. Accordingly, the arguments with respect to the issue raised in (b) (i) is not persuasive and does not raise a substantial new question with respect to the petitioned claims not so Ordered.

The issue raised with respect to (b) (ii) is unpersuasive because, *inter alia*, the explanation provided in argument (b) (ii) is not found in the Request filed 13 October 2008. On page 36 of the Request, the requester references a diagram similar to that presented in the petition on page 7. However, the said diagram is used to support the claim limitation of "channels the inbound packets based on the

inbound address information" and not to support a teaching of *a chassis*. Further, the mere referencing a single chassis of a PC is insufficient to explain how the cited printed publication is applied to the claim limitation of *a chassis* containing the claimed elements. It is for this reason that the issue raised in (b) (ii) is deemed to be not persuasive and a substantial new question is not raised by this argument with respect to the claims not so Ordered.

The issue raised in (b) (iii) is directed to the Howto Guide explicitely stating that the Linux operating system is run within the router without a hard disk. The Howto Guide describes a variety of access media from which the Linux code may be derived. There lacks a specific description as to an operating system configured in the chasis per se. The argument with respect to the issue raised in (b) (iii) is unpersuasive because an operating system on a floppy disk or like remotely transported source is not an "operating system operably configured *in the chassis*" because the floppy disk, flash drive, ZIP drive or the like is not configured in the chassis. It is for this reason that the issue raised in (b) (iii) is deemed to be not persuasive and a substantial new question is not raised by this argument with respect to the claims not so Ordered.

The issue raised in (c) (i) is unpersuasive because a CPU does not necessarily disclose an operating system. It is well known to one of ordinary skill in the art that an operating system must be installed on a CPU but that a CPU does not inherently have an operating system installed thereon. For example, note Peirce (US Patent No. 6,560,217), which was submitted in petitioner's Request dated 13 October 2008 wherein it states, "the processing platform comprises a suitable central processing unit [CPU] and an *operating system program implemented by the central processing unit*...." (emphasis added; col. 8;lines 25-28). As supported by the statement in Peirce, it was well known in the art, at the time the invention was made, that the operating system is distinct from the CPU.

Further, petitioner argues in the petition that at the very least, a CPU makes obvious an operating system (Petition, pg. 8, last two lines). MPEP §2617 states "requester should present *an explanation of how* the cited patents or printed publications are *applied* to all claims which the requester considers to merit reexamination based on patents or printed publications." The requester did not present an explanation as to why it would have been obvious to operably configure *the* operating system in the chassis in the Request. As a result, argument (c) (i) is unpersuasive. It is for these reasons that the issue raised in (c) (i) is deemed to be not persuasive and a substantial new question is not raised by these arguments with respect to the claims not so Ordered.

The issue raised in (c) (ii), the petitioner cites pages 59-63 of the Request as supporting the analysis in this argument. Notably, pages 59-63 is absent any reference to, or analysis of, the portion emphasized in the petition on page 9, i.e. "which is executed inside the intelligent router." Further, the said statement in Redlich pertains to the Address Resolution Protocol (ARP) and not the operating system. As a result, argument (c) (ii) is unpersuasive. It is for this reason that the issue raised in (c) (ii) is deemed to be not persuasive and a substantial new question is not raised by this argument with respect to the claims not so Ordered.

The issues raised in (c) (iii) & (c) (iv), the petitioner states, "...as noted in the Request, Redlich discloses: Setup of Tunnel: The IP tunnel is created between the access router and a machine outside the hosting network's corporate firewall ....The commands shown in FIG. 16 create a unidirectional tunnel from the machine with IP address 128.1.1.1 (access router) to the machine with the IP address

128.2.2.2 (outside router). (Redlich, Col. 27:37-38 and 56-59 (emphasis added); Request p. 66)." This quotation is materially different from that presented on page 66 of the Request (see indented section), wherein it states, "...the IP tunnel is created between the access router...". In the request, requester relies on this portion to disclose that the computing device connects to the wireless provisioning device "without having to first access the internet." The "set up of the tunnel" was not relied upon by petitioner to disclose that "the operating system is operably configured in the chassis."

Further, the petitioner cites Redlich col. 24:8-13 as supporting the disclosure that "the operating system is operably configured in the chassis." Contrary to petitioner's assertion that this statement is consistent with the analysis in presented in the Request on pages 63-66, Col. 24:8-13 was not cited in the Request dated 13 October 2008 as supporting the disclosure that "the operating system is operably configured in the chassis." (see Petition, pg. 9, 2nd ¶). In addition, the said statement merely explains how to set up such a tunnel server but does not disclose or make obvious "the operating system is operable configured in the chassis." It is for these reasons that the issue raised in (c) (iii) and (c) (iv) are deemed to be not persuasive and a substantial new question is not raised by these arguments with respect to the claims not so Ordered.

This decision is final and nonappealable pursuant to 35 U.S.C. § 312(c) and 37 CFR §1.927. No further communication on this matter will be acknowledged or considered.

The petition submitted 4 February 2009 is hereby denied.

CONCLUSION

1. The requester's petition dated 4 February 2009 to grant *inter partes* reexamination of claims 4 to 7 and 11 to 32 is hereby **denied.**

2. This decision is final and nonappealable. See 35 U.S.C. § 312(c) and 37 CFR § 1.927. No further communication on this matter will be acknowledged or considered.

3. All other correspondence 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
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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.

/Deborah Jones, SPE 3991/
for Gregory Morse
Director,
Central Reexamination Unit 3999

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,091	10/24/2008	7,360,338	DON02 P-1278	7156

28101 7590 03/20/2009

VAN DYKE, GARDNER, LINN & BURKHART, LLP
SUITE 207
2851 CHARLEVOIX DRIVE, S.E.
GRAND RAPIDS, MI 49546

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/20/2009

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MAILED

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CENTRAL REEXAMINATION UNIT

Inter Partes Reexamination Proceeding : **DECISION**
Control No. 95/001,091 : **GRANTING**
Filed: October 24, 2008 : **PETITION**
For: U.S. Patent No. 7,360,338 :

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

The patent owner petition will be treated as a petition under 37 CFR 1.183 for waiver of the 50-page limit requirement of 37 CFR 1.943(b). 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 credit card on February 9, 2009.

REVIEW OF THE RELEVANT FACTS

1. United States Patent Number 7,360,338 (the '338 patent) issued on April 22, 2008.

2. On October 24, 2008, a request for *inter partes* reexamination of the '338 patent was filed by a third party requester, and assigned Reexamination Control No. 95/001,091 (the '1091 proceeding).

3. On December 9, 2008, the Office issued an order granting *inter partes* reexamination in the '1091 proceeding, with an accompanying non-final Office action on the merits.

4. On February 6, 2009, patent owner filed the instant petition paper entitled, "PETITION TO WAIVE REQUIREMENTS UNDER 37 C.F.R. § 1.943." Concurrently on February 6, 2009, patent owner filed a response to the December 9, 2008 Office action, accompanied by four declarations under 37 CFR 1.132.

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.

As noted above, on February 6, 2009, patent owner concurrently filed with the instant petition a response to the December 9, 2008 Office action, which was accompanied by four declarations under 37 CFR 1.132. The response, exclusive of the accompanying declarations, exceeds the 50-page limit set forth in 37 CFR 1.943(b) by 13 pages (page 1 of the response merely includes identifying information and does not include any arguments). In the instant petition, patent owner requests waiver of 37 CFR 1.943(b) to be given a page limit that accommodates patent owner's response and accompanying fact-based exhibits.[1]

In support of waiver of the rule, patent owner points out that the December 9, 2008 Office action is "long and complex" in that it "essentially wholly" incorporates by reference from the *inter partes* request for reexamination and includes 18 grounds of rejection of the 43 claims, all of which are independent claims.[2] Patent owner submits that "[t]he complexity is compounded by the fact that all of the outstanding rejections are for obviousness," given that at least four factors must be addressed for the 43 claims (i.e., the scope and content of the prior art, the differences between the claimed invention and the prior art, the level of ordinary skill in the art, and secondary considerations).[3] Patent owner asserts that it attempted to draft the response within the 50-page limit, but finds "that it cannot fairly or adequately respond" within 50 pages and deems the 50-page limit set forth in 37 CFR 1.943(b) "woefully inadequate" for the particular circumstances of the '1091 proceeding.[4]

Upon consideration of the instant petition, it is noted that the December 9, 2008 Office action rejects independent claims 1-43 of the '338 patent based on 18 obviousness rejections, the analyses of which are discussed on pages 2-98 of the Office action. Further, for purposes of applying the references to the claims, the Office action incorporates by reference the claim charts appearing on pages 34-449 of the request for *inter partes* reexamination.[5]

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[1] Petition at page 4.
[2] Petition at page 2.
[3] Petition at page 2.
[4] Petition at pages 2-3.
[5] See December 9, 2008 Office action at page 2.

Additionally, pursuant to MPEP 2667(I)(A)(2), any declaration (or a clearly defined portion thereof) that contains opinions of the declarant or arguments 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 the page(s) of the declaration upon which the declarant opinions or arguments appear will be included against of the page limit requirements of 37 CFR 1.943. Upon cursory review of the four declarations that accompanied patent owner's February 6, 2009 response, it appears approximately 6 pages contain opinions of the declarant or arguments as to obviousness that will be counted toward the 50-page limit.

Based upon the nature of the rejections set forth in the December 9, 2008 Office action and the extensive incorporation by reference from the request therein, as well as on the individual facts and circumstances of this case, it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance. In particular, the 50-page limit of 37 CFR 1.943(b) is waived to the extent that the patent owner's February 6, 2009 response and four accompanying declarations exceed the 50-page limit by 19 pages (i.e., 13 extra pages in the response plus the 6 additional pages in the accompanying declarations that contain opinions of the declarant or arguments as to obviousness).

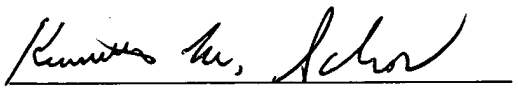
Accordingly, the patent owner petition under 37 CFR 1.183 is **granted** to the extent that the page limit of 37 CFR 1.943(b) is waived as to the **19 pages** of patent owner's February 6, 2009 response and applicable accompanying declaration portions which exceed the 50-page limit.

CONCLUSION

1. The patent owner petition under 37 CFR 1.183 is granted to the extent that the page limit of 37 CFR 1.943(b) is waived as to the 19 pages of the patent owner's February 6, 2009 response and applicable accompanying declaration portions that exceed the 50-page limit.

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

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



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CENTRAL REEXAMINATION UNIT

In re Lewno :
Inter Partes Reexamination Proceeding : **DECISION**
Control No. 95/001,092 : **GRANTING**
Filed: December 17, 2008 : **PETITION**
For: U.S. Patent No. 7,332,225 :

This is a decision on the patent owner paper entitled "PETITION TO WAIVE REQUIREMENTS UNDER 37 C.F.R. § 1.943," filed on March 17, 2009, which is being treated under 37 CFR 1.183

The patent owner petition and *inter partes* reexamination control number 95/001,092 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 page limit requirements of 37 CFR 1.943(b) for a patent owner response is granted.

FEES

In regards to the present petition under 37 CFR 1.183, as authorized by the March 17, 2009 petition, a petition fee of $400.00 under 37 CFR 1.17(f) was charged to petitioner patent owner's Deposit Account No. 22-0190.

REVIEW OF THE RELEVANT FACTS

1. On February 19, 2008, U.S. patent No. 7,332,225 ("the '225 patent") issued to Lewno.

2. On October 24, 2008, a third party deposited a request for *inter partes* reexamination of claims 1-150 of the '225 patent. The deposited reexamination request was assigned Control No. 90/001,092 (the '1092 proceeding).

3. On November 3, 2008, a "Notice of *Inter Partes* Reexamination Request Filing Date" was mailed, assigning a filing date of October 24, 2009 to the '1092 proceeding.

4. On November 11, 2008, the Office issued *sua sponte* a decision vacating the October 24, 2008 filing date for the '1092 proceeding.

5. On December 17, 2008, the third party requester submitted a response to the November 11, 2008 Office decision supplementing the request for *inter partes* reexamination of claims 1-150 of the '225 patent.

6. On January 14, 2009, a "Notice of *Inter Partes* Reexamination Request Filing Date" was mailed, assigning a filing date of December 17, 2008 to the '1092 proceeding.

7. On February 19, 2009, the Office issued an order granting the request for *inter partes* reexamination of claims 1-92 and 94-150 of the '225 patent. A non-final Office action, rejecting claims 1-20, 22-24, 26-27, 30-34 and 134-141, and confirming claims 21, 25, 28-89, 35-133 and 142-150, was mailed concurrently with the order granting reexamination.

8. On March 17, 2009 patent owner filed a response to the February 19, 2009 non-final Office action, which facially exceeds the page limit requirements of 37 C.F.R. 1.943(b).

9. Also on March 17, 2009, patent owner filed the present petition entitled "PETITION TO WAIVE REQUIREMENTS UNDER 37 C.F.R. § 1.943."

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 17, 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 19, 2009 Office action to 56 pages.[1] In support of waiver of the rule, patent owner asserts that the February 19, 2009 Office action contains 29 different obviousness based grounds of rejection, all using multiple references, against the majority of the 150 claims of the '225

[1] Petition at page 1

patent and where the Office action cites several sections of the request for reexamination to supplement the bases of the rejections.[2] The patent owner response relies heavily upon affidavit practice and the uses multiple exhibits, as permitted by rule, in an effort to prevent exceeding the 50 page limit, but patent owner notes that the response could not be contained within the 50 page limit.[3]

II. ANALYSIS AND FINDINGS

The record shows that the non-final Office action dated February 19, 2009 is 33 pages in length (excluding 4 pages of cover sheets and 1 page of contact information and signatures), and it refers to a significant portion of the request for reexamination for the reasoned basis for adopting several of the proposed rejections.[4] Hence, including the cited pages of the request for reexamination, the non-final Office action's total length is 104 pages. Accounting for duplicate citation of pages in the Office action reduces the non-final Office action's total length is 85 pages. A significant portion of the request for reexamination pages cited by the Office action are claim chart pages containing significant areas of unused white space, thus the amount of substantive content of the cited pages is less than that of pages consisting exclusively of text.

A review of patent owner's March 17, 2009 response to the February 19, 2009 Office action finds that the response includes 54 pages of substantive remarks, a caption or cover page to the remarks and a signature page. In support of the response, patent owner has filed four affidavits with multiple exhibits each totaling 255 pages.[5] A cursory review of the affidavits finds the affidavits to be substantially free of argument that discuss the ultimate legal conclusion of patentability, i.e. issues of anticipation or obviousness, except pages 15 and 24 of the declaration executed by Dr. Niall R. Lynam, where the ultimate legal conclusion of obviousness are discussed in paragraphs 40 and 62. Therefore the response contains *in toto* 56 pages of substantive remarks.

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 '1092 *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 response to run 56 pages in length is appropriate in the interest of justice.

Patent owner has pointed out the specific facts and circumstances as to why 56 pages of substantive remarks are necessary. Patent owner has submitted a response in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) to increase the page limit to 56 pages.

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[2] Petition at page 2

[3] Petition at page 3

[4] Page 3 of the action cites pp. 1-3, 5-10, 14, 22-24, 30 and 32-34 of the Request; pp. 5 of the action cites pp. 4, 26-27 of the Request; pp. 8 of the action cites pp. 74 and 110 of the Request; p. 9 of the action cites pp. 75-77 of the Request; p. 10 of the action cites pp. 83 and 85-89 of the Request; p. 7 of the action cites pp. 84-85 of the Request; p. 27 of the action cites pp. 349-362 and 362-367 of the Request; p. 30 of the action cites pp. 349-362 and 364-365 of the Request; p. 31 of the action cites pp. 362-363 of the Request.

[5] The submission of supporting expert declarations or other appendix evidence will not count towards the 50-page limit of 37 CFR 1.943(b) as long as the content of such declarations or other appendix evidence is limited to factual observations and avoids any legal conclusions about the factual observations.

The response minimizes the use of white space with an efficient format and layout, is substantially free of extraneous non-substantive material, free of repetition of information already of record and relies heavily on affidavit practice and exhibits to maximize the use of the page limit for remarks and not the presentation of facts and evidence. Therefore, patent owner has evidenced a *bona fide* attempt to comply with the 50-page limit of 37 CFR 1.943(b) to justify the need for more pages to present a complete response and has set forth an accurate determination of exactly how many additional pages are necessary to file a complete response to the Office action.

THIRD PARTY REQUESTER

This decision, *sua sponte,* waives the provisions of 37 CFR 1.943(b) to the extent 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 56 pages in length, excluding appendices of claims, formalities (*e.g.* cover and signature pages) and reference materials such as prior art references.

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 56 pages in length, excluding amendments, appendices of claims, formalities (e.g. cover and signature pages) 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 56 pages in length, excluding appendices of claims, formalities (e.g. cover and signature pages) 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 third party papers, and to process any and all party papers at the point where there is no further time remaining for filing such papers. After the Central Reexamination Unit has processed all party papers, or there are no such papers and the time for filing same has expired, jurisdiction will be transferred to the primary examiner for appropriate action on the proceeding.

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

Robert A. Clarke
Director
Office of Patent Legal Administration

UNITED STATES PATENT AND TRADEMARK OFFICE

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NOV 17 2009

CENTRAL REEXAMINATION UNIT

Dion R. Ferguson (For Requester)
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2100 Pennsylvania Avenue, N.W.
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Washington, D.C. 20037

In re Jeffrey A. Lewno :
Inter Partes Reexamination Proceeding : **DECISION DISMISSING**
Control No. 95/001,092 : **THIRD PARTY REQUESTER**
Filed: December 17, 2008 : **PETITION UNDER**
For: U.S. Patent No. 7,332,225 : **37 CFR 1.137(b)**

This is a decision on the July 7, 2009 third party requester petition under 37 CFR 1.137(b) to accept an unintentionally delayed third party comment ("the July 7, 2009 third party requester petition").

The petition fee of $1,620.00 set forth in 37 CFR 1.17(m) for a petition filed under 37 CFR 1.137(b) has been paid.

The July 7, 2009 third party requester petition is before the Office of Patent Legal Administration (OPLA) for consideration.

The July 7, 2009 third party requester petition is **dismissed**.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

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

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

35 U.S.C. 133 provides:

> Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Director in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Director that such delay was unavoidable.

35 U.S.C. 314(a) provides, in pertinent part:

> IN GENERAL. — Except as otherwise provided in this section, reexamination shall be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133.

37 CFR 1.137 provides, in pertinent part:

> (b) *Unintentional.* If the delay in reply by ... patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive ... a reexamination prosecution terminated under §§ 1.550(d) or 1.957(b) or limited under § 1.957(c) .... A grantable petition pursuant to this paragraph must be accompanied by:
>
> > (1) The reply required to the outstanding Office action or notice, unless previously filed;
> > (2) The petition fee as set forth in § 1.17(m);
> > (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional ....
>
> *
> *
>
> (d) *Terminal disclaimer.*
>
> > *
> > *
> >
> > (3) The provisions of paragraph (d)(1) of this section do not apply to ... reexamination proceedings.

37 CFR 1.957(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.

37 CFR 1.958(b) provides:

> Any response by the patent owner not timely filed in the Office may be accepted if the delay was unintentional. A grantable petition to accept an unintentionally delayed response must be filed in compliance with § 1.137(b). [Emphasis added.]

MPEP 2668 provides, in pertinent part:

> II. PETITION BASED ON UNINTENTIONAL DELAY
>
> The unintentional delay fee provisions of 35 U.S.C. 41(a)(7) are imported into, and are applicable to, any reexamination proceeding by Sec. 4605(a) of the American Inventors Protection Act of 1999. Accordingly, the Office will consider, in appropriate circumstances, a petition showing unintentional delay under 37 CFR 1.137(b) where untimely papers are filed by the patent owner subsequent to the order for reexamination. Any such petition must provide a verified statement that the delay was unintentional, a proposed response to continue prosecution (unless it has been previously filed), and the petition fee required by 37 CFR 1.17(m).
> *
> *
>
> IV. FURTHER DISCUSSION OF THE PETITION REQUIREMENTS
>
> See also MPEP § 711.03(c), subsection III, for a detailed discussion of the requirements of petitions filed under 37 CFR 1.137(a) and (b).

DECISION

The Petition Under 37 CFR 1.137(b) is Dismissed

The July 7, 2009 third party requester petition must be dismissed. 37 CFR 1.137(b) and 1.958(b) state that the **patent owner** may obtain relief under 37 CFR 1.137(b). Petitioner, however, is not the patent owner, but rather a third party requester. Accordingly, there is no basis for petitioner to obtain relief under 37 CFR 1.137(b) and 1.958(b), to the extent that they permit the Office to excuse an unintentional delay in filing a timely response.

Moreover, no statutory basis is provided, in the *inter partes* reexamination statute or elsewhere in the patent statute, for a third party requester to file a petition for relief based on either unavoidable or unintentional delay.

The July 7, 2009 third party requester petition under 37 CFR 1.137(b) is therefore **dismissed**.

Since there is no statutory basis for the July 7, 2009 third party requester petition paper, it is an improper paper, and is not entitled to be present in the present '1092 *inter partes* reexamination proceeding file. A copy of the July 7, 2009 third party requester petition paper was, however, scanned into the electronic Image File Wrapper (IFW) of the '1092 proceeding, before the discovery of the impropriety. This copy cannot be physically removed from the file. Rather, the IFW copy of the July 7, 2009 requester petition paper is being expunged by closing it in the IFW file of the '1092

inter partes reexamination proceeding and marking it "not public." It will not constitute part of the record of the present reexamination proceeding. The present decision will, however, be made part of the official record of the '1092 *inter partes* reexamination proceeding, and a copy of this decision will be publicly available in the IFW.

As to the July 3, 2009 third party requester comment paper and Information Disclosure Statement (IDS) directed to that comment paper,[1] 37 CFR 1.957(a) states that "[i]f the third party requester files an untimely or inappropriate comment ... in an *inter partes* reexamination, the paper will be refused consideration." MPEP 2667, part II.B.3, provides that the copy of later papers will be retained in the file, but will not be considered. A copy of each of the July 3, 2009 third party requester papers was scanned into the electronic Image File Wrapper (IFW) of the '1092 proceeding, and will remain in the record. The papers, however, will not be considered; this includes the Information Disclosure Statement (IDS) submitted July 3, 2009, and the file is to be annotated to that effect.

It is observed that 37 CFR 1.8 is available in some instances to establish transmitted requester papers as timely filed. In this instance, however, the facts as presented in the July 7, 2009 third party requester petition do not admit to reliance on 37 CFR 1.8.

CONCLUSION

1. The July 7, 2009 third party requester petition under 37 CFR 1.137(b) is **dismissed**.

2. The July 3, 2009 third party requester papers are late papers; they have not been considered as to their substance.

3. The July 7, 2009 third party requester petition paper is being expunged by closing the paper in the Image File Wrapper (IFW) for the '1092 *inter partes* reexamination proceeding and marking it "not public." The July 7, 2009 requester petition paper will not constitute part of the record of the present reexamination proceeding.

4. A copy of this decision is being made of record in the IFW of the '1092 *inter partes* reexamination proceeding.

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[1] One of the July 3, 2009 third party requester papers is an Information Disclosure Statement (IDS). Under 37 CFR 1.948(a), after the *inter partes* reexamination order, a third party requester IDS may only be filed as part of a comments submission under 1.947(a) or 1.951(b). Because none of the July 3, 2009 third party requester papers is entered for consideration, the July 3, 2009 third party requester IDS is also an improper paper that is not entitled to entry for consideration in the present '1092 *inter partes* reexamination proceeding.

5. Jurisdiction over the proceeding is being returned to the Central Reexamination Unit, Art Unit 3991, and will proceed with special dispatch.

6. Any inquiry concerning this decision should be directed to Raul Tamayo, Legal Advisor, at (571) 272-7728.

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

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(For Third Party Requester)

In re *Wyeth*
Inter Partes Reexamination Proceeding
Control No.: 95/001,095
Filed: October 24, 2008
For: U.S. Patent No. 7,300,662 B2

DECISION DISMISSING PETITION AND REFUSING ENTRY OF PAPER

This is a decision on third party requester's papers, filed on January 14, 2009, entitled "PETITION UNDER 37 CFR § 1.183 TO PERMIT REQUESTER COMMENTS ON PATENT OWNER PETITIONS FOR PAGE AND TIME LIMIT EXTENSIONS," and "REQUESTER COMMENTS ON PATENT OWNER PETITIONS FOR PAGE AND TIME LIMIT EXTENSIONS."

The January 14, 2009 third party requester papers are before the Office of Patent Legal Administration.

The January 14, 2009 third party requester comment is refused entry into the record, without consideration on the merits, for the reasons set forth below.

The January 14, 2009 third party requester petition under 37 CFR 1.183 is dismissed and refused entry into the record, for the reasons set forth below.

PETITION FEE

37 CFR 1.183 requires payment of the petition fee under 37 CFR 1.17(f), which is $400.00. Therefore, $400.00 has been charged to patent owner's Deposit Account No. 19-4880, as authorized in concluding paragraph of the present petition.

REVIEW OF FACTS

1. U.S Patent number 7,300,662 ("the '662 patent") issued to Robert Falotico *et al* on November 27, 2007, from an application filed on April 21, 2004, and is assigned to Wyeth.

2. On October 24, 2008, a request for *inter partes* reexamination of the '662 patent was filed by a third party requester, and assigned control number 95/001,095 ("the '1095 *inter partes* reexamination proceeding").

3. The '1095 *inter partes* reexamination proceeding was accorded a filing date of October 24, 2008.

4. An Order Granting *Inter Partes* Reexamination was mailed in the '1095 *inter partes* reexamination proceeding on December 31, 2008.

5. On December 31, 2008, a non-final Office action was mailed in which claims 1-25 of the patent were rejected.

6. On January 9, 2009, patent owner filed a request for extension of time pursuant to 37 CFR 1.956 and a petition entitled "PETITION FOR INCREASE OF PAGE LIMIT FOR PATENT OWNER'S RESPONSE PURSUANT TO 37 CFR 1.183 AND 1.943(b)." These filings are addressed in separate decisions. The request for extension of time is being addressed by the Central Reexamination Unit.

7. On January 14, 2009, the requester filed the instant comments on the present patent owner petition concurrent with the instant petition under 37 CFR 1.183 to permit Office consideration of the comments.

8. The decision on the patent owner petition to increase the page limit under 37 CFR 1.183 is being mailed on an even date with this decision.

DECISION

I. RELEVANT STATUTES, REGULATIONS, AND EXAMINING PROCEDURE

35 U.S.C. § 314(b)(2) states:

> Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.

37 CFR 1.939(a) states:

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

37 CFR 1.945(a) 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:

> 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 1.183 provides:

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

II. DISCUSSION

For the reasons set forth below, the January 14, 2009 third party requester comments and petition to enter such comments, filed in response to the patent owner's January 9, 2009 request for extension of time and petition under 37 CFR 1.183, do not have a right of entry in the '1095 proceeding.

A. Third Party Requester Comments are Not Permitted for Procedural Matters in *Inter Partes* Reexamination

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 petition under 37 CFR 1.183, requesting suspension of 37 CFR 1.953(b) for increase of page limit, however, is **not** a "response" to an Office action on the merits. [1] Neither is the patent owner's request for an extension of time. 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 request for extension of time or petition under 37 CFR 1.183 for suspension of the rules. [2]

A third party requester's paper commenting on a patent owner's extension of time request or petition to waive the page limit set out in 37 1.943(b) is a paper that is not permitted by the statute governing *inter partes* reexamination proceedings, and accordingly was not provided for (i.e., was not permitted) in the regulations that implemented the *inter partes* reexamination statute. Furthermore, third party requester's petition under 37 CFR 1.183 to waive the rules forbidding third party comments has not been granted as detailed below. Third party requester's January 14, 2009 paper commenting on the 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, the third party requester's January 14, 2009 paper commenting on the patent owner's January 9, 2009 petition under 37 CFR 1.183 does not have a right of entry into the record of the '1095 proceeding and, as such, is not an authorized paper. Because the third party requester's January 14, 2009 paper 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 '1095 proceeding. *See* MPEP 2267.

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[1] Pursuant to 37 CFR 1.937, an *inter partes* reexamination proceeding is to be conducted in accordance with 37 CFR 1.104 - 1.116. The term "response" is used in reexamination proceedings to avoid confusion with the word "reply," a term used in the context of *ex parte* reexamination proceedings in connection with the right of a third party requester to file a "reply" under 37 CFR 1.535 to a patent owner's statement. Thus, MPEP § 2666, entitled "Patent Owner Response to an Office Action," discusses the requirements for a patent owner's "response" to an Office action on the merits in terms of 37 CFR 1.111, a regulation which governs the filing of "reply" to an Office action.

[2] When a petition under 37 CFR 1.183 includes a paper that, upon granting of the petition, would trigger a right for comment or response by a third party requester, then an opportunity to provide such comment or response is given at the point where the paper is entered (if the petition is granted).

B. The Office Lacks Statutory Authority to Consider the Substance of the Petition

Third party requester, noting that the Code of Federal Regulations does not provide for a third party response to patent owner petitions to waive the page limit under 37 CFR 1.943(b) or for extensions of time, filed a petition on January 14, 2009 under 37 CFR 1.183 to waive any rules precluding such response. However, the rules cannot be waived to provide the third party requester the right to file a paper at the present stage in the '1095 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 or for an extension of time 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 January 14, 2009 petition, however, seeks to waive a requirement, that a requester response is allowed only in response to a patent owner's response on the merits, set forth in 35 U.S.C. § 314(b)(2). Accordingly, the Office is without statutory authority to consider the substance of the third party requester's January 14, 2009 petition paper. In this respect, the 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.

The requester petition includes comments, extraneous to the merits of the petition, relating to the merits of the patent owner petition for waiver of 37 CFR 1.943(b) and patent owner's request for an extension of time. For this reason, the petition paper filed by the third party requester will be excluded from the record of the '1095 proceeding. Because the third party requester's January 14, 2009 petition 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 '1095 proceeding. [3]

[3] *See* MPEP 2267.

III. ADDITIONAL DISCUSSION

It should be noted that the patent owner's January 14, 2009 petition under 37 CFR 1.183 did not stay any periods for reply running in the '1095 proceeding, as "[t]he mere filing of a petition will not stay any period for response that may be running against the application, nor act as a stay of other proceedings." [4]

Parties are advised to take care to avoid characterizing submissions by other parties. Petitions having improper commentary unrelated to the merits of the petition are subject to return or expungement without treatment upon their merits.

Further note that 37 CFR 1.4(c) states that :

> 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.

In this case, requester's comments and petition are directed both to extension of time and a petition under 1.183, which are different matters handled by different sections of the Office, and thus are improper papers. Parties should be cognizant of the requirement for separate papers for separate matters.

CONCLUSION

1. The third party requester's January 14, 2009 comments paper filed in response to the patent owner's January 9, 2009 petition under 37 CFR 1.183, requesting suspension of 37 CFR 1.943(b), is refused entry as it is an improper paper.

2. Because the January 14, 2009 paper was previously incorporated into the IFW, the paper is being expunged from the record by marking it "closed" and "non-public" in the IFW of the '1095 proceeding. No copy of the January 14, 2009 paper will be maintained of record in the Office.

3. The third party requester's January 14, 2009 petition filed in response to the patent owner's January 9, 2009 petition under 37 CFR 1.183, requesting suspension of 37 CFR 1.943(b), is dismissed.

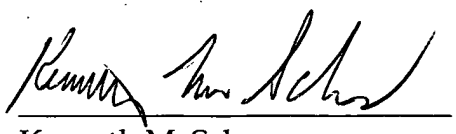
4. The petition paper filed by the third party requester on January 14, 2009 is expunged from the record for including material not having an entry right. This will be carried out by closing the petition paper (document) in the Office's Image File Wrapper (IFW) file of the '1095 *inter partes* reexamination proceeding and marking the paper "closed" and "not public.

5. A copy of this decision will be made of record in the IFW record of the '1095 proceeding.

---

[4] *See* 37 CFR 1.181(f).

6. Telephone inquiries with regard to this decision should be directed to Michael Cygan, Legal Advisor, at (571) 272-7700, or in his absence, to Pinchus M. Laufer, Legal Advisor, at (571) 272-7726.



Kenneth M. Schor
Senior Legal Advisor
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United States Patent and Trademark Office
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CENTRAL REEXAMINATION UNIT

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(For Patent Owner)

MICHAEL G. RAUCCI
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WASHINGTON, DC 20037

(For Third Party Requester)

In re Wyeth
Inter Partes Reexamination Proceeding
Control No.: 95/001,095
Filed: October 24, 2008
For: U.S. Patent No. 7,300,662 B2

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

This is a decision on the patent owner petition January 9, 2009, entitled "Petition For Increase of Page Limit For Patent Owner's Response Pursuant to 37 CFR §§ 1.183 and 1.943(b)."

The petition and the above-captioned *inter partes* reexamination proceeding are before the Office of Patent Legal Administration for consideration.

For the reasons set forth below, patent owner's petition, taken as a 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 dismissed.

PETITION FEE

37 CFR 1.183 requires payment of the petition fee under 37 CFR 1.17(f), which is $400.00. Therefore, $400.00 has been charged to patent owner's Deposit Account No. 23-3050, as authorized in concluding paragraph of the present petition.

REVIEW OF SALIENT FACTS

1. U.S Patent number 7,300,662 ("the '662 patent") issued to Robert Falotico *et al* on November 27, 2007, from an application filed on April 21, 2004, and is assigned to Wyeth.

2. On October 24, 2008, a request for *inter partes* reexamination of the '662 patent was filed by a third party requester, and assigned control number 95/001,095 ("the '1095 *inter partes* reexamination proceeding").

3. The '1095 *inter partes* reexamination proceeding was accorded a filing date of October 24, 2008.

4. An Order Granting *Inter Partes* Reexamination was mailed in the '1095 *inter partes* reexamination proceeding on December 31, 2008.

5. On December 31, 2008, a non-final Office action was mailed in which claims 1-25 of the patent were rejected.

6. On January 9, 2009, patent owner filed the present patent owner petition.

7. On January 14, 2009, the requester filed comments on the present patent owner petition concurrent with a petition under 37 CFR 1.183 to permit Office consideration of the comments. These filings will be addressed by a separate decision mailed on an even date with this decision.

DECISION

I. Applicable Regulatory Provisions

37 CFR 1.183 provides:

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

37 CFR 1.943(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. Findings and Analysis

The record shows that on January 9, 2009, the patent owner filed the present petition, in which patent owner requests a waiver of the requirements of 37 CFR 1.943(b) to permit the response to exceed the 50-page limitation set by that regulation for a patent owner's response.

In the present petition, patent owner specifically requests that the 37 CFR 1.943(b) 50-page limitation on the length of a patent owner response be waived to permit a 150 page response. Patent owner states that the non-final Office action dated December 31, 2008 comprises 47 pages and presents 22 grounds of rejection proposed by the Requester.

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 '1095 *inter partes* reexamination proceeding, the present patent owner petition fails to establish that a waiver of 37 CFR 1.943(b) is required by justice to remedy an extraordinary situation. Given that there are 47 pages of Office action, petitioner has not pointed out the specifics of what will require 150 pages, and why.

Note that the page limit does not include appendices containing evidence only which are directed to facts

CONCLUSION

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

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

3. Telephone inquiries with regard to this decision should be directed to Michael Cygan, Legal Advisor, at (571) 272-7700, or in his absence, to Pinchus Laufer at (571) 272-7726.

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

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CENTRAL REEXAMINATION UNIT

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(For Patent Owner)

Michael G. Raucci
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(For *Inter Partes* Requester)

In re Khankari et al.
Inter partes Reexamination Proceeding
Control No. 95/001,095
Filed: Oct. 24, 2008
For: U.S. Patent No. 7,300,662

:DECISION DISMISSING PETITION
:TO SUSPEND REEXAMINATION
:PROCEEDING

This decision is a decision on patent owner's July 1, 2009 petition titled "PETITION UNDER 37 CFR § 1.182 AND § 1.183 TO TEMPORARILY SUSPEND REEXAMINATION PROCEEDING 95/001,095. The petition requests that the Office temporarily suspend the present reexamination proceeding until September 21, 2009, which is asserted to be one month after the close of expert discovery in the co-pending litigation in the District Court involving the same patent. On July 13, 2008, requester filed an opposition paper titled 'REQUESTER'S PETITION TO OPPOSE PATENT OWNER'S JULY 1, 2009 PETITION TO SUSPEND *INTER PARTES* REEXAMINATION PROCEEDINGS" filed on July 13, 2009. This decision addresses both the patent owner and requester papers.

Patent Owner's petition to suspend is **DISMISSED**.

BACKGROUND

1. U.S. Patent No. 7,300,662 (the '662 patent) issued on November 27, 2007.

2. A request for reexamination of the '662 patent was filed on October 24, 2008. The request was assigned control No. 95/001,095 (the '1095 reexamination proceeding).

3. Reexamination was ordered for the '1095 reexamination proceeding on December 31, 2008. The examiner's order contained 16 pages. The Office also mailed a non-final rejection on the same date. The non-final rejection mailed was 47 pages in length.

4. On January 9, 2009, the patent owner filed an request for an extension of time to file a response the December 31, 2008 Office action, as well as a petition to waive the page limit rule under 37 CFR 1.943(b).

5. On January 16, 2009, the Office granted patent owner's request for an extension of time and granted a two-month extension of time. The patent owner's response was extended until April 30, 2009.

6. On April 30, 2009 the Patent Owner filed a response to the December 31, 2008 Office action.

7. It is asserted that, in April 2009, the Patent Owner and Requester began discussions to authorize the patent owner to provide to the Office a copy of documents produced by the requester in the litigation being conduction in the U.S. District Court for the District of New Jersey that is styled *Wyeth and Cordis Corp. v. Abbott Laboratories et al*, Civil Action No. 07-5636.

8. On June 1, 2009, the third party requester submitted comments after patent owner's response of April 30, 2009.

9. On June 1, 2009, requester also filed a petition to expunge information submitted pursuant to MPEP. The specific exhibit requested to be expunged is exhibit 79 which is asserted to be subject to a protective order.

9. On June 17, 2009, patent owner submitted a miscellaneous letter informing the Office that a terminal disclaimer was submitted, for the file of the present '662 patent, addressing target application number 10/796,396.

10. On July 1, 2009, the patent owner submitted the present petition to pursuant to 37 CFR 1.182 and 1.183 to temporarily suspend the *'1095* reexamination proceeding.

11. On July 13, 2009, the requester filed an opposition to the patent owner's petition to temporarily suspend the '1095 reexamination proceeding.

12. No Office actions are outstanding (i.e., none are awaiting response) in the present proceeding.

13. The District Court litigation has not been stayed pending resolution of this reexamination proceeding.

RELEVANT LAW AND REGULATIONS

37 CFR 1.182 provides:

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

37 CFR 1.183 provides:

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

37 CFR 1.939 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.

35 U.S.C. 305 provides:

After the times for filing the statement and reply provided for bysection 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title. In any reexamination proceeding under this chapter, the patent owner will be permitted to propose any amendment to his patent and a new claim or claims thereto, in order to distinguish the invention as claimed from the prior art cited under the provisions ofsection 301 of this title, or in response to a decision adverse to the patentability of a claim of a patent. No proposed amended or new claim enlarging the scope of a claim of the patent will be permitted in a reexamination proceeding under this chapter. All reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office.

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.

35 U.S.C. 317(b) provides:

(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.

PATENT OWNER'S ARGUMENTS

1. Additional time is necessary to obtain authorization to submit evidence in support of patentability that is obtained through the discovery process in the District Court litigation.
2. Entry into Office's Appeal Process Prior to Resolution of the Protective Order Issue in the District Court Litigation would deprive Patent Owner of the ability to adequately defend the Patent Owner's patent
3. A temporary suspension of an *Inter Partes* Reexamination proceeding is not precluded under *Ethicon v. Quigg* 849 F. 2d. 1422 (Fed. Cir. 1998).

REQUESTER'S ARGUMENTS

1. The Patent Statute and MPEP mandate that the reexam be conducted with special dispatch.

2. Patent Owner's arguments for temporary staying the proceeding would eviscerate the *inter partes* statute for litigated patents, since such stays would effectively guarantee that the litigation would end prior to *inter partes* reexamination, thus terminating the reexaminations mid-course.

3. Patent Owner has already delayed the '1095 reexamination proceeding by filing significant extensions of time for its responses.

4. Patent Owner complained of Office delay when successfully opposing a stay of litigation and then filed request for such delay in the '1095 proceeding.

5. A stay is not necessary, because Patent Owner will have an opportunity to the next Office action by the Office.

6. The rationale of the Federal Circuit's decision in *Ethicon v. Quigg* - that reexams generally should not be stayed pending litigation given Congress's "special dispatch" mandate- applies even stronger to *inter partes* reexamination since, unlike, *ex parte* reexamination, *inter partes* reexam are terminated early if not completed before the litigation ends.

ANALYSIS AND FINDINGS

As asserted by both Patent Owner and Requester, 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 an indefinite length of time in an *ex parte* reexamination, and, accordingly is not controlling authority on the present issue.

Patent owner argues that (1) additional time is necessary to obtain authorization to submit evidence in support of patentability that is obtained through the discovery process and (2) entry into the appeal process prior to resolution of the protective order issued in the District Court litigation would deprive patent owner of ability to adequately defend its patent rights.

Patent owner argues that evidence has been obtained through the discovery process in the co-pending litigation and it is reasonable to believe that additional information in support of patentability of the claims will be discovered through pre-trial discovery of expert witnesses is lacking in detail. The patent owner, however, does not establish a reasonable basis of the specifics it would expect to find. Patent owner does not provide any guidance and explanation as what information it is expected to find during expert discovery, and how that information would be expected to be relevant to this proceeding. To the extent that patent owner is relying on future discovery, patent owner's request is based upon speculation.

In addition, as pointed out by requester, the granting of stays based upon on-going 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.

Patent Owner has not met its burden of showing good cause as to why such proceeding should be temporarily stayed pending conclusion of the of the discovery period in the on-going litigation in the District Court proceeding. Accordingly, the petition is dismissed.

As to obtaining entry of additional evidence (obtained through the discovery process) into a reexamination proceeding after the filing of an appeal and the limit the ability for a party to enter additional evidence after an Action Closing Prosecution (ACP):

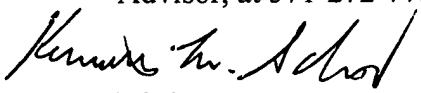
Patent owner has potential remedies pursuant to 37 CFR 1.116, 37 CFR 1.182, 37 CFR 1.183 and 37 CFR 1.951. For example, if patent owner is addressing issues raised in the Office action closing prosecution, then such evidence may be admitted as part of a 37 CFR 1.951 submission, subject to the criteria of 37 CFR 1.116. If the patent owner cannot avail itself to 37 CFR 1.116 and 37 CFR 1.951, patent owner has recourse to filing a petition pursuant to either 37 CFR 1.182 or 37 CFR 1.183, whichever may be relevant. Patent Owner is not being denied due process rights, and will have opportunity to have such evidence in its next response, if seasonably submitted with a showing to that effect, and the evidence is of the nature permitted in reexamination. Should the proceeding reach the point where an appellant brief is due prior to the asserted September 21, 2009 close of expert discovery (plus time to consider the results of the discovery), patent owner may request an extension of time by filing a petition under 37 CFR 1.183 to waive 37 CFR 41.66(a), providing the details of the need for the extension.

CONCLUSION

1. Patent Owner's petition under 37 CFR 1.182 and 1.183 to temporarily suspend the present reexamination proceeding is **DISMISSED**.

2. Jurisdiction is being returned to the Central Reexamination.

3. Questions concerning this decision should be addressed to Kery A. Fries, Senior Legal Advisor, at 571-272-7757.



Kenneth Schor
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Office of Patent Legal Administration
Office of Deputy Commissioner
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CENTRAL REEXAMINATION UNIT

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(For *Inter Partes* Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,095
Filed: October 24, 2008
For: U.S. Patent No. 7,300,662

DECISION GRANTING PETITION, EXPUNGING IMPROPER PAPER, AND *SUA SPONTE* WAIVING PAGE LIMIT

This is a decision on patent owner's petition 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 9, 2009, and on third party requester's petition paper entitled "REQUESTER'S PETITION UNDER 37 CFR 1.183 FOR WAIVER OF PAGE LIMIT UNDER 37 CFR 1.943(b)," filed on November 17, 2009.

The petitions under 37 CFR 1.183 are before the Office of Patent Legal Administration for consideration.

Patent owner's petition under 37 CFR 1.183 is granted. Third party requester's petition under 37 CFR 1.183 is being expunged as an improper paper for the reasons set forth herein. This decision also *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 92 pages in length (subject to the conditions set forth below).

FEES

The petition fee of $400 for patent owner's petition under 37 CFR 1.183 pursuant to 37 CFR 1.17(f) was charged to patent owner's deposit account no. 23-3050 on November 10, 2009. The petition fee of $400 for third party requester's petition under 37 CFR 1.183 pursuant to 37 CFR 1.17(f) was charged to requester's deposit account no. 19-4880 on November 18, 2009.

REVIEW OF THE RELEVANT FACTS

1. On November 27, 2007, United States Patent Number 7,300,663 (the '662 patent) issued.

2. On October 24, 2008, a request for *inter partes* reexamination of the '662 patent, assigned Reexamination Control No. 95/001,095 (the '1095 proceeding), was filed by a third party requester.

3. On December 31, 2008, the Office issued an order granting *inter partes* reexamination in the '1095 proceeding.

4. Concurrently, on December 31, 2008, the Office mailed an Office action in the '1095 proceeding.

5. On January 9, 2009, patent owner filed a paper entitled "REQUEST FOR EXTENSION OF TIME PURSUANT TO 37 C.F.R. §1.956."

6. Concurrently, on January 9, 2009, patent owner filed a petition 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)."

7. On January 16, 2009, the Office mailed a decision granting patent owner's January 9, 2009 petition for extension of time, extending the time period for response to the December 31, 2008 Office action to April 30, 2009.

8. On January 27, 2009, the office mailed a decision dismissing patent owner's January 9, 2009 petition under 37 CFR 1.183.

9. On April 30, 2009, patent owner filed a "PATENT OWNER'S RESPONSE PURSUANT TO 37 C.F.R. §1.945."

10. On June 9, 2009, third party requester filed "THIRD-PARTY REQUESTER ABBOTT'S COMMENTS ADDRESSING ISSUES RAISED BY DECEMBER 31, 2008 OFFICE ACTION AND PATENT OWNER'S APRIL 30, 2009 RESPONSE."

11. On October 23, 2009, the Office mailed a "NOTICE RE DEFECTIVE PAPER IN INTER PARTES REEXAMINATION," stating that patent owner's April 30, 2009 response exceeds the page limit of 37 CFR 1.943 by 22 pages and setting a time period of fifteen days from the mailing date of the notice for patent owner to take corrective action as specified therein ("notice of defective patent owner paper").

12. Concurrently, on October 23, 2009, the Office mailed a "NOTICE RE DEFECTIVE PAPER IN INTER PARTES REEXAMINATION," stating that third party requester's June 1, 2009 comments exceed the page limit of 37 CFR 1.943 by 115 pages and setting a time period of fifteen days from the mailing date of the notice for third party requester to take corrective action as specified therein ("notice of defective requester paper").

13. On November 5, 2009, the Office mailed a Miscellaneous Action, clarifying the October 23, 2009 notice of defective requester paper by withdrawing the time period running against

third party requester to take corrective action and giving third party requester 30 days from the date of service of a proper, compliant response by patent owner to file comments.

14. On November 9, 2009, patent owner filed the instant "PETITION FOR INCREASE OF PAGE LIMIT FOR PATENT OWNER'S RESPONSE PURSUANT TO 37 C.F.R. §§1.183 AND 1.943(b)," requesting waiver of the 50-page limit for its April 30, 2009 response ("patent owner petition under 37 CFR 1.183").

15. On November 17, 2009, third party requester filed the instant "REQUESTER'S PETITION UNDER 37 CFR 1.183 FOR WAIVER OF PAGE LIMIT UNDER 37 CFR 1.943(b)," requesting waiver of the 50-page limit for its June 1, 2009 comments ("requester 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 1.906 provides:

> (a) Claims in an *inter partes* reexamination proceeding will be examined on the basis of patents or printed publications and, with respect to subject matter added or deleted in the reexamination proceeding, on the basis of the requirements of 35 U.S.C. 112.
>
> (b) Claims in an *inter partes* reexamination proceeding will not be permitted to enlarge the scope of the claims of the patent.
>
> (c) Issues other than those indicated in paragraphs (a) and (b) of this section will not be resolved in an inter partes reexamination proceeding. If such issues are raised by the patent owner or the third party requester during a reexamination proceeding, the existence of such issues will be noted by the examiner in the next Office action, in which case the patent owner may desire to consider the advisability of filing a reissue application to have such issues considered and resolved.

37 CFR 1.939(a) provides:

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

37 CFR 1.943(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 provides (in-part):

> Where the length of the patent owner submission exceeds that permitted by 37 CFR 1.943, the submission is improper. Accordingly, pursuant to 37 CFR 1.957(d), a Notice will be mailed to the patent owner. The Notice will be issued by the examiner and will permit the patent owner to exercise one of the following two options:
>
> (A) Submit a re-drafted response that does not exceed the page limit set by 37 CFR 1.943; or
>
> (B) File a copy of the supplemental response with pages redacted to satisfy the 37 CFR 1.943 page limit requirement.
>
> The Notice will set a period of 15 days from the date of the notice to respond. If no response is received, the improper patent owner submission will not be considered. If the submission was necessary to respond to an outstanding Office action, the prosecution of the reexamination proceeding is either terminated pursuant to 37 CFR 1.957(b) or limited pursuant to 37 CFR 1.957(c). Any previously submitted third party comments in response to this improper patent owner submission would also not be considered, as being moot, since the patent owner did not in fact respond to the Office action in accordance with the rules.
>
> If a response to the Notice is received, then under 37 CFR 1.947, the third party requester may once file written comments, limited to issues raised by the Office action or the patent owner's response to the Notice, within 30 days from the date of service of the patent owner's response to the Notice.
>
> ****
>
> 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. (Emphasis added).

Patent Owner's Petition under 37 CFR 1.183

In patent owner's November 9, 2009 petition under 37 CFR 1.183, patent owner requests waiver of 37 CFR 1.943(b) for patent owner's April 30, 2009 response "by an amount commensurate with the papers that Patent Owner filed on April 30, 2009."[1] The October 23, 2009 notice of defective patent owner paper indicates that patent owner's April 30, 2009 response exceeds the 50-page limit of 37 CFR 1.943(b) by 22 pages.

In particular, the Central Reexamination Unit (CRU) determined that the April 30, 2009 response itself includes 33 pages of arguments and that the accompanying Mikos declaration includes 39 additional pages of arguments. While 37 CFR 1.943(b) excludes from the page limit count requirements, amendments, appendices of claims, and reference materials such as prior art references, as indicated in MPEP 2667(I)(A)(2), "[a]ny 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." Moreover, MPEP 2667(I)(A)(2) provides that "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."[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

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[1] Patent owner's petition under 37 CFR 1.183 at page 1. It is noted that in FN 1, on pages 2-3 of patent owner's petition under 37 CFR 1.183, patent owner challenges the page-length determination of the Central Reexamination Unit (CRU), which was set forth in the October 23, 2009 notice of defective patent owner paper, and requests reconsideration and withdrawal of the notice. Such a request challenging an action of the CRU would be properly presented as a petition under 37 CFR 1.181. Accordingly, the propriety of such relief is not addressed in this decision. *See* also 37 CFR 1.4(c), requiring each distinct subject, inquiry or order to be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects, particularly where the different matters are considered by different branches or sections of the Office.

[2] Partial pages of arguments are tallied as whole pages for purposes of the page-limit count.

limit, and submitting the resulting response, which is in excess of 50 pages.[3] Patent owner has further substantiated its request for waiver of the 50-page limit of 37 CFR 1.943(b) with specific facts set forth in the November 9, 2009 petition under 37 CFR 1.183. For example, patent owner asserts that the outstanding Office Action "is 47 pages long, and presents 22 separate grounds of rejection for alleged anticipation or obviousness that are said to find basis in 14 prior publications."[4] Patent owner further asserts "that 50 pages are insufficient for its response to an Office Action of such magnitude and depth. As a point of reference on the facial insufficiency of 50-page limit, Patent Owner notes that the Request for Reexamination that appears to have served as a basis for the Office Action spans 220 pages (not including exhibits or additional numerous pages of claim charts)."[5] Additionally, 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. Given the analytical standards set forth in *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727 (2007), Patent Owner should be accorded adequate briefing space to tell the full and complete story...."[6]

Based on the specific facts set forth in patent owner's November 9, 2009 petition under 37 CFR 1.183, coupled with 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 April 30, 2009 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.[7] In particular, the 50-page limit of 37 CFR 1.943(b) is waived to the extent that the portions of patent owner's April 30, 2009 response and accompanying declarations, which are included in the regulatory page count (as determined by the CRU in the October 23, 2009 notice of defective patent owner paper), exceed the 50-page limit by 22 pages. Accordingly, patent owner's petition under 37 CFR 1.183 is granted to the extent that the page limit of 37 CFR 1.943(b) is waived as to 22 pages of the portions of patent owner's April 30, 2009 response and accompanying declarations, which are included in the regulatory page count, exceed the 50-page limit.

Third Party Requester's Petition under 37 CFR 1.183

In its November 17, 2009 petition under 37 CFR 1.183, third party requester requests waiver of 37 CFR 1.943(b) for requester's June 1, 2009 response "by an amount commensurate with the

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[3] Patent owner states on page 2 of the petition under 37 CFR 1.183, "as is clear from even a cursory review of the Mikos declaration, the statements made there are necessary for Patent Owner to adequately defend itself. Given the CRU's characterization of the Mikos declaration, fifty pages simply do not afford Patent Owner due process in addressing the specific allegations that are set forth in the outstanding Office Action."

[4] Patent owner petition under 37 CFR 1.183 at page 1.

[5] Patent owner petition under 37 CFR 1.183 at page 2.

[6] Patent owner petition under 37 CFR 1.183 at page 2.

[7] It is noted that patent owner's January 9, 2009 petition under 37 CFR 1.183 requested waiver of 37 CFR 1.943(b) to the extent that patent owner be permitted a total of 150 pages in which to respond to the December 31, 2008 Office action. On January 27, 2009, the Office dismissed the January 9, 2009 petition under 37 CFR 1.183 because, among other reasons, petitioner failed to point out the specifics of what would require 150 pages, and why, given that there are 47 pages of Office action. By attempting to draft a response, and submitting the resulting April 30, 2009 response, which is in excess of 50 pages, patent owner has established that 22 additional pages are needed to respond to the December 31, 2008 Office action (as opposed to 100 additional pages).

papers that Requester filed on June 1, 2009."[8] The October 23, 2009 notice of defective requester paper indicates that requester's June 1, 2009 response exceeds the 50-page limit of 37 CFR 1.943(b) by 115 pages. In particular, the CRU determined that the June 1, 2009 response itself includes 50 pages of arguments and that the accompanying Schwartz and Hubbell declarations contain an additional 115 pages of arguments. As indicated above, while 37 CFR 1.943(b) excludes from the page limit count requirements, amendments, appendices of claims, and reference materials such as prior art references, as indicated in MPEP 2667(I)(A)(2), "[a]ny 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." Moreover, MPEP 2667(I)(A)(2) provides that "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."[9]

Requester's June 1, 2009 comments submitted in response to the improper April 30, 2009 patent owner submission (now deemed to be page-length compliant pursuant to this decision) will not be considered, as being moot, since patent owner did not in fact respond to the Office action in accordance with the rules at the time of the April 30, 2009 submission. *See* MPEP 2667.

The November 17, 2009 third party requester petition under 37 CFR 1.183 contains comments directed **to the conduct of the patent owner** during the '1095 proceeding.[10] A reexamination proceeding, which is an administrative proceeding conducted under the provisions of the reexamination statute and rules, not a litigation before a court, is limited by the provisions of 37 CFR 1.906 to issues of patentability based on prior patents and printed publications. Thus, comments on party conduct are not proper in an *inter partes* reexamination proceeding as they are beyond the scope of reexamination. *See* MPEP 2658. Therefore, the November 17, 2009 third party requester petition under 37 CFR 1.183 is being expunged from the official file of the '1095 proceeding by closing the paper in the Office's Image File Wrapper (IFW) database. Papers which have been closed in the Office's IFW are not part of the official file, and are not available to the public. Any future submission of a paper that contains issues not within the scope of reexamination, such as any paper (including a petition) that raises conduct issues, will not be entered and will be expunged by closing the paper in the IFW for the '1095 proceeding.

However, given the totality of the facts and circumstances, it is deemed equitable to *sua sponte* waive the provisions of 37 CFR 1.943(b) to the extent that any written comments filed by third party requester (including the arguments portions of any accompanying declarations) after patent owner's response as set forth in this decision shall not exceed 92 pages.[11] **This waiver is**

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[8] Requester petition under 37 CFR 1.183 at page 1.

[9] Partial pages of arguments are tallied as whole pages for purposes of the page-limit count.

[10] *See, e.g.*, requester petition under 37 CFR 1.183 at pages 2-3

[11] The October 23, 2009 notice of defective patent owner paper indicates that 39 pages of arguments of the Mikos declaration are included in the page limit count. The Mikos declaration appears to be single-spaced and, therefore, would include approximately 59 pages of arguments at 1.5 line spacing. Accordingly, patent owner's response would exceed the 50-page limit by 42 pages had the Mikos declaration used 1.5 line spacing (33 pages of arguments

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.[12]

CONCLUSION

1. Patent owner's November 9, 2009 petition under 37 CFR 1.183 is granted to the extent that the page limit of 37 CFR 1.943(b) is waived as to 22 pages of the portions of patent owner's April 30, 2009 response and accompanying declarations, which are included in the regulatory page count (as determined by the CRU in the October 23, 2009 notice of defective patent owner paper), exceed the 50-page limit. This waiver makes the patent owner's April 30, 2009 response page-length compliant.

2. Third party requester's November 17, 2009 petition under 37 CFR 1.183 is being expunged from the official file of the '1095 proceeding by closing the paper in the Office's Image File Wrapper (IFW) database.

3. 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 92 pages in length. 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. The present decision now makes patent owner's April 30, 2009 response a page-length compliant paper; thus, the mailing date of this decision constitutes the service of the response on the parties. Accordingly, any **third party requester comments must be filed within 30 days from the date of this decision**.

4. Jurisdiction for the '1095 reexamination proceeding is returned to the CRU.

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

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examining Policy

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in the response itself plus 59 pages of arguments in the Mikos declaration at 1.5 line spacing is a total of 92 pages, which is 42 pages over the 50-page limit).

[12] *See* MPEP 2666.05(I). In the November 5, 2009 Miscellaneous Action, the Office clarifies the October 23, 2009 notice of defective requester paper, withdrawing the time period running against the third party requester was to take corrective action, and giving third party requester 30 days from the date of service of a proper, compliant response by patent owner to file comments.

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Inter Partes Reexamination Proceeding
Control No. 95/001,095
Filed: October 24, 2008
For: U.S. Patent No. 7,300,662

: **DECISION ON**
: **PETITION REQUESTING**
: **CLARIFICATION OF**
: **PROCEDURES REGARDING**
: **CONFIDENTIAL**
: **DOCUMENT SUBMISSION**

This is a decision on the paper titled "Petition Under 37 C.F.R. § 1.182 and § 1.183 for Clarification of the Procedures for Submission of Third Party Confidential Documents in Support of Patentability and to Refute Positions Taken by the Third Party Requester" filed September 8, 2009 by patent owner. This decision also addresses the third party requester's "Petition to Respond to Patent Owner's September 8, 2009 Petition for Clarification" filed September 17, 2009.

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

The petition fee under 37 CFR 1.17(f) for both petitions has been received by the Office.

The patent owner's petition is **GRANTED** and clarification of Office procedures is provided herein.

The third party requester's petition is **GRANTED** to the extent that the comments have been considered.

BACKGROUND

1. U.S. Patent 7,300,662 (the '662 patent) issued on November 27, 2007 with claims 1-25. Cordis Corporation is the owner of the '662 patent.

2. There are two civil litigations involving the '662 patent: (1) *Boston Scientific Corp. et al. v. Johnson & Johnson Inc. et al.*, U.S. District Court of Delaware, 1:07:cv 765 filed November 27, 2007, and (2) *Cordis Corp. v. Abbott Laboratories*, U.S. District Court of New Jersey, 3:07:cv 5636 filed November 27, 2007.

3. A request for *inter partes* reexamination of claims 1-25 of the '662 patent was filed October 24, 2008, by third party requester, Abbott Laboratories, and assigned control No. 95/001,095 (the '1095 proceeding).

4. *Inter partes* reexamination was ordered for claims 1-25 of the '662 patent on December 31, 2008. A non-final Office action was also issued on December 31, 2008.

5. On April 30, 2009, patent owner filed a response to the Dec. 31, 2008 Office action, after receiving an extension of time.

6. On June 1, 2009, the third party requester filed comments on the Dec. 31, 2008 Office action and patent owner's April 30, 2009 response. Along with the comments, the third party requester also filed a "Submission of Exhibit Under Seal" and a "Petition to Expunge Information Submitted under MPEP § 724.02".

7. On July 1, 2009, patent owner filed a petition to temporarily suspend reexamination proceeding '1095 to provide patent owner "an opportunity to establish a full, fair and complete record of evidence in support of patentability of the claims".

8. On July 13, 2009, the third party requester filed a petition to oppose patent owner's July 1, 2009 petition.

9. A decision dismissing patent owner's July 1, 2009 petition and addressing the third party requester's July 13, 2009 petition was issued July 23, 2009.

10. After the July 23, 2009 decision, patent owner filed a reply to requester's July 13, 2009 petition on July 24, 2009, and the third party requester filed an objection to patent owner's reply on July 29, 2009. Both papers are improper and are being expunged from the record by a decision mailed concurrently herewith.

11. On September 8, 2009, patent owner filed a petition requesting clarification of procedures for submission of third party confidential documents and to refute positions taken by the third party requester. This petition is the subject of the present decision.

12. On September 17, 2009, the third party requester filed a petition to respond to patent owner's September 8, 2009 petition for clarification. This petition is also the subject of the present decision.

13. On October 23, 2009, a notice regarding defective paper based on excessive length was issued to the patent owner for the April 30, 2009 response. A notice regarding defective paper based on excessive length was also issued to the third party requester for the June 1, 2009 comments. The defective June 1, 2009 comments have been closed, and are not part of the record for the proceeding.

14. On November 9, 2009, patent owner filed a response to the Oct. 23, 2009 notice and a petition requesting an increase in page limit.

15. On November 17, 2009, the third party requester filed a petition for waiver of page limit.

16. On December 2, 2009, patent owner filed a supplemental information disclosure statement with 58 information items, a submission of protective order materials, and a petition to expunge protective order materials.

17. On January 29, 2010, a decision was issued granting patent owner's November 9, 2009 petition for an increase of page limit making the April 30 patent owner response page length compliant. The decision also expunged the third party requester's November 17, 2009 petition for waiver of page limit as an improper paper and *sua sponte* granted a page limit waiver for up to 92 pages.

18. On March 1, 2010, the third party requester filed revised comments in response to the a October 23, 2009 notice along with a re-submission of the exhibit under seal, and a petition to expunge information submitted under MPEP § 724.02.

DECISION

I. RELEVANT RULES AND REGULATIONS

37 CFR § 1.182 Questions not specifically provided for.

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

37 CFR § 1.183 Suspension of rules.

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

37 CFR § 1.59. Expungement of information or copy of papers in application file.

(a)(1) Information in an application will not be expunged, except as provided in paragraph (b) of this section.

(2) Information forming part of the original disclosure (i.e., written specification including the claims, drawings, and any preliminary amendment specifically incorporated into an executed oath or declaration under § § 1.63 and 1.175) will not be expunged from the application file.

(b) An applicant may request that the Office expunge information, other than what is excluded by paragraph (a)(2) of this section, by filing a petition under this paragraph. Any petition to expunge information from an application must include the fee set forth in § 1.17(g) and establish to the satisfaction of the Director that the expungement of the information is appropriate in which case a notice granting the petition for expungement will be provided.

(c) Upon request by an applicant and payment of the fee specified in § 1.19(b), the Office will furnish copies of an application, unless the application has been disposed of (see § § 1.53(e), (f) and (g)). The Office cannot provide or certify copies of an application that has been disposed of.

37 CFR 1.947. Comments by third party requester to patent owner's response in inter partes reexamination.

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

37 CFR 1.948. Limitations on submission of prior art by third party requester following the order for inter partes reexamination.

(a) After the inter partes reexamination order, the third party requester may only cite additional prior art as defined under § 1.501 if it is filed as part of a comments submission under § 1.947 or § 1.951(b) and is limited to prior art:
(1) which is necessary to rebut a finding of fact by the examiner;
(2) which is necessary to rebut a response of the patent owner; or
(3) which for the first time became known or available to the third party requester after the filing of the request for inter partes reexamination proceeding. Prior art submitted under paragraph (a)(3) of this section must be accompanied by a statement as to when the prior art first became known or available to the third party requester and must include a discussion of the pertinency of each reference to the patentability of at least one claim.

MPEP 724 Trade Secret, Proprietary, and Protective Order Materials (in part)

Parties bringing information to the attention of the Office for use in the examination of applications and reexaminations are frequently faced with the prospect of having legitimate trade secret, proprietary, or protective order material disclosed to the public.
Inventors and others covered by 37 CFR 1.56(c) and 1.555 have a duty to disclose to the Office information they are aware of which is material to patentability. 37 CFR 1.56(b) states that

> information is material to patentability when it is not cumulative to information already of record or being made of record in the application, and
> (1) It establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim; or
> (2) It refutes, or is inconsistent with, a position the applicant takes in:
> (i) Opposing an argument of unpatentability relied on by the Office, or
> (ii) Asserting an argument of patentability.

A prima facie case of unpatentability is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.

It is incumbent upon patent applicants, therefore, to bring "material" information to the attention of the Office. It matters not whether the "material" information can be classified as a trade secret, or as proprietary material, or whether it is subject to a protective order. The obligation is the same; it must be disclosed if "material to patentability" as defined in 37 CFR 1.56(b). The same duty rests upon a patent owner under 37 CFR 1.555 whose patent is undergoing reexamination.

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

The types of materials or information contemplated for submission under MPEP § 724.02 include information "material to patentability" but does not include information favorable to patentability. Thus, any trade secret, proprietary, and/or protective order materials which are required to be submitted on behalf of a patent applicant

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

MPEP 724.04(c) Materials Submitted in Reexamination File Open to the Public Under 37 CFR 1.11(d)

Any materials, i.e., information, submitted under MPEP § 724.02 in a reexamination file open to the public under 37 CFR 1.11(d) will be treated in the following manner:

(A) Any materials, i.e., information, properly submitted under MPEP § 724.02 in a reexamination proceeding will be sealed from public view. The submitted information will be maintained separate from the reexamination file and will not be publicly available until a determination has been made as to whether or not the information is material to patentability. A petition to expunge (37 CFR 1.59) should accompany the submission of proprietary materials, and in any event, must be filed prior to, or shortly after (i.e., in time to be addressed before the reexamination proceeding enters the reexamination certificate printing process), the mailing of a Notice of Intent to Issue Reexamination Certificate (NIRC). If the petition to expunge is not filed in time to be addressed before the reexamination proceeding enters the reexamination certificate printing process, or the petition is filed, and denied/dismissed, then the materials submitted under MPEP § 724.02 will be released to the public with any other papers in the reexamination file.
(B) Prior to the mailing of a NIRC, the examiner will review the reexamination file and determine if a petition to expunge is in the reexamination file but not acted upon. The examiner, or other appropriate Office official who is responsible for considering the information, will make a determination as to whether or not any portion or all of the information submitted is material to patentability.
(C) If any portion or all of the submitted information is found to be material to patentability, the petition to expunge will be denied and the information will thereafter become a permanent part of the reexamination file and open to the public. Where a submission containing protected material is found to be material to patentability, it still may be possible to redact the submission to eliminate the protected material while retaining the important material (e.g., where a confidential identifying number, such as a serial number or social security number, is included, which is not needed for the context of the submission). If so, the redacted version may be submitted to the Office along with a petition under 37 CFR 1.182 requesting that the unredacted version be sealed and be replaced with the redacted version.
(D) If all of the submitted information is found not to be material to patentability, the petition to expunge will be granted and the information expunged. If a portion of the submitted information is found not to be material to patentability, and a portion is found to be material to patentability, the petition to expunge will be dismissed, and patent owner (or the requester, in limited instances where appropriate) provided with an opportunity to separate the material and non-material information, such that the non-material information can be expunged. See item (C) above.
(E) If a petition to expunge is not filed prior to, or shortly after (i.e., in time to be addressed before the reexamination proceeding enters the reexamination certificate printing process), the mailing of the NIRC, the materials submitted under MPEP § 724.02 will become a permanent part of the reexamination file and open to the public under 37 CFR 1.11(d). In the event materials have already been made of record by a party, and it is subsequently determined that the materials are protected, the proper petition to submit would be a petition to seal the protected material under 37 CFR 1.182, with the requisite fee.
(F) Any petition to expunge a portion or all of the submitted information under 37 CFR 1.59(b) will be treated in accordance with MPEP § 724.05.

II. DECISION

1. Patent Owner's Request

Patent owner requests clarification of the procedures for submission of documents under seal. Specifically, patent owner requests clarification of procedures that apply to submissions of

confidential documents that support patentability and/or refute positions taken by the requester during a reexamination proceeding.

Patent owner asserts that they have identified over fifty documents that are subject to protective orders in the above-cited copending litigations and contain objective evidence bearing on the patentability of patent owner's claims. Although not specifically explained how the objective evidence is relevant, the petition implies that the evidence bearing on the patentability includes evidence of secondary considerations and objective indicia of nonobviousness. Patent owner asserts that approval to submit specifically identified documents that are covered by the protective order was requested from the third party requester and was not granted. Patent owner requests clarification of procedures for submitting this confidential evidence supporting patentability and/or refuting positions taken by requester or establishment of such procedures.

2. Third Party Requester's Opposition

Third party requester petitions to be heard in response to patent owner's request for clarification, because the third party requester believes that the patent owner's positions, if accepted, would (a) fundamentally violate the patent statute and third party requesters' statutory and due process rights and (b) significantly alter and adversely impact the procedures for all reexamination proceedings involving litigated patents. Specifically, third party requester seeks to inform the Office of a number of points outlined on pages 2 and 3 of the requester petition. It is noted that requester has agreed to retain its information for the life of the patent in the petition accompanying the June 1, 2009 Submission of Exhibit Under Seal.

3. The Materials Submitted Under Seal and Protective Order in this Proceeding

To date, the following materials have been submitted under seal and have been alleged to be covered by protective orders. It is noted that copies of the applicable protective orders have not been filed in this proceeding.

On December 2, 2009, the patent owner submitted a sealed box containing materials identified as being subject to two different protective orders. The box was submitted with a Supplemental Information Disclosure Statement in which the patent owner "makes no representation that any of the items are material, enabled references or prior art to the claims under reexamination." The box includes 58 items of information, some of which are identified as deposition transcripts and others which appear to be publicly available publications based on their description. The box was accompanied by a petition to expunge protective order materials. The petition states that "the Protective Order Material would not be important to a reasonable examiner in deciding whether any claim of the above referenced application is patentable for reasons stated in the Protective Order Material."

On March 1, 2010 the third party requester resubmitted the materials originally submitted on June 1, 2009, that included sealed materials identified as being covered by a protective order. As the June 1 submission was deemed defective, only the materials and petition filed March 1, 2010 will be addressed. The sealed materials are identified as Exhibit 79 "07/23/2002 Letter re: PMA P020026" submitted in support of the March 1, 2010 comments after the first Office Action (see page 16 of the comments in which Ex. 79 is compared to Ex. 81 to show lack of criticality of the claimed dose range).

4. The Office Procedure

The Office has clearly prescribed procedures for filing information material to patentability that is covered by a protective order as outlined in MPEP 724 *et seq.* The procedure for filing such materials set forth in MPEP 724.02 accommodates material that is required to be submitted on behalf of the patent owner under 37 CFR 1.555 and affords such material special status. However, there are no statutes or rules that require the disclosure of information favorable to patentability. Therefore, as the Office does not require such material to be submitted, the Office does not give voluntary submissions of such information any special status. Protective order materials that are submitted in favor of patentability will be made of record in the file and should not be submitted under the procedures of MPEP 724.02.

No assertions have been made by patent owner that the material intended to be submitted or already submitted is material to patentability of any claims under reexamination and should be afforded special status. In fact, the papers submitted by patent owner with the protected material specifically state that the material would not be important to a reasonable examiner in deciding whether any claim is patentable. Given this statement, it is unclear why these materials are being submitted in this proceeding.

As for the protected material submitted by the third party requester, the Exhibit appears to be offered for comparison purposes. The exhibit does not appear to be submitted as prior art. The third party requester has not made a showing that the material is necessary to respond to a specific issue raised by the Office action or patent owner's response.

Absent a clear showing that the materials must be submitted to comply with a statute or rule governing the parties in this reexamination proceeding, the Office is unwilling to enter protected materials into the record. The materials have not been shown to qualify for protected status in accordance with the procedures of MPEP 724.02 and, if they were, they would only remain protected if they are found not be material to the patentability by the examiner. Thus, if the Office accepts these materials they will entered into the public file and will not be afforded protected status. In order to honor the court orders, therefore, the Office will not enter these materials absent the following. To gain entry and consideration of the materials, the parties must obtain an agreement between themselves that some limited form of the materials, such as a redacted version, may be submitted consistent with any limitations imposed by the protective order, or obtain permission from the court to submit the necessary materials in an acceptable form. The parties have recourse through the courts to request permission to submit necessary materials in this proceeding. Therefore, there are adequate remedies in existence to address this situation.

The parties have thirty (30) days from the date of this decision to obtain the necessary documentation that the protected materials may be submitted in this proceeding and become part of the public record. Absent such documentation, the materials will be expunged from the record and returned to the respective parties or made available to be picked up by the respective parties.

Further papers and petitions on this issue, other than those described immediately above, will not be entertained as there must be a limitation on party iterations of input, given the statutory mandate for special dispatch in reexamination. As provided in MPEP 2609:

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

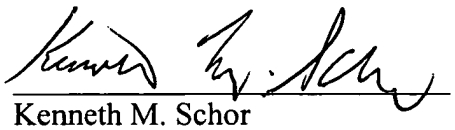
CONCLUSION

1. Patent owner's petition is granted to the extent that clarification of the procedures has been provided. Third party requester's petition has been granted to the extent that the arguments presented therein have been considered.

2. Both parties are given thirty (30) days to file documentation that agreement has been reached between the parties or permission to file has been given by the court in accordance with the protective order that certain protected documents will be submitted and become a part of the record in this proceeding.

3. Jurisdiction of this proceeding will remain with OPLA until such time that the requested documentation is received. If the requested documentation is not provided within the time period, the protected material will be expunged from the record and returned to the respective parties or the parties will be given an opportunity to retrieve the material. Jurisdiction will then be transferred to the Central Reexamination Unit to take action.

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



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

March 17, 2010
Kenpet8/expunge/Ct order

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.
95/001,095	10/24/2008	7300662	CRDS-0106	8887

45511 7590 05/26/2010

WOODCOCK WASHBURN LLP
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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 05/26/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patents and Trademark Office
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Alexandria, VA 22313-1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
Michael G. Raucci
SUGHRUE MION PLLC
2100 Pennsylvania Ave., NW, Suite 800
Washington, DC 20037

Date:
MAILED

MAY 26 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001095
PATENT NO. : 7300662
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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MAY 26 2010

CENTRAL REEXAMINATION UNIT

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(For Patent Owner)

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Inter Partes Reexamination Proceeding
Control No. 95/001,095
Filed: October 24, 2008
For: U.S. Patent No. 7,300,662

DECISION DISMISSING REQUEST FOR ADDITIONAL TIME, RETURNING IMPROPER PAPER, & DISMISSING PETITIONS TO EXPUNGE

This is a decision addressing:

(1) the petition filed April 16, 2010 by patent owner entitled "Petition Under 37 CFR §§ 1.182 and 1.956 With Respect to Submission of Materials Under Seal";

(2) the miscellaneous paper filed April 19, 2010 by the third party requester entitled "Requester's Confirmation of No Party Agreement or Court Order per the PTO's Clarification Petition Rulings Mailed on March 18-19, 2010";

(3) the petition filed December 2, 2009 by patent owner entitled "Petition to Expunge Protective Order Materials Pursuant to 37 CFR 1.59";

(4) the petition filed March 1, 2010 by third party requester entitled "Petition to Expunge Information Submitted Under MPEP § 724.02"; and,

(5) the petition filed May 11, 2010 by patent owner entitled "Petition to Expunge Protective Order Materials Pursuant to 37 CFR 1.59."

The proceeding, the petitions, and the miscellaneous paper are before the Office of Patent Legal Administration for consideration.

Patent owner's petitions and the third party requester's petition were each accompanied by a fee of $200 in accordance with 37 CFR 1.17(g). The third party requester's miscellaneous letter was not accompanied by a fee.

DECISION

(1) In a March 19, 2010 Decision by the Office, patent owner and requester were given thirty days to file, with respect to proffered protected materials, documentation that agreement has been reached between the parties to file the materials, or that permission to file has been given by the court. Such has not been done, and the thirty days have expired.

(2) The April 16, 2010 patent owner petition requests that the time period to submit documentation that the protected materials may be submitted in this proceeding be extended two weeks after the court's determination has been made. The petition states that patent owner is in the process of procuring the type of documentation identified in the March 19, 2010 Decision and states that it "intends" to seek the Magistrate's assistance in one concurrent litigation and "intends" to follow the judge's procedures for requesting assistance in the other proceeding. As patent owner has provided no evidence that procedures have been initiated to obtain the court's permission other than expressing an *intent* to obtain the documentation, the request for an extension of time for an indeterminate period is dismissed.

(3) The April 19, 2010 third party requester miscellaneous letter is an improper filing, as it is not a submission of comments on a patent owner response to an outstanding Office action and is not a response in accordance with the March 19, 2010 Decision (i.e., it is not documentation that the protected materials can be submitted.) Both parties were advised that further papers and petitions on this issue, other than the necessary documentation, would not be entertained. The April 19, 2010 paper is therefore being expunged from the image file wrapper (IFW) by closing the paper and marking it as non-public.

(4) Given the expiration of the thirty days as set forth in part (1) of this decision, the following papers are being expunged from the record and will not be considered by the examiner during reexamination.

(A) The sealed box submitted December 2, 2009 by patent owner, which will be made available for pick up by the patent owner's representative upon request for the next thirty days. If no arrangements are made for pick up, the box and papers will be disposed of.

(B) The sealed envelope labeled Exhibit 79 "07/23/2002 Letter re: PMA P020026" filed on March 1, 2010 by the third party requester, which will be made available for pick up by the requester's representative upon request for the next thirty days. If no arrangements are made for pick up, the envelope will be disposed of.

(C) The sealed envelope submitted May 11, 2010 by patent owner, which will be made available for pick up by the patent owner's representative upon request for the next thirty days. If no arrangements are made for pick up, the box and papers will be disposed of.

The papers may be resubmitted for consideration when permission for submission is obtained despite the fact that the papers will become part of the public record should the examiner find the papers material to patentability.

Information covered by the court's protective orders is not to be submitted without evidence that permission has been granted for public disclosure of the information. **Further filings that include information covered by a protective order will be expunged until permission for submission**

has been provided in this proceeding. As no evidence has been submitted that Office personnel are permitted to review the information, it is inappropriate to submit such information and cause a potential violation of a protective order. It is not acceptable to submit the information with restrictions on who may or may not open and review the information as it prohibits the Office from processing the filing. Further, it does not appear that either party has the authority to grant selective access to the protected information.

(5) The petitions to expunge filed with the sealed submissions on December 2, 2009 and May 11, 2010 by the patent owner and March 1, 2010 by the third party requester (which replaced the petition filed June 1, 2009) are also dismissed as moot by this decision as the sealed papers are no longer of record in the proceeding.

To arrange for pick up of the sealed papers, telephone inquiries are to be directed to Manuel Saldana at (571) 272-7740.

Telephone inquiries with regard to the substance of the decision should be directed to Caroline D. Dennison, Legal Advisor, at (571) 272-7729.

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

May 26, 2010
Kenpet8

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CENTRAL REEXAMINATION UNIT

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(For Patent Owner)

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(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,095
Filed: October 24, 2008
For: U.S. Patent No. 7,300,662

DECISION DISMISSING REQUEST FOR RECONSIDERATION

This is a decision addressing the June 4, 2010 patent owner's request for reconsideration of the May 26, 2010 petition decision that dismissed patent owner's request for an extension of time.

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

Patent owner's request for reconsideration is dismissed. No extension of time is granted for providing evidence of permission from both courts that information covered by their respective protective orders may be submitted and potentially made public in this proceeding. As explained in the May 26 decision, the information may be resubmitted for possible consideration when the parties provide proper documentation.

However, expungement of the information is temporarily held in abeyance based on new assertions by patent owner in the request for reconsideration that the information is patent owner's own confidential information. Based on these assertions, the Office will permit either party to provide a statement in conformance with the requirements below that the information submitted is its own confidential information and that the respective party has the authority to waive the confidentiality. If a proper statement is filed within fifteen (15) days of this decision, the information will not be expunged and may be considered by the examiner, provided it is deemed a compliant submission. Absent such a statement, the respective parties' information will be destroyed if not picked up as directed in the May 26, 2010 decision.

Detailed Response to Request for Reconsideration

In the request for reconsideration, patent owner asserts that the decision has incorrectly characterized certain facts regarding actions taken with the court by patent owner. This assertion is not accurate. Patent owner's April 16, 2010 petition failed to provide any evidence that court proceedings had been initiated. In fact, the section quoted in the present petition shows that the prior petition merely explained the procedure and did not state that patent owner had begun proceedings. The Office is not privy to actions that occurred after filing of the petition, and it must rely on evidence and statements provided by the petitioner. The evidence now provided by patent owner is a letter to one of the courts that is dated April 21, 2010, which is *subsequent* to the April 16 petition. As such, this letter does not support patent owner's assertion that proceedings had been initiated with the court prior to filing the April 16 petition. Moreover, patent owner has previously asserted that there are protective orders from TWO courts involving the patent in this proceeding, yet the evidence submitted relates to only court.

The facts have been correctly characterized and do not support patent owner's assertions. There is no valid reason for granting an extension of time, which at present would still have no fixed end date, as the information can be resubmitted. As explained in the prior decision, it is the Office's statutory duty to conduct reexamination proceedings with special dispatch. Granting an indefinite extension of time would not serve this purpose and would only serve to slow proceedings.

Patent owner additionally asserts in the request for reconsideration that the information disclosure statements previously submitted in the proceeding do not include any documents that are subject to court review. Patent owner further explains that the information disclosure statements do not include the documents that are being evaluated by the court and that patent owner does not need permission of a court to submit them in this reexamination. This is a new assertion. It is noted that the previous information disclosure submissions at issue simply stated that the information was subject to court protective orders, with no further explanation. The court protective orders have not been submitted in this proceeding (with an explanation of how the relevant documents are not included within its ambit), and the Office has no way of evaluating whose confidential documents are being submitted. The April 16, 2010 petition also did not explain this, contrary to the assertions in the subject petition, and merely stated that the information disclosure statements contain "other types of litigation materials (including Patent Owner's confidential information)". Other types of litigation materials are not limited solely to patent owner's own information. Patent owner has not clearly stated on the record that the information is exclusively its own confidential information and that patent owner has the authority to waive the confidentiality if the information is found to be material to patentability.

Statement Regarding Confidentiality and Authority to Waive

Patent owner is provided one last opportunity to make clear what information is being submitted. The patent owner may submit the following statement within 15 days of this decision to avoid expungement of the information submitted under the protective orders. The statement must include the following:

a. An identification of the confidential information, including the title and the date it was submitted;

b. An identification of the protective order(s) that covers each item of confidential information;
c. A statement that the confidential information is entitled to special status in accordance with MPEP 724.02, because the information is required under 37 CFR 1.555 and not merely evidence in favor of patentability;[1]
d. A statement that all of the information sought to be submitted is patent owner's own confidential information and that patent owner has the authority to waive such confidentiality in the event the examiner deems the information material to patentability.

The third party requester may file an objection to the statement only if it can be shown, by evidence, that the statement is inaccurate, i.e., that the confidential information is third party requester's own information. Such an objection must be filed within fifteen (15) days of service of the patent owner's statement.

If patent owner submits a compliant statement, the identified information will not be expunged. Absent this statement, or if the third party requester files an acceptable objection or raises doubts as to the ownership of the information, the expungement procedure outlined in the May 26, 2010 decision will be followed. No further requests for consideration or arguments regarding this issue will be entertained.

The third party requester may also file a statement as set forth above for the information previously submitted, with the patent owner having the ability to object within the same fifteen (15) day time limits applying, i.e., fifteen (15) days from the date of this decision to make a statement with fifteen (15) days from date of service for an objection from patent owner. No extensions will be granted and no further arguments will be entertained. Prosecution will continue contemporaneously with this decision and any responsive statements.

* * *

Both parties are reminded of the requirements of 37 CFR 10.18(b)(1) and (b)(2).

* * *

The patent owner is required to notify the Office of the status of prior and concurrent proceedings in accordance with 37 C.F.R. 1.985(a). It has come to the attention of the Office that at least two district court cases related to this reexamination proceeding may have concluded. A paper advising the Office of the status of all related proceedings, including appeals and the status of the patent claims, should be filed as soon as possible in this proceeding with updates as necessary.

The request for reconsideration is dismissed.

[1] If the information is not required under 37 CFR 1.555, it will not be afforded special status. Information favorable to patentability, such as evidence of commercial success or other secondary considerations, should not be submitted under MPEP 724.02. Such information must be made of record in the proceeding. See MPEP 724.03. If such information is patent owner's own confidential information, patent owner must waive the privilege of confidentiality and have the information entered into the record to have it considered.

Telephone inquiries with regard to the substance of the decision should be directed to Caroline D. Dennison, Legal Advisor, at (571) 272-7729.

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

July 23, 2010
Kenpet8

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CENTRAL REEXAMINATION UNIT

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WASHINGTON, DC 20037

(For Third Party Requester)

In re Cordis Corporation
Inter Partes Reexamination Proceeding
Control No.: 95/001,096
Filed: October 24, 2008
For: U.S. Patent No. 7,217,286 B2

DECISION
GRANTING-IN-PART
PETITION

This is a decision on the patent owner petition January 9, 2009, entitled "Petition For Increase of Page Limit For Patent Owner's Response Pursuant to 37 CFR §§ 1.183 and 1.943(b)."

The petition and the above-captioned *inter partes* reexamination proceeding are before the Office of Patent Legal Administration for consideration.

For the reasons set forth below, patent owner's petition, taken as a 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 69 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

PETITION FEE

37 CFR 1.183 requires payment of the petition fee under 37 CFR 1.17(f), which is $400.00. Therefore, $400.00 has been charged to patent owner's Deposit Account No. 23-3050, as authorized in concluding paragraph of the present petition.

REVIEW OF SALIENT FACTS

1. U.S Patent number 7,217,286 ("the '286 patent") issued to Robert Falotico *et al* on May 15, 2007, from an application filed on August 24, 2006, and is assigned to Cordis Corporation.

2. On October 24, 2008, a request for *inter partes* reexamination of the '286 patent was filed by a third party requester, and assigned control number 95/001,096 ("the '1096 *inter partes* reexamination proceeding").

3. The '1096 *inter partes* reexamination proceeding was accorded a filing date of October 24, 2008.

4. An Order Granting *Inter Partes* Reexamination was mailed in the '1096 *inter partes* reexamination proceeding on December 22, 2008.

5. On December 22, 2008, a non-final Office action was mailed in which claims 1-5 of the patent were rejected.

6. On January 9, 2009, patent owner filed the present patent owner petition.

7. On January 14, 2009, the requester filed comments on the present patent owner petition concurrent with a petition under 37 CFR 1.183 to permit Office consideration of the comments. These filings will be addressed by a separate decision mailed on an even date with this decision.

DECISION

I. Applicable Regulatory Provisions

37 CFR 1.183 provides:

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

37 CFR 1.943(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. Findings and Analysis

The record shows that on January 9, 2009, the patent owner filed the present petition, in which patent owner requests a waiver of the requirements of 37 CFR 1.943(b) to permit the response to exceed the 50-page limitation set by that regulation for a patent owner's response.

In the present petition, patent owner specifically requests that the 37 CFR 1.943(b) 50-page limitation on the length of a patent owner response be waived to permit a 150 page response. Patent owner states that the non-final Office action dated November 21, 2008 comprises 69 pages and presents 66 grounds of rejection proposed by the Requester.

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 '1096 *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 69 pages in length is appropriate in the interest of justice. Petitioner has not pointed out the specifics of what will require 150 pages, and why.

Note that the page limit does not include appendices containing evidence only which are directed to facts.

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 69 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 with regard to this decision should be directed to Michael Cygan, Legal Advisor, at (571) 272-7700, or in his absence, to Pinchus Laufer at (571) 272-7726.

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

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CENTRAL REEXAMINATION UNIT

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In re *Cordis Corporation*
Inter Partes Reexamination Proceeding
Control No.: 95/001,096
Filed: October 24, 2008
For: U.S. Patent No. 7,217,286 B2

DECISION DISMISSING PETITION AND REFUSING ENTRY OF PAPER

This is a decision on third party requester's papers, filed on January 14, 2009, entitled "PETITION UNDER 37 CFR § 1.183 TO PERMIT REQUESTER COMMENTS ON PATENT OWNER PETITIONS FOR PAGE AND TIME LIMIT EXTENSIONS," and "REQUESTER COMMENTS ON PATENT OWNER PETITIONS FOR PAGE AND TIME LIMIT EXTENSIONS."

The January 14, 2009 third party requester papers are before the Office of Patent Legal Administration.

The January 14, 2009 third party requester comment is refused entry into the record, without consideration on the merits, for the reasons set forth below.

The January 14, 2009 third party requester petition under 37 CFR 1.183 is dismissed and refused entry into the record, for the reasons set forth below.

PETITION FEE

37 CFR 1.183 requires payment of the petition fee under 37 CFR 1.17(f), which is $400.00. Therefore, $400.00 has been charged to patent owner's Deposit Account No. 19-4880, as authorized in concluding paragraph of the present petition.

REVIEW OF FACTS

1. U.S Patent number 7,217,286 ("the '286 patent") issued to Robert Falotico *et al* on May 15, 2007, from an application filed on August 24, 2006, and is assigned to Cordis Corporation.

2. On October 24, 2008, a request for *inter partes* reexamination of the '286 patent was filed by a third party requester, and assigned control number 95/001,096 ("the '1096 *inter partes* reexamination proceeding").

3. The '1096 *inter partes* reexamination proceeding was accorded a filing date of October 24, 2008.

4. An Order Granting *Inter Partes* Reexamination was mailed in the '1096 *inter partes* reexamination proceeding on December 22, 2008.

5. On December 22, 2008, a non-final Office action was mailed in which claims 1-5 of the patent were rejected.

6. On January 9, 2009, patent owner filed a request for extension of time pursuant to 37 CFR 1.956 and a petition entitled "PETITION FOR INCREASE OF PAGE LIMIT FOR PATENT OWNER'S RESPONSE PURSUANT TO 37 CFR 1.183 AND 1.943(b)." These filings are addressed in separate decisions. The request for extension of time is being addressed by the Central Reexamination Unit.

7. On January 14, 2009, the requester filed the instant comments on the present patent owner petition concurrent with the instant petition under 37 CFR 1.183 to permit Office consideration of the comments.

8. The decision on the patent owner petition to increase the page limit under 37 CFR 1.183 is being mailed on an even date with this decision.

DECISION

I. RELEVANT STATUTES, REGULATIONS, AND EXAMINING PROCEDURE

35 U.S.C. § 314(b)(2) states:

> Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response..

37 CFR 1.939(a) states:

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

37 CFR 1.945(a) 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:

> 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 1.183 provides:

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

II. DISCUSSION

For the reasons set forth below, the January 14, 2009 third party requester comments and petition to enter such comments, filed in response to the patent owner's January 9, 2009

request for extension of time and petition under 37 CFR 1.183, do not have a right of entry in the '1096 proceeding.

A. Third Party Requester Comments are Not Permitted for Procedural Matters in *Inter Partes* Reexamination

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 petition under 37 CFR 1.183, requesting suspension of 37 CFR 1.953(b) for increase of page limit, however, is **not** a "response" to an Office action on the merits. [1] Neither is the patent owner's request for an extension of time. 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 request for extension of time or petition under 37 CFR 1.183 for suspension of the rules. [2]

A third party requester's paper commenting on a patent owner's extension of time request or petition to waive the page limit set out in 37 CFR 1.943(b) is a paper that is not permitted by the statute governing *inter partes* reexamination proceedings, and accordingly was not provided for (i.e., was not permitted) in the regulations that implemented the *inter partes* reexamination statute. Furthermore, third party requester's petition under 37 CFR 1.183 to waive the rules forbidding third party comments has not been granted as detailed below. Third party requester's January 14, 2009 paper commenting on the 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, the third party requester's January 14, 2009 paper commenting on the patent owner's January 9, 2009 petition under 37 CFR 1.183 does not have a right of entry into the record of the '1096 proceeding and, as such, is not an authorized paper. Because the third party requester's January 14, 2009 paper 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 '1096 proceeding. *See* MPEP 2267.

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[1] Pursuant to 37 CFR 1.937, an *inter partes* reexamination proceeding is to be conducted in accordance with 37 CFR 1.104 - 1.116. The term "response" is used in reexamination proceedings to avoid confusion with the word "reply," a term used in the context of *ex parte* reexamination proceedings in connection with the right of a third party requester to file a "reply" under 37 CFR 1.535 to a patent owner's statement. Thus, MPEP § 2666, entitled "Patent Owner Response to an Office Action," discusses the requirements for a patent owner's "response" to an Office action on the merits in terms of 37 CFR 1.111, a regulation which governs the filing of "reply" to an Office action.

[2] When a petition under 37 CFR 1.183 includes a paper that, upon granting of the petition, would trigger a right for comment or response by a third party requester, then an opportunity to provide such comment or response is given at the point where the paper is entered (if the petition is granted).

B. The Office Lacks Statutory Authority to Consider the Substance of the Petition

Third party requester, noting that the Code of Federal Regulations does not provide for a third party response to patent owner petitions to waive the page limit under 37 CFR 1.943(b) or for extensions of time, filed a petition on January 14, 2009 under 37 CFR 1.183 to waive any rules precluding such response. However, the rules cannot be waived to provide the third party requester the right to file a paper at the present stage in the '1096 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 or for an extension of time 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 January 14, 2009 petition, however, seeks to waive a requirement, that a requester response is allowed only in response to a patent owner's response on the merits, set forth in 35 U.S.C. § 314(b)(2). Accordingly, the Office is without statutory authority to consider the substance of the third party requester's January 14, 2009 petition paper. In this respect, the 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.

The requester petition includes comments, extraneous to the merits of the petition, relating to the merits of the patent owner petition for waiver of 37 CFR 1.943(b) and patent owner's request for an extension of time. For this reason, the petition paper filed by the third party requester will be excluded from the record of the '1096 proceeding. Because the third party requester's January 14, 2009 petition 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 '1096 proceeding. [3]

III. ADDITIONAL DISCUSSION

It should be noted that the patent owner's January 14, 2009 petition under 37 CFR 1.183 did not stay any periods for reply running in the '1096 proceeding, as "[t]he mere filing of a petition will not stay any period for response that may be running against the application, nor act as a stay of other proceedings." [4]

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[3] *See* MPEP 2267.

[4] *See* 37 CFR 1.181(f).

Parties are advised to take care to avoid characterizing submissions by other parties. Petitions having improper commentary unrelated to the merits of the petition are subject to return or expungement without treatment upon their merits.

Further note that 37 CFR 1.4(c) states that :

> 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.

In this case, requester's comments and petition are directed both to extension of time and a petition under 1.183, which are different matters handled by different sections of the Office and are thus improper papers. Parties should be cognizant of the requirement for separate papers for separate matters.

CONCLUSION

1. The third party requester's January 14, 2009 comments paper filed in response to the patent owner's January 9, 2009 petition under 37 CFR 1.183, requesting suspension of 37 CFR 1.943(b), is refused entry as it is an improper paper.

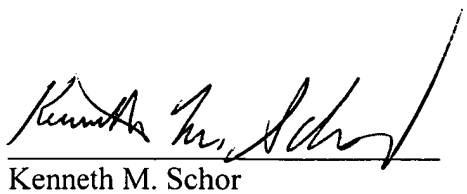
2. Because the January 14, 2009 paper was previously incorporated into the IFW, the paper is being expunged from the record by marking it "closed" and "non-public" in the IFW of the '1096 proceeding. No copy of the January 14, 2009 paper will be maintained of record in the Office.

3. The third party requester's January 14, 2009 petition filed in response to the patent owner's January 9, 2009 petition under 37 CFR 1.183, requesting suspension of 37 CFR 1.943(b), is dismissed.

4. The petition paper filed by the third party requester on January 14, 2009 is expunged from the record for including material 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 '1096 *inter partes* reexamination proceeding and marking the paper "closed" and "not public.

5. A copy of this decision will be made of record in the IFW record of the '1096 proceeding.

6. Telephone inquiries with regard to this decision should be directed to Michael Cygan, Legal Advisor, at (571) 272-7700, or in his absence, to Pinchus M. Laufer, Legal Advisor, at (571) 272-7726.



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

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(For Patent Owner)

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Sughrue Mion PLLC
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(For *Inter Partes* Requester)

In re Khankari et al.
Inter partes Reexamination Proceeding
Control No. 95/001,096
Filed: Oct. 24, 2008
For: U.S. Patent No. 7,217,286

:DECISION DISMISSING PETITION
:TO SUSPEND REEXAMINATION
:PROCEEDING

This decision is a decision on patent owner's July 1, 2009 petition titled "PETITION UNDER 37 CFR § 1.182 AND § 1.183 TO TEMPORARILY SUSPEND REEXAMINATION PROCEEDING 95/001,096. The petition requests that the Office temporarily suspend the present reexamination proceeding until September 21, 2009, which is asserted to be one month after the close of expert discovery in the co-pending litigation in the District Court involving the same patent. On July 13, 2008, requester filed an opposition paper titled 'REQUESTER'S PETITION TO OPPOSE PATENT OWNER'S JULY 1, 2009 PETITION TO SUSPEND *INTER PARTES* REEXAMINATION PROCEEDINGS" filed on July 13, 2009. This decision addresses both the patent owner and requester papers.

Patent Owner's petition to suspend is **DISMISSED**.

BACKGROUND

1. U.S. Patent No. 7,217,286 (the '286 patent) issued on May 15, 2007.

2. A request for reexamination of the '286 patent was filed on October 24, 2008. The request was assigned control No. 95/001,096 (the '1096 reexamination proceeding).

3. Reexamination was ordered for the '1096 reexamination proceeding on December 22, 2008. The examiner's order contained 35 pages. The Office also mailed a non-final rejection on the same date. The non-final rejection mailed was 69 pages in length.

4. On January 9, 2009, the patent owner filed an request for an extension of time to file a response the December 22, 2008 Office action, as well as a petition to waive the page limit rule under 37 CFR 1.943(b).

5. On January 23, 2009, the Office granted patent owner's request for an extension of time and granted a two-month extension of time. The patent owner's response was extended until April 22, 2009. On January 27, 2009, the Office granted patent owner's extension of pages limit to not exceed 69 pages.

6. On April 22, 2009 the Patent Owner filed a response to the December 31, 2008 Office action.

7. It is asserted that, in April 2009, the Patent Owner and Requester began discussions to authorize the patent owner to provide to the Office a copy of documents produced by the requester in the litigation being conduction in the U.S. District Court for the District of New Jersey that is styled *Wyeth and Cordis Corp. v. Abbott Laboratories et al*, Civil Action No. 07-5636.

8. On May 22, 2009, the third party requester submitted comments after patent owner's response of April 22, 2009.

9. On June 1, 2009, requester also filed a petition to expunge information submitted pursuant to MPEP. The specific exhibit requested to be expunged is exhibit 79 which is asserted to be subject to a protective order.

10. On July 1, 2009, the patent owner submitted the present petition to pursuant to 37 CFR 1.182 and 1.183 to temporarily suspend the *'1095* reexamination proceeding.

11. On July 13, 2009, the requester filed an opposition to the patent owner's petition to temporarily suspend the '1095 reexamination proceeding.

12. No Office actions are outstanding (i.e., none are awaiting response) in the present proceeding.

13. The District Court litigation has not been stayed pending resolution of this reexamination proceeding.

RELEVANT LAW AND REGULATIONS

37 CFR 1.182 provides:

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

37 CFR 1.183 provides:

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

37 CFR 1.939 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.

35 U.S.C. 305 provides:

After the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title. In any reexamination proceeding under this chapter, the patent owner will be permitted to propose any amendment to his patent and a new claim or claims thereto, in order to distinguish the invention as claimed from the prior art cited under the provisions of section 301 of this title, or in response to a decision adverse to the patentability of a claim of a patent. No proposed amended or new claim enlarging the scope of a claim of the patent will be permitted in a reexamination proceeding under this chapter. All reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office.

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.

35 U.S.C. 317(b) provides:

(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.

PATENT OWNER'S ARGUMENTS

1. Additional time is necessary to obtain authorization to submit evidence in support of patentability that is obtained through the discovery process in the District Court litigation.
2. Entry into Office's Appeal Process Prior to Resolution of the Protective Order Issue in the District Court Litigation would deprive Patent Owner of the ability to adequately defend the Patent Owner's patent
3. A temporary suspension of an *Inter Partes* Reexamination proceeding is not precluded under *Ethicon v. Quigg* 849 F. 2d. 1422 (Fed. Cir. 1998).

REQUESTER'S ARGUMENTS

1. The Patent Statute and MPEP mandate that the reexam be conducted with special dispatch.

2. Patent Owner's arguments for temporary staying the proceeding would eviscerate the *inter partes* statute for litigated patents, since such stays would effectively guarantee that the litigation would end prior to *inter partes* reexamination, thus terminating the reexaminations mid-course.

3. Patent Owner has already delayed the '1095 reexamination proceeding by filing significant extensions of time for its responses.

4. Patent Owner complained of Office delay when successfully opposing a stay of litigation and then filed request for such delay in the '1095 proceeding.

5. A stay is not necessary, because Patent Owner will have an opportunity to the next Office action by the Office.

6. The rationale of the Federal Circuit's decision in *Ethicon v. Quigg* - that reexams generally should not be stayed pending litigation given Congress's "special dispatch" mandate- applies even stronger to *inter partes* reexamination since, unlike, *ex parte* reexamination, *inter partes* reexam are terminated early if not completed before the litigation ends.

ANALYSIS AND FINDINGS

As asserted by both Patent Owner and Requester, 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 an indefinite length of time in an *ex parte* reexamination, and, accordingly is not controlling authority on the present issue.

Patent owner argues that (1) additional time is necessary to obtain authorization to submit evidence in support of patentability that is obtained through the discovery process and (2) entry into the appeal process prior to resolution of the protective order issued in the District Court litigation would deprive patent owner of ability to adequately defend its patent rights.

Patent owner argues that evidence has been obtained through the discovery process in the co-pending litigation and it is reasonable to believe that additional information in support of patentability of the claims will be discovered through pre-trial discovery of expert witnesses is lacking in detail. The patent owner, however, does not establish a reasonable basis of the specifics it would expect to find. Patent owner does not provide any guidance and explanation as what information it is expected to find during expert discovery, and how that information would be expected to be relevant to this proceeding. To the extent that patent owner is relying on future discovery, patent owner's request is based upon speculation.

In addition, as pointed out by requester, the granting of stays based upon on-going 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.

Patent Owner has not met its burden of showing good cause as to why such proceeding should be temporarily stayed pending conclusion of the of the discovery period in the on-going litigation in the District Court proceeding. Accordingly, the petition is dismissed.

As to obtaining entry of additional evidence (obtained through the discovery process) into a reexamination proceeding after the filing of an appeal and the limit the ability for a party to enter additional evidence after an Action Closing Prosecution (ACP):

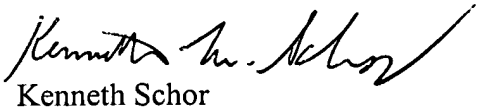
Patent owner has potential remedies pursuant to 37 CFR 1.116, 37 CFR 1.182, 37 CFR 1.183 and 37 CFR 1.951. For example, if patent owner is addressing issues raised in the Office action closing prosecution, then such evidence may be admitted as part of a 37 CFR 1.951 submission, subject to the criteria of 37 CFR 1.116. If the patent owner cannot avail itself to 37 CFR 1.116 and 37 CFR 1.951, patent owner has recourse to filing a petition pursuant to either 37 CFR 1.182 or 37 CFR 1.183, whichever may be relevant. Patent Owner is not being denied due process rights, and will have opportunity to have such evidence in its next response, if seasonably submitted with a showing to that effect, and the evidence is of the nature permitted in reexamination. Should the proceeding reach the point where an appellant brief is due prior to the asserted September 21, 2009 close of expert discovery (plus time to consider the results of the discovery), patent owner may request an extension of time by filing a petition under 37 CFR 1.183 to waive 37 CFR 41.66(a), providing the details of the need for the extension.

CONCLUSION

1. Patent Owner's petition under 37 CFR 1.182 and 1.183 to temporarily suspend the present reexamination proceeding is **DISMISSED**.

2. Jurisdiction is being returned to the Central Reexamination.

3. Questions concerning this decision should be addressed to Kery A. Fries, Senior Legal Advisor, at 571-272-7757.



Kenneth Schor
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy

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Inter Partes Reexamination Proceeding
Control No. 95/001,096
Filed: October 24, 2008
For: U.S. Patent No. 7,217,286

: **DECISION ON**
: **PETITION REQUESTING**
: **CLARIFICATION OF**
: **PROCEDURES REGARDING**
: **CONFIDENTIAL**
: **DOCUMENT SUBMISSION**

This is a decision on the paper titled "Petition Under 37 C.F.R. § 1.182 and § 1.183 for Clarification of the Procedures for Submission of Third Party Confidential Documents in Support of Patentability and to Refute Positions Taken by the Third Party Requester" filed September 8, 2009 by patent owner. This decision also addresses the third party requester's "Petition to Respond to Patent Owner's September 8, 2009 Petition for Clarification" filed September 17, 2009.

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

The petition fee under 37 CFR 1.17(f) for both petitions has been received by the Office.

The patent owner's petition is **GRANTED** and clarification of Office procedures is provided herein.

The third party requester's petition is **GRANTED** to the extent that the comments have been considered.

BACKGROUND

1. U.S. Patent 7,217,286 (the '286 patent) issued on May 15, 2007 with claims 1-5. Cordis Corporation is the owner of the '286 patent.

2. There following civil litigations involve the '286 patent: (1) *Boston Scientific Corp. et al. v. Johnson & Johnson Inc. et al.*, U.S. District Court of Delaware, 1:07cv333 filed May 25, 2007 (closed); (2) *Cordis Corp. v. Abbott Laboratories*, U.S. District Court of New Jersey, 3:07cv2265 filed May 15, 2007 (closed); (3) *Abbott Laboratories et al. v. Johnson & Johnson Inc. et al.*, U.S. District Court of Delaware, 1:07cv259 filed May 15, 2007 (closed); (4) *Boston Scientific Corporation et al. v. Cordis Corporation et al.*, U.S. District Court of New Jersey, 3:10cv296 filed January 20, 2010 (closed); (5) *Boston Scientific Corporation et al. v. Cordis Corporation et al.*, U.S. District Court of Minnesota, 0:09cv2585 filed September 22, 2009 (closed) .

3. A request for *inter partes* reexamination of claims 1-5 of the '286 patent was filed October 24, 2008, by third party requester, Abbott Laboratories, and assigned control No. 95/001,096 (the '1096 proceeding).

4. *Inter partes* reexamination was ordered for claims 1-5 of the '286 patent on December 22, 2008. A non-final Office action was also issued on December 22, 2008.

5. On April 22, 2009, patent owner filed a response to the Dec. 22, 2008 Office action, after receiving an extension of time.

6. On May 22, 2009, the third party requester filed comments on the Dec. 22, 2008 Office action and patent owner's April 22, 2009 response.

7. On July 1, 2009, patent owner filed a petition to temporarily suspend reexamination proceeding '1096 to provide patent owner "an opportunity to establish a full, fair and complete record of evidence in support of patentability of the claims".

8. On July 13, 2009, the third party requester filed a petition to oppose patent owner's July 1, 2009 petition.

9. A decision dismissing patent owner's July 1, 2009 petition and addressing the third party requester's July 13, 2009 petition was issued July 23, 2009.

10. After the July 23, 2009 decision, patent owner filed a reply to requester's July 13, 2009 petition on July 24, 2009, and the third party requester filed an objection to patent owner's reply on July 29, 2009. Both papers are improper and are being expunged from the record by a decision mailed concurrently herewith.

11. On September 8, 2009, patent owner filed a petition requesting clarification of procedures for submission of third party confidential documents and to refute positions taken by the third party requester. This petition is the subject of the present decision.

12. On September 17, 2009, the third party requester filed a petition to respond to patent owner's September 8, 2009 petition for clarification. This petition is also the subject of the present decision.

13. On December 2, 2009, patent owner filed a supplemental information disclosure statement with 58 information items, a submission of protective order materials, and a petition to expunge protective order materials.

DECISION

I. RELEVANT RULES AND REGULATIONS

37 CFR § 1.182 Questions not specifically provided for.

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

37 CFR § 1.183 Suspension of rules.

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

37 CFR § 1.59. Expungement of information or copy of papers in application file.

(a)(1) Information in an application will not be expunged, except as provided in paragraph (b) of this section.

(2) Information forming part of the original disclosure (i.e., written specification including the claims, drawings, and any preliminary amendment specifically incorporated into an executed oath or declaration under § § 1.63 and 1.175) will not be expunged from the application file.

(b) An applicant may request that the Office expunge information, other than what is excluded by paragraph (a)(2) of this section, by filing a petition under this paragraph. Any petition to expunge information from an application must include the fee set forth in § 1.17(g) and establish to the satisfaction of the Director that the expungement of the information is appropriate in which case a notice granting the petition for expungement will be provided.

(c) Upon request by an applicant and payment of the fee specified in § 1.19(b), the Office will furnish copies of an application, unless the application has been disposed of (see § § 1.53(e), (f) and (g)). The Office cannot provide or certify copies of an application that has been disposed of.

37 CFR 1.947. Comments by third party requester to patent owner's response in inter partes reexamination.

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

37 CFR 1.948. Limitations on submission of prior art by third party requester following the order for inter partes reexamination.

(a) After the inter partes reexamination order, the third party requester may only cite additional prior art as defined under § 1.501 if it is filed as part of a comments submission under § 1.947 or § 1.951(b) and is limited to prior art:

(1) which is necessary to rebut a finding of fact by the examiner;

(2) which is necessary to rebut a response of the patent owner; or

(3) which for the first time became known or available to the third party requester after the

filing of the request for inter partes reexamination proceeding. Prior art submitted under paragraph (a)(3) of this section must be accompanied by a statement as to when the prior art first became known or available to the third party requester and must include a discussion of the pertinency of each reference to the patentability of at least one claim.

MPEP 724 Trade Secret, Proprietary, and Protective Order Materials (in part)

Parties bringing information to the attention of the Office for use in the examination of applications and reexaminations are frequently faced with the prospect of having legitimate trade secret, proprietary, or protective order material disclosed to the public.
Inventors and others covered by 37 CFR 1.56(c) and 1.555 have a duty to disclose to the Office information they are aware of which is material to patentability. 37 CFR 1.56(b) states that

information is material to patentability when it is not cumulative to information already of record or being made of record in the application, and
(1) It establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim; or
(2) It refutes, or is inconsistent with, a position the applicant takes in:
(i) Opposing an argument of unpatentability relied on by the Office, or
(ii) Asserting an argument of patentability.

A prima facie case of unpatentability is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.

It is incumbent upon patent applicants, therefore, to bring "material" information to the attention of the Office. It matters not whether the "material" information can be classified as a trade secret, or as proprietary material, or whether it is subject to a protective order. The obligation is the same; it must be disclosed if "material to patentability" as defined in 37 CFR 1.56(b). The same duty rests upon a patent owner under 37 CFR 1.555 whose patent is undergoing reexamination.

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

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

MPEP 724.04(c) Materials Submitted in Reexamination File Open to the Public Under 37 CFR 1.11(d)

Any materials, i.e., information, submitted under MPEP § 724.02 in a reexamination file open to the public under 37 CFR 1.11(d) will be treated in the following manner:

(A) Any materials, i.e., information, properly submitted under MPEP § 724.02 in a reexamination proceeding will be sealed from public view. The submitted information will be maintained separate from the reexamination file and will not be publicly available until a determination has been made as to whether or not the information is material to patentability. A petition to expunge (37 CFR 1.59) should accompany the submission of proprietary materials, and in any event, must be filed prior to, or shortly after (i.e., in time to be addressed before the reexamination proceeding enters the reexamination certificate printing process), the

mailing of a Notice of Intent to Issue Reexamination Certificate (NIRC). If the petition to expunge is not filed in time to be addressed before the reexamination proceeding enters the reexamination certificate printing process, or the petition is filed, and denied/dismissed, then the materials submitted under MPEP § 724.02 will be released to the public with any other papers in the reexamination file.

(B) Prior to the mailing of a NIRC, the examiner will review the reexamination file and determine if a petition to expunge is in the reexamination file but not acted upon. The examiner, or other appropriate Office official who is responsible for considering the information, will make a determination as to whether or not any portion or all of the information submitted is material to patentability.

(C) If any portion or all of the submitted information is found to be material to patentability, the petition to expunge will be denied and the information will thereafter become a permanent part of the reexamination file and open to the public. Where a submission containing protected material is found to be material to patentability, it still may be possible to redact the submission to eliminate the protected material while retaining the important material (e.g., where a confidential identifying number, such as a serial number or social security number, is included, which is not needed for the context of the submission). If so, the redacted version may be submitted to the Office along with a petition under 37 CFR 1.182 requesting that the unredacted version be sealed and be replaced with the redacted version.

(D) If all of the submitted information is found not to be material to patentability, the petition to expunge will be granted and the information expunged. If a portion of the submitted information is found not to be material to patentability, and a portion is found to be material to patentability, the petition to expunge will be dismissed, and patent owner (or the requester, in limited instances where appropriate) provided with an opportunity to separate the material and non-material information, such that the non-material information can be expunged. See item (C) above.

(E) If a petition to expunge is not filed prior to, or shortly after (i.e., in time to be addressed before the reexamination proceeding enters the reexamination certificate printing process), the mailing of the NIRC, the materials submitted under MPEP § 724.02 will become a permanent part of the reexamination file and open to the public under 37 CFR 1.11(d). In the event materials have already been made of record by a party, and it is subsequently determined that the materials are protected, the proper petition to submit would be a petition to seal the protected material under 37 CFR 1.182, with the requisite fee.

(F) Any petition to expunge a portion or all of the submitted information under 37 CFR 1.59(b) will be treated in accordance with MPEP § 724.05.

II. DECISION

1. Patent Owner's Request

Patent owner requests clarification of the procedures for submission of documents under seal. Specifically, patent owner requests clarification of procedures that apply to submissions of confidential documents that support patentability and/or refute positions taken by the requester during a reexamination proceeding.

Patent owner asserts that they have identified over fifty documents that are subject to protective orders in the above-cited copending litigations and contain objective evidence bearing on the patentability of patent owner's claims. Although not specifically explained how the objective evidence is relevant, the petition implies that the evidence bearing on the patentability includes evidence of secondary considerations and objective indicia of nonobviousness. Patent owner asserts that approval to submit specifically identified documents that are covered by the protective order was requested from the third party requester and was not granted. Patent owner requests clarification of procedures for submitting this confidential evidence supporting patentability and/or refuting positions taken by requester or establishment of such procedures.

2. Third Party Requester's Opposition

Third party requester petitions to be heard in response to patent owner's request for clarification, because the third party requester believes that the patent owner's positions, if accepted, would (a)

fundamentally violate the patent statute and third party requesters' statutory and due process rights and (b) significantly alter and adversely impact the procedures for all reexamination proceedings involving litigated patents. Specifically, third party requester seeks to inform the Office of a number of points outlined on pages 2 and 3 of the requester petition.

3. The Materials Submitted Under Seal and Protective Order in this Proceeding

To date, the following materials have been submitted under seal and have been alleged to be covered by protective orders. It is noted that copies of the applicable protective orders have not been filed in this proceeding.

On December 2, 2009, the patent owner submitted a sealed box containing materials identified as being subject to two different protective orders. The box was submitted with a Supplemental Information Disclosure Statement in which the patent owner "makes no representation that any of the items are material, enabled references or prior art to the claims under reexamination." The box includes 58 items of information, some of which are identified as deposition transcripts and others which appear to be publicly available publications based on their description. The box was accompanied by a petition to expunge protective order materials. The petition states that "the Protective Order Material would not be important to a reasonable examiner in deciding whether any claim of the above referenced application is patentable for reasons stated in the Protective Order Material."

4. The Office Procedure

The Office has clearly prescribed procedures for filing information material to patentability that is covered by a protective order as outlined in MPEP 724 *et seq.* The procedure for filing such materials set forth in MPEP 724.02 accommodates material that is required to be submitted on behalf of the patent owner under 37 CFR 1.555 and affords such material special status. However, there are no statutes or rules that require the disclosure of information favorable to patentability. Therefore, as the Office does not require such material to be submitted, the Office does not give voluntary submissions of such information any special status. Protective order materials that are submitted in favor of patentability will be made of record in the file and should not be submitted under the procedures of MPEP 724.02.

No assertions have been made by patent owner that the material intended to be submitted or already submitted is material to patentability of any claims under reexamination and should be afforded special status. In fact, the papers submitted by patent owner with the protected material specifically state that the material would not be important to a reasonable examiner in deciding whether any claim is patentable. Given this statement, it is unclear why these materials are being submitted in this proceeding.

Absent a clear showing that the materials must be submitted to comply with a statute or rule governing the parties in this reexamination proceeding, the Office is unwilling to enter protected materials into the record. The materials have not been shown to qualify for protected status in accordance with the procedures of MPEP 724.02 and, if they were, they would only remain protected if they are found not be material to the patentability by the examiner. Thus, if the Office accepts these materials they will entered into the public file and will not be afforded protected status. In order to honor the court orders, therefore, the Office will not enter these materials absent the following. To gain entry and consideration of the materials, the parties must

obtain an agreement between themselves that some limited form of the materials, such as a redacted version, may be submitted consistent with any limitations imposed by the protective order, or obtain permission from the court to submit the necessary materials in an acceptable form. The parties have recourse through the courts to request permission to submit necessary materials in this proceeding. Therefore, there are adequate remedies in existence to address this situation.

The parties have thirty (30) days from the date of this decision to obtain the necessary documentation that the protected materials may be submitted in this proceeding and become part of the public record. Absent such documentation, the materials will be expunged from the record and returned to the respective parties or made available to be picked up by the respective parties.

Further papers and petitions on this issue, other than those described immediately above, will not be entertained as there must be a limitation on party iterations of input, given the statutory mandate for special dispatch in reexamination. As provided in MPEP 2609:

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

CONCLUSION

1. Patent owner's petition is granted to the extent that clarification of the procedures has been provided. Third party requester's petition has been granted to the extent that the arguments presented therein have been considered.

2. Both parties are given thirty (30) days to file documentation that agreement has been reached between the parties or permission to file has been given by the court in accordance with the protective order that certain protected documents will be submitted and become a part of the record in this proceeding.

3. Jurisdiction of this proceeding will remain with OPLA until such time that the requested documentation is received. If the requested documentation is not provided within the time period, the protected material will be expunged from the record and returned to the respective parties or the parties will be given an opportunity to retrieve the material. Jurisdiction will then be transferred to the Central Reexamination Unit to take action.

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

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

March 18, 2010
Kenpet8/expunge/Ct order

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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.
95/001,096	10/24/2008	7217286	CRDS-0109	8893

45511 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

David P. Emery
SUGHRUE MION PLLC
2100 Pennsylvania Ave, NW, Suite 800
Washington, DC 20037

Date:

MAILED

MAY 26 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001096
PATENT NO. : 7217286
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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Joseph Lucci
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(For Patent Owner)

MAILED

MAY 26 2010

CENTRAL REEXAMINATION UNIT

Michael G. Raucci
Sughrue Mion PLLC
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Washington, DC 20037

(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,096
Filed: October 24, 2008
For: U.S. Patent No. 7,217,286

DECISION DISMISSING REQUEST FOR ADDITIONAL TIME, RETURNING IMPROPER PAPERS & DISMISSING PETITIONS TO EXPUNGE

This is a decision addressing:

(1) the petition filed April 16, 2010 by patent owner entitled "Petition Under 37 CFR §§ 1.182 and 1.956 With Respect to Submission of Materials Under Seal";

(2) the miscellaneous paper filed April 19, 2010 by the third party requester entitled "Requester's Confirmation of No Party Agreement or Court Order per the PTO's Clarification Petition Rulings Mailed on March 18-19, 2010";

(3) the petition filed December 2, 2009 by patent owner entitled "Petition to Expunge Protective Order Materials Pursuant to 37 CFR 1.59"; and,

(4) the petition filed May 11, 2010 by patent owner requester entitled "Petition to Expunge Protective Order Materials Pursuant to 37 CFR 1.59."

The proceeding, the petitions, and the miscellaneous paper are before the Office of Patent Legal Administration for consideration.

Patent owner's petitions were each accompanied by a fee of $200 in accordance with 37 CFR 1.17(g). The third party requester's miscellaneous letter was not accompanied by a fee.

DECISION

(1) In a March 19, 2010 Decision by the Office, patent owner and requester were given thirty days to file, with respect to proffered protected materials, documentation that agreement has been reached between the parties to file the materials, or that permission to file has been given by the court. Such has not been done, and the thirty days have expired.

(2) The April 16, 2010 patent owner petition requests that the time period to submit documentation that the protected materials may be submitted in this proceeding be extended two weeks after the court's determination has been made. The petition states that patent owner is in the process of procuring the type of documentation identified in the March 19, 2010 Decision and states that it "intends" to seek the Magistrate's assistance in one concurrent litigation and "intends" to follow the judge's procedures for requesting assistance in the other proceeding. As patent owner has provided no evidence that procedures have been initiated to obtain the court's permission other than expressing an *intent* to obtain the documentation, the request for an extension of time for an indeterminate period is dismissed.

(3) The April 19, 2010 third party requester miscellaneous letter is an improper filing, as it is not a submission of comments on a patent owner response to an outstanding Office action and is not a response in accordance with the March 19, 2010 Decision (i.e., it is not documentation that the protected materials can be submitted.) Both parties were advised that further papers and petitions on this issue, other than the necessary documentation, would not be entertained. The April 19, 2010 paper is therefore being expunged from the image file wrapper (IFW) by closing the paper and marking it as non-public.

(4) Given the expiration of the thirty days as set forth in part (1) of this decision, the following papers are being expunged from the record and will not be considered by the examiner during reexamination.

(A) The sealed box submitted December 2, 2009 by patent owner, which will be made available for pick up by the patent owner's representative upon request for the next thirty days. If no arrangements are made for pick up, the box and papers will be disposed of.

(B) The sealed envelope submitted May 11, 2010 by patent owner, which will be made available for pick up by the patent owner's representative upon request for the next thirty days. If no arrangements are made for pick up, the box and papers will be disposed of.

The papers may be resubmitted for consideration when permission for submission is obtained despite the fact that the papers will become part of the public record should the examiner find the papers material to patentability.

Information covered by the court's protective orders is not to be submitted without evidence that permission has been granted for public disclosure of the information. **Further filings that include information covered by a protective order will be expunged until permission for submission has been provided in this proceeding.** As no evidence has been submitted that Office personnel are permitted to review the information, it is inappropriate to submit such information and cause a potential violation of a protective order. It is not acceptable to submit the information with restrictions on who may or may not open and review the information as it prohibits the Office from

processing the filing. Further, it does not appear that either party has the authority to grant selective access to the protected information.

(5) The petitions to expunge filed with the sealed submissions on December 2, 2009 and May 11, 2010 by the patent owner are also dismissed as moot by this decision as the sealed papers are no longer of record in the proceeding.

To arrange for pick up of the sealed papers, telephone inquiries are to be directed to Manuel Saldana at (571) 272-7740.

Telephone inquiries with regard to the substance of the decision should be directed to Caroline D. Dennison, Legal Advisor, at (571) 272-7729.

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

May 26, 2010
Kenpet8

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,096	10/24/2008	7217286	CRDS-0109	8893

45511 7590 06/02/2010

WOODCOCK WASHBURN LLP
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2929 ARCH STREET
PHILADELPHIA, PA 19104-2891

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/02/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

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Date:

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001096
PATENT NO. : 7217286
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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In re Application of 7217286 :
Appl. No.: 95/001,096 : **DECISION ON PETITION**
Filed: October 24, 2008 : **UNDER 37 CFR 1.59**
For: Local Delivery of Rapamycin For Treatment Of :
Proliferative Sequelae Associated With PTCA :
Procedures, Including Delivery Using A Modified :
Stent :
:

This is a decision on the petition under 37 CFR 1.59(b), filed May 4, 2010, to expunge information from the above identified application.

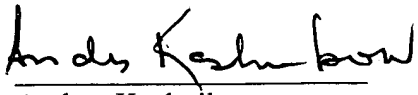
The petition is granted.

Petitioner requests that documents entitled Deposition of Dana Mead, April 23, 2009 consisting of 28 pages, and Deposition of Susan Silavin, November 5, 2008 consisting of 34 pages, filed April 16, 2010 as part of an Information Disclosure Statement, be expunged from the record. Petitioner states that either (A) that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in 37 CFR 1.17(g) has been paid.

The information in question has been determined by the undersigned to not be material to the examination of the instant application.

Applicant is required to retain the expunged material(s) for the life of any patent which issues on the above-identified application.

The expunged material has been removed from the official file. As the documents in question have been entered into the Electronic Image File Wrapper (IFW) record, the documents will be "returned" by closing the paper in the IFW record, and marking the paper nonpublic to expunge it from the record. The present decision will be made of record in the reexamination file.



Andres Kashnikow,
SPE CRU 3993
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Inter Partes Reexamination Proceeding
Control No. 95/001,096
Filed: October 24, 2008
For: U.S. Patent No. 7,217,286

DECISION DISMISSING REQUEST FOR RECONSIDERATION

This is a decision addressing the June 4, 2010 patent owner's request for reconsideration of the May 26, 2010 petition decision that dismissed patent owner's request for an extension of time.

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

Patent owner's request for reconsideration is dismissed. No extension of time is granted for providing evidence of permission from both courts that information covered by their respective protective orders may be submitted and potentially made public in this proceeding. As explained in the May 26 decision, the information may be resubmitted for possible consideration when the parties provide proper documentation.

However, expungement of the information is temporarily held in abeyance based on new assertions by patent owner in the request for reconsideration that the information is patent owner's own confidential information. Based on these assertions, the Office will permit either party to provide a statement in conformance with the requirements below that the information submitted is its own confidential information and that the respective party has the authority to waive the confidentiality. If a proper statement is filed within fifteen (15) days of this decision, the information will not be expunged and may be considered by the examiner, provided it is deemed a compliant submission. Absent such a statement, the respective parties' information will be destroyed if not picked up as directed in the May 26, 2010 decision.

Detailed Response to Request for Reconsideration

In the request for reconsideration, patent owner asserts that the decision has incorrectly characterized certain facts regarding actions taken with the court by patent owner. This assertion is not accurate. Patent owner's April 16, 2010 petition failed to provide any evidence that court proceedings had been initiated. In fact, the section quoted in the present petition shows that the prior petition merely explained the procedure and did not state that patent owner had begun proceedings. The Office is not privy to actions that occurred after filing of the petition, and it must rely on evidence and statements provided by the petitioner. The evidence now provided by patent owner is a letter to one of the courts that is dated April 21, 2010, which is *subsequent* to the April 16 petition. As such, this letter does not support patent owner's assertion that proceedings had been initiated with the court prior to filing the April 16 petition. Moreover, patent owner has previously asserted that there are protective orders from TWO courts involving the patent in this proceeding, yet the evidence submitted relates to only court.

The facts have been correctly characterized and do not support patent owner's assertions. There is no valid reason for granting an extension of time, which at present would still have no fixed end date, as the information can be resubmitted. As explained in the prior decision, it is the Office's statutory duty to conduct reexamination proceedings with special dispatch. Granting an indefinite extension of time would not serve this purpose and would only serve to slow proceedings.

Patent owner additionally asserts in the request for reconsideration that the information disclosure statements previously submitted in the proceeding do not include any documents that are subject to court review. Patent owner further explains that the information disclosure statements do not include the documents that are being evaluated by the court and that patent owner does not need permission of a court to submit them in this reexamination. This is a new assertion. It is noted that the previous information disclosure submissions at issue simply stated that the information was subject to court protective orders, with no further explanation. The court protective orders have not been submitted in this proceeding (with an explanation of how the relevant documents are not included within its ambit), and the Office has no way of evaluating whose confidential documents are being submitted. The April 16, 2010 petition also did not explain this, contrary to the assertions in the subject petition, and merely stated that the information disclosure statements contain "other types of litigation materials (including Patent Owner's confidential information)". Other types of litigation materials are not limited solely to patent owner's own information. Patent owner has not clearly stated on the record that the information is exclusively its own confidential information and that patent owner has the authority to waive the confidentiality if the information is found to be material to patentability.

Statement Regarding Confidentiality and Authority to Waive

Patent owner is provided one last opportunity to make clear what information is being submitted. The patent owner may submit the following statement within 15 days of this decision to avoid expungement of the information submitted under the protective orders. The statement must include the following:

a. An identification of the confidential information, including the title and the date it was submitted;

b. An identification of the protective order(s) that covers each item of confidential information;
c. A statement that the confidential information is entitled to special status in accordance with MPEP 724.02, because the information is required under 37 CFR 1.555 and not merely evidence in favor of patentability;[1]
d. A statement that all of the information sought to be submitted is patent owner's own confidential information and that patent owner has the authority to waive such confidentiality in the event the examiner deems the information material to patentability.

The third party requester may file an objection to the statement only if it can be shown, by evidence, that the statement is inaccurate, i.e., that the confidential information is third party requester's own information. Such an objection must be filed within fifteen (15) days of service of the patent owner's statement.

If patent owner submits a compliant statement, the identified information will not be expunged. Absent this statement, or if the third party requester files an acceptable objection or raises doubts as to the ownership of the information, the expungement procedure outlined in the May 26, 2010 decision will be followed. No further requests for consideration or arguments regarding this issue will be entertained.

The third party requester may also file a statement as set forth above for the information previously submitted, with the patent owner having the ability to object within the same fifteen (15) day time limits applying, i.e., fifteen (15) days from the date of this decision to make a statement with fifteen (15) days from date of service for an objection from patent owner. No extensions will be granted and no further arguments will be entertained. Prosecution will continue contemporaneously with this decision and any responsive statements.

* * *

Both parties are reminded of the requirements of 37 CFR 10.18(b)(1) and (b)(2).

* * *

The patent owner is required to notify the Office of the status of prior and concurrent proceedings in accordance with 37 C.F.R. 1.985(a). It has come to the attention of the Office that at least two district court cases related to this reexamination proceeding may have concluded. A paper advising the Office of the status of all related proceedings, including appeals and the status of the patent claims, should be filed as soon as possible in this proceeding with updates as necessary.

The request for reconsideration is dismissed.

[1] If the information is not required under 37 CFR 1.555, it will not be afforded special status. Information favorable to patentability, such as evidence of commercial success or other secondary considerations, should not be submitted under MPEP 724.02. Such information must be made of record in the proceeding. See MPEP 724.03. If such information is patent owner's own confidential information, patent owner must waive the privilege of confidentiality and have the information entered into the record to have it considered.

Telephone inquiries with regard to the substance of the decision should be directed to Caroline D. Dennison, Legal Advisor, at (571) 272-7729.

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

July 23, 2010
Kenpet8

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.
95/001,097	10/24/2008	7223286	CRDS-0108	8894

45511 7590 03/24/2009

WOODCOCK WASHBURN LLP
CIRA CENTRE, 12TH FLOOR
2929 ARCH STREET
PHILADELPHIA, PA 19104-2891

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/24/2009

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MAILED

MAR 2 4 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NUMBER *95/001,097*.

PATENT NUMBER *7,223,286*.

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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PHILADELPHIA, PA 19104-2891

(For Patent Owner)

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MAR 2 4 2009

CENTRAL REEXAMINATION UNIT

SUGHRUE MION PLLC
2100 PENNSYVANIA AVENUE, NW
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WASHINGTON, DC 20037

(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,097
Filed: October 24, 2008
For: U.S. Patent No. 7,223,286

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 January 11, 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. 23-3050 on February 11, 2009.

REVIEW OF THE RELEVANT FACTS

1. On May 29, 2007, United States Patent No. 7,223,286 (the '286 patent) issued to Wright *et al.*

2. On October 24, 2008, a request for *inter partes* reexamination of claims 1-77 of the '286 patent was filed by third party requester Michael G. Raucci, in which Abbott Laboratories was identified as the real party in interest. The request was assigned Reexamination Control No. 95/001,097 (the '1097 proceeding).

3. On December 19, 2008, *inter partes* reexamination was ordered in the '1097 proceeding for claims 1-77 of the '286 patent based on the examiner's determination that the October 24, 2008 request raised a substantial new question of patentability affecting these claims.

4. On January 30, 2009, an Office action was mailed in the '1097 proceeding, rejecting claims 1-77 of the '286 patent.

5. On February 11, 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))" concurrently with a paper entitled, "REQUEST FOR EXTENSION OF TIME TO RESPOND TO AN *INTER PARTES* REEXAMINATION OFFICE ACTION (37 C.F.R. § 1.956)" (request for extension of time).

6. Patent owner's period for responding to the January 30, 2009 Office action will end on March 30, 2009, absent a decision on patent owner's February 11, 2009 request for extension of time.

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 11, 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 January 30, 2009 Office action to 780 pages.[1] In support of waiver of the rule, patent owner asserts that the January 30, 2009 Office action is 303 pages long, and presents 142 separate grounds of rejection for alleged obviousness, said to find basis in 18 prior publications and alleged patent owner admissions.[2] Patent owner asserts that "the increase in pages is further necessitated by the fact that the outstanding grounds for rejection are for alleged obviousness" and that "[f]ifty pages are not adequate to address the specific allegations that are set forth in

[1] Petition at page 3 (noting that the request for reexamination spans 780 pages, excluding exhibits, and includes 25 additional pages of claim charts).
[2] Petition at pages 1-2.

the outstanding Office Action and incorporate references to the factual predicates set forth in the planned declarations and other evidence in attorney arguments."[3]

Further in support of waiver of the rule, patent owner asserts that while page-limit waivers corresponding to the length of the Office action were granted in two co-pending proceedings, patent owner is uncertain whether a comparable waiver would be adequate in the '1097 proceeding.[4] Rather, patent owner asserts that "[a]s a practical matter, Patent Owner, in order to be granted due process, needs at least the same page amounts that have been accorded to Third Party requester in its Request for Reexamination."[5]

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 780 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 equal to the number of pages of third party requester's request for reexamination; however, petitioner has not set forth with specificity the facts upon which petitioner based its determination that approximately 730 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 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 statements that patent owner needs at least the same number of pages as the request for reexamination for its response, 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.

---

[3] Petition at page 2 (indicating that patent owner intends to support its response with several factual declarations and other types of factual evidence).

[4] Petition at page 2 (referring to control no. 95/001,096, in which the page limit was increased to 69 pages, and control no. 95/001,102, in which the page limit was increased to 81 pages).

[5] Petition at page 3 (further indicating that patent owner's request is based on patent owner's understanding that pages of patent owner's accompanying factual declarations and other factual evidence will not be counted toward the 50-page limit).

Note that if the Office does not grant the 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 the petition. *See* MPEP 2667(I)(A)(2). Further, 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).[6]

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. 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
Senior Legal Advisor
Office of Patent Legal Administration

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3-23-08

[6] 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.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,097	10/24/2008	7223286	CRDS-0108	8894

45511 7590 03/24/2009

WOODCOCK WASHBURN LLP
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EXAMINER	
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MAR 2 4 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NUMBER *95/001,097*.

PATENT NUMBER *7,223,286*.

TECHNOLOGY CENTER *3999*.

ART UNIT *3993*.

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

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

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

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

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MAR 2 4 2009

CENTRAL REEXAMINATION UNIT

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(For Patent Owner)

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(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,097
Filed: October 24, 2008
For: U.S. Patent No. 7,223,286

: **DECISION**
: **DISMISSING**
: **PETITION AND**
: **REFUSING ENTRY**
: **OF PAPER**

This is a decision on third party requester's papers, filed on February 13, 2009, entitled "PETITION UNDER 37 CFR § 1.183 TO PERMIT REQUESTER OPPOSITION TO PATENT OWNER PETITIONS FOR PAGE AND TIME LIMIT EXTENSIONS" and "REQUESTER OPPOSITION TO PATENT OWNER PETITIONS FOR PAGE AND TIME LIMIT EXTENSIONS."

Third party requester's papers are before the Office of Patent Legal Administration for consideration.

The petition fee of $400.00 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183 was charged to third party requester's Deposit Account No. 19-4880 on February 17, 2009.

The February 13, 2009 third party requester opposition paper is refused entry into the record, without consideration on the merits, for the reasons set forth below. The February 13, 2009 third party requester petition under 37 CFR 1.183 is dismissed and refused entry into the record, for the reasons set forth below.

REVIEW OF THE RELEVANT FACTS

1. On May 29, 2007, United States Patent No. 7,223,286 (the '286 patent) issued to Wright *et al.*

2. On October 24, 2008, a request for *inter partes* reexamination of claims 1-77 of the '286 patent was filed by third party requester Michael G. Raucci, in which Abbott Laboratories was

identified as the real party in interest. The request was assigned Reexamination Control No. 95/001,097 (the '1097 proceeding).

3. On December 19, 2008, *inter partes* reexamination was ordered in the '1097 proceeding for claims 1-77 of the '286 patent based on the examiner's determination that the October 24, 2008 request raised a substantial new question of patentability affecting these claims.

4. On January 30, 2009, an Office action was mailed in the '1097 proceeding, rejecting claims 1-77 of the '286 patent.

5. On February 11, 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))" concurrently with a paper entitled, "REQUEST FOR EXTENSION OF TIME TO RESPOND TO AN *INTER PARTES* REEXAMINATION OFFICE ACTION (37 C.F.R. § 1.956)" (request for extension of time).

6. On February 13, 2009, third party requester filed the instant petition entitled, "PETITION UNDER 37 CFR § 1.183 TO PERMIT REQUESTER OPPOSITION TO PATENT OWNER PETITIONS FOR PAGE AND TIME LIMIT EXTENSIONS," concurrently with a paper entitled, "REQUESTER OPPOSITION TO PATENT OWNER PETITIONS FOR PAGE AND TIME LIMIT EXTENSIONS" (opposition paper).

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 1.939(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 1.945(a) provides:

> The patent owner will be given at least thirty days to file a response to any Office action on the merits of the inter partes reexamination.

37 CFR 1.947 provides:

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

37 CFR 1.183 provides:

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

II. DISCUSSION

For the reasons set forth below, the February 13, 2009 third party requester opposition paper and petition under 1.183 to enter such opposition paper, filed in response to patent owner's February 11, 2009 request for extension of time and petition under 37 CFR 1.183, do not have a right of entry in the '1097 proceeding.

A. Third Party Requester Comments are Not Permitted for Procedural Matters in *Inter Partes* Reexamination

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 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. [1] Neither is the patent owner's request for an extension of time. 35 U.S.C. § 314(b)(2)

[1] Pursuant to 37 CFR 1.937, an *inter partes* reexamination proceeding is to be conducted in accordance with 37 CFR 1.104 - 1.116. The term "response" is used in reexamination proceedings to avoid confusion with the word "reply," a term used in the context of *ex parte* reexamination proceedings in connection with the right of a third party requester to file a "reply" under 37 CFR 1.535 to a patent owner's statement. Thus, MPEP § 2666, entitled "Patent Owner Response to an Office Action," discusses the requirements for a patent owner's "response" to an Office action on the merits in terms of 37 CFR 1.111, a regulation which governs the filing of "reply" to an Office action.

does not provide any right for the third party requester to file comments on a patent owner's request for extension of time or petition under 37 CFR 1.183 for suspension of the rules. [2]

A third party requester's opposition paper in response to a patent owner's request for extension of time and 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 opposition paper has not been granted as detailed below. Third party requester's February 13, 2009 opposition paper in response to the patent owner's request for extension of time and 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, the third party requester's February 13, 2009 opposition paper in response to patent owner's February 11, 2009 request for extension of time and petition under 37 CFR 1.183 does not have a right of entry into the record of the '1097 proceeding and, as such, is not an authorized paper. Because the third party requester's February 13, 2009 opposition paper 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 '1097 proceeding. *See* MPEP 2267.

B. The Office Lacks Statutory Authority to Consider the Substance of Requester's Petition

As noted above, on February 13, 2009, third party requester filed a petition under 37 CFR 1.183 requesting waiver of the rules for entry of an opposition paper in response to patent owner's February 11, 2009 request for extension of time and 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 '1097 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 or for an extension of time 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

[2] When a petition under 37 CFR 1.183 includes a paper that, upon granting of the petition, would trigger a right for comment or response by a third party requester, then an opportunity to provide such comment or response is given at the point where the paper is entered (if the petition is granted).

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 13, 2009 petition, however, seeks to waive a requirement set forth in 35 U.S.C. § 314(b)(2), allowing 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 13, 2009 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.

Third party requester's February 13, 2009 petition under 37 CFR 1.183, requesting entry of the concurrently filed opposition paper, includes comments, extraneous to the merits of the petition, relating to the merits of patent owner's February 11, 2009 petition for waiver of 37 CFR 1.943(b) and request for extension of time. For this reason, the petition paper filed by the third party requester will be excluded from the record of the '1097 proceeding. Because the third party requester's February 13, 2009 petition has been scanned into the 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 '1097 proceeding. *See* MPEP 2267.

III. ADDITIONAL DISCUSSION

It should be noted that patent owner's February 11, 2009 petition under 37 CFR 1.183 did not stay any periods for reply running in the '1097 proceeding, as "[t]he mere filing of a petition will not stay any period for response that may be running against the application, nor act as a stay of other proceedings."

Parties are advised to take care to avoid characterizing submissions by other parties. Petitions having improper commentary unrelated to the merits of the petition are subject to return or expungement without treatment upon their merits.

Further note that 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.

In this case, third party requester's opposition paper and petition requesting entry of the opposition paper are directed both to extension of time and a petition under 1.183, which are different matters handled by different sections of the Office, and thus are improper papers. Parties should be cognizant of the requirement for separate papers for separate matters.

CONCLUSION

1. Third party requester's February 13, 2009 opposition paper filed in response to patent owner's February 11, 2009 request for extension of time and petition under 37 CFR 1.183, requesting suspension of 37 CFR 1.943(b), is refused entry as it is an improper paper.

2. Because the February 13, 2009 opposition paper was previously incorporated into the IFW, the paper is being expunged from the record by marking it "closed" and "non-public" in the IFW of the '1097 proceeding. No copy of the February 13, 2009 opposition paper will be maintained of record in the Office.

3. Third party requester's February 13, 2009 petition under 37 CFR 1.183, filed in response to patent owner's February 11, 2009 request for extension of time and petition under 37 CFR 1.183, requesting suspension of 37 CFR 1.943(b), is dismissed.

4. The February 13, 2009 petition paper filed by third party requester is expunged from the record for including material not having an entry right. This will be carried out by closing the petition paper (document) in the IFW of the '1097 proceeding and marking the paper "closed" and "not public."

5. A copy of this decision will be made of record in the IFW of the '1097 proceeding.

6. 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.
95/001,097	10/24/2008	7223286	CRDS-0108	8894

45511 7590 05/18/2009

WOODCOCK WASHBURN LLP
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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 05/18/2009

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SUITE 800
WASHINGTON, DC 20037

MAILED

MAY 18 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NUMBER *95/001,097*.

PATENT NUMBER *7,223,286*.

TECHNOLOGY CENTER *3999*.

ART UNIT *3993*.

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

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

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

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

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(For Third Party Requester)

MAILED

MAY 18 2009

CENTRAL REEXAMINATION UNIT

Inter Partes Reexamination Proceeding
Control No. 95/001,097
Filed: October 24, 2008
For: U.S. Patent No. 7,223,286

DECISION
GRANTING
PETITION IN-PART

This is a decision on patent owner's renewed 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 April 6, 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. 23-3050 on April 7, 2009.

The petition under 37 CFR 1.183 is granted in-part.

REVIEW OF THE RELEVANT FACTS

1. On May 29, 2007, United States Patent No. 7,223,286 (the '286 patent) issued to Wright *et al.*

2. On October 24, 2008, a request for *inter partes* reexamination of claims 1-77 of the '286 patent was filed by third party requester Michael G. Raucci, in which Abbott Laboratories was identified as the real party in interest. The request was assigned Reexamination Control No. 95/001,097 (the '1097 proceeding).

3. On December 19, 2008, *inter partes* reexamination was ordered in the '1097 proceeding for claims 1-77 of the '286 patent based on the examiner's determination that the October 24, 2008 request raised a substantial new question of patentability affecting those claims.

4. On January 30, 2009, an Office action was mailed in the '1097 proceeding, rejecting claims 1-77 of the '286 patent.

5. On February 11, 2009, patent owner filed a 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 TO RESPOND TO AN *INTER PARTES* REEXAMINATION OFFICE ACTION (37 C.F.R. § 1.956)" (request for extension of time).

6. On March 20, 2009, the Office mailed a decision granting patent owner's February 11, 2009 request for extension of time. Patent owner's time period for responding to the January 30, 2009 Office action will end on May 30, 2009.

7. On March 24, 2009, the Office mailed a decision dismissing patent owner's February 11, 2009 petition under 37 CFR 1.183, and mailed a supplemental decision on March 25, 2009, reissuing the March 24, 2009 decision (collectively "the March 24, 2009 decision").

8. On April 6, 2009, patent owner filed the instant petition 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)" (renewed petition under 37 CFR 1.183).

DECISION

37 CFR 1.183 provides:

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

37 CFR 1.943(b) provides:

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

The instant renewed 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 stated in the March 24, 2009 decision, 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] Further, the March 24, 2009 decision stated:

> 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.[2]

In this instance, petitioner requests that the page limit for patent owner's response to the January 30, 2009 Office action be increased to the number of pages of the Office action (301 pages) because "considerations of basic fairness (and, arguably, due process) mandate that Patent Owner be granted a commensurate amount of briefing space."[3] Petitioner asserts that "[t]he sheer length of the Office Action in relation to the currently applicable page limit constitutes a 'specific fact which [justifies] an increase in the number of pages available for patent owner to respond.'"[4] Further, in support of not attempting to draft a patent owner's response in compliance with the 50-page limit and submitting a resulting response that is in excess of 50 pages, petitioner asserts:

> [A]lthough the proposed "wait and see" procedure might have application in some circumstances, it is impractical and unworkable where, as here, there is a gross disparity between the length of the office action and the 50 pages limit set forth in Rule 943(b). Because there exists a high degree of probability well in advance of the response deadline that 50 pages will be insufficient, it would be needlessly prejudicial to Patent Owner's planning and preparation of a response to maintain uncertainty on this issue.[5]

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. The substantive portions of the January 20, 2009 Office action have been determined to span approximately 283 pages. Thus, absent a fact-supported determination by petitioner of exactly how many additional pages patent owner requires to complete its response, it is deemed

---

[1] *See* March 24, 2009 decision at page 3.
[2] *See* March 24, 2009 decision at page 3.
[3] *See* renewed petition under 37 CFR 1.183 at page 2.
[4] *See* renewed petition under 37 CFR 1.183 at pages 2-3.
[5] *See* renewed petition under 37 CFR 1.183 at page 3.

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 January 30, 2009 Office action not exceed 283 pages.[6]

Accordingly, patent owner's renewed 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 patent owner's response to the January 30, 2009 Office action not exceed 283 pages in length, excluding appendices of claims and reference materials, such as prior art references. Patent owner's time period for responding to the January 30, 2009 Office action continues to run and will end on May 30, 2009.

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 283 pages in length, excluding reference materials, such as prior art references.

CONCLUSION

1. Patent owner's renewed 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 patent owner's response to the January 30, 2009 Office action not exceed 283 pages in length, excluding appendices of claims and reference materials, such as prior art references.

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 283 pages in length, excluding reference materials, such as prior art references.

3. Jurisdiction for the '1097 reexamination proceeding is returned to the Central Reexamination Unit (CRU).

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

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

kenpet7/IP/length
5-15-09

[6] 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).

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,097	10/24/2008	7223286	CRDS-0108	8894

45511 7590 07/10/2009

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 07/10/2009

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JUL 10 2009

CENTRAL REEXAMINATION UNIT

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

REEXAMINATION CONTROL NUMBER *95/001,097*.

PATENT NUMBER *7,223,286*.

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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JUL 10 2009

CENTRAL REEXAMINATION UNIT

Inter Partes Reexamination Proceeding
Control No. 95/001,097
Filed: October 24, 2008
For: U.S. Patent No. 7,223,286

DECISION DISMISSING PETITION AND REFUSING ENTRY OF OPPOSITION PAPER

This is a decision on third party requester's papers, filed April 10, 2009, entitled "PETITION UNDER 37 C.F.R. 1.183 TO PERMIT REQUESTER OPPOSITION TO PATENT OWNER'S SECOND PETITION FOR INCREASE OF PAGE LIMIT " and "REQUESTER OPPOSITION TO PATENT OWNER PETITION FOR INCREASE OF PAGE LIMIT."

Third party requester's papers are before the Office of Patent Legal Administration for consideration.

The petition fee of $400.00 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183 was charged to third party requester's Deposit Account No. 19-4880 on April 13, 2009.

The April 10, 2009 third party requester petition under 37 CFR 1.183 is dismissed, for the reasons set forth below.

The April 10, 2009 third party requester opposition paper is refused entry into the record, without consideration on the merits, for the reasons set forth below.

REVIEW OF THE RELEVANT FACTS

1. On May 29, 2007, United States Patent No. 7,223,286 (the '286 patent) issued to Wright *et al.*

2. On October 24, 2008, a request for *inter partes* reexamination of claims 1-77 of the '286 patent was filed by third party requester Michael G. Raucci, in which Abbott Laboratories was identified as the real party in interest. The request was assigned Reexamination Control No. 95/001,097 (the '1097 proceeding).

3. On December 19, 2008, *inter partes* reexamination was ordered in the '1097 proceeding for claims 1-77 of the '286 patent based on the examiner's determination that the October 24, 2008 request raised a substantial new question of patentability affecting these claims.

4. On January 30, 2009, an Office action was mailed in the '1097 proceeding, rejecting claims 1-77 of the '286 patent.

5. On February 11, 2009, patent owner filed a first 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))" concurrently with a paper entitled, "REQUEST FOR EXTENSION OF TIME TO RESPOND TO AN *INTER PARTES* REEXAMINATION OFFICE ACTION (37 C.F.R. § 1.956)" (request for extension of time).

6. On February 13, 2009, third party requester filed a petition entitled, "PETITION UNDER 37 CFR § 1.183 TO PERMIT REQUESTER OPPOSITION TO PATENT OWNER PETITIONS FOR PAGE AND TIME LIMIT EXTENSIONS" concurrently with a paper entitled, "REQUESTER OPPOSITION TO PATENT OWNER PETITIONS FOR PAGE AND TIME LIMIT EXTENSIONS."

7. On March 20, 2009, a decision on patent owner's request for extension of time was mailed, extending the time period for patent owner's response to the January 20, 2009 Office action to May 30, 2009.

8. On March 24, 2009, the Office dismissed patent owner's February 11, 2009 petition under 37 CFR 1.183.

9. Concurrently on March 24, 2009, the Office dismissed third party requester's February 13, 2009 petition under 37 CFR 1.183, and refused entry into the record of the petition paper and concurrently filed opposition paper.

10. On April 6, 2009, patent owner filed a second 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)."

11. On April 10, 2009, third party requester filed the instant petition entitled, "PETITION UNDER 37 C.F.R. 1.183 TO PERMIT REQUESTER OPPOSITION TO PATENT OWNER'S SECOND PETITION FOR INCREASE OF PAGE LIMIT" concurrently with a paper entitled, "REQUESTER OPPOSITION TO PATENT OWNER PETITION FOR INCREASE OF PAGE LIMIT" (opposition paper).

12. On May 18, 2009, the Office granted, in-part, patent owner's April 6, 2009 petition under 37 CFR 1.183, to the extent that patent owner's response to the January 30, 2009 Office action

not exceed 283 pages in length. Additionally, the Office *sua sponte* waived 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 the May 18, 2009 decision not exceed 283 pages in length, excluding reference materials, such as prior art references.

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 1.939(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 1.945(a) provides:

> The patent owner will be given at least thirty days to file a response to any Office action on the merits of the inter partes reexamination.

37 CFR 1.947 provides:

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

37 CFR 1.183 provides:

> In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, sua sponte, or on petition of the interested party, subject to such other requirements as may be

imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

II. DISCUSSION

A. Third Party Requester Comments are Not Permitted for Procedural Matters in *Inter Partes* Reexamination

As set forth in the March 24, 2009 dismissal of requester's February 13, 2009 petition under 37 CFR 1.183 for entry of the concurrently filed opposition paper, 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**. Patent owner's April 6, 2009 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. [1] 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. [2]

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, requester's instant petition under 37 CFR 1.183 requesting entry of the concurrently filed opposition paper has not been granted as detailed section II(B). Requester's April 10, 2009 opposition paper in response to the patent owner's April 6, 2009 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." Requester's April 10, 2009 opposition paper in response to patent owner's April 6, 2009 petition under 37 CFR 1.183 does not have a right of entry into the record of the '1097 proceeding and, as such, is not an authorized paper. Because requester's April 10, 2009 opposition paper 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 '1097 proceeding. *See* MPEP 2267.

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[1] Pursuant to 37 CFR 1.937, an *inter partes* reexamination proceeding is to be conducted in accordance with 37 CFR 1.104 - 1.116. The term "response" is used in reexamination proceedings to avoid confusion with the word "reply," a term used in the context of *ex parte* reexamination proceedings in connection with the right of a third party requester to file a "reply" under 37 CFR 1.535 to a patent owner's statement. Thus, MPEP § 2666, entitled "Patent Owner Response to an Office Action," discusses the requirements for a patent owner's "response" to an Office action on the merits in terms of 37 CFR 1.111, a regulation which governs the filing of a "reply" to an Office action.

[2] When a petition under 37 CFR 1.183 includes a paper that, upon granting of the petition, would trigger a right for comment or response by a third party requester, then an opportunity to provide such comment or response is given at the point where the paper is entered (if the petition is granted).

B. Requester's April 10, 2009 Petition

As noted above, on April 10, 2009, third party requester filed the instant petition under 37 CFR 1.183 requesting waiver of the rules for entry of a concurrently filed opposition paper in response to patent owner's April 6, 2009 petition under 37 CFR 1.183.

As set forth in the March 24, 2009 dismissal of requester's February 13, 2009 petition under 37 CFR 1.183, 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.

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 the exercise of the Office's discretion based on a showing of equities; this does not go to the merits of the proceeding. While enactment of the *inter partes* reexamination statute was for the purpose of expanding a third party requester's participation in the merits of the proceeding, there is no indication whatsoever in the legislative history of the *inter partes* reexamination statute that the requester was granted any right to challenge the granting of a petition under 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 April 10, 2009 petition, however, seeks to take action in a manner not authorized by the statute, which permits requester comments/input only in response to a patent owner's response on the merits or in the appeal stage. Accordingly, the Office is without statutory authority to consider the substance of third party requester's April 10, 2009 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 reexamination proceeding or in a patent application. The patent statute simply does not provide for such intervention.

Moreover, 37 CFR 1.183 does not support waiver of a rule where waiver is being requested to oppose actions which are in the sole discretion of the Office, such as the granting of page limit waivers. In addition, entry and consideration of oppositions to such discretionary actions of the Office would not further the statutory mandate of special dispatch pursuant to 35 U.S.C. 314(c).

Requester argues that 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), MPEP 2686.01(VI) and MPEP 2646(II).[3] With respect to 37 CFR 1.985(b), this regulation 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

[3] *See* April 10, 2009 petition at page 2.

are limited to bare notice only; the party may not challenges 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 where there is no pending reexamination, and thus, the Office has no jurisdiction over the patent. Regarding MPEP 2646(II), permitting 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 telling the Office not to exercise its discretion, where the Office is not required to act, or refrain from acting, as requester says it should, and the failure to do so is not an *ultra vires* action by the Office. With respect to the guidance provided in MPEP 2686.01(VI), indicating that a requester may file a petition to merge proceedings, to the extent that such guidance is inconsistent with the 35 U.S.C. 314(b), the statute governs.[4]

Accordingly, third party requester's April 10, 2009 petition under 37 CFR 1.183, filed in response to patent owner's April 6, 2009 petition under 37 CFR 1.183, requesting suspension of 37 CFR 1.943(b), is dismissed.

CONCLUSION

1. Third party requester's April 10, 2009 petition under 37 CFR 1.183 is dismissed.

2. Third party requester's April 10, 2009 paper filed in opposition to patent owner's April 6, 2009 petition under 37 CFR 1.183, requesting suspension of 37 CFR 1.943(b), is refused entry as it is an improper paper.

3. Because the April 10, 2009 opposition paper was previously incorporated into the IFW, the paper is being expunged from the record by marking it "closed" and "non-public" in the IFW of the '1097 proceeding. No copy of the April 10, 2009 opposition paper will be maintained of record in the Office.

4. A copy of this decision will be made of record in the IFW of the '1097 proceeding.

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[4] Revision of the portion of MPEP 2686.01(VI) stating that "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" is being considered in view of 37 CFR 1.985(b), which affords third party requester a mechanism for notifying the Office of the multiple reexamination proceedings.

5. 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

7-9-09

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,097	10/24/2008	7223286	CRDS-0108	8894

45511 7590 07/23/2009

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EXAMINER	
ART UNIT	PAPER NUMBER

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Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001097
PATENT NO. : 7223286
TECHNOLOGY CENTER : 3999
ART UNIT : 3993

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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(For Patent Owner)

RECEIVED
JUL 23 2009
CENTRAL REEXAMINATION UNIT

Michael G. Raucci
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(For *Inter Partes* Requester)

In re Khankari et al.
Inter partes Reexamination Proceeding
Control No. 95/001,097
Filed: Oct. 24, 2008
For: U.S. Patent No. 7,223,286

:DECISION DISMISSING PETITION
:TO SUSPEND REEXAMINATION
:PROCEEDING

This decision is a decision on patent owner's July 1, 2009 petition titled "PETITION UNDER 37 CFR § 1.182 AND § 1.183 TO TEMPORARILY SUSPEND REEXAMINATION PROCEEDING 95/001,097. The petition requests that the Office temporarily suspend the present reexamination proceeding until September 21, 2009, which is asserted to be one month after the close of expert discovery in the co-pending litigation in the District Court involving the same patent. On July 13, 2008, requester filed an opposition paper titled 'REQUESTER'S PETITION TO OPPOSE PATENT OWNER'S JULY 1, 2009 PETITION TO SUSPEND *INTER PARTES* REEXAMINATION PROCEEDINGS" filed on July 13, 2009. This decision addresses both the patent owner and requester papers.

Patent Owner's petition to suspend is **DISMISSED**.

BACKGROUND

1. U.S. Patent No. 7,223,286 (the '286 patent) issued on May 29, 2007.

2. A request for reexamination of the '286 patent was filed on October 24, 2008. The request was assigned control No. 95/001,097 (the '1097 reexamination proceeding).

3. Reexamination was ordered for the '1097 reexamination proceeding on December 19, 2008. The examiner's order contained 55 pages. The Office also mailed a non-final rejection on January 30, 2008. The non-final rejection mailed was 303 pages in length.

4. On February 11, 2009, the patent owner filed an request for an extension of time to file a response the December 19, 2008 Office action, as well as a petition to waive the page limit rule under 37 CFR 1.943(b).

5. On March 20, 2009, the Office granted patent owner's request for an extension of time and granted a two-month extension of time. The patent owner's response was extended until May 30, 2009. On March 24, 2009 the Office dismissed patent owner's extension of pages limit. Patent Owner had requested of waiver from 50 pages to not exceed 780 pages.

5. ON April 6, patent owner filed a renewed request for a waiver of page limit . On April 10, 2009 requester filed an opposition to the page limit waiver.

6. On May 18, 2009 the Office granted-in-part to patent owner a waiver of page limits and allowed patent owner a limit not to exceed 283 pages.

7. It is asserted that, in April 2009, the Patent Owner and Requester began discussions to authorize the patent owner to provide to the Office a copy of documents produced by the requester in the litigation being conduction in the U.S. District Court for the District of New Jersey that is styled *Wyeth and Cordis Corp. v. Abbott Laboratories et al*, Civil Action No. 07-5636.

8. On May 29, the patent owner filed a response to the non-final rejection including an amendment to the claims in the '1097 reexamination proceeding. T

9. On June 29, 2009, the requester filed a response to the patent owner amendment filed on May 29, 2009. The response was 80 pages.

10. On July 1, 2009, the patent owner submitted the present petition to pursuant to 37 CFR 1.182 and 1.183 to temporarily suspend the *'1095* reexamination proceeding.

11. On July 10, 2009, the Office dismissed requester's opposition to the patent owner's request to waive page limits.

12. On July 13, 2009, the requester filed an opposition to the patent owner's petition to temporarily suspend the '1095 reexamination proceeding.

13. No Office actions are outstanding (i.e., none are awaiting response) in the present proceeding.

14. The District Court litigation has not been stayed pending resolution of this reexamination proceeding.

RELEVANT LAW AND REGULATIONS

37 CFR 1.182 provides:

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

37 CFR 1.183 provides:

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

37 CFR 1.939 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.

35 U.S.C. 305 provides:

After the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title. In any reexamination proceeding under this chapter, the patent owner will be permitted to propose any amendment to his patent and a new claim or claims thereto, in order to distinguish the invention as claimed from the prior art cited under the provisions of section 301 of this title, or in response to a decision adverse to the patentability of a claim of a patent. No proposed amended or new claim enlarging the scope of a claim of the patent will be permitted in a reexamination proceeding under this chapter. All

reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office.

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.

35 U.S.C. 317(b) provides:

(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.

PATENT OWNER'S ARGUMENTS

1. Additional time is necessary to obtain authorization to submit evidence in support of patentability that is obtained through the discovery process in the District Court litigation.
2. Entry into Office's Appeal Process Prior to Resolution of the Protective Order Issue in the District Court Litigation would deprive Patent Owner of the ability to adequately defend the Patent Owner's patent
3. A temporary suspension of an *Inter Partes* Reexamination proceeding is not precluded under *Ethicon v. Quigg* 849 F. 2d. 1422 (Fed. Cir. 1998).

REQUESTER'S ARGUMENTS

1. The Patent Statute and MPEP mandate that the reexam be conducted with special dispatch.

2. Patent Owner's arguments for temporary staying the proceeding would eviscerate the *inter partes* statute for litigated patents, since such stays would effectively guarantee that the litigation would end prior to *inter partes* reexamination, thus terminating the reexaminations mid-course.

3. Patent Owner has already delayed the '1096 reexamination proceeding by filing significant extensions of time for its responses.

4. Patent Owner complained of Office delay when successfully opposing a stay of litigation and then filed request for such delay in the '1096 proceeding.

5. A stay is not necessary, because Patent Owner will have an opportunity to the next Office action by the Office.

6. The rationale of the Federal Circuit's decision in *Ethicon v. Quigg* - that reexams generally should not be stayed pending litigation given Congress's "special dispatch" mandate- applies even stronger to *inter partes* reexamination since, unlike, *ex parte* reexamination, *inter partes* reexam are terminated early if not completed before the litigation ends.

ANALYSIS AND FINDINGS

As asserted by both Patent Owner and Requester, 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 an indefinite length of time in an *ex parte* reexamination, and, accordingly is not controlling authority on the present issue.

Patent owner argues that (1) additional time is necessary to obtain authorization to submit evidence in support of patentability that is obtained through the discovery process and (2) entry into the appeal process prior to resolution of the protective order issued in the District Court litigation would deprive patent owner of ability to adequately defend its patent rights.

Patent owner argues that evidence has been obtained through the discovery process in the co-pending litigation and it is reasonable to believe that additional information in support of patentability of the claims will be discovered through pre-trial discovery of expert witnesses is lacking in detail. The patent owner, however, does not establish a reasonable basis of the specifics it would expect to find. Patent owner does not provide any guidance and explanation as what information it is expected to find during expert discovery, and how that information would be expected to be relevant to this proceeding. To the extent that patent owner is relying on future discovery, patent owner's request is based upon speculation.

In addition, as pointed out by requester, the granting of stays based upon on-going 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.

Patent Owner has not met its burden of showing good cause as to why such proceeding should be temporarily stayed pending conclusion of the of the discovery period in the on-going litigation in the District Court proceeding. Accordingly, the petition is dismissed.

As to obtaining entry of additional evidence (obtained through the discovery process) into a reexamination proceeding after the filing of an appeal and the limit the ability for a party to enter additional evidence after an Action Closing Prosecution (ACP):

Patent owner has potential remedies pursuant to 37 CFR 1.116, 37 CFR 1.182, 37 CFR 1.183 and 37 CFR 1.951. For example, if patent owner is addressing issues raised in the Office action closing prosecution, then such evidence may be admitted as part of a 37 CFR 1.951 submission, subject to the criteria of 37 CFR 1.116. If the patent owner cannot avail itself to 37 CFR 1.116 and 37 CFR 1.951, patent owner has recourse to filing a petition pursuant to either 37 CFR 1.182 or 37 CFR 1.183, whichever may be relevant. Patent Owner is not being denied due process rights, and will have opportunity to have such evidence in its next response, if seasonably submitted with a showing to that effect, and the evidence is of the nature permitted in reexamination. Should the proceeding reach the point where an appellant brief is due prior to the asserted September 21, 2009 close of expert discovery (plus time to consider the results of the discovery), patent owner may request an extension of time by filing a petition under 37 CFR 1.183 to waive 37 CFR 41.66(a), providing the details of the need for the extension.

CONCLUSION

1. Patent Owner's petition under 37 CFR 1.182 and 1.183 to temporarily suspend the present reexamination proceeding is **DISMISSED**.

2. Jurisdiction is being returned to the Central Reexamination.

3. Questions concerning this decision should be addressed to Kery A. Fries, Senior Legal Advisor, at 571-272-7757.

Kenneth Schor
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy

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UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,097	10/24/2008	7223286	CRDS-0108	8894

45511 7590 03/18/2010

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2929 ARCH STREET
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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/18/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/001,097	10/24/08	7223286	CRDS-0108

EXAMINER
O'CONNOR, CARY

ART UNIT	PAPER
3993	

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DATE MAILED:

03/18/10

INTER PARTES REEXAMINATION COMMUNICATION

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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EXAMINER
O'CONNOR, CARY

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UNITED STATES PATENT AND TRADEMARK OFFICE

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MAR 18 2010

CENTRAL REEXAMINATION UNIT

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(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,097
Filed: October 24, 2008
For: U.S. Patent No. 7,223,286

: **DECISION ON**
: **PETITION REQUESTING**
: **CLARIFICATION OF**
: **PROCEDURES REGARDING**
: **CONFIDENTIAL**
: **DOCUMENT SUBMISSION**

This is a decision on the paper titled "Petition Under 37 C.F.R. § 1.182 and § 1.183 for Clarification of the Procedures for Submission of Third Party Confidential Documents in Support of Patentability and to Refute Positions Taken by the Third Party Requester" filed September 8, 2009 by patent owner. This decision also addresses the third party requester's "Petition to Respond to Patent Owner's September 8, 2009 Petition for Clarification" filed September 17, 2009.

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

The petition fee under 37 CFR 1.17(f) for both petitions has been received by the Office.

The patent owner's petition is **GRANTED** and clarification of Office procedures is provided herein.

The third party requester's petition is **GRANTED** to the extent that the comments have been considered.

BACKGROUND

1. U.S. Patent 7,223,286 (the '286 patent) issued on May 29, 2007 with claims 1-77. Cordis Corporation is the owner of the '286 patent.

2. There following civil litigations involve the '286 patent: (1) *Boston Scientific Corp. et al. v. Johnson & Johnson Inc. et al.*, U.S. District Court of Delaware, 1:07cv348 filed June 1, 2007; and (2) *Cordis Corp. v. Abbott Laboratories*, U.S. District Court of New Jersey, 3:07cv2477 filed May 29, 2007.

3. A request for *inter partes* reexamination of claims 1-77 of the '286 patent was filed October 24, 2008, by third party requester, Abbott Laboratories, and assigned control No. 95/001,097 (the '1097 proceeding).

4. *Inter partes* reexamination was ordered for claims 1-77 of the '286 patent on December 19, 2008.

5. A non-final Office action was issued on January 30, 2009.

6. On May 29, 2009, patent owner filed a response to the January 30, 2009 Office action, after receiving an extension of time.

7. On June 29, 2009, the third party requester filed comments on the January 30, 2009 Office action and patent owner's May 29, 2009 response.

8. On July 1, 2009, patent owner filed a petition to temporarily suspend reexamination proceeding '1097 to provide patent owner "an opportunity to establish a full, fair and complete record of evidence in support of patentability of the claims".

9. On July 13, 2009, the third party requester filed a petition to oppose patent owner's July 1, 2009 petition.

10. A decision dismissing patent owner's July 1, 2009 petition and addressing the third party requester's July 13, 2009 petition was issued July 23, 2009.

11. After the July 23, 2009 decision, patent owner filed a reply to requester's July 13, 2009 petition on July 24, 2009, and the third party requester filed an objection to patent owner's reply on July 29, 2009. Both papers are improper and are being expunged from the record by a decision mailed concurrently herewith.

12. On September 8, 2009, patent owner filed a petition requesting clarification of procedures for submission of third party confidential documents and to refute positions taken by the third party requester. This petition is the subject of the present decision.

13. On September 17, 2009, the third party requester filed a petition to respond to patent owner's September 8, 2009 petition for clarification. This petition is also the subject of the present decision.

14. On December 2, 2009, patent owner filed a supplemental information disclosure statement with 58 information items, a submission of protective order materials, and a petition to expunge protective order materials.

DECISION

I. RELEVANT RULES AND REGULATIONS

37 CFR § 1.182 Questions not specifically provided for.

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

37 CFR § 1.183 Suspension of rules.

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

37 CFR § 1.59 Expungement of information or copy of papers in application file.

(a)(1) Information in an application will not be expunged, except as provided in paragraph (b) of this section.

(2) Information forming part of the original disclosure (i.e., written specification including the claims, drawings, and any preliminary amendment specifically incorporated into an executed oath or declaration under § § 1.63 and 1.175) will not be expunged from the application file.

(b) An applicant may request that the Office expunge information, other than what is excluded by paragraph (a)(2) of this section, by filing a petition under this paragraph. Any petition to expunge information from an application must include the fee set forth in § 1.17(g) and establish to the satisfaction of the Director that the expungement of the information is appropriate in which case a notice granting the petition for expungement will be provided.

(c) Upon request by an applicant and payment of the fee specified in § 1.19(b), the Office will furnish copies of an application, unless the application has been disposed of (see § § 1.53(e), (f) and (g)). The Office cannot provide or certify copies of an application that has been disposed of.

37 CFR 1.947 Comments by third party requester to patent owner's response in inter partes reexamination.

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

37 CFR 1.948. Limitations on submission of prior art by third party requester following the order for inter partes reexamination.

(a) After the inter partes reexamination order, the third party requester may only cite additional prior art as defined under § 1.501 if it is filed as part of a comments submission under § 1.947 or § 1.951(b) and is limited to prior art:

(1) which is necessary to rebut a finding of fact by the examiner;

(2) which is necessary to rebut a response of the patent owner; or

(3) which for the first time became known or available to the third party requester after the

filing of the request for inter partes reexamination proceeding. Prior art submitted under paragraph (a)(3) of this section must be accompanied by a statement as to when the prior art first became known or available to the third party requester and must include a discussion of the pertinency of each reference to the patentability of at least one claim.

MPEP 724 Trade Secret, Proprietary, and Protective Order Materials (in part)

Parties bringing information to the attention of the Office for use in the examination of applications and reexaminations are frequently faced with the prospect of having legitimate trade secret, proprietary, or protective order material disclosed to the public.
Inventors and others covered by 37 CFR 1.56(c) and 1.555 have a duty to disclose to the Office information they are aware of which is material to patentability. 37 CFR 1.56(b) states that

> information is material to patentability when it is not cumulative to information already of record or being made of record in the application, and
> (1) It establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim; or
> (2) It refutes, or is inconsistent with, a position the applicant takes in:
> (i) Opposing an argument of unpatentability relied on by the Office, or
> (ii) Asserting an argument of patentability.

A prima facie case of unpatentability is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.

It is incumbent upon patent applicants, therefore, to bring "material" information to the attention of the Office. It matters not whether the "material" information can be classified as a trade secret, or as proprietary material, or whether it is subject to a protective order. The obligation is the same; it must be disclosed if "material to patentability" as defined in 37 CFR 1.56(b). The same duty rests upon a patent owner under 37 CFR 1.555 whose patent is undergoing reexamination.

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

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

MPEP 724.04(c) Materials Submitted in Reexamination File Open to the Public Under 37 CFR 1.11(d)

Any materials, i.e., information, submitted under MPEP § 724.02 in a reexamination file open to the public under 37 CFR 1.11(d) will be treated in the following manner:

(A) Any materials, i.e., information, properly submitted under MPEP § 724.02 in a reexamination proceeding will be sealed from public view. The submitted information will be maintained separate from the reexamination file and will not be publicly available until a determination has been made as to whether or not the information is material to patentability. A petition to expunge (37 CFR 1.59) should accompany the submission of proprietary materials, and in any event, must be filed prior to, or shortly after (i.e., in time to be addressed before the reexamination proceeding enters the reexamination certificate printing process), the

mailing of a Notice of Intent to Issue Reexamination Certificate (NIRC). If the petition to expunge is not filed in time to be addressed before the reexamination proceeding enters the reexamination certificate printing process, or the petition is filed, and denied/dismissed, then the materials submitted under MPEP § 724.02 will be released to the public with any other papers in the reexamination file.

(B) Prior to the mailing of a NIRC, the examiner will review the reexamination file and determine if a petition to expunge is in the reexamination file but not acted upon. The examiner, or other appropriate Office official who is responsible for considering the information, will make a determination as to whether or not any portion or all of the information submitted is material to patentability.

(C) If any portion or all of the submitted information is found to be material to patentability, the petition to expunge will be denied and the information will thereafter become a permanent part of the reexamination file and open to the public. Where a submission containing protected material is found to be material to patentability, it still may be possible to redact the submission to eliminate the protected material while retaining the important material (e.g., where a confidential identifying number, such as a serial number or social security number, is included, which is not needed for the context of the submission). If so, the redacted version may be submitted to the Office along with a petition under 37 CFR 1.182 requesting that the unredacted version be sealed and be replaced with the redacted version.

(D) If all of the submitted information is found not to be material to patentability, the petition to expunge will be granted and the information expunged. If a portion of the submitted information is found not to be material to patentability, and a portion is found to be material to patentability, the petition to expunge will be dismissed, and patent owner (or the requester, in limited instances where appropriate) provided with an opportunity to separate the material and non-material information, such that the non-material information can be expunged. See item (C) above.

(E) If a petition to expunge is not filed prior to, or shortly after (i.e., in time to be addressed before the reexamination proceeding enters the reexamination certificate printing process), the mailing of the NIRC, the materials submitted under MPEP § 724.02 will become a permanent part of the reexamination file and open to the public under 37 CFR 1.11(d). In the event materials have already been made of record by a party, and it is subsequently determined that the materials are protected, the proper petition to submit would be a petition to seal the protected material under 37 CFR 1.182, with the requisite fee.

(F) Any petition to expunge a portion or all of the submitted information under 37 CFR 1.59(b) will be treated in accordance with MPEP § 724.05.

II. DECISION

1. Patent Owner's Request

Patent owner requests clarification of the procedures for submission of documents under seal. Specifically, patent owner requests clarification of procedures that apply to submissions of confidential documents that support patentability and/or refute positions taken by the requester during a reexamination proceeding.

Patent owner asserts that they have identified over fifty documents that are subject to protective orders in the above-cited copending litigations and contain objective evidence bearing on the patentability of patent owner's claims. Although not specifically explained how the objective evidence is relevant, the petition implies that the evidence bearing on the patentability includes evidence of secondary considerations and objective indicia of nonobviousness. Patent owner asserts that approval to submit specifically identified documents that are covered by the protective order was requested from the third party requester and was not granted. Patent owner requests clarification of procedures for submitting this confidential evidence supporting patentability and/or refuting positions taken by requester or establishment of such procedures.

2. Third Party Requester's Opposition

Third party requester petitions to be heard in response to patent owner's request for clarification, because the third party requester believes that the patent owner's positions, if accepted, would (a)

fundamentally violate the patent statute and third party requesters' statutory and due process rights and (b) significantly alter and adversely impact the procedures for all reexamination proceedings involving litigated patents. Specifically, third party requester seeks to inform the Office of a number of points outlined on pages 2 and 3 of the requester petition.

3. The Materials Submitted Under Seal and Protective Order in this Proceeding

To date, the following materials have been submitted under seal and have been alleged to be covered by protective orders. It is noted that copies of the applicable protective orders have not been filed in this proceeding.

On December 2, 2009, the patent owner submitted a sealed box containing materials identified as being subject to two different protective orders. The box was submitted with a Supplemental Information Disclosure Statement in which the patent owner "makes no representation that any of the items are material, enabled references or prior art to the claims under reexamination." The box includes 58 items of information, some of which are identified as deposition transcripts and others which appear to be publicly available publications based on their description. The box was accompanied by a petition to expunge protective order materials. The petition states that "the Protective Order Material would not be important to a reasonable examiner in deciding whether any claim of the above referenced application is patentable for reasons stated in the Protective Order Material."

4. The Office Procedure

The Office has clearly prescribed procedures for filing information material to patentability that is covered by a protective order as outlined in MPEP 724 *et seq.* The procedure for filing such materials set forth in MPEP 724.02 accommodates material that is required to be submitted on behalf of the patent owner under 37 CFR 1.555 and affords such material special status. However, there are no statutes or rules that require the disclosure of information favorable to patentability. Therefore, as the Office does not require such material to be submitted, the Office does not give voluntary submissions of such information any special status. Protective order materials that are submitted in favor of patentability will be made of record in the file and should not be submitted under the procedures of MPEP 724.02.

No assertions have been made by patent owner that the material intended to be submitted or already submitted is material to patentability of any claims under reexamination and should be afforded special status. In fact, the papers submitted by patent owner with the protected material specifically state that the material would not be important to a reasonable examiner in deciding whether any claim is patentable. Given this statement, it is unclear why these materials are being submitted in this proceeding.

Absent a clear showing that the materials must be submitted to comply with a statute or rule governing the parties in this reexamination proceeding, the Office is unwilling to enter protected materials into the record. The materials have not been shown to qualify for protected status in accordance with the procedures of MPEP 724.02 and, if they were, they would only remain protected if they are found not be material to the patentability by the examiner. Thus, if the Office accepts these materials they will entered into the public file and will not be afforded protected status. In order to honor the court orders, therefore, the Office will not enter these materials absent the following. To gain entry and consideration of the materials, the parties must

obtain an agreement between themselves that some limited form of the materials, such as a redacted version, may be submitted consistent with any limitations imposed by the protective order, or obtain permission from the court to submit the necessary materials in an acceptable form. The parties have recourse through the courts to request permission to submit necessary materials in this proceeding. Therefore, there are adequate remedies in existence to address this situation.

The parties have thirty (30) days from the date of this decision to obtain the necessary documentation that the protected materials may be submitted in this proceeding and become part of the public record. Absent such documentation, the materials will be expunged from the record and returned to the respective parties or made available to be picked up by the respective parties.

Further papers and petitions on this issue, other than those described immediately above, will not be entertained as there must be a limitation on party iterations of input, given the statutory mandate for special dispatch in reexamination. As provided in MPEP 2609:

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

CONCLUSION

1. Patent owner's petition is granted to the extent that clarification of the procedures has been provided. Third party requester's petition has been granted to the extent that the arguments presented therein have been considered.

2. Both parties are given thirty (30) days to file documentation that agreement has been reached between the parties or permission to file has been given by the court in accordance with the protective order that certain protected documents will be submitted and become a part of the record in this proceeding.

3. Jurisdiction of this proceeding will remain with OPLA until such time that the requested documentation is received. If the requested documentation is not provided within the time period, the protected material will be expunged from the record and returned to the respective parties or the parties will be given an opportunity to retrieve the material. Jurisdiction will then be transferred to the Central Reexamination Unit to take action.

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

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

March 18, 2010
Kenpet8/expunge/Ct order

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,097	10/24/2008	7223286	CRDS-0108	8894

45511 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

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SUITE 800
WASHINGTON, DC 20037

Date:

MAILED

MAY 26 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001097
PATENT NO. : 7223286
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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Joseph Lucci
Woodcock Washburn LLP
Cira Centre
2929 Arch St. 12th Floor
Philadelphia, PA 19104-2891

(For Patent Owner)

MAILED

MAY 26 2010

CENTRAL REEXAMINATION UNIT

Michael G. Raucci
Sughrue Mion PLLC
2100 Pennsylvania Ave. Suite 800
Washington, DC 20037

(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,097
Filed: October 24, 2008
For: U.S. Patent No. 7,223,286

DECISION DISMISSING REQUEST FOR ADDITIONAL TIME, RETURNING IMPROPER PAPERS & DISMISSING PETITIONS TO EXPUNGE

This is a decision addressing:

(1) the petition filed April 16, 2010 by patent owner entitled "Petition Under 37 CFR §§ 1.182 and 1.956 With Respect to Submission of Materials Under Seal";

(2) the miscellaneous paper filed April 19, 2010 by the third party requester entitled "Requester's Confirmation of No Party Agreement or Court Order per the PTO's Clarification Petition Rulings Mailed on March 18-19, 2010";

(3) the petition filed December 2, 2009 by patent owner entitled "Petition to Expunge Protective Order Materials Pursuant to 37 CFR 1.59"; and,

(4) the petition filed May 11, 2010 by patent owner entitled "Petition to Expunge Protective Order Materials Pursuant to 37 CFR 1.59."

The proceeding, the petitions, and the miscellaneous paper are before the Office of Patent Legal Administration for consideration.

Patent owner's petitions were each accompanied by a fee of $200 in accordance with 37 CFR 1.17(g). The third party requester's miscellaneous letter was not accompanied by a fee.

DECISION

(1) In a March 19, 2010 Decision by the Office, patent owner and requester were given thirty days to file, with respect to proffered protected materials, documentation that agreement has been reached between the parties to file the materials, or that permission to file has been given by the court. Such has not been done, and the thirty days have expired.

(2) The April 16, 2010 patent owner petition requests that the time period to submit documentation that the protected materials may be submitted in this proceeding be extended two weeks after the court's determination has been made. The petition states that patent owner is in the process of procuring the type of documentation identified in the March 19, 2010 Decision and states that it "intends" to seek the Magistrate's assistance in one concurrent litigation and "intends" to follow the judge's procedures for requesting assistance in the other proceeding. As patent owner has provided no evidence that procedures have been initiated to obtain the court's permission other than expressing an *intent* to obtain the documentation, the request for an extension of time for an indeterminate period is dismissed.

(3) The April 19, 2010 third party requester miscellaneous letter is an improper filing, as it is not a submission of comments on a patent owner response to an outstanding Office action and is not a response in accordance with the March 19, 2010 Decision (i.e., it is not documentation that the protected materials can be submitted.) Both parties were advised that further papers and petitions on this issue, other than the necessary documentation, would not be entertained. The April 19, 2010 paper is therefore being expunged from the image file wrapper (IFW) by closing the paper and marking it as non-public.

(4) Given the expiration of the thirty days as set forth in part (1) of this decision, the following papers are being expunged from the record and will not be considered by the examiner during reexamination.

(A) The sealed box submitted December 2, 2009 by patent owner, which will be made available for pick up by the patent owner's representative upon request for the next thirty days. If no arrangements are made for pick up, the box and papers will be disposed of.

(B) The sealed envelope submitted May 11, 2010 by patent owner, which will be made available for pick up by the patent owner's representative upon request for the next thirty days. If no arrangements are made for pick up, the box and papers will be disposed of.

The papers may be resubmitted for consideration when permission for submission is obtained despite the fact that the papers will become part of the public record should the examiner find the papers material to patentability.

Information covered by the court's protective orders is not to be submitted without evidence that permission has been granted for public disclosure of the information. **Further filings that include information covered by a protective order will be expunged until permission for submission has been provided in this proceeding.** As no evidence has been submitted that Office personnel are permitted to review the information, it is inappropriate to submit such information and cause a potential violation of a protective order. It is not acceptable to submit the information with restrictions on who may or may not open and review the information as it prohibits the Office from

processing the filing. Further, it does not appear that either party has the authority to grant selective access to the protected information.

(5) The petitions to expunge filed with the sealed submissions on December 2, 2009 and May 11, 2010 by the patent owner are also dismissed as moot by this decision as the sealed papers are no longer of record in the proceeding.

To arrange for pick up of the sealed papers, telephone inquiries are to be directed to Manuel Saldana at (571) 272-7740.

Telephone inquiries with regard to the substance of the decision should be directed to Caroline D. Dennison, Legal Advisor, at (571) 272-7729.

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

May 26, 2010
Kenpet8

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,097	10/24/2008	7223286	CRDS-0108	8894

45511 7590 06/29/2010

WOODCOCK WASHBURN LLP
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2929 ARCH STREET
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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/29/2010

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WASHINGTON, DC 20037

Date:

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001097
PATENT NO. : 7223286
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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In re Application of 7223286
Appl. No.: 95/001,097
Filed: October 24, 2008
For: Local Delivery Of Rapamycin For Treatment Of Proliferative Sequelae Associated With PTCA Procedures, Including Delivery Using A Modified Stent

DECISION ON PETITION UNDER 37 CFR 1.59

This is a decision on the petition under 37 CFR 1.59(b), filed May 4, 2010, to expunge information from the above identified reexamination proceeding.

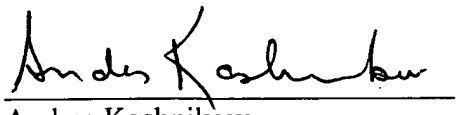
The petition is granted.

Petitioner requests that a document entitled Deposition of Dana Mead, April 23, 2009 consisting of 28 pages, and Deposition of Susan Silavin, November 5, 2008 consisting of 34 pages, filed April 16, 2010, be expunged from the record. Petitioner states that either (A) that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in 37 CFR 1.17(g) has been paid.

The information in question has been determined by the undersigned to not be material to the examination of the instant reexamination proceeding.

Applicant is required to retain the expunged material(s) for the life of the patent identified above.

The expunged material has been removed from the official file. As the documents in question have been entered into the Electronic Image File Wrapper (IFW) record, the documents will be "returned" by closing the paper in the IFW record, and marking the papers non-public to expunge them from the record. The present decision will be made of record in the reexamination proceeding.



Andres Kashnikow,
SPE, CRU 3993
(571) 272-4361

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,097	10/24/2008	7223286	CRDS-0108	8894

45511 7590 07/27/2010

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ART UNIT	PAPER NUMBER

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JUL 27 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NUMBER *95/001,097*.

PATENT NUMBER *7,223,286*.

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.
95/001,097	10/24/08	7223286	CRDS-0108

EXAMINER
O'CONNOR, CARY

ART UNIT	PAPER
3993	

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SUITE 800
WASHINGTON, DC 20037

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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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/001,097	10/24/08	7223286	CRDS-0108

EXAMINER
O'CONNOR, CARY

ART UNIT	PAPER
3993	

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Joseph Lucci
Woodcock Washburn LLP
Cira Centre
2929 Arch St. 12th Floor
Philadelphia, PA 19104-2891

(For Patent Owner)

MAILED

JUL 27 2010

CENTRAL REEXAMINATION UNIT

Michael G. Raucci
Sughrue Mion PLLC
2100 Pennsylvania Ave. Suite 800
Washington, DC 20037

(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,097
Filed: October 24, 2008
For: U.S. Patent No. 7,223,286

DECISION DISMISSING REQUEST FOR RECONSIDERATION

This is a decision addressing the June 4, 2010 patent owner's request for reconsideration of the May 26, 2010 petition decision that dismissed patent owner's request for an extension of time.

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

Patent owner's request for reconsideration is dismissed. No extension of time is granted for providing evidence of permission from both courts that information covered by their respective protective orders may be submitted and potentially made public in this proceeding. As explained in the May 26 decision, the information may be resubmitted for possible consideration when the parties provide proper documentation.

However, expungement of the information is temporarily held in abeyance based on new assertions by patent owner in the request for reconsideration that the information is patent owner's own confidential information. Based on these assertions, the Office will permit either party to provide a statement in conformance with the requirements below that the information submitted is its own confidential information and that the respective party has the authority to waive the confidentiality. If a proper statement is filed within fifteen (15) days of this decision, the information will not be expunged and may be considered by the examiner, provided it is deemed a compliant submission. Absent such a statement, the respective parties' information will be destroyed if not picked up as directed in the May 26, 2010 decision.

Detailed Response to Request for Reconsideration

In the request for reconsideration, patent owner asserts that the decision has incorrectly characterized certain facts regarding actions taken with the court by patent owner. This assertion is not accurate. Patent owner's April 16, 2010 petition failed to provide any evidence that court proceedings had been initiated. In fact, the section quoted in the present petition shows that the prior petition merely explained the procedure and did not state that patent owner had begun proceedings. The Office is not privy to actions that occurred after filing of the petition, and it must rely on evidence and statements provided by the petitioner. The evidence now provided by patent owner is a letter to one of the courts that is dated April 21, 2010, which is *subsequent* to the April 16 petition. As such, this letter does not support patent owner's assertion that proceedings had been initiated with the court prior to filing the April 16 petition. Moreover, patent owner has previously asserted that there are protective orders from TWO courts involving the patent in this proceeding, yet the evidence submitted relates to only court.

The facts have been correctly characterized and do not support patent owner's assertions. There is no valid reason for granting an extension of time, which at present would still have no fixed end date, as the information can be resubmitted. As explained in the prior decision, it is the Office's statutory duty to conduct reexamination proceedings with special dispatch. Granting an indefinite extension of time would not serve this purpose and would only serve to slow proceedings.

Patent owner additionally asserts in the request for reconsideration that the information disclosure statements previously submitted in the proceeding do not include any documents that are subject to court review. Patent owner further explains that the information disclosure statements do not include the documents that are being evaluated by the court and that patent owner does not need permission of a court to submit them in this reexamination. This is a new assertion. It is noted that the previous information disclosure submissions at issue simply stated that the information was subject to court protective orders, with no further explanation. The court protective orders have not been submitted in this proceeding (with an explanation of how the relevant documents are not included within its ambit), and the Office has no way of evaluating whose confidential documents are being submitted. The April 16, 2010 petition also did not explain this, contrary to the assertions in the subject petition, and merely stated that the information disclosure statements contain "other types of litigation materials (including Patent Owner's confidential information)". Other types of litigation materials are not limited solely to patent owner's own information. Patent owner has not clearly stated on the record that the information is exclusively its own confidential information and that patent owner has the authority to waive the confidentiality if the information is found to be material to patentability.

Statement Regarding Confidentiality and Authority to Waive

Patent owner is provided one last opportunity to make clear what information is being submitted. The patent owner may submit the following statement within 15 days of this decision to avoid expungement of the information submitted under the protective orders. The statement must include the following:

a. An identification of the confidential information, including the title and the date it was submitted;

b. An identification of the protective order(s) that covers each item of confidential information;
c. A statement that the confidential information is entitled to special status in accordance with MPEP 724.02, because the information is required under 37 CFR 1.555 and not merely evidence in favor of patentability;[1]
d. A statement that all of the information sought to be submitted is patent owner's own confidential information and that patent owner has the authority to waive such confidentiality in the event the examiner deems the information material to patentability.

The third party requester may file an objection to the statement only if it can be shown, by evidence, that the statement is inaccurate, i.e., that the confidential information is third party requester's own information. Such an objection must be filed within fifteen (15) days of service of the patent owner's statement.

If patent owner submits a compliant statement, the identified information will not be expunged. Absent this statement, or if the third party requester files an acceptable objection or raises doubts as to the ownership of the information, the expungement procedure outlined in the May 26, 2010 decision will be followed. No further requests for consideration or arguments regarding this issue will be entertained.

The third party requester may also file a statement as set forth above for the information previously submitted, with the patent owner having the ability to object within the same fifteen (15) day time limits applying, i.e., fifteen (15) days from the date of this decision to make a statement with fifteen (15) days from date of service for an objection from patent owner. No extensions will be granted and no further arguments will be entertained. Prosecution will continue contemporaneously with this decision and any responsive statements.

* * *

Both parties are reminded of the requirements of 37 CFR 10.18(b)(1) and (b)(2).

* * *

The patent owner is required to notify the Office of the status of prior and concurrent proceedings in accordance with 37 C.F.R. 1.985(a). It has come to the attention of the Office that at least two district court cases related to this reexamination proceeding may have concluded. A paper advising the Office of the status of all related proceedings, including appeals and the status of the patent claims, should be filed as soon as possible in this proceeding with updates as necessary.

The request for reconsideration is dismissed.

---

[1] If the information is not required under 37 CFR 1.555, it will not be afforded special status. Information favorable to patentability, such as evidence of commercial success or other secondary considerations, should not be submitted under MPEP 724.02. Such information must be made of record in the proceeding. See MPEP 724.03. If such information is patent owner's own confidential information, patent owner must waive the privilege of confidentiality and have the information entered into the record to have it considered.

Telephone inquiries with regard to the substance of the decision should be directed to Caroline D. Dennison, Legal Advisor, at (571) 272-7729.

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

July 23, 2010
Kenpet8

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,102	10/24/2008	7,229,473	CRDS-0107	8914

45511 7590 01/27/2009

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ART UNIT	PAPER NUMBER

DATE MAILED: 01/27/2009

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JAN 27 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001102
PATENT NO. : 7229473
TECHNOLOGY CENTER : 3999
ART UNIT : 3993

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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WOODCOCK WASHBURN LLP
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PHILADELPHIA PA 19104-2891

(For Patent Owner)

MAILED

JAN 27 2009

CENTRAL REEXAMINATION UNIT

DAVID P. EMERY
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2100 PENNSYLVANIA AVE. NW, SUITE 800
WASHINGTON, DC 20037

(For Third Party Requester)

In re Cordis Corporation :
Inter Partes Reexamination Proceeding : **DECISION**
Control No.: 95/001,102 : **GRANTING-IN-PART**
Filed: October 24, 2008 : **PETITION**
For: U.S. Patent No. 7,229,473 B2 :

This is a decision on the patent owner petition January 9, 2009, entitled "Petition For Increase of Page Limit For Patent Owner's Response Pursuant to 37 CFR §§ 1.183 and 1.943(b)."

The petition and the above-captioned *inter partes* reexamination proceeding are before the Office of Patent Legal Administration for consideration.

For the reasons set forth below, patent owner's petition, taken as a 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 81 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

PETITION FEE

37 CFR 1.183 requires payment of the petition fee under 37 CFR 1.17(f), which is $400.00. Therefore, $400.00 has been charged to patent owner's Deposit Account No. 23-3050, as authorized in concluding paragraph of the present petition.

REVIEW OF SALIENT FACTS

1. U.S Patent number 7,229,473 ("the '473 patent") issued to Robert Falotico *et al* on June 12, 2007, from an application filed on August 24, 2006, and is assigned to Cordis Corporation.

2. On October 24, 2008, a request for *inter partes* reexamination of the '473 patent was filed by a third party requester, and assigned control number 95/001,102 ("the '1102 *inter partes* reexamination proceeding").

3. The '1102 *inter partes* reexamination proceeding was accorded a filing date of October 24, 2008.

4. An Order Granting *Inter Partes* Reexamination was mailed in the '1102 *inter partes* reexamination proceeding on January 5, 2009.

5. On January 5, 2009, a non-final Office action was mailed in which claims 1-5 of the patent were rejected.

6. On January 9, 2009, patent owner filed the present patent owner petition.

7. On January 14, 2009, the requester filed comments on the present patent owner petition concurrent with a petition under 37 CFR 1.183 to permit Office consideration of the comments. These filings will be addressed by a different decision.

DECISION

I. Applicable Regulatory Provisions

37 CFR 1.183 provides:

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

37 CFR 1.943(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. Findings and Analysis

The record shows that on January 9, 2009, the patent owner filed the present petition, in which patent owner requests a waiver of the requirements of 37 CFR 1.943(b) to permit the response to exceed the 50-page limitation set by that regulation for a patent owner's response.

In the present petition, patent owner specifically requests that the 37 CFR 1.943(b) 50-page limitation on the length of a patent owner response be waived to permit a 150 page response. Patent owner states that the non-final Office action dated January 5, 2009 comprises 81 pages and presents 82 grounds of rejection proposed by the Requester.

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 '1102 *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 81 pages in length is appropriate in the interest of justice. Petitioner has not pointed out the specifics of what will require 150 pages, and why.

Note that the page limit does not include appendices containing evidence only which are directed to facts.

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 81 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 with regard to this decision should be directed to Michael Cygan, Legal Advisor, at (571) 272-7700, or, in his absence, to Pinchus Laufer at (571) 272-7726.

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

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.
95/001,102	10/24/2008	7,229,473	CRDS-0107	8914

45511 7590 01/27/2009

WOODCOCK WASHBURN LLP
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2929 ARCH STREET
PHILADELPHIA, PA 19104-2891

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 01/27/2009

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

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Date:

MAILED

JAN 27 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001102
PATENT NO. : 7229473
TECHNOLOGY CENTER : 3999
ART UNIT : 3993

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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(For Patent Owner)

MAILED

JAN 27 2009

CENTRAL REEXAM

DAVID P. EMERY
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WASHINGTON, DC 20037

(For Third Party Requester)

In re *Cordis Corporation*
Inter Partes Reexamination Proceeding
Control No.: 95/001,102
Filed: October 24, 2008
For: U.S. Patent No. 7,229,473 B2

DECISION DISMISSING PETITION AND REFUSING ENTRY OF PAPER

This is a decision on third party requester's papers, filed on January 14, 2009, entitled "PETITION UNDER 37 CFR § 1.183 TO PERMIT REQUESTER COMMENTS ON PATENT OWNER PETITIONS FOR PAGE AND TIME LIMIT EXTENSIONS," and "REQUESTER COMMENTS ON PATENT OWNER PETITIONS FOR PAGE AND TIME LIMIT EXTENSIONS."

The January 14, 2009 third party requester papers are before the Office of Patent Legal Administration.

The January 14, 2009 third party requester comment is refused entry into the record, without consideration on the merits, for the reasons set forth below.

The January 14, 2009 third party requester petition under 37 CFR 1.183 is dismissed and refused entry into the record, for the reasons set forth below.

PETITION FEE

37 CFR 1.183 requires payment of the petition fee under 37 CFR 1.17(f), which is $400.00. Therefore, $400.00 has been charged to patent owner's Deposit Account No. 19-4880, as authorized in concluding paragraph of the present petition.

REVIEW OF FACTS

1. U.S Patent number 7,229,473 ("the '473 patent") issued to Robert Falotico *et al* on June 12, 2007, from an application filed on August 24, 2006, and is assigned to Cordis Corporation.

2. On October 24, 2008, a request for *inter partes* reexamination of the '473 patent was filed by a third party requester, and assigned control number 95/001,102 ("the '1102 *inter partes* reexamination proceeding").

3. The '1102 *inter partes* reexamination proceeding was accorded a filing date of October 24, 2008.

4. An Order Granting *Inter Partes* Reexamination was mailed in the '1102 *inter partes* reexamination proceeding on January 5, 2009.

5. On January 5, 2009, a non-final Office action was mailed in which claims 1-5 of the patent were rejected.

6. On January 9, 2009, patent owner filed a request for extension of time pursuant to 37 CFR 1.956 and a petition entitled "PETITION FOR INCREASE OF PAGE LIMIT FOR PATENT OWNER'S RESPONSE PURSUANT TO 37 CFR 1.183 AND 1.943(b)." These filings are addressed in separate decisions. The request for extension of time is being addressed by the Central Reexamination Unit.

7. On January 14, 2009, the requester filed the instant comments on the present patent owner petition concurrent with the instant petition under 37 CFR 1.183 to permit Office consideration of the comments.

8. The decision on the patent owner petition to increase the page limit under 37 CFR 1.183 is being mailed on an even date with this decision.

DECISION

I. RELEVANT STATUTES, REGULATIONS, AND EXAMINING PROCEDURE

35 U.S.C. § 314(b)(2) states:

> Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.

37 CFR 1.939(a) states:

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

37 CFR 1.945(a) 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:

> 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 1.183 provides:

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

II. DISCUSSION

For the reasons set forth below, the January 14, 2009 third party requester comments and petition to enter such comments, filed in response to the patent owner's January 9, 2009

request for extension of time and petition under 37 CFR 1.183, do not have a right of entry in the '1102 proceeding.

A. Third Party Requester Comments are Not Permitted for Procedural Matters in *Inter Partes* Reexamination

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 petition under 37 CFR 1.183, requesting suspension of 37 CFR 1.953(b) for increase of page limit, however, is **not** a "response" to an Office action on the merits. [1] Neither is the patent owner's request for an extension of time. 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 request for extension of time or petition under 37 CFR 1.183 for suspension of the rules. [2]

A third party requester's paper commenting on a patent owner's extension of time request or petition to waive the page limit set out in 37 CFR 1.943(b) is a paper that is not permitted by the statute governing *inter partes* reexamination proceedings, and accordingly was not provided for (i.e., was not permitted) in the regulations that implemented the *inter partes* reexamination statute. Furthermore, third party requester's petition under 37 CFR 1.183 to waive the rules forbidding third party comments has not been granted as detailed below. Third party requester's January 14, 2009 paper commenting on the 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, the third party requester's January 14, 2009 paper commenting on the patent owner's January 9, 2009 petition under 37 CFR 1.183 does not have a right of entry into the record of the '1102 proceeding and, as such, is not an authorized paper. Because the third party requester's January 14, 2009 paper 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 '1102 proceeding. See MPEP 2267.

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[1] Pursuant to 37 CFR 1.937, an *inter partes* reexamination proceeding is to be conducted in accordance with 37 CFR 1.104 - 1.116. The term "response" is used in reexamination proceedings to avoid confusion with the word "reply," a term used in the context of *ex parte* reexamination proceedings in connection with the right of a third party requester to file a "reply" under 37 CFR 1.535 to a patent owner's statement. Thus, MPEP § 2666, entitled "Patent Owner Response to an Office Action," discusses the requirements for a patent owner's "response" to an Office action on the merits in terms of 37 CFR 1.111, a regulation which governs the filing of "reply" to an Office action.

[2] When a petition under 37 CFR 1.183 includes a paper that, upon granting of the petition, would trigger a right for comment or response by a third party requester, then an opportunity to provide such comment or response is given at the point where the paper is entered (if the petition is granted).

B. The Office Lacks Statutory Authority to Consider the Substance of the Petition

Third party requester, noting that the Code of Federal Regulations does not provide for a third party response to patent owner petitions to waive the page limit under 37 CFR 1.943(b) or for extensions of time, filed a petition on January 14, 2009 under 37 CFR 1.183 to waive any rules precluding such response. However, the rules cannot be waived to provide the third party requester the right to file a paper at the present stage in the '1102 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 or for an extension of time 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 January 14, 2009 petition, however, seeks to waive a requirement, that a requester response is allowed only in response to a patent owner's response on the merits, set forth in 35 U.S.C. § 314(b)(2). Accordingly, the Office is without statutory authority to consider the substance of the third party requester's January 14, 2009 petition paper. In this respect, the 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.

The requester petition includes comments, extraneous to the merits of the petition, relating to the merits of the patent owner petition for waiver of 37 CFR 1.943(b) and patent owner's request for an extension of time. For this reason, the petition paper filed by the third party requester will be excluded from the record of the '1102 proceeding. Because the third party requester's January 14, 2009 petition 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 '1102 proceeding. [3]

III. ADDITIONAL DISCUSSION

It should be noted that the patent owner's January 14, 2009 petition under 37 CFR 1.183 did not stay any periods for reply running in the '1102 proceeding, as "[t]he mere filing of a petition will not stay any period for response that may be running against the application, nor act as a stay of other proceedings." [4]

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[3] *See* MPEP 2267.

[4] *See* 37 CFR 1.181(f).

Parties are advised to take care to avoid characterizing submissions by other parties. Petitions having improper commentary unrelated to the merits of the petition are subject to return or expengement without treatment upon their merits.

Further note that 37 CFR 1.4(c) states that :

> 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.

In this case, requester's comments and petition are directed both to extension of time and a petition under 1.183, which are different matters handled by different sections of the Office and are thus improper papers. Parties should be cognizant of the requirement for separate papers for separate matters.

CONCLUSION

1. The third party requester's January 14, 2009 comments paper filed in response to the patent owner's January 9, 2009 petition under 37 CFR 1.183, requesting suspension of 37 CFR 1.943(b), is refused entry as it is an improper paper.

2. Because the January 14, 2009 paper was previously incorporated into the IFW, the paper is being expunged from the record by marking it "closed" and "non-public" in the IFW of the '1102 proceeding. No copy of the January 14, 2009 paper will be maintained of record in the Office.

3. The third party requester's January 14, 2009 petition filed in response to the patent owner's January 9, 2009 petition under 37 CFR 1.183, requesting suspension of 37 CFR 1.943(b), is dismissed.

4. The petition paper filed by the third party requester on January 14, 2009 is expunged from the record for including material 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 '1102 *inter partes* reexamination proceeding and marking the paper "closed" and "not public.

5. A copy of this decision will be made of record in the IFW record of the '1102 proceeding.

6. Telephone inquiries with regard to this decision should be directed to Michael Cygan, Legal Advisor, at (571) 272-7700, or in his absence, to Pinchus M. Laufer, Legal Advisor, at (571) 272-7726.

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

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JUL 31 2009

CENTRAL REEXAMINATION UNIT

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(For *Inter Partes* Requester)

In re Falotico et al.
Inter partes Reexamination Proceeding
Control No. 95/001,102
Filed: Oct. 24, 2008
For: U.S. Patent No. 7,229,473

: DECISION DISMISSING
: PETITION TO SUSPEND
: REEXAMINATION
: PROCEEDING

This is a decision on the patent owner's July 1, 2009 petition titled "PETITION UNDER 37 C.F.R. § 1.182 and § 1.183 TO TEMPORARILY SUSPEND REEXAMINATION PROCEEDING 95/001,102." The petition requests that the Office temporarily suspend the present reexamination proceeding until September 21, 2009, which is asserted to be one month after the close of expert discovery in the co-pending litigation in the District Court involving the same patent. On July 13, 2009, requester filed an opposition paper titled "REQUESTER'S PETITION TO OPPOSE PATENT OWNER'S JULY 1, 2009 PETITION TO SUSPEND *INTER PARTES* REEXAMINATION PROCEEDINGS." This decision addresses both the patent owner and requester papers.

Patent owner's petition to suspend is **DISMISSED**.

RELEVANT FACTS

1. U.S. Patent No. 7,229,473 (the '473 patent) issued on June 12, 2007.

2. A request for reexamination of the '473 patent was filed on October 24, 2008. The request was assigned control No. 95/001,102 (the '1102 reexamination proceeding).

3. Reexamination was ordered for the '1102 reexamination proceeding on January 5, 2009. The examiner's order contained 40 pages. The Office also mailed a non-final rejection on the same date.

4. On January 9, 2009, the patent owner filed a request for an extension of time to file a response to the January 5, 2009 Office action, as well as a petition to waive the page limit rule under 37 CFR 1.943(b).

5. On January 23, 2009, the Office addressed patent owner's request for an extension of time and granted a two-month extension of time. The patent owner's response was extended until May 5, 2009.

6. It is asserted that, in April 2009, the patent owner and requester began discussions to authorize the patent owner to provide to the Office a copy of documents produced by the requester in the litigation being conducted in the U.S. District Court for the District of New Jersey that is styled *Wyeth and Cordis Corp. v. Abbott Laboratories et al*, Civil Action No. 07-5636.[1]

7. On May 5, 2009, patent owner timely filed a response to the January 5, 2009 Office action.

8. On June 4, 2009, the third party requester submitted comments after patent owner's response of May 5, 2009.

9. On July 1, 2009, the patent owner submitted the present petition pursuant to 37 CFR 1.182 and 1.183 to temporarily suspend the '1102 reexamination proceeding.

10. On July 13, 2009, the requester filed an opposition to the patent owner's petition to temporarily suspend the '1102 reexamination proceeding.

11. No Office actions are outstanding (i.e., none are awaiting response) in the present proceeding.

12. The District Court litigation has not been stayed pending resolution of this reexamination proceeding.

RELEVANT LAW AND REGULATIONS

37 CFR 1.182 provides:

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

[1] Patent owner petition at page 5.

37 CFR 1.183 provides:

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

37 CFR 1.939 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.

35 U.S.C. 305 provides:

After the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title. In any reexamination proceeding under this chapter, the patent owner will be permitted to propose any amendment to his patent and a new claim or claims thereto, in order to distinguish the invention as claimed from the prior art cited under the provisions of section 301 of this title, or in response to a decision adverse to the patentability of a claim of a patent. No proposed amended or new claim enlarging the scope of a claim of the patent will be permitted in a reexamination proceeding under this chapter. All reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office.

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.

35 U.S.C. 317(b) provides:

(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.

PATENT OWNER'S ARGUMENTS

1. Additional time is necessary to obtain authorization to submit evidence in support of patentability that is obtained through the discovery process in the District Court litigation.

2. Entry into Office's Appeal Process Prior to Resolution of the Protective Order Issue in the District Court Litigation would deprive Patent Owner of the ability to adequately defend the patent owner's patent.

3. A temporary suspension of an *inter partes* reexamination proceeding is not precluded under *Ethicon v. Quigg* 849 F. 2d. 1422 (Fed. Cir. 1998).

REQUESTER'S ARGUMENTS

1. The Patent Statute and MPEP mandate that the reexam be conducted with special dispatch.

2. Patent owner's arguments for temporarily staying the proceeding would eviscerate the *inter partes* statute for litigated patents, since such stays would effectively guarantee that the litigation would end prior to *inter partes* reexamination, thus terminating the reexaminations mid-course.

3. Patent owner has already delayed the '1102 reexamination proceeding by filing significant extensions of time for its responses.

4. Patent owner complained of Office delay when successfully opposing a stay of litigation and then filed request for such delay in the '1102 proceeding.

5. A stay is not necessary, because patent owner will have an opportunity to respond to the next Office action.

6. The rationale of the Federal Circuit's decision in *Ethicon v. Quigg* - that reexams generally should not be stayed pending litigation given Congress's "special dispatch" mandate- applies even stronger to *inter partes* reexamination since, unlike, *ex parte* reexamination, *inter partes* reexam are terminated early if not completed before the litigation ends.

ANALYSIS AND FINDINGS

As asserted by both patent owner and requester, 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 (a) for an indefinite length of time (b) in an *ex parte* reexamination, and, accordingly is not controlling authority on the present issue.

Patent owner argues that (1) additional time is necessary to obtain authorization to submit evidence in support of patentability that is obtained through the discovery process and (2) entry into the appeal process prior to resolution of the protective order issued in the District Court litigation would deprive patent owner of ability to adequately defend its patent rights.

Patent owner's argument that evidence has been obtained through the discovery process in the co-pending litigation and that it is reasonable to believe that additional information in support of patentability of the claims will be discovered through pre-trial discovery of expert witnesses is lacking in detail. The patent owner does not establish a reasonable basis as to the specifics it would expect to find. Patent owner does not provide any guidance and explanation as to what information it is expected to find during expert discovery, and how that information would be expected to be relevant to this proceeding. To the extent that patent owner is relying on future discovery, patent owner's request is based upon speculation.

In addition, as pointed out by the requester, the granting of stays based upon on-going 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.

Patent owner has not met its burden of showing good cause as to why such proceeding should be temporarily stayed pending conclusion of the discovery period in the on-going litigation in the District Court proceeding. Accordingly, the petition is dismissed.

As to obtaining entry of additional evidence (obtained through the discovery process) into a reexamination proceeding after the filing of an appeal and the limit the ability for a party to enter additional evidence after an Action Closing Prosecution (ACP):

Patent owner has potential remedies pursuant to 37 CFR 1.116, 37 CFR 1.182, 37 CFR 1.183 and 37 CFR 1.951. For example, if patent owner is addressing issues raised in the Office action closing prosecution, then such evidence may be admitted as part of a 37 CFR 1.951 submission, subject to the criteria of 37 CFR 1.116. If the patent owner cannot avail itself to 37 CFR 1.116 and 37 CFR

1.951, patent owner has recourse to filing a petition pursuant to either 37 CFR 1.182 or 37 CFR 1.183, whichever may be relevant. Patent owner is not being denied due process rights, and will have opportunity to have such evidence in its next response, if seasonably submitted with a showing to that effect, and the evidence is of the nature permitted in reexamination. Should the proceeding reach the point where an appellant brief is due prior to the asserted September 21, 2009 close of expert discovery (plus time to consider the results of the discovery), patent owner may request an extension of time by filing a petition under 37 CFR 1.183 to waive 37 CFR 41.66(a), providing the details of the need for the extension.

CONCLUSION

1. Patent owner's petition under 37 CFR 1.182 and 1.183 to temporarily suspend the present reexamination proceeding is **DISMISSED**.

2. Jurisdiction is being returned to the Central Reexamination.

3. Questions concerning this decision should be addressed to Susy Tsang-Foster, Legal Advisor, at 571-272-7711.

/Kenneth Schor/

Kenneth Schor
Senior Legal Advisor
Office of Patent Legal Administration

7-30-09
Kenpet7/IP/suspension

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,102	10/24/2008	7,229,473	CRDS-0107 / JJI-51-CON3	8914

45511 7590 03/18/2010

WOODCOCK WASHBURN LLP
CIRA CENTRE, 12TH FLOOR
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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/18/2010

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

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MAILED

MAR 18 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NUMBER *95/001,102*.

PATENT NUMBER *7,229,473*.

TECHNOLOGY CENTER *3999*.

ART UNIT *3993*.

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

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

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

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

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(For Patent Owner)

MAILED

MAR 18 2010

CENTRAL REEXAMINATION UNIT

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(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,102
Filed: October 24, 2008
For: U.S. Patent No. 7,229,473

: **DECISION ON**
: **PETITION REQUESTING**
: **CLARIFICATION OF**
: **PROCEDURES REGARDING**
: **CONFIDENTIAL**
: **DOCUMENT SUBMISSION**

This is a decision on the paper titled "Petition Under 37 C.F.R. § 1.182 and § 1.183 for Clarification of the Procedures for Submission of Third Party Confidential Documents in Support of Patentability and to Refute Positions Taken by the Third Party Requester" filed September 8, 2009 by patent owner. This decision also addresses the third party requester's "Petition to Respond to Patent Owner's September 8, 2009 Petition for Clarification" filed September 17, 2009.

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

The petition fee under 37 CFR 1.17(f) for both petitions has been received by the Office.

The patent owner's petition is **GRANTED** and clarification of Office procedures is provided herein.

The third party requester's petition is **GRANTED** to the extent that the comments have been considered.

BACKGROUND

1. U.S. Patent 7,229,473 (the '473 patent) issued on June 12, 2007 with claims 1-5. Cordis Corporation is the owner of the '473 patent.

2. There following civil litigations involve the '473 patent: (1) *Boston Scientific Corp. et al. v. Johnson & Johnson Inc. et al.*, U.S. District Court of Delaware, 1:07cv409 filed June 22, 2007 (closed); (2) *Cordis Corp. v. Abbott Laboratories*, U.S. District Court of New Jersey, 3:10cv296 filed January 20, 2010 (closed); (3) *Boston Scientific Corp. et al. v. Johnson & Johnson Inc. et al.*, U.S. District Court of Minnesota, 1:09cv2585 filed September 22, 2009 (closed); (4) *Cordis Corp. v. Abbott Laboratories*, U.S. District Court of New Jersey, 3:07cv2728 filed June 11, 2007 (closed).

3. A request for *inter partes* reexamination of claims 1-5 of the '473 patent was filed October 24, 2008, by third party requester, Abbott Laboratories, and assigned control No. 95/001,102 (the '1102 proceeding).

4. *Inter partes* reexamination was ordered for claims 1-5 of the '473 patent on January 5, 2009.

5. A non-final Office action was issued on January 5, 2009.

6. On May 5, 2009, patent owner filed a response to the January 5, 2009 Office action, after receiving an extension of time.

7. On June 4, 2009, the third party requester filed comments on the January 5, 2009 Office action and patent owner's May 5, 2009 response.

8. On July 1, 2009, patent owner filed a petition to temporarily suspend reexamination proceeding '1102 to provide patent owner "an opportunity to establish a full, fair and complete record of evidence in support of patentability of the claims".

9. On July 13, 2009, the third party requester filed a petition to oppose patent owner's July 1, 2009 petition.

10. Patent owner filed a reply to requester's July 13, 2009 petition on July 24, 2009, and the third party requester filed an objection to patent owner's reply on July 29, 2009. Both papers are improper and are being expunged from the record by a decision mailed concurrently herewith.

11. A decision dismissing patent owner's July 1, 2009 petition and addressing the third party requester's July 13, 2009 petition was issued July 31, 2009.

12. On September 8, 2009, patent owner filed a petition requesting clarification of procedures for submission of third party confidential documents and to refute positions taken by the third party requester. This petition is the subject of the present decision.

13. On September 17, 2009, the third party requester filed a petition to respond to patent owner's September 8, 2009 petition for clarification. This petition is also the subject of the present decision.

14. On December 2, 2009, patent owner filed a supplemental information disclosure statement with 58 information items, a submission of protective order materials, and a petition to expunge protective order materials.

DECISION

I. RELEVANT RULES AND REGULATIONS

37 CFR § 1.182 Questions not specifically provided for.

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

37 CFR § 1.183 Suspension of rules.

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

37 CFR § 1.59 Expungement of information or copy of papers in application file.

(a)(1) Information in an application will not be expunged, except as provided in paragraph (b) of this section.

(2) Information forming part of the original disclosure (i.e., written specification including the claims, drawings, and any preliminary amendment specifically incorporated into an executed oath or declaration under § § 1.63 and 1.175) will not be expunged from the application file.

(b) An applicant may request that the Office expunge information, other than what is excluded by paragraph (a)(2) of this section, by filing a petition under this paragraph. Any petition to expunge information from an application must include the fee set forth in § 1.17(g) and establish to the satisfaction of the Director that the expungement of the information is appropriate in which case a notice granting the petition for expungement will be provided.

(c) Upon request by an applicant and payment of the fee specified in § 1.19(b), the Office will furnish copies of an application, unless the application has been disposed of (see § § 1.53(e), (f) and (g)). The Office cannot provide or certify copies of an application that has been disposed of.

37 CFR 1.947 Comments by third party requester to patent owner's response in inter partes reexamination.

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

37 CFR 1.948 Limitations on submission of prior art by third party requester following the order for inter partes reexamination.

(a) After the inter partes reexamination order, the third party requester may only cite additional prior art as defined under § 1.501 if it is filed as part of a comments submission under § 1.947 or § 1.951(b) and is limited to prior art:

(1) which is necessary to rebut a finding of fact by the examiner;

(2) which is necessary to rebut a response of the patent owner; or

(3) which for the first time became known or available to the third party requester after the

filing of the request for inter partes reexamination proceeding. Prior art submitted under paragraph (a)(3) of this section must be accompanied by a statement as to when the prior art first became known or available to the third party requester and must include a discussion of the pertinency of each reference to the patentability of at least one claim.

MPEP 724 Trade Secret, Proprietary, and Protective Order Materials (in part)

Parties bringing information to the attention of the Office for use in the examination of applications and reexaminations are frequently faced with the prospect of having legitimate trade secret, proprietary, or protective order material disclosed to the public.
Inventors and others covered by 37 CFR 1.56(c) and 1.555 have a duty to disclose to the Office information they are aware of which is material to patentability. 37 CFR 1.56(b) states that

> information is material to patentability when it is not cumulative to information already of record or being made of record in the application, and
> (1) It establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim; or
> (2) It refutes, or is inconsistent with, a position the applicant takes in:
> (i) Opposing an argument of unpatentability relied on by the Office, or
> (ii) Asserting an argument of patentability.

A prima facie case of unpatentability is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.

It is incumbent upon patent applicants, therefore, to bring "material" information to the attention of the Office. It matters not whether the "material" information can be classified as a trade secret, or as proprietary material, or whether it is subject to a protective order. The obligation is the same; it must be disclosed if "material to patentability" as defined in 37 CFR 1.56(b). The same duty rests upon a patent owner under 37 CFR 1.555 whose patent is undergoing reexamination.

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

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

MPEP 724.04(c) Materials Submitted in Reexamination File Open to the Public Under 37 CFR 1.11(d)

Any materials, i.e., information, submitted under MPEP § 724.02 in a reexamination file open to the public under 37 CFR 1.11(d) will be treated in the following manner:

(A) Any materials, i.e., information, properly submitted under MPEP § 724.02 in a reexamination proceeding will be sealed from public view. The submitted information will be maintained separate from the reexamination file and will not be publicly available until a determination has been made as to whether or not the information is material to patentability. A petition to expunge (37 CFR 1.59) should accompany the submission of proprietary materials, and in any event, must be filed prior to, or shortly after (i.e., in time to be addressed before the reexamination proceeding enters the reexamination certificate printing process), the

mailing of a Notice of Intent to Issue Reexamination Certificate (NIRC). If the petition to expunge is not filed in time to be addressed before the reexamination proceeding enters the reexamination certificate printing process, or the petition is filed, and denied/dismissed, then the materials submitted under MPEP § 724.02 will be released to the public with any other papers in the reexamination file.

(B) Prior to the mailing of a NIRC, the examiner will review the reexamination file and determine if a petition to expunge is in the reexamination file but not acted upon. The examiner, or other appropriate Office official who is responsible for considering the information, will make a determination as to whether or not any portion or all of the information submitted is material to patentability.

(C) If any portion or all of the submitted information is found to be material to patentability, the petition to expunge will be denied and the information will thereafter become a permanent part of the reexamination file and open to the public. Where a submission containing protected material is found to be material to patentability, it still may be possible to redact the submission to eliminate the protected material while retaining the important material (e.g., where a confidential identifying number, such as a serial number or social security number, is included, which is not needed for the context of the submission). If so, the redacted version may be submitted to the Office along with a petition under 37 CFR 1.182 requesting that the unredacted version be sealed and be replaced with the redacted version.

(D) If all of the submitted information is found not to be material to patentability, the petition to expunge will be granted and the information expunged. If a portion of the submitted information is found not to be material to patentability, and a portion is found to be material to patentability, the petition to expunge will be dismissed, and patent owner (or the requester, in limited instances where appropriate) provided with an opportunity to separate the material and non-material information, such that the non-material information can be expunged. See item (C) above.

(E) If a petition to expunge is not filed prior to, or shortly after (i.e., in time to be addressed before the reexamination proceeding enters the reexamination certificate printing process), the mailing of the NIRC, the materials submitted under MPEP § 724.02 will become a permanent part of the reexamination file and open to the public under 37 CFR 1.11(d). In the event materials have already been made of record by a party, and it is subsequently determined that the materials are protected, the proper petition to submit would be a petition to seal the protected material under 37 CFR 1.182, with the requisite fee.

(F) Any petition to expunge a portion or all of the submitted information under 37 CFR 1.59(b) will be treated in accordance with MPEP § 724.05.

II. DECISION

1. Patent Owner's Request

Patent owner requests clarification of the procedures for submission of documents under seal. Specifically, patent owner requests clarification of procedures that apply to submissions of confidential documents that support patentability and/or refute positions taken by the requester during a reexamination proceeding.

Patent owner asserts that they have identified over fifty documents that are subject to protective orders in the above-cited copending litigations and contain objective evidence bearing on the patentability of patent owner's claims. Although not specifically explained how the objective evidence is relevant, the petition implies that the evidence bearing on the patentability includes evidence of secondary considerations and objective indicia of nonobviousness. Patent owner asserts that approval to submit specifically identified documents that are covered by the protective order was requested from the third party requester and was not granted. Patent owner requests clarification of procedures for submitting this confidential evidence supporting patentability and/or refuting positions taken by requester or establishment of such procedures.

2. Third Party Requester's Opposition

Third party requester petitions to be heard in response to patent owner's request for clarification, because the third party requester believes that the patent owner's positions, if accepted, would (a)

fundamentally violate the patent statute and third party requesters' statutory and due process rights and (b) significantly alter and adversely impact the procedures for all reexamination proceedings involving litigated patents. Specifically, third party requester seeks to inform the Office of a number of points outlined on pages 2 and 3 of the requester petition.

3. The Materials Submitted Under Seal and Protective Order in this Proceeding

To date, the following materials have been submitted under seal and have been alleged to be covered by protective orders. It is noted that copies of the applicable protective orders have not been filed in this proceeding.

On December 2, 2009, the patent owner submitted a sealed box containing materials identified as being subject to two different protective orders. The box was submitted with a Supplemental Information Disclosure Statement in which the patent owner "makes no representation that any of the items are material, enabled references or prior art to the claims under reexamination." The box includes 58 items of information, some of which are identified as deposition transcripts and others which appear to be publicly available publications based on their description. The box was accompanied by a petition to expunge protective order materials. The petition states that "the Protective Order Material would not be important to a reasonable examiner in deciding whether any claim of the above referenced application is patentable for reasons stated in the Protective Order Material."

4. The Office Procedure

The Office has clearly prescribed procedures for filing information material to patentability that is covered by a protective order as outlined in MPEP 724 *et seq.* The procedure for filing such materials set forth in MPEP 724.02 accommodates material that is required to be submitted on behalf of the patent owner under 37 CFR 1.555 and affords such material special status. However, there are no statutes or rules that require the disclosure of information favorable to patentability. Therefore, as the Office does not require such material to be submitted, the Office does not give voluntary submissions of such information any special status. Protective order materials that are submitted in favor of patentability will be made of record in the file and should not be submitted under the procedures of MPEP 724.02.

No assertions have been made by patent owner that the material intended to be submitted or already submitted is material to patentability of any claims under reexamination and should be afforded special status. In fact, the papers submitted by patent owner with the protected material specifically state that the material would not be important to a reasonable examiner in deciding whether any claim is patentable. Given this statement, it is unclear why these materials are being submitted in this proceeding.

Absent a clear showing that the materials must be submitted to comply with a statute or rule governing the parties in this reexamination proceeding, the Office is unwilling to enter protected materials into the record. The materials have not been shown to qualify for protected status in accordance with the procedures of MPEP 724.02 and, if they were, they would only remain protected if they are found not be material to the patentability by the examiner. Thus, if the Office accepts these materials they will entered into the public file and will not be afforded protected status. In order to honor the court orders, therefore, the Office will not enter these materials absent the following. To gain entry and consideration of the materials, the parties must

obtain an agreement between themselves that some limited form of the materials, such as a redacted version, may be submitted consistent with any limitations imposed by the protective order, or obtain permission from the court to submit the necessary materials in an acceptable form. The parties have recourse through the courts to request permission to submit necessary materials in this proceeding. Therefore, there are adequate remedies in existence to address this situation.

The parties have thirty (30) days from the date of this decision to obtain the necessary documentation that the protected materials may be submitted in this proceeding and become part of the public record. Absent such documentation, the materials will be expunged from the record and returned to the respective parties or made available to be picked up by the respective parties.

Further papers and petitions on this issue, other than those described immediately above, will not be entertained as there must be a limitation on party iterations of input, given the statutory mandate for special dispatch in reexamination. As provided in MPEP 2609:

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

CONCLUSION

1. Patent owner's petition is granted to the extent that clarification of the procedures has been provided. Third party requester's petition has been granted to the extent that the arguments presented therein have been considered.

2. Both parties are given thirty (30) days to file documentation that agreement has been reached between the parties or permission to file has been given by the court in accordance with the protective order that certain protected documents will be submitted and become a part of the record in this proceeding.

3. Jurisdiction of this proceeding will remain with OPLA until such time that the requested documentation is received. If the requested documentation is not provided within the time period, the protected material will be expunged from the record and returned to the respective parties or the parties will be given an opportunity to retrieve the material. Jurisdiction will then be transferred to the Central Reexamination Unit to take action.

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

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

March 18, 2010
Kenpet8/expunge/Ct order

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,102	10/24/2008	7,229,473	CRDS-0107 / JJI-51-CON3	8914

45511 7590 05/26/2010

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 05/26/2010

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WASHINGTON, DC 20037

Date: **MAILED**

MAY 26 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001102
PATENT NO. : 7229473
TECHNOLOGY CENTER : 3999
ART UNIT : 3993

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

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

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

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

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(For Patent Owner)

MAILED

MAY 26 2010

CENTRAL REEXAMINATION UNIT

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(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,102
Filed: October 24, 2008
For: U.S. Patent No. 7,229,473

DECISION DISMISSING REQUEST FOR ADDITIONAL TIME, RETURNING IMPROPER PAPERS & DISMISSING PETITIONS TO EXPUNGE

This is a decision addressing:

(1) the petition filed April 16, 2010 by patent owner entitled "Petition Under 37 CFR §§ 1.182 and 1.956 With Respect to Submission of Materials Under Seal";

(2) the miscellaneous paper filed April 19, 2010 by the third party requester entitled "Requester's Confirmation of No Party Agreement or Court Order per the PTO's Clarification Petition Rulings Mailed on March 18-19, 2010";

(3) the petition filed December 2, 2009 by patent owner entitled "Petition to Expunge Protective Order Materials Pursuant to 37 CFR 1.59"; and,

(4) the petition filed May 11, 2010 by patent owner entitled "Petition to Expunge Protective Order Materials Pursuant to 37 CFR 1.59."

The proceeding, the petitions, and the miscellaneous paper are before the Office of Patent Legal Administration for consideration.

Patent owner's petitions were each accompanied by a fee of $200 in accordance with 37 CFR 1.17(g). The third party requester's miscellaneous letter was not accompanied by a fee.

DECISION

(1) In a March 19, 2010 Decision by the Office, patent owner and requester were given thirty days to file, with respect to proffered protected materials, documentation that agreement has been reached between the parties to file the materials, or that permission to file has been given by the court. Such has not been done, and the thirty days have expired.

(2) The April 16, 2010 patent owner petition requests that the time period to submit documentation that the protected materials may be submitted in this proceeding be extended two weeks after the court's determination has been made. The petition states that patent owner is in the process of procuring the type of documentation identified in the March 19, 2010 Decision and states that it "intends" to seek the Magistrate's assistance in one concurrent litigation and "intends" to follow the judge's procedures for requesting assistance in the other proceeding. As patent owner has provided no evidence that procedures have been initiated to obtain the court's permission other than expressing an *intent* to obtain the documentation, the request for an extension of time for an indeterminate period is dismissed.

(3) The April 19, 2010 third party requester miscellaneous letter is an improper filing, as it is not a submission of comments on a patent owner response to an outstanding Office action and is not a response in accordance with the March 19, 2010 Decision (i.e., it is not documentation that the protected materials can be submitted.) Both parties were advised that further papers and petitions on this issue, other than the necessary documentation, would not be entertained. The April 19, 2010 paper is therefore being expunged from the image file wrapper (IFW) by closing the paper and marking it as non-public.

(4) Given the expiration of the thirty days as set forth in part (1) of this decision, the following papers are being expunged from the record and will not be considered by the examiner during reexamination.

(A) The sealed box submitted December 2, 2009 by patent owner, which will be made available for pick up by the patent owner's representative upon request for the next thirty days. If no arrangements are made for pick up, the box and papers will be disposed of.

(B) The sealed envelope submitted May 11, 2010 by patent owner, which will be made available for pick up by the patent owner's representative upon request for the next thirty days. If no arrangements are made for pick up, the box and papers will be disposed of.

The papers may be resubmitted for consideration when permission for submission is obtained despite the fact that the papers will become part of the public record should the examiner find the papers material to patentability.

Information covered by the court's protective orders is not to be submitted without evidence that permission has been granted for public disclosure of the information. **Further filings that include information covered by a protective order will be expunged until permission for submission has been provided in this proceeding.** As no evidence has been submitted that Office personnel are permitted to review the information, it is inappropriate to submit such information and cause a potential violation of a protective order. It is not acceptable to submit the information with restrictions on who may or may not open and review the information as it prohibits the Office from

processing the filing. Further, it does not appear that either party has the authority to grant selective access to the protected information.

(5) The petitions to expunge filed with the sealed submissions on December 2, 2009 and May 11, 2010 by the patent owner are also dismissed as moot by this decision as the sealed papers are no longer of record in the proceeding.

To arrange for pick up of the sealed papers, telephone inquiries are to be directed to Manuel Saldana at (571) 272-7740.

Telephone inquiries with regard to the substance of the decision should be directed to Caroline D. Dennison, Legal Advisor, at (571) 272-7729.

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

May 26, 2010
Kenpet8

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,102	10/24/2008	7,229,473	CRDS-0107 / JJI-51-CON3	8914

45511 7590 06/02/2010

WOODCOCK WASHBURN LLP
CIRA CENTRE, 12TH FLOOR
2929 ARCH STREET
PHILADELPHIA, PA 19104-2891

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/02/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

Date:

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001102
PATENT NO. : 7229473
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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In re Application of 7229473
Appl. No.: 95/001,102
Filed: October 24, 2008
For: Local Delivery of Rapamycin For Treatment Of Proliferative Sequelae Associated With PTCA Procedures, Including Delivery Using A Modified Stent

DECISION ON PETITION UNDER 37 CFR 1.59

This is a decision on the petition under 37 CFR 1.59(b), filed May 4, 2010, to expunge information from the above identified application.

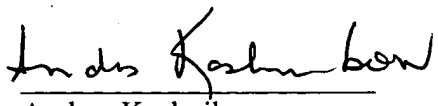
The petition is granted.

Petitioner requests that documents entitled Deposition of Dana Mead, April 23, 2009 consisting of 28 pages, and Deposition of Susan Silavin, November 5, 2008 consisting of 34 pages, filed April 16, 2010 as part of an Information Disclosure Statement, be expunged from the record. Petitioner states that either (A) that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in 37 CFR 1.17(g) has been paid.

The information in question has been determined by the undersigned to not be material to the examination of the instant application.

Applicant is required to retain the expunged material(s) for the life of any patent which issues on the above-identified application.

The expunged material has been removed from the official file. As the documents in question have been entered into the Electronic Image File Wrapper (IFW) record, the documents will be "returned" by closing the paper in the IFW record, and marking the paper nonpublic to expunge it from the record. The present decision will be made of record in the reexamination file.



Andres Kashnikow,
SPE CRU 3993
(571) 272-4361

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,102	10/24/2008	7,229,473	CRDS-0107 / JJI-51-CON3	8914

45511 7590 07/27/2010

WOODCOCK WASHBURN LLP
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PHILADELPHIA, PA 19104-2891

EXAMINER	

ART UNIT	PAPER NUMBER

DATE MAILED: 07/27/2010

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WASHINGTON, DC 20037

Date:
MAILED

JUL 27 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001102
PATENT NO. : 7229473
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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Joseph Lucci
Woodcock Washburn LLP
Cira Centre
2929 Arch St. 12th Floor
Philadelphia, PA 19104-2891

(For Patent Owner)

MAILED

JUL 27 2010

CENTRAL REEXAMINATION UNIT

Michael G. Raucci
Sughrue Mion PLLC
2100 Pennsylvania Ave. Suite 800
Washington, DC 20037

(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,102
Filed: October 24, 2008
For: U.S. Patent No. 7,229,473

DECISION DISMISSING REQUEST FOR RECONSIDERATION

This is a decision addressing the June 4, 2010 patent owner's request for reconsideration of the May 26, 2010 petition decision that dismissed patent owner's request for an extension of time.

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

Patent owner's request for reconsideration is dismissed. No extension of time is granted for providing evidence of permission from both courts that information covered by their respective protective orders may be submitted and potentially made public in this proceeding. As explained in the May 26 decision, the information may be resubmitted for possible consideration when the parties provide proper documentation.

However, expungement of the information is temporarily held in abeyance based on new assertions by patent owner in the request for reconsideration that the information is patent owner's own confidential information. Based on these assertions, the Office will permit either party to provide a statement in conformance with the requirements below that the information submitted is its own confidential information and that the respective party has the authority to waive the confidentiality. If a proper statement is filed within fifteen (15) days of this decision, the information will not be expunged and may be considered by the examiner, provided it is deemed a compliant submission. Absent such a statement, the respective parties' information will be destroyed if not picked up as directed in the May 26, 2010 decision.

Detailed Response to Request for Reconsideration

In the request for reconsideration, patent owner asserts that the decision has incorrectly characterized certain facts regarding actions taken with the court by patent owner. This assertion is not accurate. Patent owner's April 16, 2010 petition failed to provide any evidence that court proceedings had been initiated. In fact, the section quoted in the present petition shows that the prior petition merely explained the procedure and did not state that patent owner had begun proceedings. The Office is not privy to actions that occurred after filing of the petition, and it must rely on evidence and statements provided by the petitioner. The evidence now provided by patent owner is a letter to one of the courts that is dated April 21, 2010, which is *subsequent* to the April 16 petition. As such, this letter does not support patent owner's assertion that proceedings had been initiated with the court prior to filing the April 16 petition. Moreover, patent owner has previously asserted that there are protective orders from TWO courts involving the patent in this proceeding, yet the evidence submitted relates to only court.

The facts have been correctly characterized and do not support patent owner's assertions. There is no valid reason for granting an extension of time, which at present would still have no fixed end date, as the information can be resubmitted. As explained in the prior decision, it is the Office's statutory duty to conduct reexamination proceedings with special dispatch. Granting an indefinite extension of time would not serve this purpose and would only serve to slow proceedings.

Patent owner additionally asserts in the request for reconsideration that the information disclosure statements previously submitted in the proceeding do not include any documents that are subject to court review. Patent owner further explains that the information disclosure statements do not include the documents that are being evaluated by the court and that patent owner does not need permission of a court to submit them in this reexamination. This is a new assertion. It is noted that the previous information disclosure submissions at issue simply stated that the information was subject to court protective orders, with no further explanation. The court protective orders have not been submitted in this proceeding (with an explanation of how the relevant documents are not included within its ambit), and the Office has no way of evaluating whose confidential documents are being submitted. The April 16, 2010 petition also did not explain this, contrary to the assertions in the subject petition, and merely stated that the information disclosure statements contain "other types of litigation materials (including Patent Owner's confidential information)". Other types of litigation materials are not limited solely to patent owner's own information. Patent owner has not clearly stated on the record that the information is exclusively its own confidential information and that patent owner has the authority to waive the confidentiality if the information is found to be material to patentability.

Statement Regarding Confidentiality and Authority to Waive

Patent owner is provided one last opportunity to make clear what information is being submitted. The patent owner may submit the following statement within 15 days of this decision to avoid expungement of the information submitted under the protective orders. The statement must include the following:

a. An identification of the confidential information, including the title and the date it was submitted;

b. An identification of the protective order(s) that covers each item of confidential information;
c. A statement that the confidential information is entitled to special status in accordance with MPEP 724.02, because the information is required under 37 CFR 1.555 and not merely evidence in favor of patentability;[1]
d. A statement that all of the information sought to be submitted is patent owner's own confidential information and that patent owner has the authority to waive such confidentiality in the event the examiner deems the information material to patentability.

The third party requester may file an objection to the statement only if it can be shown, by evidence, that the statement is inaccurate, i.e., that the confidential information is third party requester's own information. Such an objection must be filed within fifteen (15) days of service of the patent owner's statement.

If patent owner submits a compliant statement, the identified information will not be expunged. Absent this statement, or if the third party requester files an acceptable objection or raises doubts as to the ownership of the information, the expungement procedure outlined in the May 26, 2010 decision will be followed. No further requests for consideration or arguments regarding this issue will be entertained.

The third party requester may also file a statement as set forth above for the information previously submitted, with the patent owner having the ability to object within the same fifteen (15) day time limits applying, i.e., fifteen (15) days from the date of this decision to make a statement with fifteen (15) days from date of service for an objection from patent owner. No extensions will be granted and no further arguments will be entertained. Prosecution will continue contemporaneously with this decision and any responsive statements.

* * *

Both parties are reminded of the requirements of 37 CFR 10.18(b)(1) and (b)(2).

* * *

The patent owner is required to notify the Office of the status of prior and concurrent proceedings in accordance with 37 C.F.R. 1.985(a). It has come to the attention of the Office that at least two district court cases related to this reexamination proceeding may have concluded. A paper advising the Office of the status of all related proceedings, including appeals and the status of the patent claims, should be filed as soon as possible in this proceeding with updates as necessary.

The request for reconsideration is dismissed.

---

[1] If the information is not required under 37 CFR 1.555, it will not be afforded special status. Information favorable to patentability, such as evidence of commercial success or other secondary considerations, should not be submitted under MPEP 724.02. Such information must be made of record in the proceeding. See MPEP 724.03. If such information is patent owner's own confidential information, patent owner must waive the privilege of confidentiality and have the information entered into the record to have it considered.

Telephone inquiries with regard to the substance of the decision should be directed to Caroline D. Dennison, Legal Advisor, at (571) 272-7729.

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

July 23, 2010
Kenpet8

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,103	10/29/2008	7390848	00448USREX	2944

24199 7590 07/15/2009

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PATENT RECORDS CENTER
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WILMINGTON, DE 19805

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 07/15/2009

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3M INNOVATIVE PROPERTIES COMPANY
P.O. BOX 33427
ST. PAUL, MN 55133-3427

Date:

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JUL 15 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001103
PATENT NO. : 7390848
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

(For Patent Owner)

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WILMINGTON DE 19805

(For Third Party Requester)

3M INNOVATIVE PROPERTIES COMPANY
P.O. BOX 33427
ST. PAUL, MN 55133-3427

In re Chapman, Jr. et al.	:	
Inter Partes Reexamination Proceeding	:	DECISION ON
Control No. 95/001,103	:	PETITION UNDER
Filed: October 29, 2008	:	37 CFR 1.181 & 1.927
For: U.S. Patent No. 7,390,848	:	

The third party Requester filed a paper on February 17, 2009, entitled "Petition Under 37 C.F.R. § 1.927" and an attached "Memorandum in Support of Petition" (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 January 16, 2009.

The Petition is **DENIED**.

REVIEW OF FACTS

1. U.S. Patent No. 7,390,848 (hereinafter, the '848 patent) issued on June 24, 2008.

2. A request for *inter partes* reexamination was filed on October 29, 2008. The resulting reexamination proceeding was assigned Control No. 95/001,103 (hereinafter, the '103 proceeding). Reexamination was requested for claims 1-3 and 5-8 of the '848 patent based upon U.S. Patent No. 4,904,735 to Chapman Jr., et al. (hereafter Chapman '735"), U.S. Patent No. 5,010,130 to Chapman Jr., et al. (hereafter "Chapman '130"), U.S. Patent No. 5,013,792 to Chapman Jr., et al. (hereafter "Chapman '792"), U.S. Patent No. 5,587,429 to Priester, U.S. Patent No. 5,830,947 to Blong et al. (hereafter "Blong"), U.S. Patent No. 6,380,313 to Dillon et al. (hereafter "Dillon"), Fronek et al., "Tailoring Processing Additives for High Density Polyethylene Applications", ANTEC '90, pp. 1172-1177 (hereafter "Fronek"), "Viton® FreeFlow" product sheet, DuPont Dow Elastomers pamphlet, September 1998, Reorder No.: H-79965 (hereafter "Viton"), and "Viton® Free Flow™23" product sheet, DuPont Polymers pamphlet, May 1991, Reorder No.: H-28365 (hereafter "Viton 23").

3. A Notice of Reexamination Request Filing Date for the '103 proceeding was issued on November 5, 2008.

4. An order denying the request for reexamination for claims 1-3 and 5-8 in the '103 proceeding was mailed on January 16, 2009.

5. On February 17, 2009, the third party requester filed the present petition under 37 CFR §§ 1.181 and 1.927 in the '103 proceeding.

Petitioner's Grounds in Support of the Requested Relief

Petitioner (the third party requester) alleges that the examiner's denial of the request for reexamination is improper because the examiner incorrectly concluded that the request did not present the "old art" in a new light or in a different way, and that the "new art" was relied upon for the same teachings present in the previously considered prior art.

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 1-28 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 1-28 of the '848 patent.

II. The Legal Standard for Ordering Reexamination

A review of 35 USC §§ 311-317 and 37 CFR 1.915, 1.919, and 1.923 shows that *inter partes* reexamination of a United States Patent is only authorized when a consideration of prior art consisting of patents or printed publications establishes that a substantial new question of patentability exists with respect to one or more claims of that patent. In particular, 35 USC 311(a) requires that a request for *inter partes* reexamination be based upon prior art as set forth in 35 USC § 301, that is, prior art consisting of patents or printed publications, while 37 CFR 1.915(b)(3) requires that a request for *inter partes* reexamination include "a statement pointing out each substantial new question of patentability based on the cited patents and printed publications." A substantial question of patentability is raised by a cited patent or printed publication when there is a substantial likelihood that a reasonable examiner would consider the prior art patent or printed publication important in deciding whether or not the claim is patentable. If the prior art patents and printed publications relied upon in the request raise a substantial question of patentability, then a "substantial new question of patentability" is present, unless the same question of patentability has already been decided by a final holding of invalidity after all appeals, or by the Office in a previous examination or in a reexamination of a patent.

In accordance with this legislative history for the original reexamination statute,[1] MPEP 2642, part II.A. was drafted to require, in order to raise a SNQ for old art, that the old art must be "presented/viewed in a new light, or in a different way, as compared with its use in the earlier examination(s), in view of a material new argument or interpretation presented in the request." This new light must be in terms of how to interpret the state of the "pre-existing technology," as was envisioned by the authors of the original reexamination statute, and left unchanged by the 2002 enactment. For example, a reference may be read in a "new light" if the requester draws attention to a portion of the reference that was not relied upon, or otherwise addressed, in a rejection during the

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

earlier concluded examination of the patent for which reexamination is requested. Similarly, a reference may be interpreted in a new light, or in a different way, by defining a term of art used in the reference, where the definition of the term of art had not been previously presented in the earlier concluded examination of the patent. If a substantial new question of patentability is found, an order for *inter partes* reexamination of the patent is issued. An SNQ is not raised by the old prior art if the Office has previously considered (in an earlier examination of the patent) the same question of patentability as to the patent and has decided that question in favor of the patent owner based on the same prior art patents or printed publications. *In re Recreative Technologies*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996).

III. Analysis of the Request for Reexamination in the '103 proceeding

The Request in the '103 proceeding sets forth the following proposed rejections based upon a substantial new question (SNQ) of patentability:

I. The request indicates that Requester considers that claims 1-3 and 5-8 are unpatentable over Blong (Request, pages 8-12).

II. The request indicates that Requester considers that claims 1-3 and 5-8 are unpatentable over Priester (Request, pages 13-18).

III. The request indicates that Requester considers that claims 1-3 and 5-8 are unpatentable over Priester and Chapman '735 (Request, pages 18-21).

IV. The request indicates that Requester considers that claims 1-3 and 5-8 are unpatentable over Priester in view of Chapman ' 130 (Request, pages 21-23).

V. The request indicates that Requester considers that claims 1-3 and 5-8 are unpatentable over Priester in view of Chapman '792 (Request, pages 23-24).

VI. The request indicates that Requester considers that claims 1-3 and 5-8 are unpatentable over Dillon (Request, pages 25-28).

VII. The request indicates that Requester considers that claims 1-3 and 5-8 are unpatentable over Dillon in view of Fronek and Viton (Request, pages 29-33).

VIII. The request indicates that Requester considers that claims 1-3 and 5-8 are unpatentable over Dillon in view of Fronek and Viton 23 (Request, pages 33-34).

The Request was denied in the January 16, 2009 Order Denying Request for *Inter Partes* Reexamination, wherein the examiner maintained that the cited prior art does not

raise a SNQ that is different from the determinations made in the application that matured into the '848 patent. The examiner determined that the prior art was not being presented or viewed in a new light by the arguments set forth in the Request. Therefore, the examiner stated that the Request did not present a new non-cumulative technical teaching.

As pointed out above, 37 CFR 1.927 provides for the filing of a petition to review an examiner's determination refusing to order *inter partes* reexamination. The CRU Director reviews the request *de novo* in response to the Petition, and such a review of the record, as a whole, has been made in this case.

The petition alleges that the examiner erred in his consideration of proposed rejections I, VI, VII and VIII.

A. Turning to the Request, pp. 8-12 state that claims 1-3 and 5-8 are anticipated by Blong. Blong discloses a melt-processable composition comprising, in admixture, 1) one or more melt-processable thermoplastic hydrocarbon polymers, 2) an effective amount of a chemically resistant, fluoropolymer process aid and 3) one or more poly(oxyalkylene) polymers. See abstract. Blong teaches:

> Fluoropolymers used in the invention should readily flow under the processing conditions of the thermoplastic hydrocarbon polymer into which it is admixed. In matching the fluoropolymer process aid with a thermoplastic hydrocarbon polymer, the fluoropolymer preferably should be chosen such that its melt viscosity matches or is about the same as the melt viscosity of the hydrocarbon polymer. For such matching, the fluoropolymer process aid can be selected such that the ratio of its melt viscosity to the melt viscosity of the thermoplastic hydrocarbon polymer is in the range of ratios from 0.01 to 100, more preferably in the range from 0.02 to 20, most preferably in the range between 0.05 and 5.

See paragraph bridging cols. 7-8. Blong does not teach using a fluoropolymer process aid having a Mooney viscosity of 60 to 80, as required by the claims.

The Request points to Blong's disclosure of comparative example C24, in which 500 ppm of fluoropolymer V10 in resin D was extruded (col. 34). This composition does not anticipate the claims because it does not contain an interfacial agent different from the other two components, as required by the claims of the '848 patent.

The petition argues that the examiner improperly used a § 103 type analysis in determining that the claims are not anticipated. The fact remains that Blong does not teach a composition having a fluoropolymer process aid with Mooney viscosity of 60 to 80, and therefore no SNQ is raised by Blong.

B. The Request states at pp. 25-28 that claims 1-3 and 5-8 are anticipated by Dillon. Dillon was applied in a rejection under § 103 during prosecution of the application that became the '848 patent. The examiner stated that "the disclosure of Dillon et al differs

from the presently claimed invention in not expressly exemplifying the use of a fluoroelastomer having a Mooney viscosity within the claimed range of 60 to 80." In asserting that this is an anticipatory reference, the Request cites the same portion of the disclosure as did the examiner. This is not a new interpretation of the state of the pre-existing technology, which is required to raise a SNQ. Moreover, disclosure of a range of 5-120 does not anticipate a claim requiring a range of 60-80, as there is nothing in the disclosure to lead one skilled in the art to the narrower range. See MPEP 2131.03(II). Petitioner's argument that the range of 60-80 is no "more unique" than 5-120 is not persuasive because "uniqueness" is not the test for anticipation. The test is whether the prior art discloses the claimed range with sufficient specificity to be anticipatory.

C. The Request states at pp. 29-33 that claims 1-3 and 5-8 are obvious over Dillon, Fronek and Viton. Dillon and Fronek were applied in a rejection under § 103 during prosecution of the application that became the '848 patent. In a statement of allowable subject matter (Office action of December 12, 2007), the examiner stated:

> These claims are directed to compositions comprising linear low density polyethylene. The optimum Mooney viscosities taught in Fronek are directed to high density polyethylene applications and not to linear low density polyethylene applications. Fronek discloses that the selection of an optimum fluoroelastomer Mooney viscosity is dependent on the particular non-fluorinated host resin that is selected, that is, they are resin dependent.

The new teaching not considered by the examiner is the Viton reference. The Request alleges that it was known in the art that the same process additive could be used interchangeably for LLDPE and HDPE, and that this is demonstrated by Table 1 of Viton. Viton is a "product selection guide" listing several fluoropolymer processing additives sold by DuPont Dow Elastomers. The specific composition of these products is not disclosed, nor is the Mooney viscosity. The Viton reference shows that different processing additives are recommended depending on the host resin and the intended application, and specifically states that the values shown in Table 1 should considered starting points for determining the amounts that should be used for a given application. Viton does not support Petitioner's assertion (p. 16 of the petition) that "the same type and concentration range of polymer processing additive was recommended for linear low density polyethylene and high density polyethylene."

The argument set forth in the Request appears to be that it would have been obvious to optimize the concentration and viscosity of fluoropolymer, as this was known to be a result effective variable. However, this argument was already made by the examiner during prosecution and determined not to apply to the narrower claims specifying LDPE, as quoted above. The Viton disclosure informs one skilled in the art that various fluoropolymers can be used with a variety of host resins. However, this same information is disclosed in Dillon at col. 8, lines 24-38. Thus addition of the Viton reference does not present the previously considered prior art in a new light and does not raise a SNQ.

D. The Request states at pp. 33-34 that claims 1-3 and 5-8 are obvious over Dillon, Fronek and Viton 23. Petitioner's argument is similar to that discussed immediately above. In this case, the Viton 23 reference provides even less information than the Viton reference. The only pertinent disclosure is that the product can be used in all types of polyolefins to achieve "processing improvements." The fact that fluoropolymer additives can be used with a variety of host resins was already disclosed in Dillon at col. 8, lines 24-38. Thus addition of the Viton 23 reference does not present the previously considered prior art in a new light and does not raise a SNQ.

E. The petition did not allege any errors in the examiner's analysis of proposed rejections II-V. These proposed rejections have also been reviewed *de novo* and it is agreed that they do not raise a SNQ with regard to claims 1-3 and 5-8 of the '848 patent.

CONCLUSION

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

2. A partial refund of the filing fee for the request for reexamination will be made to the third party requester in due course. See 35 U.S.C. 312(c) and 37 CFR 1.26(c).

3. This decision is final and nonappealable. 37 CFR 1.927. No further communication on this matter will be acknowledged or considered.

4. Telephone inquiries related to this decision should be directed to Deborah Jones, Supervisory Patent Examiner, at (571) 272-1535, or in her absence to the undersigned at (571) 272-3838.

Gregory A. Morse
Director
Central Reexamination Unit

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In re Farmwald et al.	
Inter partes Reexamination Proceeding	
Control No. 95/001,105	
Filed: November 6, 2008	DECISION, *SUA SPONTE*,
For: U.S. Patent No. 6,751,696	TO MERGE REEXAMINATION
	PROCEEDINGS
In re Farmwald et al.	
Inter partes Reexamination Proceeding	
Control No. 95/001,133	
Filed: December 31, 2008	
For: U.S. Patent No. 6,751,696	

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 6,751,696 (the '696 patent) issued to Farmwald et al. on June 15, 2004, with 60 claims.

2. A request for *inter partes* reexamination of the '696 patent, assigned Reexamination Control No. 95/001,105 ('1105), was filed by third party requester Samsung Electronics Co., Ltd. on November 6, 2008.

3. A request for *inter partes* reexamination of the '696 patent, assigned Reexamination Control No. 95/001,133 ('1133), was filed by third party requester Micron Technology on December 31, 2008.

4. An order granting reexamination of claims 1 and 4 of the '696 patent was mailed for the '1105 reexamination proceeding on January 9, 2009.

5. An order granting reexamination of claims 1 and 4 of the '696 patent was mailed for the '1133 reexamination proceeding on January 22, 2009.

DECISION

I. MERGER OF PROCEEDINGS

Under 37 CFR 1.989(a):

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

As evidenced by the above review of facts, both the '1105 and the '1133 reexamination proceedings are currently pending. An order granting reexamination, limited to claims 1 and 4 of the '696 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 95/001,105 and 95/001,133 reexamination proceedings would address these considerations. Thus, pursuant to 37 CFR 1.989(a), the 95/001,105 and 95/001,133 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 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 requesters are reminded that every paper filed in the merged proceeding subsequent to this Decision must be served on the other parties, including papers filed *via* facsimile transmission.

C. Amendments:

The filing of any amendments to the specification, claims, and drawings must comply with the provisions of 37 CFR 1.530 and the guidelines of MPEP § 2666. 37 CFR 1.121 does not apply to amendments in a reexamination proceeding. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via markings pursuant to 37 CFR 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

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

D. Fees:

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

E. Citation of Patents and Printed Publications:

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

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/001,105 and *inter partes* Reexamination Control No. 95/001,133 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 Michael Cygan, at (571) 272-7700, or in his absence, to Pinchus M. Laufer, at (571)272-7726.

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

March 3, 2008
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In re Farmwald et al.
Inter Partes Reexamination Proceeding
Control No. 95/001,105
Filed: November 6, 2008
For U.S. Patent Number 6,751,696 B2

In re Farmwald et al.
Inter Partes Reexamination Proceeding
Control No. 95/001,133
Filed: December 31, 2008
For U.S. Patent Number 6,751,696 B2

DECISION DISMISSING PATENT OWNER'S PETITION TO WAIVE THE PAGE LIMIT FOR ITS APPELLANTS' BRIEF, AND DISMISSING PETITIONS TO WAIVE THE PAGE LIMITS FOR RESPONDENT'S BRIEFS

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

(1) Petition filed March 16, 2010 by patent owner entitled "EXPEDITED PETITION SEEKING WAIVER OF 37 CFR § 1.943."

(2) Petition filed March 29, 2010 by patent owner entitled "SECOND PETITION SEEKING WAIVER OF 37 CFR § 1.943."

(3) Petition filed April 28, 2010, by third party requester entitled "THIRD PARTY REQUESTER'S PETITION UNDER 37 C.F.R. § 1.183 FOR LIMITED WAIVER OF 37 C.F.R. § 1.943(C)."

(4) Petition filed April 29, 2010 by patent owner entitled "PETITION SEEKING WAIVER OF 37 C.F.R. § 1.943 FOR PATENT OWNER'S RESPONDENT APPEAL BRIEF."

This decision also addresses the third party requester's May 14, 2010 opposition paper entitled "THIRD PARTY REQUESTER'S OPPOSITION TO PATENT OWNER'S PETITION SEEKING WAIVER OF 37 C.F.R. § 1.943 FOR PATENT OWNER'S RESPONDENT APPEAL BRIEF."

The proceeding, the patent owner's petitions, and the third party requestor's petition and opposition paper, 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 C.F.R. § 1.183 has been received.

SUMMARY

(1) The patent owner's March 16, 2010, and March 29, 2010 petitions requesting waiver of its appellant brief page limit restrictions under 37 C.F.R. § 1.943(c) are dismissed as the situation has not been shown to be extraordinary as explained below. The appellant brief filed March 29, 2010 is expunged as improper, since it does not comply with 37 CFR 1.943(c). The patent owner's brief shall not exceed 30 pages. The patent owner is given 15 days from the date of this decision to file a compliant appellant that that does not exceed 30 pages.[1]

(2) The third party requester's April 28, 2010 petition requesting waiver of its respondent brief page limit restrictions under 37 C.F.R. § 1.943(c) is dismissed as the situation has not been shown to be extraordinary as explained below. The respondent brief filed April 29, 2010 is expunged as improper as it does not comply with 37 CFR 1.943(c). Third party requester's brief shall not exceed 15 pages. The third party requester may file a corrected or redacted respondent brief that does not exceed 15 pages in response to patent owner appellant brief once filed, within one month from the date of service of the appellant brief.

(3) The patent owner's April 29, 2010 petition requesting waiver of its respondent brief page limit restrictions under 37 C.F.R. § 1.943(c) is dismissed as the situation has not been shown to be extraordinary as explained below. The respondent brief filed April 29, 2010 is expunged as improper as it does not comply with 37 C.F.R. § 1.943(c). Patent owner's respondent brief shall not exceed 15 pages. Patent owner may file a corrected or redacted respondent brief that does not exceed 15 pages in response to third party requester's appeal brief within 15 days of the date of this decision.

(4) The third party requester's May 14, 2010 opposition paper to patent owner's April 29, 2010 petition is dismissed and expunged as having no right of entry in this proceeding.

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

REVIEW OF THE RELEVANT FACTS

1. On June 15, 2004, U.S. Patent No. 6,751,696 B2 ('the '696 patent) issued with sixty claims to Farmwald *et al.* and assigned on its face to Rambus, Inc.

2. On November 6, 2008, the filing date requirements for a request for *inter partes* reexamination of claims 1 and 4 of the '696 patent was submitted by a third party requester, Samsung Electronics, which request was assigned control number 95/001,105 ("the '1105 proceeding").

3. On December 31, 2008, the filing date requirements for a second request for *inter partes* reexamination of claims 1 and 4 of the '696 patent was submitted by a third party requester, Micron Technology, which request was assigned control number 95/001,133 ("the '1133 proceeding").

4. On January 9, 2009, an Order was granted for *inter partes* reexamination of claims 1 and 4 of the '696 patent in the '1105 proceeding.

5. On January 22, 2009, an Order was granted for *inter partes* reexamination of claims 1 and 4 of the '696 patent in the '1133 proceeding.

6. On March 9, 2009, the '1105 and '1133 proceedings were merged.

7. The merged proceeding has progressed to the point where, on December 18, 2009, a Right of Appeal Notice (RAN) was mailed in the merged proceeding.

8. On January 15, 2010, patent owner filed a Notice of Appeal for claims 1 and 4.

9. On January 29, 2010, third party requester Micron Technology filed a Notice of Cross Appeal for claims 1 and 4.

10. On March 16, 2010, patent owner filed a petition under 37 C.F.R. § 1.183 requesting waiver of the page limit requirements of 37 CFR 1.943(c).

11. On March 29, 2010, patent owner filed an appellant's brief, along with a second petition under 37 C.F.R. § 1.183 requesting waiver of the page limit requirements of 37 CFR 1.943(c).

12. On March 29, 2010, third party requester filed an appellant's brief.

13. On April 28, 2010 third party requester filed a petition under 37 C.F.R. § 1.183 requesting waiver of page limit requirements of 37 CFR 1.943(c). On April 29, 2010, third party requester filed the respondent's brief.

14. On April 29, 2010, patent owner filed a respondent's brief, along with a petition under 37 C.F.R. § 1.183 requesting waiver of the page limit requirements of 37 CFR 1.943(c).

15. On May 14, 2010, third party requester filed an opposition paper, citing no authority for its entry, requesting dismissal of patent owner's April 29, 2010 petition.

RELEVANT AUTHORITY

37 CFR 1.183 provides:

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

37 CFR 1.943(c) provides:

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

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 Petitions of March 16, 2010 and March 29, 2010.

The patent owner requests waiver of 37 C.F.R. § 1.943(c), which limits patent owner's appellant brief to thirty (30) pages or 14,000 words in length. The patent owner states that the brief as filed is 23,240 words.

Waiver is requested for the following reasons, which according to the patent owner, present an extraordinary situation:

(1) The extensive arguments made by the Office in the RAN, which is over 100 pages in length.

(2) The size of the applied Bennett reference, in combination with the other applied references.

(3) The number of issues raised by the Office in the RAN, including claim rejections, secondary considerations, and claim construction issues.

II. Third Party Requester Petition of April 29, 2010

The third party requester Micron Technology requests waiver of 37 C.F.R. § 1.943(c), which limits third party requester's respondent brief to fifteen (15) pages or 7,000 words in length. The third party requester desires waiver to 33 pages or 15,400 words.

Waiver is requested for the sole reason that patent owner's appellant's brief exceeded the page limit requirements, which according to the third party requester, presents an extraordinary situation.

III. Patent Owner Petition of April 29, 2010

The patent owner requests waiver of 37 C.F.R. § 1.943(c), which limits the respondent brief to fifteen (15) pages or 7,000 words in length. The patent owner states that the respondent brief as filed is 9,389 words.

Waiver is requested for the reason that Micron's appellant's brief raises numerous (three) issues, which according to the patent owner, present an extraordinary situation.

IV. Third Party Requester's Opposition Paper of May 14, 2010

The third party requester Micron Technology requests that the patent owner petition of April 29, 2010 be dismissed as not meeting the requirements of 37 C.F.R. § 1.183 because the patent owner should not need extra pages in a respondent brief to address issues raised in a third party requester appellant brief which did not exceed the normal page length requirements.

V. Analysis and findings

A. Determining Page Length

As noted in MPEP 2667(I)(A)(2), the provisions of 37 C.F.R. § 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 C.F.R. § 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 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.

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

B. Patent Owner Has Not Shown the Existence of an Extraordinary Situation Requiring Waiver of the Page Limit Rule For Patent Owner's Appellant's Brief

Patent owner's petition rests upon three facts supporting an unfairness in application of the page limit rules. First, the RAN, which is over 100 pages in length, includes extensive arguments made by the Office requiring treatment at some length in the appellant's brief. Second, the size of the applied Bennett reference, in combination with the other applied references, presents an unusual situation. Third, the number of issues raised by the Office in the RAN, including claim rejections, secondary considerations, and claim construction issues, necessarily requires treatment at some length in the appellant's brief.

The content of patent owner's appellant's brief has been considered, in view of the prosecution history, to determine the necessity of page limit waiver on the arguments presented by patent owner. Prior to appeal, the claims and rejections/issues were adequately addressed in significantly fewer pages than in the appellant's brief. Furthermore, the appellant's brief addresses fewer grounds of rejection than were addressed in earlier patent owner responses, as some rejections have been adopted but not maintained. Additionally, it is noted that only one independent claim, and a total of two claims, are under appeal. Nevertheless, patent owner has devoted over 50 pages to the obviousness rejections of claim 1.[3] It is further noted that the RAN addresses these rejections primarily over a 12 page span, and although significant additional treatment of claim construction issues is present, it is clear that a significant number of the 105 pages in the RAN are not the subject of patent owner's appellant brief.[4]

Despite the simplification of issues, and the fact that the regulations contemplate an appellate brief to be 40% shorter than an response to an Office action, patent owner has here submitted an appellant brief having a number of pages that is longer than the permitted page limit for a response to an action, and indeed, over 50% greater than that contemplated under the regulations even when measured by the word count. No reason why an increase in pages, relative to the length of patent owner's previous responses to Office actions, is now warranted has been provided.

The appeal rules for reexamination have been structured such that treatment of issues is expected to be compressed relative to responses during prosecution. As patent owner filed responses within the 50 page limit for responses, it should be expected that, barring extraordinary circumstances, patent owner's appellant's brief should remain within the 30 page limit for appellant's briefs. None of the above facts, viewed in context of the circumstances of the proceeding, give rise to an extraordinary situation such that waiver of the page limit rules would be necessary to satisfy the requirements of justice in the instant proceeding. Therefore, patent

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[3] Patent owner's appellant brief, at ii-iii, indicating that pages 6-57 address the rejection of claim 1. Pages 58-60 address the rejection of claim 4, and pages 61-64 address secondary considerations of nonobviousness.

[4] Patent owner's appellant's brief cites primarily to pages 89-101 of the RAN; however, the brief also cites to additional pages of the RAN , particularly pages 9, 21-26, 36-38, 53-57, and 60-67 for claim construction issues. It is further noted that approximately the first eight pages of the argument in the appellant's brief are devoted towards a general discussion of the claimed invention and the Bennett reference; the discussion merits of the rejection appear to begin at page 13 of the brief; *e.g.*, at the section entitled "e. *Bennett* Does Not Read on the Claimed Inventions."

owner's request to waive 37 C.F.R. § 1.943(c), to the extent necessary to permit the March 29, 2010 patent owner's appellant's brief, is **dismissed**.

C. Third Party Requester Has Not Shown the Existence of an Extraordinary Situation Requiring Waiver of the Page Limit Rule For Third Party Requester's Respondent's Brief

Third party requester Micron Technology's petition rests on the sole ground that a waiver of page limit requirements for an appellant's brief necessarily requires a waiver of page limit requirements for the corresponding respondent's brief. However, the rationale for waiver of page limit requirements for the appellant's brief rest upon the combination of a lengthy RAN, lengthy references, and numerous issues requiring treatment by the patent owner. The third party requester has not set forth any facts supporting a contention that the respondent's brief could not fairly be written within the standard page limits. Furthermore, it is not apparent from the prosecution history that a combination of factors exists such that an extraordinarily lengthy respondent's brief would be necessitated to satisfy the requirements of justice.

Third party requester Micron Technology has failed to persuasively establish the existence of an extraordinary situation requiring waiver of the page limit requirements for its yet-to-be-filed respondent's brief. Therefore, third party requester's request to waive 37 C.F.R. § 1.943(c), to permit a respondent brief of up to 14,000 words or 30 pages, is **dismissed**.

D. Patent Owner Has Not Shown the Existence of an Extraordinary Situation Requiring Waiver of the Page Limit Rule For Patent Owner's Respondent's Brief

Patent Owner's petition requests waiver of the page limit requirement for patent owner's respondent's brief based upon the fact that the third party requester's appellant's brief raises numerous (three) issues. However, it is noted that the third party requester's appellant's brief presents these issues and yet remains within the page limit requirements set forth in 37 C.F.R. § 1.943(c). No reason why an increase in pages is now warranted has been provided. Furthermore, it is not apparent from the prosecution history that a combination of factors exists such that an extraordinarily lengthy respondent's brief would be necessitated to satisfy the requirements of justice.

Patent owner has failed to persuasively establish the existence of an extraordinary situation requiring waiver of the page limit requirements for its yet-to-be-filed respondent's brief. Therefore, third party requester's request to waive 37 C.F.R. § 1.943(c), to permit a respondent brief of 9,885 words is **dismissed**.

E. 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.

Both parties 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. 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 with the brief.

F. Third Party Requester's Opposition Paper Has No Right Of Entry

With respect to the May 14, 2010 requester paper opposing patent owner's petition under 37 C.F.R. § 1.183, no statute or regulation provides any right for the third party requester to file an opposition to, or comment on, the patent owner's petition to request waiver of respondent brief page limits. A request for waiver of respondent brief page limits 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 equities as to the "special dispatch" requirement and 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 not expressly provided for by the rules. 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 waiver of respondent brief page limits. No mechanism has been provided for the third party requester to file a paper, such as the present 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 waiver of respondent brief page limits is a paper that is not permitted by the statute governing *inter partes* reexamination proceedings, and accordingly it was not provided for (i.e., was not permitted) in the regulations that implemented the *inter partes* reexamination statute. Third party requester's opposition to patent owner's petition for waiver of respondent brief page limits is therefore not enterable into the record.

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 opposition, filed on May 14, 2010 to the patent owner's

petition for waiver of respondent brief page limits filed on April 29, 2010 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 for revival will be 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. The patent owner petitions filed on March 16, 2010 and March 29, 2010 under 37 C.F.R. § 1.183 to waive the provisions of 37 C.F.R. § 1.943(c) for the appeal brief are **dismissed**. The appellant brief filed March 29, 2010 is expunged from IFW by closing it in IFW and marking it as non-public. Patent owner has 15 days from the date of this decision to file a compliant appellant brief pursuant to 37 C.F.R. § 41.67(d). The time for filing an appeal brief may not be extended.

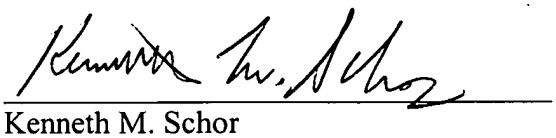
2. The third party requester petition filed April 28, 2010 under 37 C.F.R. § 1.183 to waive the provisions of 37 C.F.R. § 1.943(c) for the respondent brief is **dismissed**. The respondent brief filed April 29, 2010 is expunged from IFW by closing it in IFW and marking it non-public. Third party requester has one month from the date of service of patent owner's appellant brief to file a compliant respondent brief pursuant to 37 C.F.R. § 41.68(c). The time for filing a respondent brief may not be extended. Failure to timely file a respondent brief will result in the respondent brief not being considered.

3. The patent owner petition filed April 29, 2010 under 37 CFR 1.183 to waive the provisions of 37 C.F.R. § 1.943(c) for the respondent brief is **dismissed**. The respondent brief filed April 29, 2010 is expunged from IFW by closing it in IFW and marking it non-public. Patent owner has 15 days from the date of this decision to file a compliant respondent brief pursuant to 37 C.F.R. § 41.68(c). The time for filing a respondent brief may not be extended. Failure to timely file a respondent brief will result in the respondent brief not being considered.

4. The May 14, 2010 requester opposition petition paper is **refused entry**, as it is an improper paper. The opposition paper is being expunged by closing the paper in the Image File Wrapper (IFW) for the proceeding and marking it "not public." It will not constitute part of the record of the present reexamination proceeding.

5. Jurisdiction over the merged reexamination proceeding is hereby returned to the Central Reexamination Unit.

6. Any questions concerning this communication should be directed to Michael Cygan, Legal Advisor, at 571-272-7700.



Kenneth M. Schor
Senior Legal Advisor
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May 26, 2010

UNITED STATES PATENT AND TRADEMARK OFFICE

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CENTRAL REEXAMINATION UNIT

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In re Farmwald et al.
Inter Partes Reexamination Proceeding
Control No. 95/001,105
Filed: November 6, 2008
For U.S. Patent Number 6,751,696 B2

In re Farmwald et al.
Inter Partes Reexamination Proceeding
Control No. 95/001,133
Filed: December 31, 2008
For U.S. Patent Number 6,751,696 B2

DECISION DISMISSING PETITIONS

This is a decision on the following papers:

(1) Petition filed March 4, 2010 by patent owner entitled "PETITION TO SIMPLIFY ISSUES FOR APPEAL," by striking portions of the third party requester's Notice of Cross Appeal.

(2) Opposition filed March 19, 2010 by the '1133 third party requester entitled "THIRD PARTY REQUESTER'S OPPOSITION TO PATENT OWNER'S PETITION TO SIMPLIFY ISSUES FOR APPEAL."

(3) Petition filed April 29, 2010, by patent owner entitled "PETITION TO DISMISS THIRD PARTY REQUESTER'S CROSS APPEAL."

(4) Opposition filed June 1, 2010 by the '1133 third party requester entitled "THIRD PARTY REQUESTER'S OPPOSITION AND REQUEST TO EXPUNGE IMPROPER PAPER."

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

The petitions and oppositions are dismissed as moot.

FEES

The fee set forth in 37 CFR 1.17(f) for both patent owner petitions is $400, which was charged to Patent Owner's credit card on March 5, 2010 and April 30, 2010 pursuant to the authorizations for same in Patent Owner's EFS-WEB fee transmittals filed on March 4, 2010 and April 29, 2010.

The '1133 third party requester oppositions are being taken as petitions under 37 CFR 1.182/1.183. The fee set forth in 37 CFR 1.17(f) for these petitions is $400.

Regarding the March 19, 2010 opposition, the $400 fee will be charged to the '1133 requester's deposit account no. 14-1437, pursuant to the authorization on page two of requester's March 19, 2010 petition.

Regarding the June 1, 2010 opposition, the $400 was charged to the '1133 requester's deposit account no. 14-1437 on June 2, 2010, pursuant to the authorization on page one of requester's June 1, 2010 opposition.

REVIEW OF THE RELEVANT FACTS

1. On June 15, 2004, U.S. Patent No. 6,751,696 B2 ('the '696 patent) issued with sixty claims to Farmwald *et al.* and assigned on its face to Rambus, Inc.

2. On November 6, 2008, the filing date requirements for a request for *inter partes* reexamination of claims 1 and 4 of the '696 patent was submitted by a third party requester, Samsung Electronics, which request was assigned control number 95/001,105 ("the '1105 proceeding").

3. On December 31, 2008, the filing date requirements for a second request for *inter partes* reexamination of claims 1 and 4 of the '696 patent was submitted by a third party requester, Micron Technology, which request was assigned control number 95/001,133 ("the '1133 proceeding").

4. On January 9, 2009, an Order granted *inter partes* reexamination of claims 1 and 4 of the '696 patent in the '1105 proceeding.

5. On January 22, 2009, an Order granted *inter partes* reexamination of claims 1 and 4 of the '696 patent in the '1133 proceeding.

6. On March 9, 2009, the '1105 and '1133 proceedings were merged.

7. The merged proceeding has progressed to the point where, on December 18, 2009, a Right of Appeal Notice (RAN) was mailed in the merged proceeding.

8. On January 15, 2010, patent owner filed a Notice of Appeal for claims 1 and 4.

9. On January 29, 2010, the '1133 third party requester, Micron Technology, filed a Notice of Cross Appeal for claims 1 and 4.

10. On March 4, 2010, patent owner filed a petition under 37 CFR 1.182 requesting issues be stricken from the '1133 third party requester's January 29, 2010 Notice of Cross Appeal.

11. On March 19, 2010, the '1133 third party requester filed an opposition paper, citing no authority for its entry, requesting dismissal of patent owner's March 4, 2010 petition.

12. On March 29, 2010, patent owner filed an appeal brief.

13. On March 29, 2010, the '1133 third party requester filed a cross appeal brief.

14. On April 29, 2010, patent owner filed a respondent brief, along with a petition under 37 CFR 1.182 requesting dismissal of the '1133 third party requester's cross appeal.

15. On April 29, 2010, third party requester filed a respondent brief.

16. On May 27, 2010, the Office issued a decision expunging patent owner's March 29, 2010 appeal brief and April 29, 2010 respondent brief and third party requester's April 29, 2010 respondent brief.

17. On June 1, 2010, the '1133 third party requester filed an opposition paper, requesting dismissal and expungement of patent owner's April 29, 2010 petition.

18. On June 11, 2010, patent owner filed a revised appeal brief and a revised respondent brief.

19. On July 2, 2010, the Office reopened prosecution of the merged proceeding by issuing an Action Closing Prosecution (ACP).

DECISION

On March 4, 2010, and April 29, 2010, patent owner filed its present petitions. On March 19, 2010, the '1133 third party requester filed its opposition to patent owner's March 4, 2010 petition. On June 1, 2010, the '1133 third party requester filed its opposition to patent owner's April 29, 2010 petition. In the March 4, 2010 petition, patent owner requests that the Office strike from the record specific issues for appeal in the '1133 third party requester's January 29, 2010 notice of cross appeal. In the April 29, 2010 petition, patent owner requests that the Office strike from the record the '1133 third party requester's March 29, 2010 cross appeal brief and dismiss the cross appeal. The '1133 third party requester opposes patent owner's March 4, 2010 request to strike issues raised on cross appeal and opposes patent owner's April 29, 2010 request to strike the March 29, 2010 cross appeal brief and dismissal of the cross appeal.

On July 2, 2010, the Office issued an ACP, reopening prosecution in the merged proceeding and removing the merged proceeding from appeal. The Office's reopening of prosecution renders the petitions and oppositions regarding the propriety of '1133 third party requester's appeal moot. Accordingly, the all the present petitions and oppositions are DISMISSED AS MOOT.

ADDITIONAL DISCUSSION

In the '1133 third party requester's June 1, 2010 opposition the position that patent owner's April 29, 2010 is an improper paper was advanced. The '1133 requester asserts patent owner's April 29, 2010 petition is a "renewal" of patent owner's March 4, 2010 petition and responsive to the '1133 requester's March 19, 2010 oppositions. The '1133 requester therefore concludes patent owner's April 29, 2010 petition is an improper, iterative paper that should be expunged from the record of the proceeding. The '1133 requester is in error. Patent owner's March 4, 2010 petition is in response to the '1133 requester's notice of cross appeal filed on January 29, 2010 and asks for the relief of striking from the record all issues listed in the notice of cross appeal that were not raised by the '1133 requester. Patent owner's April 29, 2010 petition is in response to the '1133 requester's cross appeal brief filed on March 29, 2010 and asks for the relief of expungement of the brief and dismissal of the appeal. As the April 29, 2010 petition is responding to a different submission, it is neither a renewal of the March 4, 2010 petition nor an improper iterative response to the '1133 requester's March 19, 2010 opposition. Therefore, patent owner's April 29, 2010 petition submission is not an improper paper. Accordingly, patent owner's April 29, 2010 petition submission is not subject to expungement.

CONCLUSION

1. The petitions and oppositions are **dismissed as moot**.

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

3. Any questions concerning this communication should be directed to Joseph F. Weiss, Jr., Legal Advisor, at 571-272-7759.

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

July 9, 2010

UNITED STATES PATENT AND TRADEMARK OFFICE

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CENTRAL REEXAMINATION UNIT

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In re Farmwald et al.
Inter partes Reexamination Proceeding
Control No. 95/001,106
Filed: November 6, 2008
For: U.S. Patent No. 6,266,285

In re Farmwald et al.
Inter partes Reexamination Proceeding
Control No. 95/001,131
Filed: December 31, 2008
For: U.S. Patent No. 6,266,285

DECISION, *SUA SPONTE*,
TO MERGE REEXAMINATION
PROCEEDINGS

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

REVIEW OF FACTS

1. United States Patent Number 6,266,285 (the '285 patent) issued to Farmwald et al. on July 24, 2001, with 33 claims.

2. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/001,106 ('1106), was filed by third party requester Samsung Electronics Co., Ltd. on November 6, 2008.

3. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/001,131 ('1131), was ifiled by third party requester Micron Technology on December 31, 2008.

4. An order granting reexamination of claims 13, 15, and 16 of the '285 patent was mailed for the '1106 reexamination proceeding on January 9, 2009.

5. An order granting reexamination of claims 13, 15, and 16 of the '285 patent was mailed for the '1131 reexamination proceeding on January 22, 2009.

DECISION

I. MERGER OF PROCEEDINGS

Under 37 CFR 1.989(a):

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

As evidenced by the above review of facts, both the '1106 and the '1131 reexamination proceedings are currently pending. An order granting reexamination, limited to claims 13, 15, and 16 of the '285 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 95/001,106 and 95/001,131 reexamination proceedings would address these considerations. Thus, pursuant to 37 CFR 1.989(a), the 95/001,106 and 95/001,131 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 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 requesters are reminded that every paper filed in the merged proceeding subsequent to this Decision must be served on the other parties, including papers filed *via* facsimile transmission.

C. Amendments:

The filing of any amendments to the specification, claims, and drawings must comply with the provisions of 37 CFR 1.530 and the guidelines of MPEP § 2666. 37 CFR 1.121 does not apply to amendments in a reexamination proceeding. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via markings pursuant to 37 CFR 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

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

D. Fees:

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

E. Citation of Patents and Printed Publications:

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

PATENT OWNER'S ADDRESS

The 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 Neil A. Steinberg, Rambus,

Inc., 2465 Latham Street, Mountain View, CA 94040. However, correspondence previously sent to this address in the '1106 and '1131 proceedings has been returned marked undeliverable.

The certificate of service for the 95/001,106 request rendered service upon Neal Steinberg at the patent owner address of record and additionally upon Ann Williams, Rambus, Inc., 4440 El Camino Real, Los Altos, CA 94022. The certificate of service for the 95/001,131 request designated the same mailing address. As a courtesy, this decision is being mailed to both addresses.

The address of Neil A. Steinberg, Rambus, Inc., 2465 Latham Street, Mountain View, CA 94040, will be the sole address used in future correspondence, until a change in correspondence address in the patent and the reexamination is made in accordance with 37 CFR 1.33(c).

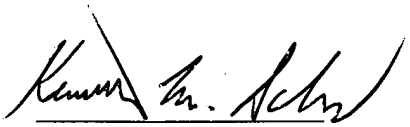
CONCLUSION

1. *Inter partes* Reexamination Control No. 95/001,106 and *inter partes* Reexamination Control No. 95/001,131 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

2. Patent owner is required to file an appropriate change of correspondence address of record in the patent (the same should be done for the reexamination proceedings), if the current address is not correct.

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.

4. Any questions concerning this communication should be directed to the Office of Patent Legal Administration, to Michael Cygan, at (571) 272-7700, or in his absence, to Pinchus M. Laufer, at (571)272-7726.



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JUN 23 2010

CENTRAL REEXAMINATION UNIT

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In re: Farmwald *et alia*
Reexamination Proceeding
Control No. 95/001,106
Request Deposited: November 6, 2008
For: U.S. Patent No. 6,266,285

In re: Farmwald *et alia*
Reexamination Proceeding
Control No. 95/001,131
Request Deposited: December 31, 2008
For: U.S. Patent No. 6,266,285

: **DECISION DISMISSING**
: **PETITION TO**
: **WITHDRAW ACP**

The merged *inter partes* reexamination proceeding is before the Director of the Central Reexamination Unit to address the patent owner petition filed November 23, 2009 entitled "PETITION TO WITHDRAW THE ACTION CLOSING PROSECUTION OF OCTOBER 23, 2009" and a third-party paper filed December 23, 2009 entitled "RESPONSE TO RAMBUS'S PETITION TO WITHDRAW THE ACTION CLOSING PROSECUTION OF OCTOBER 23, 2009".

The patent owner petition is timely filed and considered pursuant to 37 CFR §1.181. 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.

BACKGROUND

After inter partes reexamination control numbers 95/001,106 (the '1106 proceeding) and 95/001,131 (the '1131 proceeding) were merged, a non-final office action was mailed on March 13, 2009. Patent Owner responded with arguments and no amendments to the claims on June 15, 2009. After both requesters filed comments, the office issued an Action Closing Prosecution (ACP) on October 23, 2009. On November 23, 2009, Patent Owner (PO) filed a petition to withdraw the ACP. On December 22, 2009, the '1106 Requester filed a paper entitled "RESPONSE TO RAMBUS'S PETITION TO WITHDRAW THE ACTION CLOSING PROSECUTION OF OCTOBER 23, 2009".

DECISION

Petitioner argues the merits of the rejections or characterizes points raised by the examiner in the response to arguments section of the ACP as new positions taken by the office.

Arguing the merits of a rejection is subject to appeal to the Board of Patent Appeals and Interferences and it thus not a petitionable issue. This decision takes no position as to the merits of any rejection.

Petitioner argues that the examiner has raised "new issues" by responding to some of the arguments presented by PO. Petitioner takes the position that answering arguments presented by the PO should be construed as the examiner not having fully developed the grounds of rejection. For example, petitioner argues that the examiner defines the term "memory device" for the first time on pages 18-21 of the ACP. However, the examiner fully developed the rejections of the claims in the non-final office action of March 13, 2009. The section referenced in the petition is a rebuttal of PO's arguments as to the claim rejections. The key point is that the examiner has not altered the grounds of rejection and has not given a new thrust to the rejections. The position taken in the response to arguments is consistent with the manner in which the examiner applied art against the claim term "memory device" in the non-final rejection. The examiner is simply

rebutting PO's argument that the references do not disclose a "memory device". Therefore, closing prosecution in the ACP was not done prematurely.

Therefore, the petition is **dismissed**.

Regarding the third-party paper filed December 22, 2009 entitled "RESPONSE TO RAMBUS'S PETITION TO WITHDRAW THE ACTION CLOSING PROSECUTION OF OCTOBER 23, 2009", 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 December 22, 2009 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 ACP be withdrawn. 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 from an action of an examiner. No mechanism has been provided for the third party requester to file a paper, such as the December 22, 2009 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 from an action of an examiner 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 to provide a limited reopening of prosecution. 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 withdraw the ACP 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 December 22, 2009 opposition to the patent owner's November 23, 2009 petition requesting entry of an amendment 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 for revival 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 withdraw the ACP is **dismissed**.

2. The December 22, 2009 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.

Gregory Morse
Director, Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,107	11/07/2008	6314051	38512.19	6166

22852 7590 11/12/2009

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 11/12/2009

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/001,107	11/07/08	6314051	38512.19

EXAMINER
ESCALANTE, OVIDIO

ART UNIT	PAPER
3992	

DAVID M. O'DELL, ESQ.
HAYNES AND BOONE, LLP
2323 VICTORY AVENUE, SUITE 700
DALLAS, TX 75219

DATE MAILED:
MAILED
NOV 12 2009
CENTRAL REEXAMINATION UNIT

INTER PARTES REEXAMINATION COMMUNICATION

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/001,132	12/31/08	6314051	896.002.051

TRACY W. DRUCE, ESQ.
NOVAK DRUCE & QUIGG, LLP
1000 LOUISIANA AVE, 53rd FLOOR
HOUSTON, TX 77002

EXAMINER	
ESCALANTE, OVIDIO	
ART UNIT	**PAPER**
3992	

DATE MAILED:

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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

NOV 12 2009

CENTRAL REEXAMINATION UNIT

David M O'Dell
HAYNES AND BOONE, LLP
IP SECTION
2323 VICTORY AVENUE
SUITE 700
DALLAS, TX 75219

(For Third Party Requester)

Tracy W Druce
NOVAK DRUCE & QUIGG, LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET
FIFTY-THIRD FLOOR
HOUSTON, TX 77002

(For Third Party Requester)

DECISION
DISMISSING
PETITION FOR EXTENSION
OF TIME
[37 CFR § 1.956 and § 1.181]

In re: Farmwald *et alia*
Inter Partes Reexamination Proceeding
Control No. 95/001,107
Deposited on: 07 November 2008
For: US Patent No. 6,314,051

In re: Farmwald *et alia*
Inter Partes Reexamination Proceeding
Control No. 95/001,132
Deposited on: 31 December 2008
For: US Patent No. 6,314,051

This is a decision on the 06 November 2009, "Patent Owner's Petition for Extension of Time Pursuant to 37 CFR 1.956" requesting that the time for responding to the Action Closing Prosecution mailed 23 October 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 action mailed 23 October 2009, which set a two (2) months time for filing a response thereto. The petition for extension of time was timely filed on 06 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 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.

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 action was mailed 23 October 2009. The patent owner submitted a timely filed the petition on 06 November 2009 with the appropriate fee and certificate of service.

The petition dated 06 November 2009 cites the length of the Office action as well as interpretation issues among multiple prior art rejections, the petitioner further notes a large number of co-pending proceedings. The possible need for declarations was also noted. The previously granted petition for extension of time recited essentially the same reasoning. On balance, the petitioner has not demonstrated "sufficient cause" to grant an extension of time.

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 Action Closing Prosecution dated 23 October 2009 is hereby **dismissed.**

2 The Patent Owner's response is due **23 November 2009.**

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

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

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

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

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

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

/Mark Reinhart/
for

Gregory Morse,
Director,
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,107	11/07/2008	6314051	38512.19	6166

22852 7590 06/21/2010

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP
901 NEW YORK AVENUE, NW
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ART UNIT	PAPER NUMBER

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/001,132	12/31/08	6314051	896.002.051

TRACY W. DRUCE, ESQ.
NOVAK DRUCE & QUIGG, LLP
1000 LOUISIANA AVE, 53rd FLOOR
HOUSTON, TX 77002

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

HAYNES AND BOONE, LLP
IP SECTION
2323 VICTORY AVENUE
SUITE 700
DALLAS TX 75219

MAILED

JUN 21 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NUMBER *95/001,107*, *95/001,132*

PATENT NUMBER *6,314,051*.

TECHNOLOGY CENTER *3900*.

ART UNIT *3992*.

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

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

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

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

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2323 VICTORY AVENUE
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DALLAS TX 75219

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

REEXAMINATION CONTROL NUMBER *95/001,107*, 95/001,132

PATENT NUMBER *6,314,051*.

TECHNOLOGY CENTER *3900*.

ART UNIT *3992*.

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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(For Patent Owner)

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

(For '1107 Requester)

HAYNES AND BOONE, LLP
IP SECTION
2323 VICTORY AVENUE
SUITE 700
DALLAS, TX 75219

(For '1132 Requester)

NOVAK DRUCE & QUIGG, LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET
FIFTY-THIRD FLOOR
HOUSTON, TX 77002

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JUN 21 2010

CENTRAL REEXAMINATION UNIT

In re: Farmwald *et alia*
Reexamination Proceeding
Control No. 95/001,107
Request Deposited: November 7, 2008
For: U.S. Patent No. 6,314,051

In re: Farmwald *et alia*
Reexamination Proceeding
Control No. 95/001,132
Request Deposited: December 31, 2008
For: U.S. Patent No. 6,314,051

DECISION DISMISSING PETITION TO WITHDRAW ACP

The merged *inter partes* reexamination proceeding is before the Director of the Central Reexamination Unit to address the patent owner petition filed November 23, 2009 entitled "PETITION TO WITHDRAW THE ACTION CLOSING PROSECUTION OF OCTOBER 23, 2009" and a third-party paper filed December 22, 2009 entitled "THIRD PARTY REQUESTER'S OPPOSITION TO PATENT OWNER'S PETITION TO WITHDRAW THE ACTION CLOSING PROSECUTION OF OCTOBER 23, 2009".

The patent owner petition is timely filed and considered pursuant to 37 CFR §1.181. 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.

BACKGROUND

After inter partes reexamination control numbers 95/001,107 (the '1107 proceeding) and 95/001,132 (the '1132 proceeding) were merged, a non-final office action was mailed on March 13, 2009. Patent Owner responded with arguments and no amendments to the claims on June 15, 2009. After both requesters filed comments, the office issued an Action Closing Prosecution (ACP) on October 23, 2009. On November 23, 2009, Patent Owner (PO) filed a petition to withdraw the ACP. On December 22, 2009, the '1132 Requester filed a paper entitled "THIRD PARTY REQUESTER'S OPPOSITION TO PATENT OWNER'S PETITION TO WITHDRAW THE ACTION CLOSING PROSECUTION OF OCTOBER 23, 2009".

DECISION

Petitioner either argues the merits of the rejections or characterizes points raised by the examiner in the response to arguments section of the ACP as new positions taken by the office.

Arguing the merits of a rejection is subject to appeal to the Board of Patent Appeals and Interferences and it thus not a petitionable issue. This decision takes no position as to the merits of any rejection.

Petitioner argues that the examiner has raised "new issues" by responding to some of the arguments presented by PO. Petitioner takes the position that answering arguments presented by the PO should be construed as the examiner not having fully developed the grounds of rejection. For example, petitioner argues that the examiner defines the term "memory device" for the first time on pages 18-21 of the ACP. However, the examiner fully developed the rejections of the claims in the non-final office action of March 13, 2009. The section referenced in the petition is a rebuttal of PO's arguments as to the claim rejections. The key point is that the examiner has not altered the grounds of rejection and has not given a new thrust to the rejections. The position taken in the response to arguments is consistent with the manner in which the examiner applied art against the claim term "memory device" in the non-final rejection. The examiner is simply

rebutting PO's argument that the references do not disclose a "memory device". Therefore, closing prosecution in the ACP was not done prematurely.

Therefore, the petition is **dismissed**.

Regarding the third-party paper filed December 22, 2009 entitled "THIRD PARTY REQUESTER'S OPPOSITION TO PATENT OWNER'S RENEWED PETITION UNDER 37 CFR §1.181 REQUESTING ENTRY OF AMENDMENT", 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 December 22, 2009 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 ACP be withdrawn. 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 from an action of an examiner. No mechanism has been provided for the third party requester to file a paper, such as the December 22, 2009 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 from an action of an examiner 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 to provide a limited reopening of prosecution. 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 withdraw the ACP 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 December 22, 2009 opposition to the patent owner's November 23, 2009 petition requesting entry of an amendment 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 for revival 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 withdraw the ACP is **dismissed**.

2. The December 22, 2009 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.

Gregory Morse
Director, Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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JUL 21 2009

CENTRAL REEXAMINATION UNIT

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.
901 NEW YORK AVENUE, NW
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(For Patent Owner)

DAVID L. MCCOMBS, ESQ.
HAYNES AND BOONE, LLP
901 MAIN STREET, SUITE 3100
DALLAS, TX 75202-3789

(For 95/001,108 Requester)

TRACY W. DRUCE
NOVAK DRUCE & QUIGG, LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET 53rd FLOOR
HOUSTON, TX 77002

(For 95/001,154 Requester)

In re Farmwald et al.
Inter partes Reexamination Proceeding
Control No.: 95/001,108
Filed: November 7, 2008
For: U.S. Patent No. 6,584,037

In re Farmwald et al.
Inter partes Reexamination Proceeding
Control No. 95/001,154
Filed: March 3, 2009
For: U.S. Patent No. 6,584,037

DECISION, *SUA SPONTE*, TO MERGE REEXAMINATION PROCEEDINGS

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

REVIEW OF RELEVANT FACTS

1. U. S. Patent Number 6,584,037 (the '037 patent) issued to Farmwald et al. on June 24, 2003, with 45 claims.

2. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/001,108 ('1108 proceeding), was filed by third party requester on November 7, 2008. Samsung Electronics, Co. Ltd. is identified as the real party in interest.

3. An order granting reexamination of claim 34 of the '037 patent was mailed for the '1108 reexamination proceeding on January 9, 2009.

4. An Office action containing at least one rejection of claim 34 of the '037 patent was mailed for the '1108 reexamination proceeding on February 13, 2009.

5. Patent owner filed a timely response on May 13, 2009, retaining original patent claims 1-45 as unamended.

6. Third party requester filed timely comments on June 12, 2009, pursuant to 37 CFR 1.947.

7. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/001,154 ('1154 proceeding), was filed March 3, 2009, by third party requester Micron Technology, Inc.

8. An order granting reexamination of claim 34 of the '037 patent was mailed for the '1154 reexamination proceeding on April 22, 2009.

9. No Office action has been mailed, and no amendments to the claims have been made, in the '1154 *inter partes* reexamination proceeding.

DECISION

I. MERGER OF PROCEEDINGS

Under 37 CFR 1.989(a):

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

As evidenced by the above review of facts, both the '1108 and the '1154 reexamination proceedings are currently pending. The order to reexamine has been mailed for both reexamination proceedings, and a decision under 37 CFR 1.989(a) is timely.

The general policy of the Office is that two reexamination proceedings will not be conducted separately, and at the same time, as to a particular patent. The rationale for this policy is (1) to prevent inconsistent, and possibly conflicting, amendments from being introduced into the two proceedings on behalf of the patent owner, (2) to provide a comprehensive examination of the patent based on the issues raised in both of the proceedings, and (3) to expedite the prosecution of both proceedings. In the present instance, merger of the 95/001,108 and 95/001,154 reexamination proceedings would address these considerations. Thus, pursuant to 37 CFR 1.989(a), the 95/001,108 and 95/001,154 reexamination proceedings are hereby merged. The merged proceeding will be conducted in accordance with the guidelines and requirements which follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

The claims are identical in both proceedings. The patent owner is required to continue to maintain the same claims (and specification) in both files *throughout the merged proceeding*.

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

The present decision merges an *inter partes* reexamination proceeding with another *inter partes* reexamination proceeding. Pursuant to 37 CFR 1.989(b), the merged proceeding is governed by 37 CFR 1.902 through 1.997.

B. Papers mailed/filed:

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

All papers that are filed by the patent owner and the third party requesters should be directed:

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

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

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

By hand (or delivery service):

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

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

The patent owner and the requesters are reminded that every paper filed in the merged proceeding subsequent to this Decision must be served on the other parties, including papers filed *via* facsimile transmission.

C. Amendments:

The filing of any amendments to the specification, claims, and drawings must comply with the provisions of 37 CFR 1.530 and the guidelines of MPEP § 2666. 37 CFR 1.121 does not apply to amendments in a reexamination proceeding. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via markings pursuant to 37 CFR 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

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

D. Fees:

Where a paper is filed which requires payment of a fee (e.g., extension of time fee, excess claims fee, petition fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For example, only one fee need be paid for patent owner's appellant brief (or that of one of the *inter partes* reexamination requesters), even though the brief relates to merged multiple proceedings

and even though copies must be filed (as pointed out above) for each file in the merged proceeding.

E. Citation of Patents and Printed Publications:

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

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/001,108 and *inter partes* Reexamination Control No. 95/001,154 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

2. Jurisdiction over the merged reexamination is being forwarded via the Central Reexamination Unit Director to the examiner for the preparation of an Office action, to be issued in due course for the merged proceeding.

3. Any questions concerning this communication should be directed to Pinchus M. Laufer, Legal Advisor, at (571) 272-7726.

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

July 10, 2009
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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.
95/001,108	11/07/2008	6584037	38512.15	6309

22852 7590 07/27/2010

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 07/27/2010

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.
95/001,108	11/07/2008	6584037	38512.15

DAVID L. MCCOMBS
HAYNES AND BOONE, LLP
901 MAIN STREET
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DALLAS, TX 75202-3789

EXAMINER	
OVIDIO, ESCALANTE	
ART UNIT	**PAPER**
3992	

DATE MAILED:

07/27/10

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.
95/001,108	11/07/2008	6584037	38512.15

DAVID L. MCCOMBS
HAYNES AND BOONE, LLP
901 MAIN STREET
SUITE 3100
DALLAS, TX 75202-3789

EXAMINER
OVIDIO, ESCALANTE

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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FINNEGAN, HENDERSON, FARABOW,
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(For patent owner)

David L. McCombs
Haynes and Boone, LLP
901 Main Street, Suite 3100
Dallas, TX 75202-3789

(For the '1108 *inter partes* requester)

Tracy W. Druce
NOVAK, DRUCE & QUIGG, LLP
1000 Louisiana Avenue, 53rd Floor
Houston, TX 77002

(For the '1154 *inter partes* requester)

MAILED

JUL 27 2010

CENTRAL REEXAMINATION UNIT

In re Farmwald *et al.*
Inter Partes Reexamination Proceeding
Control No.: 95/001,108
Filed: November 7, 2008
For: U.S. Patent No.: 6,584,037

In re Farmwald *et al.*
Inter Partes Reexamination Proceeding
Control No.: 95/001,154
Filed: March 3, 2009
For: U.S. Patent No.: 6,584,037

DECISION DISMISSING PETITION

This is a decision on the June 10, 2010 patent owner petition entitled "PETITION TO STRIKE PORTIONS OF THE THIRD PARTY REQUESTER'S APPEAL BRIEF AND UNMERGE THE MERGED REEXAMINATION PROCEEDING."

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

The petition is dismissed.

BACKGROUND

1. On June 24, 2003 the Office issued U.S. Patent No. 6,584,037 to Farmwald *et al.*

2. On November 7, 2008, a request for *inter partes* reexamination was filed, which was assigned reexamination proceeding control No. 95/001,108 ("the '1108 proceeding"), by third party requester Samsung Electronics, Co. Ltd., the real party in interest.

3. On January 9, 2009, the Office issued an order granting the request for *inter partes* reexamination in the '1108 proceeding.

4. On February 13, 2009, the Office issued a first Office action on the merits in the '1108 proceeding.

5. On March 9, 2009, a request for *inter partes* reexamination was filed, which was assigned reexamination proceeding control no. 95/001,154 ("the '1154 proceeding"), by third party requester Micron Technology, the real party in interest.

6. On April 22, 2009, the Office issued an order granting the request for *inter partes* reexamination in the '1154 proceeding.

7. On May 13, 2009, patent owner timely filed a response to the February 13, 2009 Office action of the '1108 proceeding.

8. On June 12, 2009, third party requester timely filed comments after the May 13, 2009 patent owner response.

9. On July 21, 2009, the Office *sua sponte* issued a decision merging the '1108 and '1154 proceedings ("the merged proceeding").

10. On February 19, 2010, prosecution in the merged proceeding advanced to where the Office issued a Right of Appeal Notice (RAN).

11. On March 10, 2010, the '1154 third party requester filed a Notice of Appeal.

12. On May 10, 2010, the '1154 third party requester filed an Appellant's Brief.

13. On June 10, 2010, patent owner filed the present petition concurrently with a Respondent's Brief.

RELEVANT RULE AND GUIDANCE

37 CFR 1.4(c) states:

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

37 CFR 1.181(f) states:

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

DECISION

I. Improper Petition under 37 CFR 1.4(c)

The present petition requests multiple forms of relief. When two different forms of relief are being requested in a single petition, such petition is improper under 37 CFR 1.4(c). However, in the interest of special dispatch, pursuant to 35 U.S.C. 314, patent owner's petition to demerge ("unmerge") the merged *inter partes* reexamination proceeding is being addressed in this decision. Patent owner's petition under 37 CFR 1.182 to strike portions of the third party requester's appeal brief 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. If patent owner wishes to renew the petition under 37 CFR 1.182 to strike, it should be filed as a petition under 37 CFR 1.181 to challenge the Central Reexamination Unit's (CRU's) placement of the requester's appeal brief in the Image File Wrapper (IFW) record of the two merged proceedings, based on the asserted improper content as to portions to the appeal brief. Patent owner is actually requesting that the appeal brief be expunged and replaced by a redacted or revised appeal brief to exclude the portions of the paper argued to be improper.

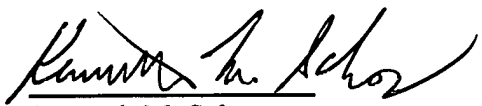
II. Untimely Petition under 37 CFR 1.181(f)

37 CFR 1.181(f) provides that any petition submitted under part 1 of 37 C.F.R. that is not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely. Patent owner's June 10, 2010 petition is challenging the July 21, 2009 Office decision to merge *inter partes* proceedings 95/001,108 and 95/001,154. Patent owner's June 10, 2009 petition requesting demerger of proceedings was submitted almost a year after the decision to merge was issued, and more important, after the appeal has be initiated and briefed for the merged proceeding. It would be inequitable to delay the proceeding and possibly need to regress the proceeding at this time. The petition is untimely; accordingly, the June 10, 2010 petition to demerge is dismissed as untimely.

CONCLUSION

1. Patent owner's June 10, 2010 petition is **dismissed**.

2. Telephone inquiries related to this decision should be directed to Joseph F. Weiss, Jr., Legal Advisor, at (571) 272-7759.



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

7-23-10
Kenpetmerger/reexreex/pet to demerge

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,109	11/11/2008	6546446	38512.20	9305

22852 7590 07/23/2009

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 07/23/2009

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
HAYNES AND BOONE, LLP IP SECTION
2323 VICTORY AVENUE,
SUITE 700
DALLAS, TX 75219

Date MAILED

JUL 23 2009

CENTRAL REEXAMINATION UNIT

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

REEXAMINATION CONTROL NO. : 95001109
PATENT NO. : 6546446
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
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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

JUL 23 2009

CENTRAL REEXAMINATION UNIT

DAVID M. O'DELL
HAYNES AND BOONE, LLP
2323 VICTORY AVENUE, SUITE 700
DALLAS, TEXAS 75219-7672

(For 95/001,109 Requester)

TRACY W. DRUCE
NOVAK DRUCE & QUIGG, LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET, 53rd FLOOR
HOUSTON, TX 77002

(For 95/001,155 Requester)

In re Farmwald et al.
Inter partes Reexamination Proceeding
Control No.: 95/001,109
Filed: November 11, 2008
For: U.S. Patent No. 6,546,446

In re Farmwald et al.
Inter partes Reexamination Proceeding
Control No. 95/001,155
Filed: March 11, 2009
For: U.S. Patent No. 6,546,446

DECISION, *SUA SPONTE*, TO MERGE REEXAMINATION PROCEEDINGS

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

REVIEW OF RELEVANT FACTS

1. U. S. Patent Number 6,546,446 (the '446 patent) issued to Farmwald et al. on April 8, 2003, with 45 claims.

2. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/001,109 ('1109 proceeding), was filed by third party requester on November 11, 2008. Samsung Electronics Co., Ltd., is identified as the real party in interest.

3. An order granting reexamination of claims 1-4 of the '446 patent was mailed for the '1109 reexamination proceeding on January 9, 2009.

4. An Office action containing at least one rejection of each of claims 1-4 of the '446 patent was mailed for the '1109 reexamination proceeding on February 13, 2009.

5. Patent owner filed a petition entitled "PATENT OWNER'S REQUEST FOR EXTENSION OF TIME PURSUANT TO 37 C.F.R. § 1.956" on March 23, 2009 for a thirty-day extension of time to respond to the February 13, 2009 Office action.

6. On March 26, 2009, the Office mailed a decision on the March 23, 2009 patent owner petition, extending the period to respond (to the February 13, 2009 Office action) by one month to May 13, 2009.

7. Patent owner filed a timely response on May 13, 2009, retaining original patent claims 1-4 as unamended.

8. Third party requester filed timely comments on June 12, 2009, pursuant to 37 CFR 1.947.

9. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/001,155 ('1155 proceeding), was filed March 11, 2009, by third party requester Micron Technology, Inc. Micron Technology, Inc. is identified as the real party in interest.

10. An order granting reexamination of claims 1-4 of the '446 patent was mailed for the '1155 reexamination proceeding on April 23, 2009.

11. No Office action has been mailed, and no amendments to the claims have been made in the '1155 *inter partes* reexamination proceeding.

DECISION

I. MERGER OF PROCEEDINGS

37 CFR 1.989(a) provides:

> If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge the two

> proceedings or to suspend one of the two proceedings. Where merger is ordered, the merged examination will normally result in the issuance of a single reexamination certificate under § 1.997.

As evidenced by the above review of facts, both the '1109 and the '1155 reexamination proceedings are currently pending. The order to reexamine has been mailed for both reexamination proceedings, and a decision under 37 CFR 1.989(a) is timely.

The general policy of the Office is that two reexamination proceedings will not be conducted separately, and at the same time, as to a particular patent. The rationale for this policy is (1) to prevent inconsistent, and possibly conflicting, amendments from being introduced into the two proceedings on behalf of the patent owner, (2) to provide a comprehensive examination of the patent based on the issues raised in both of the proceedings, and (3) to expedite the prosecution of both proceedings. In the present instance, merger of the 95/001,109 and 95/001,155 reexamination proceedings would address these considerations. Thus, pursuant to 37 CFR 1.989(a), the 95/001,109 and 95/001,155 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 Mail to: Mail Stop "*Inter Partes* Reexam"
Attn: Central Reexamination Unit
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By FAX to: (571) 273-9900
Central Reexamination Unit

By hand (or delivery service) to:

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Randolph Building, Lobby Level
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 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 one of the *inter partes* reexamination requesters), even though the brief relates to merged multiple proceedings and even though copies must be filed (as pointed out above) for each file in the merged proceeding.

E. Citation of Patents and Printed Publications:

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

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/001,109 and *inter partes* Reexamination Control No. 95/001,155 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 Susy Tsang-Foster, Legal Advisor, at (571) 272-7711.

Pinchus M. Laufer
Legal Advisor
Office of Patent Legal Administration

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Waddey & Patterson, P.C.
1600 Division Street
Suite 500
Nashville, TN 37203

(For Patent Owner)

MAILED

JUL 08 2009

CENTRAL REEXAMINATION UNIT

Novak Druce & Quigg LLP
(NDQ Reexamination Group)
1000 Louisiana Street Fifty-Third Floor
Houston, TX 77002

(For Requester)

In re Stuart R. Kipperman et al.
Inter Partes Reexamination Proceeding
Control No. 95/001,111
Filed: November 14, 2008
For: U.S. Patent No. 7,040,500

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

This is a decision on the May 4, 2009 patent owner petition under 37 CFR 1.137(b) to accept an unintentionally delayed response in the above-identified reexamination proceeding ("the May 4, 2009 patent owner petition").

The May 4, 2009 patent owner petition is before the Office of Patent Legal Administration (OPLA) for consideration.

The petition fee of $1,620.00 set forth in 37 CFR 1.17(m) for the May 4, 2009 patent owner petition has been paid.

The May 4, 2009 patent owner petition is **granted**.

The April 15, 2009 Action Closing Prosecution (ACP) issued for failure to timely respond to the January 7, 2009 Office action is **withdrawn**.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

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

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

35 U.S.C. 133 provides:

> Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Director in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Director that such delay was unavoidable.

35 U.S.C. 314(a) provides, in pertinent part:

> IN GENERAL. — Except as otherwise provided in this section, reexamination shall be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title.

37 CFR 1.137 provides, in pertinent part:

> (b) *Unintentional.* If the delay in reply by ... patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive ... a reexamination prosecution terminated under §§ 1.550(d) or 1.957(b) or limited under § 1.957(c) .... A grantable petition pursuant to this paragraph must be accompanied by:
>
> (1) The reply required to the outstanding Office action or notice, unless previously filed;
> (2) The petition fee as set forth in § 1.17(m);
> (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional ....
>
> *
> *
>
> (d) *Terminal disclaimer.*
>
> *
> *
>
> (3) The provisions of paragraph (d)(1) of this section do not apply to ... reexamination proceedings.

37 CFR 1.945(a) provides, in pertinent part:

> The patent owner will be given at least thirty days to file a response to any Office action on the merits of the *inter partes* reexamination.

37 CFR 1.957(c) provides, in pertinent part:

> If claims are found patentable and the patent owner fails to file a timely and appropriate response to any Office action in an *inter partes* reexamination proceeding, further prosecution will be limited to the claims found patentable at the time of the failure to

respond, and to any claims added thereafter which do not expand the scope of the claims which were found patentable at that time.

37 CFR 1.958(b) provides, in pertinent part:

Any response by the patent owner not timely filed in the Office may be accepted if the delay was unintentional. A grantable petition to accept an unintentionally delayed response must be filed in compliance with § 1.137(b).

MPEP 2668 provides, in pertinent part:

II. PETITION BASED ON UNINTENTIONAL DELAY

The unintentional delay fee provisions of 35 U.S.C. 41(a)(7) are imported into, and are applicable to, any reexamination proceeding by Sec. 4605(a) of the American Inventors Protection Act of 1999. Accordingly, the Office will consider, in appropriate circumstances, a petition showing unintentional delay under 37 CFR 1.137(b) where untimely papers are filed by the patent owner subsequent to the order for reexamination. Any such petition must provide a verified statement that the delay was unintentional, a proposed response to continue prosecution (unless it has been previously filed), and the petition fee required by 37 CFR 1.17(m).

*

*

IV. FURTHER DISCUSSION OF THE PETITION REQUIREMENTS

See also MPEP § 711.03(c), subsection III, for a detailed discussion of the requirements of petitions filed under 37 CFR 1.137(a) and (b).

DECISION

The Petition Under 37 CFR 1.137(b) is Granted

A grantable petition under 37 CFR 1.137(b) for a reexamination proceeding must be accompanied by: (1) a response to the outstanding Office action; (2) the petition fee set forth in 37 CFR 1.17(m); and (3) a proper statement under 37 CFR 1.137(b)(3) that the entire delay in filing the required response from the due date of the response to the filing of a grantable petition was unintentional.

Regarding item (1), this reexamination proceeding prosecution was limited under 37 CFR 1.957(c) due to the failure to timely submit a response to the January 7, 2009 Office action pursuant to 37 CFR 1.945(a). 37 CFR 1.945(a) provides that the patent owner will be given at least thirty days to file a response to any Office action on the merits of the *inter partes* reexamination. The January 7, 2009 Office action set a two-month period for response. A response to the January 7, 2009 Office action was not

filed until May 4, 2009, which was untimely. However, for the purpose of evaluating whether the May 4, 2009 patent owner petition is a grantable petition, the submission of the May 4, 2009 response satisfies item (1).[1]

A petition fee and a proper statement under 37 CFR 1.137(b)(3) have been submitted with the May 4, 2009 patent owner petition, which satisfy items (2) and (3), respectively. Regarding the May 4, 2009 statement under 37 CFR 1.137(b)(3), it is understood to have been made with respect to the January 7, 2009 Office action, rather than the April 15, 2009 ACP, due to: (i) the statement at page 1 of the May 4, 2009 Amendment announcing that "Patentee is simultaneously filing a Petition for Revival of an Application for Patent Abandoned Unintentionally due to Patentee's unintentional failure to timely respond to the Office Action of January 7, 2009;" and (ii) the fact that the May 4, 2009 Amendment was filed within the one-month period for responding to the April 15, 2009 ACP.

Accordingly, the May 4, 2009 patent owner petition is **granted**.

The April 15, 2009 Action Closing Prosecution (ACP) issued for failure to timely respond is **withdrawn**.

CONCLUSION

1. The May 4, 2009 patent owner petition under 37 CFR 1.137(b) to accept an unintentionally delayed response is **granted**.

2. The April 15, 2009 Action Closing Prosecution (ACP) issued for failure to timely respond is **withdrawn**.

3. Patent owner's response to the January 7, 2009 Office action is hereby entered in the record, thus triggering a comment right for third party requester under 37 CFR 1.947. Accordingly, third party requester may file comments to patent owner's response as per 37 CFR 1.947 within 30 days of the mailing date of this decision.

4. Jurisdiction over this reexamination proceeding is being returned to the Central Reexamination Unit, Art Unit 3993, to await requester's comments under 37 CFR 1.947, or the expiration of the time to file such comments, after which the examiner will treat the May 4, 2009 Amendment as an amendment after first Office action and issue a new Office action to replace the withdrawn April 15, 2009 ACP.

---

[1] This decision is not directed to the persuasiveness and propriety of the arguments presented in the May 4, 2009 response as to each of the rejections set forth in the January 7, 2009 Office action; such is the examiner's province.

5. The February 13, 2009 third party requester paper titled "Third Party Requester Notice Of No Comment To Patent Owner Response; Notice Of Litigation Settlement" is noted. It states that the third party requester "will not file any subsequent substantive responses as may be allowed under the Rules in this inter partes reexamination." The Office will consider the February 13, 2009 third party requester paper as a waiver of third party requester's comment rights under 37 CFR 1.947, and not await requester's comments under 37 CFR 1.947 submitted in response to subsequent responses by patent owner, unless informed otherwise within 30 days of the mailing date of this decision.

6. Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Joseph Kaufman, of CRU Art Unit 3993, at (571) 272-4928.

7. Any inquiry concerning this decision should be directed to Raul Tamayo, Legal Advisor, at (571) 272-7728.

Robert A. Clarke
Director
Office of Patent Legal Administration

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,112	11/17/2008	6,182,184	8963.002.184	6635

22852 7590 03/06/2009

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/06/2009

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

MAR 06 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001112
PATENT NO. : 6181284
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.
95/000,183	08/24/2007	6182184	38512.5	2395

22852 7590 03/06/2009

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/06/2009

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
HAYNES AND BOONE LLP
901 MAIN STREET SUITE 3100
DALLAS, TX 75202

Date:

MAILED

MAR 06 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000183
PATENT NO. : 6181284
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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MAR 06 2009

CENTRAL REEXAMINATION UNIT

DAVID L. SOLTZ & NAVEEN MODI
FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

(For Patent Owner)

DAVID L. MCCOMBS, ESQ.
HAYNES AND BOONE, LLP
901 MAIN STREET, SUITE 3100
DALLAS, TX 75202-3789

(For 95/000,183 Requester)

TRACY W. DRUCE
NOVAK DRUCE & QUIGG, LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET 53rd FLOOR
HOUSTON, TX 77002

(For 95/001,112 Requester)

In re Farmwald et al.
Inter partes Reexamination Proceeding
Control No.: 95/000,183
Filed: August 24, 2007
For: U.S. Patent No. 6,182,184

In re Farmwald et al.
Inter partes Reexamination Proceeding
Control No. 95/001,112
Filed: November 17, 2008
For: U.S. Patent No. 6,182,184

DECISION, *SUA SPONTE*, TO MERGE REEXAMINATION PROCEEDINGS

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

REVIEW OF RELEVANT FACTS

1. U. S. Patent Number 6,182,184 (the '184 patent) issued to Farmwald et al. on January 30, 2001, with 29 claims.

2. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/000,183 ('183 proceeding), was initially deposited by third party requester on October 4, 2006, and received a filing date of August 24, 2007. Samsung Electronics Co., Ltd., is identified as the real party in interest.

3. An order granting reexamination of claims 1-29 of the '184 patent was mailed for the '183 reexamination proceeding on October 19, 2007.

4. An Office action containing at least one rejection of each of claims 1-29 of the '184 patent was mailed for the '183 reexamination proceeding on July 3, 2008.

5. Patent owner filed a timely response on September 5, 2008, retaining original patent claims 1-29 as unamended.

6. Third party requester filed timely comments on October 3, 2008, pursuant to 37 CFR 1.947.

7. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/001,112 ('1112 proceeding), was filed November 17, 2008, by third party requester Micron Technology Inc.

8. An order granting reexamination of claims 13 and 14 of the '184 patent was mailed for the '1112 reexamination proceeding on January 16, 2009.

9. No Office action has been mailed, and no amendments to the claims have been made in the '1112 *inter partes* reexamination proceeding.

DECISION

I. MERGER OF PROCEEDINGS

Under 37 CFR 1.989(a):

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

As evidenced by the above review of facts, both the '183 and the '1112 reexamination proceedings are currently pending. The order to reexamine has been mailed for both reexamination proceedings, and a decision under 37 CFR 1.989(a) is timely.

The general policy of the Office is that two reexamination proceedings will not be conducted separately, and at the same time, as to a particular patent. The rationale for this policy is (1) to prevent inconsistent, and possibly conflicting, amendments from being introduced into the two proceedings on behalf of the patent owner, (2) to provide a comprehensive examination of the patent based on the issues raised in both of the proceedings, and (3) to expedite the prosecution of both proceedings. In the present instance, merger of the 95/000,183 and 95/001,112 reexamination proceedings would address these considerations. Thus, pursuant to 37 CFR 1.989(a), the 95/000,183 and 95/001,112 reexamination proceedings are hereby merged. The merged proceeding will be conducted in accordance with the guidelines and requirements which follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

The claims are identical in both proceedings. The patent owner is required to continue to maintain the same claims (and specification) in both files *throughout the merged proceeding*.

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

The present decision merges an *inter partes* reexamination proceeding with another *inter partes* reexamination proceeding. Pursuant to 37 CFR 1.989(b), the merged proceeding is governed by 37 CFR 1.902 through 1.997.

B. Papers mailed/filed:

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

All papers that are filed by the patent owner and the third party requesters should be directed:

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

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

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

By hand (or delivery service):

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

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

The patent owner and the requesters are reminded that every paper filed in the merged proceeding subsequent to this Decision must be served on the other parties, including papers filed *via* facsimile transmission.

C. Amendments:

The filing of any amendments to the specification, claims, and drawings must comply with the provisions of 37 CFR 1.530 and the guidelines of MPEP § 2666. 37 CFR 1.121 does not apply to amendments in a reexamination proceeding. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via markings pursuant to 37 CFR 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

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

D. Fees:

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

E. Citation of Patents and Printed Publications:

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

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/000,183 and *inter partes* Reexamination Control No. 95/001,112 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 Susy Tsang-Foster, Legal Advisor, at (571) 272-7711.

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.
95/001,112	11/17/2008	6,182,184	8963.002.184	6635

22852 7590 04/28/2009

EXAMINER	

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

ART UNIT	PAPER NUMBER

DATE MAILED: 04/28/2009

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TRACY W. DRUCE
NOVAK DRUCE & QUIGG, LLP
1000 LOUISIANA STREET, FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date:

MAILED

APR 28 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001112
PATENT NO. : 6181284
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.
95/000,183	08/24/2007	6182184	38512.5	2395

22852 7590 04/28/2009

EXAMINER	

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

ART UNIT	PAPER NUMBER

DATE MAILED: 04/28/2009

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

DAVID L. McCOMBS
HAYNES AND BOONE LLP (IP SECTION)
2323 VICTORY AVENUE, SUITE 700
DALLAS, TX 75219

Date:

MAILED

APR 28 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000183
PATENT NO. : 6181284
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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APR 28 2009

CENTRAL REEXAMINATION UNIT

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

(For Patent Owner)

David L. McCombs
HAYNES AND BOONE, LLP
IP SECTION
2323 VICTORY AVENUE
SUITE 700
DALLAS, TX 75219

(For Third Party Requester)

Tracy W Druce
NOVAK DRUCE & QUIGG, LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET
FIFTY-THIRD FLOOR
HOUSTON, TX 77002

(For Third Party Requester)

DECISION
GRANTING-IN-PART
PETITION FOR EXTENSION
OF TIME
[37 CFR § 1.956 and § 1.181]

In re: Farmwald *et alia*
Inter Partes Reexamination Proceeding
Control No. 95/000,183
Deposited on: 04 October 2006
For: US Patent No. 6,182,184

In re: Farmwald *et alia*
Inter Partes Reexamination Proceeding
Control No. 95/001,112
Deposited on: 17 November 2008
For: US Patent No. 6,182,184

This is a decision on the 23April 2009, "Patent Owner's Petition for Extension of Time Pursuant to 37 CFR 1.956" requesting that the time for responding to the Action Closing

Prosecution mailed 20 March 2009, be extended by forty-five (45) days. The petition was timely filed.

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

The petition is granted-in-part for the reasons set forth below.

Statement of Relevant Facts

1. On 30 January 2001 US patent No. 6,182,184 was granted to Farmwald *et alia.*

2. On 04 October 2006 a request for reexamination was deposited by a third party requester for *Inter Partes* Reexamination with the Office identified by control number 95/000,183.

3. On 26 December 2006 an Order Granting Request for *Inter Partes* Reexamination 95/000,183 was mailed.

4. On 17 November 2008 a request for reexamination was deposited by a third party requester for *Inter Partes* Reexamination with the Office identified by control number 95/001,112.

5. On 16 January 2009 an Order Granting Request for *Inter Partes* Reexamination 95/001,112 was mailed.

6. On 06 March 2009 a decision s*ua sponte* was mailed merging proceedings 95/000,183 and 95/001,112

7. On 20 March 2009 a non-final Office action was mailed was mailed in the abovementioned proceedings.

8. On 23 April 2009 the instant petition for a forty-five (45) days extension of time was submitted by the patent owner's representative.

Discussion

The Patent Owner's representative requests the period of time be extended in which to file a response to the non-final Office action mailed 20 March 2009, which set a two (2) months time for filing a response thereto. The petition for extension of time was timely filed on 23 April 2009, together with electronic fee transmittal for the $200.00 petition fee as

required by 37 CFR § 1.956 and 37 CFR § 1.17 (g). A certificate of service was provided with the petition.

The request is granted-in-part.

> **37 CFR § 1.956. Patent owner extensions of time in inter partes reexamination.** *The time for taking any action by a patent owner in an inter partes reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified. Any request for such extension must be filed on or before the day on which action by the patent owner is due, but in no case will the mere filing of a request effect any extension. Any request for such extension must be accompanied by the petition set forth in § 1.17(g). See § 1.304(a) for extensions of time for filing a notice of appeal to the U.S. Court of Appeals for the Federal Circuit.*

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

> As noted above, a request for extension of time under 37 CFR § 1.956 will be granted only for sufficient cause, ...
>
> Evaluation of whether "sufficient cause" has been shown for an extension must be made by **balancing** the desire to provide the patent owner with a fair opportunity to respond, **against** the requirement of the statute, 35 U.S.C. § 314(c), that the proceedings be conducted with special dispatch. ...

Any petition request must include the required petition fee as set forth according to 37 CFR § 1.17 (g) and 37 CFR § 1.956.

MPEP § 2665 Extension of Time for Patent Owner Response (in-part)

> Requests for an extension of time in an inter partes reexamination proceeding will be considered only after the first Office action on the merits in the reexamination is mailed. Any request for an extension of time filed prior to the first action will be denied.
>
> The certificate of mailing and the certificate of transmission procedures (37 CFR § 1.8), and the "Express Mail" mailing procedure (37 CFR § 1.10), may be used to file a request for extension of time, as well as any other paper in an existing *inter partes* reexamination proceeding (see MPEP § 2666).
>
> 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 forty-five (45) days to the period for response. The decision to extend the period for response is evaluated based upon a showing of "sufficient cause." There is always the consideration to balance the need for the patent owner to have a fair opportunity to respond to the Office action between the need for special dispatch.

The non-final Office action was mailed 20 March 2009. The patent owner submitted a timely filed the petition on 23 April 2009 with the appropriate fee and certificate of service.

The petition dated 23 April 2009 cites the length and complexity of the Office action with its many rejections as well as the number of concurrently handled proceedings by the patent owner. While concurrent proceedings are generally no considered to rise to the level of sufficient cause, on balance, the petitioner has demonstrated "sufficient cause" to grant a one (1) month extension of time based upon the length and complexity of the Office action.

The petition request to extend the response time by one (1) month is hereby granted-in-part.

CONCLUSION

1. The patent owner's petition for extension for forty-five (45) days time in which to file a response to the non-final Office action dated 20 March 2009 is hereby **granted-in-part**

2. The period for response is extended by one (1) month.

3. The Patent Owner's response is due **20 June 2009.**

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

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

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

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

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

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

/Mark Reinhart/
for

Gregory Morse,
Director,
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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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.
95/001,114	11/18/2008	7219744	069669-0007-06	8073

9629 7590 07/21/2010

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 07/21/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
BRACEWELL & GIULIANI LLP
P.O. BOX 61389
HOUSTON, TX 77208-1389

Date:
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JUL 21 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001114
PATENT NO. : 7219744
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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WASHINGTON, DC 20004

(Patent Owner)

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JUL 21 2010

CENTRAL REEXAMINATION UNIT

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

(Third Party Requester)

In re Pietras
Reexamination Proceeding
Control No. : 95/001,114
Filed: November 18, 2008
Patent No. 7,219,744

: DECISION
: ON
: REQUESTER'S
: PETITION
: UNDER 37 CFR 1.181

This is a decision addressing Third Party Requester's petition, filed July 2, 2010, which is treated as a petition under 37 CFR 1.181 requesting supervisory review of the examiner's action in issuing the Right of Appeal Notice (RAN). It is noted that Requester filed a combined petition under 37 CFR 1.181, 1.182, and 1.183, which is deemed improper because the combination of three distinct petitions is not compliant with 37 CFR 1.4. Requester must file separate petitions if Requester wants consideration of the issues under 37 CFR 1.182 and 1.183.

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

SUMMARY

Third Party Requester's petition is DISMISSED as untimely for the reasons set forth below, without consideration of the merits.

Brief Statement of Relevant Facts

1. Patent No. 7,219,744 (the '744 patent) issued on May 22, 2007.

2. A request for reexamination, assigned Control No. 95/001,114 (the '114 proceeding), was filed by a third party Requester on November 18, 2008.

3. Reexamination was ordered in the '114 reexamination proceeding on February 6, 2009.

4. An Office action on the merits was mailed on the same day, February 6, 2009.

5. Prosecution continued in the reexamination proceeding, and on March 12, 2010, a Right of Appeal Notice (RAN) was mailed. The RAN maintained the same rejections set forth in the Action Closing Prosecution. The RAN also explicitly informed the requester that the newly proposed rejections identified in the Requester's comments of February 16, 2010 are improper and not considered.

6. On April 9, 2010, the Third Party Requester filed a Notice of Appeal.

7. On April 12, 2010, the Patent Owner filed a Notice of Appeal.

8. On June 9, 2010, the Third Party Requester filed an Appellant Brief.

9. On June 14, 2010, the Patent Owner filed an Appellant Brief.

10. On July 2, 2010, the Third Party Requester filed the petition, which is treated as a petition under 37 CFR 1.181.

11. On July 9, 2010, the Patent Owner filed a Respondent Brief.

12. On July 14, 2010, the Third Party Requester filed a Respondent Brief.

Discussion

The Third Party Requester (petitioner) requests supervisory review of the examiner's action in issuing the Right of Appeal Notice, dated March 12, 2010. The petitioner considers the RAN improper because of the examiner's refusal to consider newly proposed rejections.

The request to review the RAN is dismissed as untimely.

Statement of Relevant Authority

37 CFR 1.181(f) states:

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

...

Decision

The petitioner brings before the Office a petition, which is treated as a petition under 37 CFR § 1.181, to review the RAN, dated March 12, 2010. The petitioner filed the petition on July 2, 2010. The action from which relief is requested is the RAN, which was mailed on March 12, 2010. Therefore, the petition was filed over **two** months from the mailing date of the action (March 12, 2010) from which relief is requested. As quoted above, 37 CFR 1.181(f) requires petitions under that section be filed within **two** months from the mailing date of the action from which relief is requested and that such time period is not extendable.

Therefore, the petition is dismissed as untimely, without consideration of the merits, because it was not filed within the two month time period required by 37 CFR 1.181(f).

CONCLUSION

1. Third Party Requester's petition under 37 CFR 1.181, filed July 2, 2010, is **dismissed** as untimely for the reasons discussed above.

2. Telephone inquiries related to this decision should be directed to Andy Kashnikow, Supervisory Patent Examiner, at (571) 272-4361, or in his absence to the undersigned at (571) 272-3838.

Gregory A. Morse
Director
Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,119	11/18/2008	7353880	069669-0007-09	8440

9629 7590 07/21/2010

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 07/21/2010

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P.O. BOX 61389
HOUSTON, TX 77208-1389

Date:

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JUL 21 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001119
PATENT NO. : 7353880
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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WASHINGTON, DC 20004

(Patent Owner)

MAILED

JUL 21 2010

CENTRAL REEXAMINATION UNIT

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

(Third Party Requester)

In re Pietras
Reexamination Proceeding
Control No. : 95/001,119
Filed: November 18, 2008
Patent No. 7,353,880

: DECISION
: ON
: REQUESTER'S
: PETITION
: UNDER 37 CFR 1.181

This is a decision addressing Third Party Requester's petition, filed July 2, 2010, which is treated as a petition under 37 CFR 1.181 requesting supervisory review of the examiner's action in issuing the Right of Appeal Notice (RAN). It is noted that Requester filed a combined petition under 37 CFR 1.181, 1.182, and 1.183, which is deemed improper because the combination of three distinct petitions is not compliant with 37 CFR 1.4. Requester must file separate petitions if Requester wants consideration of the issues under 37 CFR 1.182 and 1.183.

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

SUMMARY

Third Party Requester's petition is DISMISSED as untimely for the reasons set forth below, without consideration of the merits.

Brief Statement of Relevant Facts

1. Patent No. 7,353,880 (the '880 patent) issued on April 8, 2008.

2. A request for reexamination, assigned Control No. 95/001,119 (the '119 proceeding), was filed by a third party Requester on November 18, 2008.

3. Reexamination was ordered in the '119 reexamination proceeding on February 6, 2009.

4. An Office action on the merits was mailed on the same day, February 6, 2009.

5. Prosecution continued in the reexamination proceeding, and on March 29, 2010, a Right of Appeal Notice (RAN) was mailed. The RAN explicitly informed the requester that the newly proposed rejections identified in the Requester's comments of January 5, 2010 are improper and not considered.

6. On April 29, 2010, the Third Party Requester filed a Notice of Appeal.

7. On April 29, 2010, the Patent Owner filed a Notice of Appeal.

8. On June 28, 2010, the Third Party Requester filed an Appellant Brief.

9. On June 29, 2010, the Patent Owner filed an Appellant Brief.

10. On July 2, 2010, the Third Party Requester filed the petition, which is treated as a petition under 37 CFR 1.181.

Discussion

The Third Party Requester (petitioner) requests supervisory review of the examiner's action in issuing the Right of Appeal Notice, dated March 29, 2010. The petitioner considers the RAN improper because of the examiner's refusal to consider newly proposed rejections.

The request to review the RAN is dismissed as untimely.

Statement of Relevant Authority

37 CFR 1.181(f) states:

> The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within **two months** of the mailing date of the action or notice from which relief is requested may be

dismissed as untimely, except as otherwise provided. **This two-month period is not extendable.** (Emphasis added.)

...

Decision

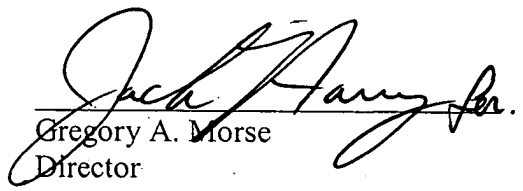
The petitioner brings before the Office a petition, which is treated as a petition under 37 CFR § 1.181, to review the RAN, dated March 29, 2010. The petitioner filed the petition on July 2, 2010. The action from which relief is requested is the RAN, which was mailed on March 29, 2010. Therefore, the petition was filed over **two** months from the mailing date of the action (March 29, 2010) from which relief is requested. As quoted above, 37 CFR 1.181(f) requires petitions under that section be filed within **two** months from the mailing date of the action from which relief is requested and that such time period is not extendable.

Therefore, the petition is dismissed as untimely, without consideration of the merits, because it was not filed within the two month time period required by 37 CFR 1.181(f).

CONCLUSION

1. Third Party Requester's petition under 37 CFR 1.181, filed July 2, 2010, is **dismissed** as untimely for the reasons discussed above.

2. Telephone inquiries related to this decision should be directed to Andy Kashnikow, Supervisory Patent Examiner, at (571) 272-4361, or in his absence to the undersigned at (571) 272-3838.



Gregory A. Morse
Director
Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,120	11/18/2008	7228901	069669-0007-07	8445

9629 7590 06/23/2010

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/23/2010

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P.O. BOX 61389
HOUSTON, TX 77208-1389

Date: **MAILED**

JUN 23 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001120
PATENT NO. : 7228901
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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ALEXANDRIA, VA 22313-1450
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MORGAN LEWIS & BOCKIUS LLP
1111 PENNSYLVANIA AVENUE NW
WASHINGTON, DC 20004

(For Patent Owner)

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

(For Third Party Requester)

MAILED

JUN 28 2010

CENTRAL REEXAMINATION UNIT

In re Vail, III et al.
Inter Partes Reexamination Proceeding
Control No. 95/001,120
Filed: November 18, 2008
For: U.S. Patent No. 7,228,901

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

This is a decision on the May 11, 2010 third party requester petition entitled "PETITION UNDER 37 CFR § 1.183 TO ACCEPT THIRD PARTY REQUESTER COMMENTS SUBMITTED NOVEMBER 20, 2009."

The third party requester's 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 processed on May 12, 2010.

The petition is **dismissed as premature**.

BACKGROUND

1. On June 12, 2007, U.S. Patent No. 7,228,901 issued to Vail, III et al. ("the '901 patent").

2. On November 18, 2008, a request for *inter partes* reexamination of the '901 patent was filed by a third party requester, which request was assigned reexamination proceeding control number 95/001,120 ("the '1120 proceeding").

3. On January 30, 2009, the Office mailed an order granting *inter partes* reexamination in the '1120 proceeding, concurrently with a non-final Office action on the merits.

4. On March 30, 2009, patent owner filed a "RESPONSE TO OFFICE ACTION DATED 01/30/2009."

5. On April 29, 2009, third party requester filed "COMMENTS IN RESPONSE TO THE AMENDMENT FILED ON MARCH 30, 2009."

6. On September 23, 2009, the Office mailed an action closing prosecution (ACP) in the '1120 proceeding.

7. On October 23, 2009, patent owner filed a "RESPONSE TO OFFICE ACTION DATED September 23, 2009."

8. On November 20, 2009, third party requester filed "COMMENTS IN RESPONSE TO THE AMENDMENT FILED ON 10/23/2009 IN RESPONSE TO THE OFFICE ACTION CLOSING PROSECUTION MAILED ON 9/23/2009" ("the November 20, 2009 comments submission").

9. On April 26, 2010, the Office mailed a "NOTICE OF DEFECTIVE PAPER IN INTER PARTES REEXAMINATION" ("the Notice of Defective Paper"), stating "The comments filed by the third party requester on 20 November 2009 are improper because they fail to comply with 37 CFR 1.947 and 1.948. Specifically, the written comments are improper because: (1) they are not limited to issues and points covered by the Action Closing Prosecution mailed on 23 September 2009 and the patent owner's response to the ACP filed on 23 October 2009; and (2) the prior art submitted with the comments does not satisfy the provisions of 37 CFR 1.948." The Notice of Defective Paper set a time period of fifteen days from the mailing date of the notice for third party requester to "rectify and refile the improper comments."

10. On May 11, 2010, third party requester filed a paper entitled "PETITION UNDER 37 CFR § 1.181 AND/OR 37 CFR § 1.182 TO ACCEPT THIRD PARTY REQUESTER COMMENTS SUBMITTED NOVEMBER 20, 2009" ("the petition under 37 CFR 1.181 and/or 1.182").

11. Concurrently, on May 11, 2010, third party requester filed the instant paper entitled "PETITION UNDER 37 CFR § 1.183 TO ACCEPT THIRD PARTY REQUESTER COMMENTS SUBMITTED NOVEMBER 20, 2009" ("the petition under 37 CFR 1.183").

12. Also, on May 11, 2010, third party requester filed "COMMENTS IN RESPONSE TO THE NOTICE OF IMPROPER 3RD PARTY REQUESTOR COMMENTS AND THE AMENDMENT FILED ON 10/23/2009 IN RESPONSE TO THE OFFICE ACTION CLOSING PROSECUTION MAILED ON 9/23/2009."

STATUTES, REGULATIONS, AND PATENT EXAMINING 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 1.181 provides, in pertinent part:

(a) Petition may be taken to the Director:

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

DECISION

In the May 11, 2010 petition under 37 CFR 1.183, third party requester requests waiver of the rules (presumably 37 CFR §§ 1.947 and 1.948) to permit entry of its November 20, 2009 comments submission.

Addressing the petition, it is initially pointed out that the extraordinary relief of waiving a rule is not granted if the rules provide an alternative avenue for obtaining the relief sought. *See*, *Cantello v. Rasmussen*, 220 USPQ 664 (Comr. 1982). In this instance, third party requester has concurrently pursued an alternative avenue to obtain the requested relief via a petition under 37 CFR 1.181 and/or 37 CFR 1.182.

The concurrently filed May 11, 2010 petition under 37 CFR 1.181 and/or 37 CFR 1.182 has not yet been decided. Thus, consideration of the waiver of a rule for entry of the November 20, 2009 comments submission would be premature. Further, the relief requested in the instant petition under 37 CFR 1.183 would be rendered moot should the relief requested be granted under 37 CFR 1.181 and/or 1.182.

Accordingly, the instant petition under 37 CFR 1.183, requesting entry of the November 20, 2009 comments submission **is dismissed**.

ADDITIONAL DISCUSSION

Third party requester retains the option of filing a renewed petition under 37 CFR 1.183 if, at some future date, relief has not been granted under 37 CFR 1.181 and/or 37 CFR 1.182, and relief under 37 CFR 1.181 and/or 37 CFR 1.182 is no longer being pursued. Until such time, the issue is not ripe for consideration by the Office under 37 CFR 1.183.

It is noted that the content of the May 11, 2010 petition under 37 CFR 1.183 is identical to that set forth in the concurrently filed petition under 37 CFR 1.181 and/or 1.182. 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. Thus, if third party requester subsequently files a renewed petition, requesting entry of the November 20, 2009 comments submission under 37 CFR 1.183, the petition should identify which rule(s) are sought to be waived and should set forth specific facts that demonstrate an extraordinary situation in which justice requires suspension of the rule(s).

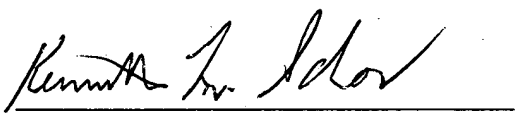
As a final point, even if 37 CFR 1.948 is shown to be satisfied or waived, such would not necessarily permit requester to propose a new ground of rejection based on additional art, as 37 CFR 1.947 must be satisfied in order for requester to be permitted to propose a new ground of rejection. And, 37 CFR 1.947 cannot be waived to the extent that it promulgates a requirement of the statute – in this instance, 35 U.S.C. 314(b)(2). As to whether 37 CFR 1.947 is satisfied, such issue is resolved by way of a 37 CFR 1.181 petition, not by way of a 37 CFR 1.183 petition.

CONCLUSION

1. The third party requester's May 11, 2010 petition under 37 CFR 1.183 is **dismissed**.

2. The Central Reexamination Unit will consider third party requester's concurrently filed May 11, 2010 petition under 37 CFR 1.181 and/or 37 CFR 1.182 in due course.

3. Any inquiry concerning the instant decision should be directed to Nicole Dretar, Legal Advisor, at (571) 272-7717.



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MAR 09 2009

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(Courtesy Copy)

In re Farmwald et al.
Inter partes Reexamination Proceeding
Control No.: 95/000,166
Filed: August 22, 2007
For: U.S. Patent No. 6,426,916

In re Farmwald et al.
Inter partes Reexamination Proceeding
Control No. 95/001,122
Filed: November 20, 2008
For: U.S. Patent No. 6,426,916

DECISION, *SUA SPONTE*, TO MERGE REEXAMINATION PROCEEDINGS

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

REVIEW OF RELEVANT FACTS

1. U. S. Patent Number 6,426,916 (the '916 patent) issued to Farmwald et al. on July 30, 2002, with 41 claims.

2. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/000,166 ('166 proceeding), was initially deposited by third party requester on August 8, 2006, and received a filing date of August 22, 2007. Samsung Electronics, Co. Ltd. is identified as the real party in interest.

3. An order granting reexamination of claims 1-41 of the '916 patent was mailed for the '166 reexamination proceeding on October 19, 2007.

4. An Office action containing at least one rejection of each of claims 1-41 of the '916 patent was mailed for the '166 reexamination proceeding on July 3, 2008.

5. Patent owner filed a timely response on September 3, 2008, retaining original patent claims 1-41 as unamended.

6. Third party requester filed timely comments on October 3, 2008, pursuant to 37 CFR 1.947.

7. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/001,122 ('1122 proceeding), was filed November 20, 2008, by third party requester Micron Technology, Inc.

8. An order granting reexamination of claims 26 and 28 of the '916 patent was mailed for the '1122 reexamination proceeding on January 16, 2009.

9. No Office action has been mailed, and no amendments to the claims have been made, in the '1122 *inter partes* reexamination proceeding.

DECISION

I. MERGER OF PROCEEDINGS

Under 37 CFR 1.989(a):

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

As evidenced by the above review of facts, both the '166 and the '1122 reexamination proceedings are currently pending. The order to reexamine has been mailed for both reexamination proceedings, and a decision under 37 CFR 1.989(a) is timely.

The general policy of the Office is that two reexamination proceedings will not be conducted separately, and at the same time, as to a particular patent. The rationale for this policy is (1) to prevent inconsistent, and possibly conflicting, amendments from being introduced into the two proceedings on behalf of the patent owner, (2) to provide a comprehensive examination of the patent based on the issues raised in both of the proceedings, and (3) to expedite the prosecution of both proceedings. In the present instance, merger of the 95/000,166 and 95/001,122 reexamination proceedings would address these considerations. Thus, pursuant to 37 CFR 1.989(a), the 95/000,166 and 95/001,122 reexamination proceedings are hereby merged. The merged proceeding will be conducted in accordance with the guidelines and requirements which follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

The claims are identical in both proceedings. The patent owner is required to continue to maintain the same claims (and specification) in both files *throughout the merged proceeding*.

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

The present decision merges an *inter partes* reexamination proceeding with another *inter partes* reexamination proceeding. Pursuant to 37 CFR 1.989(b), the merged proceeding is governed by 37 CFR 1.902 through 1.997.

B. Papers mailed/filed:

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

All papers that are filed by the patent owner and the third party requesters should be directed:

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

By Mail to: Mail Stop *Inter Partes* Reexam
Attn: Central Reexamination Unit
Commissioner for Patents

United States Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

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

By hand (or delivery service):

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

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

The patent owner and the requesters are reminded that every paper filed in the merged proceeding subsequent to this Decision must be served on the other parties, including papers filed *via* facsimile transmission.

C. Amendments:

The filing of any amendments to the specification, claims, and drawings must comply with the provisions of 37 CFR 1.530 and the guidelines of MPEP § 2666. 37 CFR 1.121 does not apply to amendments in a reexamination proceeding. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via markings pursuant to 37 CFR 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

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

D. Fees:

Where a paper is filed which requires payment of a fee (e.g., extension of time fee, excess claims fee, petition fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For

example, only one fee need be paid for patent owner's appellant brief (or that of one of the *inter partes* reexamination requesters), even though the brief relates to merged multiple proceedings and even though copies must be filed (as pointed out above) for each file in the merged proceeding.

E. Citation of Patents and Printed Publications:

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

PATENT OWNER'S ADDRESS

The patent owner is called upon to coordinate the proper correspondence addresses in (1) the patent, (2) the '166 proceeding and (3) the '1122 proceeding. Different patent owner counsel and addresses are of record for the two reexamination proceedings. The current correspondence address of record for the patent file is the proper patent owner address for reexamination mailings pursuant to 37 CFR 1.33(c), and it is that of RAMBUS, INC., c/o Ann Williams, 4440 El Camino Real, Los Altos, CA 94022. Accordingly, all future correspondence will be directed to RAMBUS, INC., c/o Ann Williams, 4440 El Camino Real, Los Altos, CA 94022, unless, within ONE (1) MONTH of this decision, patent owner changes the correspondence address of record in the patent (the same should be done for the reexamination proceedings).

It is further noted that different attorneys are of record for the two reexamination proceedings. In order to permit filing of patent owner papers in the now merged proceeding by one attorney alone, the two proceedings must given a single attorney of record, with appointment being made as appropriate. Patent owner is provided with ONE (1) MONTH from the mailing of this decision to do so. If there is a newly designated attorney, patent owner must supply the designated attorney with the requisite power of attorney in the appropriate files (the patent file and both reexamination proceedings).

As a courtesy, this decision is being mailed to both addresses. However, as pointed out above, the address of RAMBUS, INC., c/o Ann Williams, 4440 El Camino Real, Los Altos, CA 94022, will be used in future correspondence, unless the address of record is changed as set forth above.

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/000,166 and *inter partes* Reexamination Control No. 95/001,122 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

2. Patent owner is provided with ONE (1) MONTH from the mailing of this decision to file papers to address the correspondence address and attorney of record considerations in both proceedings, as set forth in the last section of this decision.

3. Jurisdiction over the merged reexamination is being forwarded via the Central Reexamination Unit Director to the examiner for the preparation of an Office action, to be issued in due course for the merged proceeding. The examiner should not issue an Office action for the present merged proceeding until after the earlier of:

(A) The expiration of the one month period set for filing the papers addressing the correspondence address and attorney of record in both proceedings, or

(B) The receipt of such papers.

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

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

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APR 29 2009

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(For Third Party Requester)

DECISION
GRANTING-IN-PART
PETITION FOR EXTENSION
OF TIME
[37 CFR § 1.956 and § 1.181]

In re: Farmwald *et alia*
Inter Partes Reexamination Proceeding
Control No. 95/000,166
Deposited on: 12 October 2006
For: US Patent No. 6,426,916

In re: Farmwald *et alia*
Inter Partes Reexamination Proceeding
Control No. 95/001,122
Deposited on: 20 November 2008
For: US Patent No. 6,426,916

This is a decision on the 23April 2009, "Patent Owner's Petition for Extension of Time Pursuant to 37 CFR 1.956" requesting that the time for responding to the Action Closing

Prosecution mailed 20 March 2009, be extended by forty-five (45) days. The petition was timely filed.

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

The petition is granted-in-part for the reasons set forth below.

Statement of Relevant Facts

1. On 30 July 2002 US patent No. 6,426,916 was granted to Farmwald *et alia.*

2. On 12 October 2006 a request for reexamination was deposited by a third party requester for *Inter Partes* Reexamination with the Office identified by control number 95/000,166.

3. On 26 December 2006 an Order Granting Request for *Inter Partes* Reexamination 95/000,155 was mailed.

4. On 20 November 2008 a request for reexamination was deposited by a third party requester for *Inter Partes* Reexamination with the Office identified by control number 95/001,122.

5. On 16 January 2009 an Order Granting Request for *Inter Partes* Reexamination 95/001,122 was mailed.

6. On 09 March 2009 a decision s*ua sponte* was mailed merging proceedings 95/000,166 and 95/001,122

7. On 20 March 2009 a non-final Office action was mailed was mailed in the above mentioned proceedings.

8. On 23 April 2009 the instant petition for a forty-five (45) days extension of time was submitted by the patent owner's representative.

Discussion

The Patent Owner's representative requests the period of time be extended in which to file a response to the non-final Office action mailed 20 March 2009, which set a two (2) months time for filing a response thereto. The petition for extension of time was timely filed on 23 April 2009, together with electronic fee transmittal for the $200.00 petition fee as

required by 37 CFR § 1.956 and 37 CFR § 1.17 (g). A certificate of service was provided with the petition.

The request is granted-in-part.

> **37 CFR § 1.956. Patent owner extensions of time in inter partes reexamination.** *The time for taking any action by a patent owner in an inter partes reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified. Any request for such extension must be filed on or before the day on which action by the patent owner is due, but in no case will the mere filing of a request effect any extension. Any request for such extension must be accompanied by the petition set forth in § 1.17(g). See § 1.304(a) for extensions of time for filing a notice of appeal to the U.S. Court of Appeals for the Federal Circuit.*

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

> As noted above, a request for extension of time under 37 CFR § 1.956 will be granted only for sufficient cause, ...
>
> Evaluation of whether "sufficient cause" has been shown for an extension must be made by **balancing** the desire to provide the patent owner with a fair opportunity to respond, **against** the requirement of the statute, 35 U.S.C. § 314(c), that the proceedings be conducted with special dispatch. ...

Any petition request must include the required petition fee as set forth according to 37 CFR § 1.17 (g) and 37 CFR § 1.956.

MPEP § 2665 Extension of Time for Patent Owner Response (in-part)

> Requests for an extension of time in an inter partes reexamination proceeding will be considered only after the first Office action on the merits in the reexamination is mailed. Any request for an extension of time filed prior to the first action will be denied.
>
> The certificate of mailing and the certificate of transmission procedures (37 CFR § 1.8), and the "Express Mail" mailing procedure (37 CFR § 1.10), may be used to file a request for extension of time, as well as any other paper in an existing *inter partes* reexamination proceeding (see MPEP § 2666).
>
> 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 forty-five (45) days to the period for response. The decision to extend the period for response is evaluated based upon a showing of "sufficient cause." There is always the consideration to balance the need for the patent owner to have a fair opportunity to respond to the Office action between the need for special dispatch.

The non-final Office action was mailed 20 March 2009. The patent owner submitted a timely filed the petition on 23 April 2009 with the appropriate fee and certificate of service.

The petition dated 23 April 2009 cites the length and complexity of the Office action with its many rejections as well as the number of concurrently handled proceedings by the patent owner. While concurrent proceedings are generally no considered to rise to the level of sufficient cause, on balance, the petitioner has demonstrated "sufficient cause" to grant a one (1) month extension of time based upon the length and complexity of the Office action.

The petition request to extend the response time by one (1) month is hereby granted-in-part.

CONCLUSION

1. The patent owner's petition for extension for forty-five (45) days time in which to file a response to the non-final Office action dated 20 March 2009 is hereby **granted-in-part**

2. The period for response is extended by one (1) month.

3. The Patent Owner's response is due **20 June 2009.**

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

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

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

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

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

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

/Mark Reinhart/
for

_____
Gregory Morse,
Director,
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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In re Farmwald et al.
Inter Partes Reexamination Proceeding
Control No. 95/000,166
Filed: August 22, 2007
For U.S. Patent Number 6,426,916

In re Farmwald et al.
Inter Partes Reexamination Proceeding
Control No. 95/001,122
Filed: November 20, 2008
For U.S. Patent Number 6,426,916

DECISION DISMISSING PATENT OWNER'S PETITION TO WAIVE THE PAGE LIMIT FOR ITS APPELLANTS' BRIEF, AND DISMISSING PETITIONS TO WAIVE THE PAGE LIMITS FOR RESPONDENT'S BRIEFS

This is a decision on the following petitions requesting waiver of 37 C.F.R. § 1.943(c):

(1) Petition filed March 16, 2010 by patent owner entitled "EXPEDITED PETITION SEEKING WAIVER OF 37 CFR § 1.943."

(2) Petition filed March 29, 2010 by patent owner entitled "SECOND PETITION SEEKING WAIVER OF 37 CFR § 1.943."

(3) Petition filed April 19, 2010, by third party requester entitled "THIRD PARTY REQUESTER'S PETITION UNDER 37 C.F.R. § 1.183 FOR LIMITED WAIVER OF 37 C.F.R. § 1.943(C)."

(4) Petition filed April 29, 2010 by patent owner entitled "PETITION SEEKING WAIVER OF 37 C.F.R. § 1.943 FOR PATENT OWNER'S RESPONDENT APPEAL BRIEF."

This decision also addresses the third party requester's May 14, 2010 opposition paper entitled "Third Party Requester's Opposition to Patent Owner's Petition Seeking Waiver of 37 CFR § 1.943 for Patent Owner's Respondent Appeal Brief".

The proceeding, the third party requestor's petition and opposition, and the patent owner's petitions 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 C.F.R. § 1.183 has been received.

SUMMARY

(1) The patent owner's March 16, 2010, and March 29, 2010 petitions requesting waiver of its appellant brief page limit restrictions under 37 C.F.R. § 1.943(c) are dismissed as the situation has not been shown to be extraordinary as explained below. The brief filed March 29, 2010 is expunged as improper, since it does not comply with 37 CFR 1.943(c). The patent owner's brief shall not exceed 30 pages. The patent owner 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 19, 2010 petition requesting waiver of its respondent brief page limit restrictions under 37 C.F.R. § 1.943(c) is dismissed as the situation has not been shown to be extraordinary as explained below. The brief filed April 29, 2010 is expunged as improper, since it does not comply with 37 CFR 1.943(c). The third party requester's brief shall not exceed 15 pages. The third party requester may file a corrected or redacted respondent brief that does not exceed 15 pages in response to patent owner's appellant brief once filed, within one month from the date of service of the appellant brief.

(3) The patent owner's April 29, 2010 petition requesting waiver of its respondent brief page limit restrictions under 37 C.F.R. § 1.943(c) is dismissed as the situation has not been shown to be extraordinary as explained below. The respondent brief filed April 29, 2010 is expunged as improper as it does not comply with 37 C.F.R. § 1.943(c). Patent owner's respondent brief shall not exceed 15 pages. Patent owner may file a corrected or redacted respondent brief that does not exceed 15 pages within 15 days from the date of this decision.

(4) The third party requester's May 14, 2010 opposition paper to patent owner's April 29, 2010 petition is dismissed and expunged as having no right of entry in this proceeding.

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

REVIEW OF THE RELEVANT FACTS

1. On July 30, 2002, U.S. Patent No. 6,426,916 B2 ('the '916 patent) issued with forty-one claims to Farmwald *et al.* and assigned on its face to Rambus, Inc.

2. On August 8, 2006, a request for *inter partes* reexamination of claims 1-41 of the '916 patent was submitted by a third party requester, Samsung Electronics Ltd., which request was assigned control number 95/000,166 ("the '166 proceeding"). After receipt of a corrected request the '166 proceeding was granted a filing date of October 12, 2006. An Order was granted for the *inter partes* reexamination on Dec. 26, 2006, which was then vacated in a decision mailed August 14, 2007.

3. On August 22, 2007, a redacted/corrected request for *inter* partes reexamination of the claims of the '916 patent was filed by Samsung Electronics and was granted a filing date.

4. On October 19, 2007, an order granting *inter partes* reexamination of claims 1-41 of the '916 patent was issued.

5. On November 20, 2008, a second request for *inter partes* reexamination of claims 26 and 28 of the '916 patent was submitted by a third party requester, Micron Technology, which request was assigned control number 95/001,122 ("the '1122 proceeding") and granted a filing date of November 20, 2008.

6. On January 16, 2009, an Order was granted for *inter partes* reexamination of claims 26 and 28 of the '916 patent in the '1122 proceeding.

7. On March 9, 2009, the '166 and '1122 proceedings were merged.

8. The merged proceeding has progressed to the point where, on December 18, 2009, a Right of Appeal Notice (RAN) was mailed in the merged proceeding.

9. On January 15, 2010, patent owner filed a Notice of Appeal for claims 26, 28, and 40.

10. On January 29, 2010, third party requester Micron filed a Notice of Cross Appeal for claims 26 and 28.

11. On March 16, 2010, patent owner filed a petition under 37 C.F.R. § 1.183 requesting waiver of the page limit requirements of 37 C.F.R. § 1.943(c).

12. On March 29, 2010, patent owner filed an appellant's brief, along with a second petition under 37 C.F.R. § 1.183 requesting waiver of the page limit requirements of 37 C.F.R. § 1.943(c).

13. On March 29, 2010, third party requester filed an appellant's brief.

14. On April 19, 2010, third party requester filed a petition under 37 C.F.R. § 1.183 requesting waiver of page limit requirements of 37 C.F.R. § 1.943(c) for third party requester's respondent brief. The respondent brief was filed on April 29, 2010.

15. On April 29, 2010, patent owner filed a respondent's brief, along with a petition under 37 C.F.R. § 1.183 requesting waiver of the page limit requirements of 37 C.F.R. § 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 Petitions of March 16, 2010 and March 29, 2010.

The patent owner requests waiver of 37 C.F.R. § 1.943(c), which limits patent owner's appellant brief to thirty (30) pages or 14,000 words in length. The patent owner submitted a brief that includes 51 pages of arguments and has certified that the brief as filed is 21,542 words.

Waiver is requested for the following reasons, which according to the patent owner, present an extraordinary situation:

(1) The extensive arguments made by the Office in the RAN, which is over 100 pages in length.
(2) The size of the applied Bennett reference, in combination with the other applied references.
(3) The number of issues raised by the Office in the RAN, including claim rejections, a written description determination allegedly made as a priority determination, and claim construction issues.

II. Third Party Requester Petition of April 19, 2010

The third party requester Micron Technology requests waiver of 37 C.F.R. § 1.943(c), which limits third party requester's respondent brief to fifteen (15) pages or 7,000 words in length. The third party requester desires waiver to double the limit set forth in § 1.943(c).

Waiver is requested for the sole reason that patent owner's appellant's brief exceeded the page limit requirements, which according to the third party requester, presents an extraordinary situation.

III. Patent Owner Petition of April 29, 2010

The patent owner requests waiver of 37 C.F.R. § 1.943(c), which limits the respondent brief to fifteen (15) pages or 7,000 words in length. The patent owner states that the respondent brief as filed is 9,885 words.

Waiver is requested for the reason that Micron's appellant's brief raises numerous (three) issues, which according to the patent owner, present an extraordinary situation.

IV. Analysis and findings

A. Determining Page Length

As noted in MPEP 2667(I)(A)(2), the provisions of 37 C.F.R. § 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 C.F.R. § 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 C.F.R. § 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 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.

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

B. Patent Owner Has Not Shown the Existence of an Extraordinary Situation Requiring Waiver of the Page Limit Rule For Patent Owner's Appellant's Brief

Patent owner's petition rests upon three facts supporting an unfairness in application of the page limit rules. First, the RAN, which is over 100 pages in length, includes extensive arguments made by the Office requiring treatment at some length in the appellant's brief. Second the size of the applied Bennett reference, in combination with the other applied references, presents an unusual situation. Third, the number of issues raised by the Office in the RAN, including claim rejections, a written description determination allegedly made as a priority determination, and claim construction issues, necessarily requires treatment at some length in the appellant's brief. Analysis of the RAN and the appellant's brief reveals that both discuss issues of claim construction raised in evidentiary submissions.

The content of patent owner's appellant's brief has been considered, in view of the prosecution history, to determine the necessity of page limit waiver on the arguments presented by patent owner. Prior to appeal, the claims and rejections/issues were adequately addressed in significantly fewer pages than in the appellant's brief. The regulations contemplate that issues addressable in 50 pages during the pre-appeal stage should be addressable in 30 pages in an appellant's brief. Furthermore, the appellant's brief addresses fewer grounds of rejection than were addressed in earlier patent owner responses. Of the approximately 54 pages of argument in patent owner's appellant brief, as indicated by the table of contents, approximately 44 address a single anticipation rejection.[3] Although patent owner states that the necessity for page limit waiver is, in part, due to "numerous issues," patent owner's treatment of this single issue has exceeded the page limit requirements for an appellant brief. It is further noted that the RAN addresses this single anticipation rejection primarily over an 18 page span, and although significant additional treatment of claim construction issues is present, it is clear that a significant number of the 136 pages in the RAN are not the subject of patent owner's appellant brief.[4]

Despite the simplification of issues, and the fact that the regulations contemplate an appellant brief to be 40% shorter than an response to an Office action, patent owner has here submitted an appellant brief having a number of pages that is longer than the permitted page limit for a response to an action, and indeed, over 50% greater than that contemplated under the regulations even when measured by the word count. No reason has been provided why such an increase in pages, relative to the length of patent owner's previous responses to Office actions, is now warranted.

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[3] Patent owner's appellant brief, at ii-iii, indicating that pages 6-50 address the anticipation of claim 26 by *Bennett*, and pages 51-52 address the anticipation of claim 28 by *Bennett*.

[4] Patent owner's appellant's brief cites to pages 83-100 of the RAN; e.g., at pages 6-32 and 48-50 of appellant's brief. The appellant's brief, at pages 35-44, cites to additional pages of the RAN (individual pages starting between page 9 and 48) for claim construction issues. It is further noted that approximately the first ten pages of the appellant's brief are devoted towards a general discussion of the claimed invention and the Bennett reference; the discussion merits of the rejection appear to begin at page 15 of the brief; *e.g.*, at the section entitled "d. *Bennett* Does Not Read on the Claimed Inventions."

The appeal rules for reexamination have been structured such that treatment of issues is expected to be compressed relative to responses during prosecution. As patent owner filed responses within the 50 page limit for responses, it should be expected that, barring extraordinary circumstances, patent owner's appellant's brief should remain within the 30 page limit for appellant's briefs. None of the above facts, viewed in context of the circumstances of the proceeding, give rise to an extraordinary situation such that waiver of the page limit rules would be necessary to satisfy the requirements of justice in the instant proceeding. Therefore, patent owner's request to waive 37 C.F.R. § 1.943(c), to the extent necessary to permit the March 29, 2010 patent owner's appellant's brief, is **dismissed**.

C. Third Party Requester Has Not Shown the Existence of an Extraordinary Situation Requiring Waiver of the Page Limit Rule For Third Party Requester's Respondent's Brief

Third party requester Micron Technology's petition rests on the sole ground that a waiver of page limit requirements for an appellant's brief necessarily requires a waiver of page limit requirements for the corresponding respondent's brief. However, the rationale for waiver of page limit requirements for the appellant's brief rest upon the combination of a lengthy RAN, lengthy references, and numerous issues requiring treatment by the patent owner. The third party requester has not set forth any facts supporting a contention that the respondent's brief could not fairly be written within the standard page limits. Furthermore, it is not apparent from the prosecution history that a combination of factors exists such that an extraordinarily lengthy respondent's brief would be necessitated to satisfy the requirements of justice.

Third party requester Micron Technology has failed to persuasively establish the existence of an extraordinary situation requiring waiver of the page limit requirements for its respondent's brief, which as filed includes 31 pages of arguments. Therefore, third party requester's request to waive 37 C.F.R. § 1.943(c), to permit a respondent brief of up to 14,000 words or 30 pages, is **dismissed**.

D. Patent Owner Has Not Shown the Existence of an Extraordinary Situation Requiring Waiver of the Page Limit Rule For Patent Owner's Respondent's Brief

Patent Owner's petition requests waiver of the page limit requirement for patent owner's respondent's brief based upon the fact that the third party requester's appellant's brief raises numerous (three) issues. However, the third party requester's appellant's brief presents these issues and yet remains within the page limit requirements set forth in 37 C.F.R. § 1.943(c). No reason why an increase in pages is now warranted has been provided. Furthermore, it is not apparent from the prosecution history that a combination of factors exists such that an extraordinarily lengthy respondent's brief would be necessitated to satisfy the requirements of justice.

Patent owner has failed to persuasively establish the existence of an extraordinary situation requiring waiver of the page limit requirements for its respondent's brief, which as filed includes 27 pages of arguments. Therefore, third party requester's request to waive 37 C.F.R. § 1.943(c), to permit a respondent brief of 9,885 words is **dismissed**.

E. 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.

Both parties 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. 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 with the brief.

F. Third Party Requester's Opposition Paper Has No Right Of Entry

With respect to the May 14, 2010 requester paper opposing patent owner's petition under 37 C.F.R. § 1.183, no statute or regulation provides any right for the third party requester to file an opposition to, or comment on, the patent owner's petition to request waiver of respondent brief page limits. A request for waiver of respondent brief page limits 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 equities as to the "special dispatch" requirement and 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 not expressly provided for by the rules. 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 waiver of respondent brief page limits. No mechanism has been provided for the third party requester to file a paper, such as the present 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 waiver of respondent brief page limits is a paper that is not permitted by the statute governing *inter partes* reexamination proceedings, and accordingly it was not provided for (i.e., was not permitted) in the regulations that implemented the *inter partes* reexamination statute. Third party requester's

opposition to patent owner's petition for waiver of respondent brief page limits is therefore not enterable into the record.

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 opposition, filed on May 14, 2010 to the patent owner's petition for waiver of respondent brief page limits filed on April 29, 2010 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 for revival will be 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. The patent owner petitions filed on March 16, 2010 and March 29, 2010 under 37 C.F.R. § 1.183 to waive the provisions of 37 C.F.R. § 1.943(c) for the appellant brief are **dismissed**. The appellant brief filed March 29, 2010 is expunged from IFW by closing it in IFW and marking it as non-public. Patent owner has 15 days from the date of this decision to file a compliant appellant brief pursuant to 37 C.F.R. § 41.67(d). The time for filing an appellant brief may not be extended.

2. The third party requester petition filed April 19, 2010 under 37 C.F.R. § 1.183 to waive the provisions of 37 C.F.R. § 1.943(c) for the respondent brief is **dismissed**. The respondent brief filed April 29, 2010 is expunged from IFW by closing it in IFW and marking it as non-public. Third party requester has one month from the date of service of patent owner's appellant brief to file a compliant respondent brief pursuant to 37 C.F.R. § 41.68(c). The time for filing a respondent brief may not be extended. Failure to timely file a respondent brief will result in the respondent brief not being considered.

3. The patent owner petition filed April 29, 2010 under 37 CFR 1.183 to waive the provisions of 37 C.F.R. § 1.943(c) for the respondent brief is **dismissed**. The respondent brief filed April 29, 2010 is expunged from IFW by closing it in IFW and marking it as non-public. Patent owner has 15 days from the date of this decision to file a compliant respondent brief pursuant to 37 C.F.R. § 41.67(d). The time for filing a respondent brief may not be extended. Failure to timely file a respondent brief will result in the respondent brief not being considered.

4. The May 14, 2010 requester opposition petition paper is **refused entry**, as it is an improper paper. The opposition paper is being expunged by closing the paper in the Image File

Wrapper (IFW) for the proceeding and marking it "not public." It will not constitute part of the record of the present reexamination proceeding.

5. Jurisdiction over the merged reexamination proceeding is hereby returned to the Central Reexamination Unit.

6. Any questions concerning this communication should be directed to Michael Cygan, Legal Advisor, at 571-272-7700.

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

May 26, 2010

UNITED STATES PATENT AND TRADEMARK OFFICE

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In re Farmwald et al.
Inter Partes Reexamination Proceeding
Control No. 95/000,166
Filed: August 22, 2007
For U.S. Patent Number 6,426,916

In re Farmwald et al.
Inter Partes Reexamination Proceeding
Control No. 95/001,122
Filed: November 20, 2008
For U.S. Patent Number 6,426,916

DECISION DISMISSING PETITIONS

This is a decision on the following papers:

(1) Petition filed March 4, 2010 by patent owner entitled "PETITION TO SIMPLIFY ISSUES FOR APPEAL," by striking portions of the third party requester's Notice of Cross Appeal.

(2) Opposition filed March 19, 2010 by the '1122 third party requester entitled "THIRD PARTY REQUESTER'S OPPOSITION TO PATENT OWNER'S PETITION TO SIMPLIFY ISSUES FOR APPEAL."

(3) Petition filed April 29, 2010, by patent owner entitled "PETITION TO DISMISS THIRD PARTY REQUESTER'S CROSS APPEAL."

(4) Opposition filed June 1, 2010 by the '1122 third party requester entitled "THIRD PARTY REQUESTER'S OPPOSITION AND REQUEST TO EXPUNGE IMPROPER PAPER."

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

The petitions and oppositions are dismissed as moot.

FEES

The fee set forth in 37 CFR 1.17(f) for both patent owner petitions is $400, which was charged to Patent Owner's credit card on March 5, 2010 and April 30, 2010 pursuant to the authorizations for same in Patent Owner's EFS-WEB fee transmittals filed on March 4, 2010 and April 29, 2010.

The '1122 third party requester oppositions are being taken as petitions under 37 CFR 1.182/1.183. The fee set forth in 37 CFR 1.17(f) for these petitions is $400.

Two $400 fees will be charged to the '1122 requester's deposit account no. 14-1437, one fee pursuant to the authorization on page two of requester's March 19, 2010 petition, and the other fee pursuant to the authorization on page one of the '1122 requester's June 1, 2010 opposition.

REVIEW OF THE RELEVANT FACTS

1. On July 30, 2002, U.S. Patent No. 6,426,916 B2 ('the '916 patent) issued with forty-one claims to Farmwald *et al.* and assigned on its face to Rambus, Inc.

2. On August 8, 2006, a request for *inter partes* reexamination of claims 1-41 of the '916 patent was submitted by a third party requester, Samsung Electronics Ltd., which request was assigned control number 95/000,166 ("the '166 proceeding"). After receipt of a corrected request the '166 proceeding was granted a filing date of October 12, 2006. An Order was granted for the *inter partes* reexamination on Dec. 26, 2006, which was then vacated in a decision mailed August 14, 2007.

3. On August 22, 2007, a redacted/corrected request for *inter* partes reexamination of the claims of the '916 patent was filed by Samsung Electronics and was granted a filing date.

4. On October 19, 2007, an Order granting *inter partes* reexamination of claims 1-41 of the '916 patent was issued.

5. On November 20, 2008, a second request for *inter partes* reexamination of claims 26 and 28 of the '916 patent was submitted by a third party requester, Micron Technology, which request was assigned control number 95/001,122 ("the '1122 proceeding") and granted a filing date of November 20, 2008.

6. On January 16, 2009, an Order granted *inter partes* reexamination of claims 26 and 28 of the '916 patent in the '1122 proceeding.

7. On March 9, 2009, the '166 and '1122 proceedings were merged.

8. The merged proceeding then progressed to the point where, on December 18, 2009, a Right of Appeal Notice (RAN) was mailed in the merged proceeding.

9. On January 15, 2010, patent owner filed a Notice of Appeal for claims 26, 28, and 40.

10. On January 29, 2010, third party requester Micron filed a Notice of Cross Appeal for claims 26 and 28.

11. On March 4, 2010, patent owner filed a petition under 37 CFR 1.182 requesting issues be stricken from the '1122 third party requester's January 29, 2010 Notice of Cross Appeal.

12. On March 19, 2010, the '1122 third party requester filed an opposition paper, citing no authority for its entry, requesting dismissal of patent owner's March 4, 2010 petition.

13. On March 29, 2010, patent owner filed an appeal brief.

14. On March 29, 2010, '1122 third party requester filed a cross appeal brief.

15. On April 29, 2010, patent owner filed a respondent brief, along with a petition under 37 CFR 1.182 requesting dismissal of the '1122 third party requester's cross appeal.

16. On April 29, 2010, third party requester filed a respondent brief.

17. On May 27, 2010, the Office issued a decision expunging patent owner's March 29, 2010 appeal brief and April 29, 2010 respondent brief and third party requester's April 29, 2010 respondent brief.

18. On June 1, 2010, the '1122 third party requester filed an opposition paper, requesting dismissal and expungement of patent owner's April 29, 2010 petition.

19. On June 11, 2010, patent owner filed a revised appeal brief and a revised respondent brief.

20. On June 19, 2010, the Office issued an Action Closing Prosecution (ACP), reopening prosecution of the merged proceeding.

DECISION

On March 4, 2010, and April 29, 2010, patent owner filed its present petitions. On March 19, 2010, the '1122 third party requester filed its opposition to patent owner's March 4, 2010 petition. On June 1, 2010, the '1122 third party requester filed its opposition to patent owner's April 29, 2010 petition. In the March 4, 2010 petition, patent owner requests that the Office strike from the record specific issues for appeal in the '1122 third party requester's January 29, 2010 notice of cross appeal. In the April 29, 2010 petition, patent owner requests that the Office strike from the record the '1122 third party requester's March 29, 2010 cross appeal brief and dismiss the cross appeal. The '1122 third party requester opposes patent owner's March 4, 2010 request to strike issues raised on cross appeal and opposes patent owner's April 29, 2010 request to strike the March 29, 2010 cross appeal brief and dismissal of the cross appeal.

On June 19, 2010, the Office issued an ACP, reopening prosecution in the merged proceeding and removing the merged proceeding from appeal. The Office's reopening of prosecution renders the petitions and oppositions regarding the propriety of '1122 third party requester's appeal moot. Accordingly, the all the present petitions and oppositions are DISMISSED AS MOOT.

ADDITIONAL DISCUSSION

In the '1122 third party requester's June 1, 2010 opposition the position that patent owner's April 29, 2010 is an improper paper was advanced. The '1122 requester asserts patent owner's April 29, 2010 petition is a "renewal" of patent owner's March 4, 2010 petition and responsive to the '1122 requester's March 19, 2010 oppositions. The '1122 requester therefore concludes patent owner's April 29, 2010 petition is an improper, iterative paper that should be expunged from the record of the proceeding. The '1122 requester is in error. Patent owner's March 4, 2010 petition is in response to the '1122 requester's notice of cross appeal filed on January 29, 2010 and asks for the relief of striking from the record all issues listed in the notice of cross appeal that were not raised by the '1122 requester. Patent owner's April 29, 2010 petition is in response to the '1122 requester's cross appeal brief filed on March 29, 2010 and asks for the relief of expungement of the brief and dismissal of the appeal. As the April 29, 2010 petition is responding to a different submission, it is neither a renewal of the March 4, 2010 petition nor an improper iterative response to the '1122 requester's March 19, 2010 opposition. Therefore, patent owner's April 29, 2010 petition submission is not an improper paper. Accordingly, patent owner's April 29, 2010 petition submission is not subject to expungement.

CONCLUSION

1. The petitions and oppositions are **dismissed as moot**.

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

3. Any questions concerning this communication should be directed to Joseph F. Weiss, Jr., Legal Advisor, at 571-272-7759.

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

July 9, 2010

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CENTRAL REEXAMINATION UNIT

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(For Third Party Requester)

In re Farmwald et al.
Inter Partes Reexamination Proceeding
Control No. 95/000,166
Filed: August 22, 2007
For U.S. Patent Number 6,426,916

In re Farmwald et al.
Inter Partes Reexamination Proceeding
Control No. 95/001,122
Filed: November 20, 2008
For U.S. Patent Number 6,426,916

DECISION DISMISSING PETITIONS

This is a decision on the following papers:

(1) Petition filed March 4, 2010 by patent owner entitled "PETITION TO SIMPLIFY ISSUES FOR APPEAL," by striking portions of the third party requester's Notice of Cross Appeal.

(2) Opposition filed March 19, 2010 by the '1122 third party requester entitled "THIRD PARTY REQUESTER'S OPPOSITION TO PATENT OWNER'S PETITION TO SIMPLIFY ISSUES FOR APPEAL."

(3) Petition filed April 29, 2010, by patent owner entitled "PETITION TO DISMISS THIRD PARTY REQUESTER'S CROSS APPEAL."

(4) Opposition filed June 1, 2010 by the '1122 third party requester entitled "THIRD PARTY REQUESTER'S OPPOSITION AND REQUEST TO EXPUNGE IMPROPER PAPER."

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

The petitions and oppositions are dismissed as moot.

FEES

The fee set forth in 37 CFR 1.17(f) for both patent owner petitions is $400, which was charged to Patent Owner's credit card on March 5, 2010 and April 30, 2010 pursuant to the authorizations for same in Patent Owner's EFS-WEB fee transmittals filed on March 4, 2010 and April 29, 2010.

The '1122 third party requester oppositions are being taken as petitions under 37 CFR 1.182/1.183. The fee set forth in 37 CFR 1.17(f) for these petitions is $400.

Two $400 fees will be charged to the '1122 requester's deposit account no. 14-1437, one fee pursuant to the authorization on page two of requester's March 19, 2010 petition, and the other fee pursuant to the authorization on page one of the '1122 requester's June 1, 2010 opposition.

REVIEW OF THE RELEVANT FACTS

1. On July 30, 2002, U.S. Patent No. 6,426,916 B2 ('the '916 patent) issued with forty-one claims to Farmwald *et al.* and assigned on its face to Rambus, Inc.

2. On August 8, 2006, a request for *inter partes* reexamination of claims 1-41 of the '916 patent was submitted by a third party requester, Samsung Electronics Ltd., which request was assigned control number 95/000,166 ("the '166 proceeding"). After receipt of a corrected request the '166 proceeding was granted a filing date of October 12, 2006. An Order was granted for the *inter partes* reexamination on Dec. 26, 2006, which was then vacated in a decision mailed August 14, 2007.

3. On August 22, 2007, a redacted/corrected request for *inter* partes reexamination of the claims of the '916 patent was filed by Samsung Electronics and was granted a filing date.

4. On October 19, 2007, an Order granting *inter partes* reexamination of claims 1-41 of the '916 patent was issued.

5. On November 20, 2008, a second request for *inter partes* reexamination of claims 26 and 28 of the '916 patent was submitted by a third party requester, Micron Technology, which request was assigned control number 95/001,122 ("the '1122 proceeding") and granted a filing date of November 20, 2008.

6. On January 16, 2009, an Order granted *inter partes* reexamination of claims 26 and 28 of the '916 patent in the '1122 proceeding.

7. On March 9, 2009, the '166 and '1122 proceedings were merged.

8. The merged proceeding then progressed to the point where, on December 18, 2009, a Right of Appeal Notice (RAN) was mailed in the merged proceeding.

9. On January 15, 2010, patent owner filed a Notice of Appeal for claims 26, 28, and 40.

10. On January 29, 2010, third party requester Micron filed a Notice of Cross Appeal for claims 26 and 28.

11. On March 4, 2010, patent owner filed a petition under 37 CFR 1.182 requesting issues be stricken from the '1122 third party requester's January 29, 2010 Notice of Cross Appeal.

12. On March 19, 2010, the '1122 third party requester filed an opposition paper, citing no authority for its entry, requesting dismissal of patent owner's March 4, 2010 petition.

13. On March 29, 2010, patent owner filed an appeal brief.

14. On March 29, 2010, '1122 third party requester filed a cross appeal brief.

15. On April 29, 2010, patent owner filed a respondent brief, along with a petition under 37 CFR 1.182 requesting dismissal of the '1122 third party requester's cross appeal.

16. On April 29, 2010, third party requester filed a respondent brief.

17. On May 27, 2010, the Office issued a decision expunging patent owner's March 29, 2010 appeal brief and April 29, 2010 respondent brief and third party requester's April 29, 2010 respondent brief.

18. On June 1, 2010, the '1122 third party requester filed an opposition paper, requesting dismissal and expungement of patent owner's April 29, 2010 petition.

19. On June 11, 2010, patent owner filed a revised appeal brief and a revised respondent brief.

20. On June 19, 2010, the Office issued an Action Closing Prosecution (ACP), reopening prosecution of the merged proceeding.

DECISION

On March 4, 2010, and April 29, 2010, patent owner filed its present petitions. On March 19, 2010, the '1122 third party requester filed its opposition to patent owner's March 4, 2010 petition. On June 1, 2010, the '1122 third party requester filed its opposition to patent owner's April 29, 2010 petition. In the March 4, 2010 petition, patent owner requests that the Office strike from the record specific issues for appeal in the '1122 third party requester's January 29, 2010 notice of cross appeal. In the April 29, 2010 petition, patent owner requests that the Office strike from the record the '1122 third party requester's March 29, 2010 cross appeal brief and dismiss the cross appeal. The '1122 third party requester opposes patent owner's March 4, 2010 request to strike issues raised on cross appeal and opposes patent owner's April 29, 2010 request to strike the March 29, 2010 cross appeal brief and dismissal of the cross appeal.

On June 19, 2010, the Office issued an ACP, reopening prosecution in the merged proceeding and removing the merged proceeding from appeal. The Office's reopening of prosecution renders the petitions and oppositions regarding the propriety of '1122 third party requester's appeal moot. Accordingly, the all the present petitions and oppositions are DISMISSED AS MOOT.

ADDITIONAL DISCUSSION

In the '1122 third party requester's June 1, 2010 opposition the position that patent owner's April 29, 2010 is an improper paper was advanced. The '1122 requester asserts patent owner's April 29, 2010 petition is a "renewal" of patent owner's March 4, 2010 petition and responsive to the '1122 requester's March 19, 2010 oppositions. The '1122 requester therefore concludes patent owner's April 29, 2010 petition is an improper, iterative paper that should be expunged from the record of the proceeding. The '1122 requester is in error. Patent owner's March 4, 2010 petition is in response to the '1122 requester's notice of cross appeal filed on January 29, 2010 and asks for the relief of striking from the record all issues listed in the notice of cross appeal that were not raised by the '1122 requester. Patent owner's April 29, 2010 petition is in response to the '1122 requester's cross appeal brief filed on March 29, 2010 and asks for the relief of expungement of the brief and dismissal of the appeal. As the April 29, 2010 petition is responding to a different submission, it is neither a renewal of the March 4, 2010 petition nor an improper iterative response to the '1122 requester's March 19, 2010 opposition. Therefore, patent owner's April 29, 2010 petition submission is not an improper paper. Accordingly, patent owner's April 29, 2010 petition submission is not subject to expungement.

CONCLUSION

1. The petitions and oppositions are **dismissed as moot**.

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

3. Any questions concerning this communication should be directed to Joseph F. Weiss, Jr., Legal Advisor, at 571-272-7759.

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

July 9, 2010

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,123	11/21/2008	6871450	DON02 P-900	1847

28101 7590 03/24/2009

VAN DYKE, GARDNER, LINN & BURKHART, LLP
SUITE 207
2851 CHARLEVOIX DRIVE, S.E.
GRAND RAPIDS, MI 49546

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/24/2009

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SUITE 800
WASHINGTON, DC 20037

Date:
MAILED

MAR 24 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001123
PATENT NO. : 6871450
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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VAN DYKE, GARDNER, LINN & BURKHART, LLP (For Patent Owner)
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MAILED

MAR 24 2009

CENTRAL REEXAMINATION UNIT

SUGHRUE MION, PLLC (For Third Party Requester)
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WASHINGTON, DC 20037

Inter Partes Reexamination Proceeding : **DECISION**
Control No. 95/001,123 : **GRANTING**
Filed: November 21, 2008 : **PETITION**
For: U.S. Patent No. 6,871,450 :

This is a decision on the patent owner paper entitled "PETITION TO WAIVE REQUIREMENTS UNDER 37 C.F.R. § 1.943" filed on February 5, 2009.

The patent owner petition will be treated as a petition under 37 CFR 1.183 for waiver of the 50-page limit requirement of 37 CFR 1.943(b). 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 credit card on February 6, 2009.

REVIEW OF THE RELEVANT FACTS

1. United States Patent Number 6,871,450 (the '450 patent) issued on March 29, 2005.

2. On November 21, 2008, a request for *inter partes* reexamination of the '450 patent was filed by a third party requester, and assigned Reexamination Control No. 95/001,123 (the '1123 proceeding).

3. On January 7, 2009, the Office issued an order granting *inter partes* reexamination in the '1123 proceeding, with an accompanying non-final Office action on the merits.

4. On February 5, 2009, patent owner filed the instant petition paper entitled, "PETITION TO WAIVE REQUIREMENTS UNDER 37 C.F.R. § 1.943." Concurrently on February 5, 2009, patent owner filed a response to the January 7, 2009 Office action, accompanied by four declarations under 37 CFR 1.132.

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.

As noted above, on February 5, 2009, patent owner concurrently filed with the instant petition a response to the January 7, 2009 Office action, which was accompanied by four declarations under 37 CFR 1.132. The response, exclusive of the accompanying declarations, exceeds the 50-page limit set forth in 37 CFR 1.943(b) by 15 pages (page 1 of the response merely includes identifying information and does not include any arguments). In the instant petition, patent owner requests waiver of 37 CFR 1.943(b) to be given a page limit that accommodates patent owner's response and accompanying fact-based exhibits.[1]

In support of waiver of the rule, patent owner points out that the January 7, 2009 Office action is "long and complex" in that it "essentially wholly" incorporates by reference from the *inter partes* request for reexamination and includes 26 grounds of rejection of the 166 claims, 18 of which are independent claims.[2] Patent owner submits that "[t]he complexity is compounded by the fact that all of the outstanding rejections are for obviousness," given that at least four factors must be addressed for the 166 claims (i.e., the scope and content of the prior art, the differences between the claimed invention and the prior art, the level of ordinary skill in the art, and secondary considerations).[3] Patent owner asserts that it attempted to draft the response within the 50-page limit, but finds "that it cannot fairly or adequately respond" within 50 pages and deems the 50-page limit set forth in 37 CFR 1.943(b) "woefully inadequate" for the particular circumstances of the '1123 proceeding.[4]

Upon consideration of the instant petition, it is noted that the January 7, 2009 Office action rejects claims 1-166 of the '450 patent based on 26 different obviousness rejections. Further, the Office action incorporates by reference the detailed explanations of the rejections from pages 34-189 of the request for *inter partes* reexamination.[5]

---

[1] Petition at page 4.
[2] Petition at page 2.
[3] Petition at page 2.
[4] Petition at pages 2-3.
[5] See January 7, 2009 Office action at page 2.

Additionally, pursuant to MPEP 2667(I)(A)(2), any declaration (or a clearly defined portion thereof) that contains opinions of the declarant or arguments 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 the page(s) of the declaration upon which the declarant opinions or arguments appear will be included against of the page limit requirements of 37 CFR 1.943. Upon cursory review of the four declarations that accompanied patent owner's February 5, 2009 response, it appears approximately 4 pages contain opinions of the declarant or arguments as to obviousness that will be counted toward the 50-page limit.

Based upon the nature of the rejections set forth in the January 7, 2009 Office action and the extensive incorporation by reference from the request therein, as well as on the individual facts and circumstances of this case, it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance. In particular, the 50-page limit of 37 CFR 1.943(b) is waived to the extent that the patent owner's February 5, 2009 response and four accompanying declarations exceed the 50-page limit by 19 pages (i.e., 15 extra pages in the response plus the 4 additional pages in the accompanying declarations that contain opinions of the declarant or arguments as to obviousness).

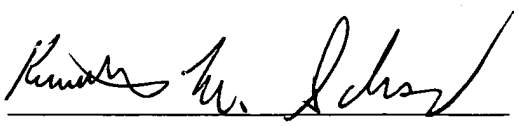
Accordingly, the patent owner petition under 37 CFR 1.183 is **granted** to the extent that the page limit of 37 CFR 1.943(b) is waived as to the **19 pages** of the patent owner's February 5, 2009 response and applicable accompanying declaration portions that exceed the 50-page limit.

CONCLUSION

1. The patent owner petition under 37 CFR 1.183 is granted to the extent that the page limit of 37 CFR 1.943(b) is waived as to the 19 pages of the patent owner's February 5, 2009 response and applicable accompanying declaration portions that exceed the 50-page limit.

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

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



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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,124	11/24/2008	6452863	896.002.863	5356

22852 7590 05/13/2009

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 05/13/2009

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,250	06/28/2007	6452863	38512.8	4189

22852 7590 05/13/2009

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP
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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 05/13/2009

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DALLAS, TX 75219

Date:

MAILED

MAY 13 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000250
PATENT NO. : 6452863
TECHNOLOGY CENTER : 3999
ART UNIT : 3900

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

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

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

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

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Date:

MAILED

MAY 13 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001124
PATENT NO. : 6452863
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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(For Patent Owner)

MAILED

MAY 13 2009

CENTRAL REEXAMINATION UNIT

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(For Third Party
(Requester)

Tracy W Druce
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(For Third Party
Requester)

DECISION
GRANTING-IN-PART
PETITION FOR EXTENSION
OF TIME
[37 CFR § 1.956 and § 1.181]

In re: Farmwald *et alia*
Inter Partes Reexamination Proceeding
Control No. 95/000,250
Deposited on: 28 June 2007
For: US Patent No. 6,452,863

In re: Farmwald *et alia*
Inter Partes Reexamination Proceeding
Control No. 95/001,124
Deposited on: 24 November 2008
For: US Patent No. 6,452,863

This is a decision on the 23April 2009, "Patent Owner's Petition for Extension of Time Pursuant to 37 CFR 1.956" requesting that the time for responding to the Action Closing

Prosecution mailed 20 March 2009, be extended by forty-five (45) days. The petition was timely filed.

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

The petition is granted-in-part for the reasons set forth below.

Statement of Relevant Facts

1. On 17 September 2002 US patent No. 6,452,863 was granted to Farmwald *et alia.*

2. On 28 June 2007 a request for reexamination was deposited by a third party requester for *Inter Partes* Reexamination with the Office identified by control number 95/000,250.

3. On 5 September 2007 an Order Granting Request for *Inter Partes* Reexamination 95/000,250 was mailed.

4. On 24 November 2008 a request for reexamination was deposited by a third party requester for *Inter Partes* Reexamination with the Office identified by control number 95/001,124.

5. On 16 January 2009 an Order Granting Request for *Inter Partes* Reexamination 95/001,124 was mailed.

6. On 06 March 2009 a decision *sua sponte* was mailed merging proceedings 95/000,250 and 95/001,124.

7. On 20 March 2009 a non-final Office action was mailed was mailed in the abovementioned proceedings.

8. On 23 April 2009 the instant petition for a forty-five (45) day extension of time was submitted by the patent owner's representative.

Discussion

The Patent Owner's representative requests the period of time be extended in which to file a response to the non-final Office action mailed 20 March 2009, which set a two (2) months time for filing a response thereto. The petition for extension of time was timely filed on 23 April 2009, together with electronic fee transmittal for the $200.00 petition fee as required by 37 CFR § 1.956 and 37 CFR § 1.17 (g). A certificate of service was provided with the petition.

The request is granted-in-part

37 CFR § 1.956. Patent owner extensions of time in inter partes reexamination.

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

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

> As noted above, a request for extension of time under 37 CFR § 1.956 will be granted only for sufficient cause, ...
>
> Evaluation of whether "sufficient cause" has been shown for an extension must be made by **balancing** the desire to provide the patent owner with a fair opportunity to respond, **against** the requirement of the statute, 35 U.S.C. § 314(c), that the proceedings be conducted with special dispatch. ...

Any petition request must include the required petition fee as set forth according to 37 CFR § 1.17 (g) and 37 CFR § 1.956.

MPEP § 2665 Extension of Time for Patent Owner Response (in-part)

> Requests for an extension of time in an inter partes reexamination proceeding will be considered only after the first Office action on the merits in the reexamination is mailed. Any request for an extension of time filed prior to the first action will be denied.
>
> The certificate of mailing and the certificate of transmission procedures (37 CFR § 1.8), and the "Express Mail" mailing procedure (37 CFR § 1.10), may be used to file a request for extension of time, as well as any other paper in an existing *inter partes* reexamination proceeding (see MPEP § 2666).
>
> ...
>
> Evaluation of whether "sufficient cause" has been shown for an extension must be made by balancing the desire to provide the patent owner with a fair opportunity to respond, against the requirement of the statute, 35 U.S.C. § 314(c), that the proceedings be conducted with special dispatch.

Decision

The patent owner's representative petitions under 37 CFR § 1.956 to extend the period for response by adding forty-five (45) days to the period for response. The decision to extend the period for response is evaluated based upon a showing of "sufficient cause." There is always

the consideration to balance the need for the patent owner to have a fair opportunity to respond to the Office action between the need for special dispatch.

The non-final Office action was mailed 20 March 2009. The patent owner submitted a timely filed the petition on 23 April 2009 with the appropriate fee and certificate of service.

The petition dated 23 April 2009 cites the complexity of the lengthy Office action with its many rejections as well as the number of concurrently handled proceedings by the patent owner. The requester further states that they have contacted a technical expert and are assessing the need for a declaration. While concurrent proceedings are generally no considered to rise to the level of sufficient cause, on balance, the petitioner has demonstrated "sufficient cause" to grant a one (1) month extension of time based upon the length, complexity of the Office action and consideration of a declaration.

The petition request to extend the response time by one (1) month is hereby granted-in-part

CONCLUSION

1. The patent owner's petition for extension for one (1) month time in which to file a response to the non-final Office action dated 20 March 2009 is hereby **granted-in-part.**

2. The period for response is extended by one (1) month.

3. The Patent Owner's response is due **20 June 2009.**

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

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

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

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

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

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

/Mark Reinhart/
for

Gregory Morse,
Director,
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,250	06/28/2007	6452863	38512.8	4189

22852 7590 03/06/2009

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/06/2009

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

Copied from 95000250 on 07/26/2010

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.
95/001,124	11/24/2008	6452863	896.002.863	5356

69090 7590 03/06/2009

RAMBUS, INC.
C/O Ann Williams
4440 EL CAMINO REAL
LOS ALTOS, CA 94022

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/06/2009

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

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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

DAVID L. MCCOMBS
HAYNES AND BOONE LLP
901 MAIN STREET, SUITE 3100
DALLAS, TX 75202

Date:

MAILED

MAR 0 6 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000250
PATENT NO. : 6452863
TECHNOLOGY CENTER : 3999
ART UNIT : 3900

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

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

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

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

PTOL-2070(Rev.07-04)

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MAR 0 6 2009

CENTRAL REEXAMINATION UNIT

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

NOVAK DRUCE & QUIGG LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET, 53RD FLOOR
HOUSTON, TX 77002

Date:

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001124
PATENT NO. : 6452863
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

PTOL-2070(Rev.07-04)

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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

RAMBUS, INC.
C/O ANN WILLIAMS
4440 EL CAMINO REAL
LOS ALTOS, CA 94022

(For Patent Owner)

MAILED

MAR 0 6 2009

CENTRAL REEXAMINATION UNIT

DAVID L. MCCOMBS, ESQ.
HAYNES AND BOONE, LLP
901 MAIN STREET, SUITE 3100
DALLAS, TX 75202-3789

(For 95/000,250 Requester)

TRACY W. DRUCE
NOVAK DRUCE & QUIGG, LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET 53rd FLOOR
HOUSTON, TX 77002

(For 95/001,124 Requester)

NAVEEN MODI
FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

(Courtesy Copy)

In re Farmwald et al.
Inter partes Reexamination Proceeding
Control No.: 95/000,250
Filed: June 28, 2007
For: U.S. Patent No. 6,452,863

In re Farmwald et al.
Inter partes Reexamination Proceeding
Control No. 95/001,124
Filed: November 24, 2008
For: U.S. Patent No. 6,452,863

DECISION, *SUA SPONTE*, TO MERGE REEXAMINATION PROCEEDINGS

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

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REVIEW OF RELEVANT FACTS

1. U. S. Patent Number 6,452,863 (the '863 patent) issued to Farmwald et al. on September 17, 2002, with 35 claims.

2. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/000,250 ('250 proceeding), was initially deposited by third party requester on April 4, 2007, and received a filing date of June 28, 2007. Samsung Electronics, Co. Ltd. is identified as the real party in interest.

3. An order granting reexamination of claims 1-35 of the '863 patent was mailed for the '250 reexamination proceeding on September 5, 2007.

4. An Office action containing at least one rejection of each of claims 1-35 of the '863 patent was mailed for the '250 reexamination proceeding on July 3, 2008.

5. Patent owner filed a timely response on September 5, 2008, retaining original patent claims 1-35 as unamended.

6. Third party requester filed timely comments on October 3, 2008, pursuant to 37 CFR 1.947.

7. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/001,124 ('1124 proceeding), was filed November 24, 2008, by third party requester Micron Technology, Inc.

8. An order granting reexamination of claims 14-16 of the '863 patent was mailed for the '1124 reexamination proceeding on January 16, 2009.

9. No Office action has been mailed, and no amendments to the claims have been made, in the '1124 *inter partes* reexamination proceeding.

DECISION

I. MERGER OF PROCEEDINGS

Under 37 CFR 1.989(a):

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

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As evidenced by the above review of facts, both the '250 and the '1124 reexamination proceedings are currently pending. The order to reexamine has been mailed for both reexamination proceedings, and a decision under 37 CFR 1.989(a) is timely.

The general policy of the Office is that two reexamination proceedings will not be conducted separately, and at the same time, as to a particular patent. The rationale for this policy is (1) to prevent inconsistent, and possibly conflicting, amendments from being introduced into the two proceedings on behalf of the patent owner, (2) to provide a comprehensive examination of the patent based on the issues raised in both of the proceedings, and (3) to expedite the prosecution of both proceedings. In the present instance, merger of the 95/000,250 and 95/001,124 reexamination proceedings would address these considerations. Thus, pursuant to 37 CFR 1.989(a), the 95/000,250 and 95/001,124 reexamination proceedings are hereby merged. The merged proceeding will be conducted in accordance with the guidelines and requirements which follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

The claims are identical in both proceedings. The patent owner is required to continue to maintain the same claims (and specification) in both files *throughout the merged proceeding*.

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

The present decision merges an *inter partes* reexamination proceeding with another *inter partes* reexamination proceeding. Pursuant to 37 CFR 1.989(b), the merged proceeding is governed by 37 CFR 1.902 through 1.997.

B. Papers mailed/filed:

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

All papers that are filed by the patent owner and the third party requesters should be directed:

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

By Mail to: Mail Stop *Inter Partes* Reexam
Attn: Central Reexamination Unit
Commissioner for Patents

Copied from 95000250 on 07/26/2010

United States Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

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

By hand (or delivery service):

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

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

The patent owner and the requesters are reminded that every paper filed in the merged proceeding subsequent to this Decision must be served on the other parties, including papers filed *via* facsimile transmission.

C. Amendments:

The filing of any amendments to the specification, claims, and drawings must comply with the provisions of 37 CFR 1.530 and the guidelines of MPEP § 2666. 37 CFR 1.121 does not apply to amendments in a reexamination proceeding. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via markings pursuant to 37 CFR 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

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

D. Fees:

Where a paper is filed which requires payment of a fee (e.g., extension of time fee, excess claims fee, petition fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For

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example, only one fee need be paid for patent owner's appellant brief (or that of one of the *inter partes* reexamination requesters), even though the brief relates to merged multiple proceedings and even though copies must be filed (as pointed out above) for each file in the merged proceeding.

E. Citation of Patents and Printed Publications:

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

PATENT OWNER'S ADDRESS

The patent owner is called upon to coordinate the proper correspondence addresses in (1) the patent, (2) the '250 proceeding and (3) the '1124 proceeding. Different patent owner counsel and addresses are of record for the two reexamination proceedings. The current correspondence address of record for the patent file is the proper patent owner address for reexamination mailings pursuant to 37 CFR 1.33(c), and it is that of RAMBUS, INC., c/o Ann Williams, 4440 El Camino Real, Los Altos, CA 94022. Accordingly, all future correspondence will be directed to RAMBUS, INC., c/o Ann Williams, 4440 El Camino Real, Los Altos, CA 94022, unless, within ONE (1) MONTH of this decision, patent owner changes the correspondence address of record in the patent (the same should be done for the reexamination proceedings).

It is further noted that different attorneys are of record for the two reexamination proceedings. In order to permit filing of patent owner papers in the now merged proceeding by one attorney alone, the two proceedings must given a single attorney of record, with appointment being made as appropriate. Patent owner is provided with ONE (1) MONTH from the mailing of this decision to do so. If there is a newly designated attorney, patent owner must supply the designated attorney with the requisite power of attorney in the appropriate files (the patent file and both reexamination proceedings).

As a courtesy, this decision is being mailed to both addresses. However, as pointed out above, the address of RAMBUS, INC., c/o Ann Williams, 4440 El Camino Real, Los Altos, CA 94022, will be used in future correspondence, unless the address of record is changed as set forth above.

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/000,250 and *inter partes* Reexamination Control No. 95/001,124 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

2. Patent owner is provided with ONE (1) MONTH from the mailing of this decision to file papers to address the correspondence address and attorney of record considerations in both proceedings, as set forth in the last section of this decision.

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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

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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.
95/001,125	11/26/2008	7334846	2202214.121US4	8734

24395 7590 05/07/2010

WILMERHALE/DC
1875 PENNSYLVANIA AVE., NW
WASHINGTON, DC 20006

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 05/07/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Kevin P. Moran
MICHAEL BEST & FRIEDRICH LLP
100 East Wisconsin Ave.
Milwaukee, WI 53202

Date:

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001125
PATENT NO. : 7334846
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

In re Application of 7334846
Appl. No.: 95/001,125
Filed: November 26, 2008
For: Bicycle Wheel Rim

DECISION ON PETITION UNDER 37 CFR 1.59

This is a decision on the petition under 37 CFR 1.59(b), filed April 12, 2010, to expunge information from the above identified application.

The petition is dismissed.

Petitioner requests that documents submitted April 12, 2010 in a box under seal, which material is subject to a protective order, be expunged from the record.

"Materiality" is defined as any information which the examiner considers as being important to a determination of patentability of the claims. The final decision as to whether or not any portion or all of the information submitted is "material to patentability" will be made prior to the mailing of the Notice of Intent to Issue *Inter Partes* Reexamination Certificate (NIRC).

The petition is deficient for the reasons listed below.

1. The petition does not clearly identify the information requested to be expunged. It merely refers to "contents within the attached container". The material that is subject to a protective order that is to be expunged must be clearly identified without disclosing the contents thereof.

2. The petition does not contain a commitment on the part of petitioner to retain the information to be expunged for the period of any patent with regard to which such information is submitted.

3. The petition does not contain a statement that the petition is being submitted by, or on behalf of, the party in interest who originally submitted this information.

A renewed petition to expunge the material that is subject to the protective order should be promptly submitted. If a renewed petition to expunge is not filed in time to be addressed before the reexamination certificate printing process (i.e., after the mailing of the NIRC), or the petition

is dismissed/denied, the materials submitted under MPEP § 724.02 will be released to the public with any other papers in the reexamination file.

Any questions regarding this decision should be directed to the undersigned at telephone number (571) 272-4361.

Andres Kashnikow,
SPE, CRU 3993

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.
95/001,127	12/09/2008	7205544	AAQUI.0147	2411

8156 7590 07/08/2009

JOHN P. O'BANION
O'BANION & RITCHEY LLP
400 CAPITOL MALL SUITE 1550
SACRAMENTO, CA 95814

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 07/08/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/001,127	12/09/08	7205544	AAQUI.0147

EXAMINER
GAGLIARDI, ALBERT J.

ART UNIT	PAPER
3992	

CARSTENS & CAHOON, LLP
P O BOX 802334
DALLAS, TX 75380

DATE MAILED:

MAILED

JUL 08 2009

CENTRAL REEXAMINATION UNIT

INTER PARTES REEXAMINATION COMMUNICATION

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

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

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

JOHN P. O'BANION
O'BANION & RITCHEY LLP
400 CAPITOL MALL SUITE 1550
SACRAMENTO CA 95814

(For Patent Owner)

MAILED

JUL 08 2009

CENTRAL REEXAMINATION UNIT

Zachary Hilton
CARSTENS & CAHOON, LLP
P O BOX 802334
DALLAS, TX 75380

(For Third Party Requester)

DECISION DISMISSING
PETITION FOR
REVIEW DENIAL TO
GRANT REEXAMINATION
[37 CFR §§ 1.927 & 1.181]

In re: Jerrold T. Bushberg
Ex Parte Reexamination Proceeding
Control No. 95/001,127
Deposited: 09 December 2008
For: US Patent No. 7,205,544

This is a decision on the 20 March 2009, "Petition to Review Refusal to Grant *Inter Partes* Reexamination of Claims 19-35 and 37-42 of US Patent No. 7,205,544" The petition seeks *de novo* review from the group director of denial to Order reexamination of claims 19-35 and 37-42.

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

The petition is dismissed for the reasons set forth below.

SUMMARY OF RELEVANT FACTS

1. On 17 April 2007 US Patent No. 7,205,544 was granted.

2. On 09 December 2008 a third party requester, requested *inter partes* reexamination of US Patent No. 7,205,544 claims 1 to 42.

3. On 20 February 2009 the Order granting request for *inter partes* reexamination was mailed granting reexamination of claims 1 to 18 and 37 to 42.

4. On 20 March 2009 the instant petition was received seeking *de novo* review of the requested claims.

5. On 17 June 2009 the patent owner submitted opposition to the third party requester's petition noting that the requester's petition was filed without service on the patent owner.

DECISION

The requester seeks *de novo* review pursuant to 37 CFR 1.927 of some the claims for which request for reexamination was denied. The third party request submitted 09 December 2009 sought *inter partes* reexamination of claims 1 to 42. The examiner Ordered reexamination of claims 1 to 18 and 37 to 42. The requester seeks review of claims 19 to 35 and 37 to 42. The requester has not sought review of claim 36. It is noted that the petition was submitted with the appropriate fee by deposit account. It is further noted that there is no certificate of service of the papers on the patent owner as is required pursuant to 37 CFR § 1.903.

The petition is herby dismissed.

CITATION OF RELEVANT AUTHORITY

37 CFR § 1.927 Petition to review refusal to order *inter partes* reexamination.

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

MPEP § 2620 Certificate of Service

> The third party requester must serve the owner of the patent with a copy of the request in its entirety. See 37 CFR § 1.915(b)(6). The service must be made on the patent owner's correspondence address in the patent file as indicated in 37 CFR § 1.33(c). The name and address of the person served and the certificate of service should be indicated on the request. See also MPEP § 2666.06 regarding service on the requester and patent owner.

It is required that third party requester set forth the name and address of the party served and the mode method of service on the certificate of service attached to the request. Further, the requester must include a copy of the certificate of service with the copy of the request served on the patent owner. If service was not possible after a reasonable effort to do so, a duplicate copy of the request papers must be supplied to the Office together with a **cover letter** including an explanation of what effort was made to effect service, and why that effort was not successful. To avoid the possibility of the Office erroneously charging a duplicate filing fee, requesters are strongly encouraged to clearly word the cover letter by stating, for example, in bold print in the heading "**Duplicate Copy of Request Filed under 37 CFR 1.915(b)(6)When Service on the Patent Owner Was Not Possible.**"

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. (emphasis added)

ANALYSIS AND FINDINGS

The petition submitted by the third party requester dated 20 March 2009 does not reflect the required service on the Patent Owner. Since this is a requirement pursuant to 37 CFR § 1.903, the petition is hereby dismissed.

CONCLUSION

1. The third party requester's petition for review of refusal to grant *inter partes* reexamination under 37 CFR § 1.927 is hereby **dismissed.**

2. The proceeding is hereby returned to the examiner in charge of the proceeding for the issuance of an action.

3. Future correspondence from either party 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

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, alternatively where 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

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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JUL 2 1 2009

CENTRAL REEXAMINATION UNIT

Ann Williams (For Patent Owner)
Rambus, Inc.
4440 El Camino Real
Los Altos, CA 94022

David M. O'Dell, Esq. (For 95/001,026 Requester)
Haynes and Boone, LLP
IP Section
2323 Victory Avenue, Suite 700
Dallas, TX 75219

Tracy W. Druce (For 95/001,128 Requester)
Novak, Druce, and Quigg, LLP
1000 Louisiana Ave.
53rd Floor
Houston, TX 77002

Finnegan, Henderson, Farabow, (Courtesy Copy - Patent Owner)
Garrett & Dunner, L.L.P.
901 New York Avenue, NW
Washington, DC 20001-4413

In re Farmwald et al.
Inter partes Reexamination Proceeding
Control No. 95/001,026
Filed: January 31, 2008
For: U.S. Patent No. 6,378,020

In re Farmwald et al.
Inter partes Reexamination Proceeding
Control No. 95/001,128
Filed: December 15, 2008
For: U.S. Patent No. 6,378,020

DECISION, *SUA SPONTE*,
TO MERGE REEXAMINATION
PROCEEDINGS

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

REVIEW OF FACTS

1. United States Patent Number 6,378,020 (the '020 patent) issued to Farmwald et al. on April 23, 2002, with 41 claims.

2. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/001,026 ('1026), was initially deposited by third party requester, identifying Samsung Electronics Co., Ltd. as the real party in interest, on January 24, 2008 and received a filing date of January 31, 2008.

3. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/001,128 ('1128), was initially deposited by third party requester Micron Technology on December 15, 2008 and received a filing date of December 15, 2008.

4. An order granting reexamination of claims 30-33, 35-36, and 38-41 of the '020 patent was mailed for the '1026 reexamination proceeding on April 9, 2008.

5. An order granting reexamination of claims 30, 35, and 36 of the '020 patent was mailed for the '1128 reexamination proceeding on February 6, 2009.

6. No Office action has been mailed, and no amendments to the claims have been made, in either of the '1026 and the '1128 *inter partes* reexamination proceedings.

DECISION

I. MERGER OF PROCEEDINGS

Under 37 CFR 1.989(a):

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

As evidenced by the above review of facts, both the '1026 and the '1128 reexamination proceedings are currently pending. The order to reexamine has been mailed for both reexamination proceedings, and a decision under 37 CFR 1.989(a) is timely.

The general policy of the Office is that two reexamination proceedings will not be conducted separately, and at the same time, as to a particular patent. The rationale for this policy is (1) to prevent inconsistent, and possibly conflicting, amendments from being introduced into the two proceedings on behalf of the patent owner, (2) to provide a comprehensive examination of the patent based on the issues raised in both of the proceedings, and (3) to expedite the prosecution of

both proceedings. In the present instance, where there is overlap in the claims subject to reexamination in the two proceedings, merger of the 95/001,026 and 95/001,128 reexamination proceedings would address these considerations. Thus, pursuant to 37 CFR 1.989(a), the 95/001,026 and 95/001,128 reexamination proceedings are hereby merged. The merged proceeding will be conducted in accordance with the guidelines and requirements which follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

The claims are identical in both proceedings. The patent owner is required to continue to maintain the same claims (and specification) in both files *throughout the merged proceeding.*

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

The present decision merges an *inter partes* reexamination proceeding with another *inter partes* reexamination proceeding. Pursuant to 37 CFR 1.989(b), the merged proceeding is governed by 37 CFR 1.902 through 1.997.

B. Papers mailed/filed:

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

All papers that are filed by the patent owner and the third party requesters should be directed:

By U.S. Postal Service Mail:

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

By FAX to:

(571) 273-9900
Central Reexamination Unit

By hand (or delivery service):

Customer Service Window
Attn: Central Reexamination Unit
Randolph Building
401 Dulaney St.
Alexandria, VA 22314

The patent owner and the requesters are reminded that every paper filed in the merged proceeding subsequent to this Decision must be served on the other parties, including papers filed *via* facsimile transmission.

C. Amendments:

The filing of any amendments to the specification, claims, and drawings must comply with the provisions of 37 CFR 1.530 and the guidelines of MPEP § 2666. 37 CFR 1.121 does not apply to amendments in a reexamination proceeding. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via markings pursuant to 37 CFR 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

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

D. Fees:

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

E. Citation of Patents and Printed Publications:

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

PATENT OWNER'S ADDRESS

The current correspondence address of record for the patent file is the proper patent owner address for reexamination mailings pursuant to 37 CFR 1.33(c), and it is that of Ann Williams, Rambus, Inc., 4440 El Camino Real, Los Altos, CA 94022.

A change of correspondence address was filed in each of the reexamination proceedings designating the Finnegan Henderson address noted above for all future correspondence to patent owner. As a courtesy, this decision is being mailed to both patent owner addresses.

The address of Ann Williams, Rambus, Inc., 4440 El Camino Real, Los Altos, CA 94022, will be the sole address for patent owner used in future correspondence, until a change in correspondence address in the patent and the reexamination is made in accordance with 37 CFR 1.33(c).

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/001,026 and *inter partes* Reexamination Control No. 95/001,128 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

2. Jurisdiction over the merged reexamination is being forwarded via the Central Reexamination Unit Director to the examiner for the preparation of an Office action, to be issued in due course for the merged proceeding.

3. Any questions concerning this communication should be directed to Pinchus M. Laufer, Legal Advisor at (571)272-7726.

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

July 10, 2009
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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.
95/001,129	12/19/2008	7340506	PA5039REX	9225

22830 7590 04/30/2010

CARR & FERRELL LLP
2200 GENG ROAD
PALO ALTO, CA 94303

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/30/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
ONE WORLD TRADE CENTER
121 S.W. SALMON STREET
PORTLAND, OR 97204

Date:

MAILED

APR 30 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001129
PATENT NO. : 7340506
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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CARR & FERRELL LLP
2200 GENG ROAD
PALO ALTO CA 94303

(For Patent Owner)

MAILED

APR 30 2010

CENTRAL REEXAMINATION UNIT

Klarquist Sparkman, LLP
One World Trade Center, Suite 1600
121 S.W. Salmon Street
Portland, OR 97204

(For Requester)

In re Application of 7340506
Appl. No.: 95/001,129
Filed: December 19, 2008
For: **VALUE-ADDED NETWORK SWITCHING AND OBJECT ROUTING**

DECISION ON PETITION UNDER 37 CFR 1.59

This is a decision on the petition under 37 CFR 1.59(b), filed June 1, 2009, to expunge information from the above identified application.

The petition is **dismissed**.

Petitioner requests that various documents entitled Cyberman Business Plan, filed June 1, 2009, be expunged from the record.

MPEP 724.03 states:
The types of materials or information contemplated for submission under MPEP §724.02 include information "material to patentability" but does not include information favorable to patentability. Thus, any trade secret, proprietary, and/or protective order materials which are required to be submitted on behalf of a patent applicant under 37 CFR 1.56 or patent owner under 37 CFR 1.555 can be submitted in accordance with MPEP § 724.02. Neither 37 CFR 1.56 nor 1.555 require the disclosure of information favorable to patentability, e.g., evidence of commercial success of the invention (see 42 Fed. Reg. 5590). Such information should not be submitted in accordance with MPEP § 724.02. If any trade secret, proprietary, and/or protective order materials are submitted in amendments, arguments in favor of patentability, or affidavits under 37 CFR 1.131 or 1.132, they will be made of record in the file and will not be given any special status.

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

The petition is deficient because:

1) The information has been made public. The same information was submitted to the office by Patent Owner's new counsel as part of their public response of March 25, 2010.

2) The petition does not contain a commitment on the part of petitioner to retain the information to be expunged for the life of any patent with regard to which such information has been submitted.

3) The petition does not contain a statement that the petition is being submitted by, or on behalf of, the party in interest who originally submitted the information.

4) The information was submitted by patent owner as allegedly favorable to patentability.

Accordingly the petition of June 1, 2009 is **dismissed** and the material will be made of record.

Eric Keasel

ERIC S. KEASEL
CRU SPE-AU 3992

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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MAR 09 2009

CENTRAL REEXAMINATION UNIT

Neil A. Steinberg (For Patent Owner)
Rambus, Inc.
2465 Latham Street
Mountain View, CA 94040

David M. O'Dell, Esq. (For 95/001,106 Requester)
Haynes and Boone, LLP
IP Section
2323 Victory Avenue, Suite 700
Dallas, TX 75219

Tracy W. Druce (For 95/001,131 Requester)
Novak, Druce, and Quigg, LLP
1000 Louisiana Ave.
53rd Floor
Houston, TX 77002

Ann Williams (Courtesy Copy - Patent Owner)
Rambus, Inc.
4440 El Camino Real
Los Altos, CA 94022

In re Farmwald et al.
Inter partes Reexamination Proceeding
Control No. 95/001,106
Filed: November 6, 2008
For: U.S. Patent No. 6,266,285

In re Farmwald et al.
Inter partes Reexamination Proceeding
Control No. 95/001,131
Filed: December 31, 2008
For: U.S. Patent No. 6,266,285

: DECISION, *SUA SPONTE*,
: TO MERGE REEXAMINATION
: PROCEEDINGS

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

REVIEW OF FACTS

1. United States Patent Number 6,266,285 (the '285 patent) issued to Farmwald et al. on July 24, 2001, with 33 claims.

2. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/001,106 ('1106), was filed by third party requester Samsung Electronics Co., Ltd. on November 6, 2008.

3. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/001,131 ('1131), was ifiled by third party requester Micron Technology on December 31, 2008.

4. An order granting reexamination of claims 13, 15, and 16 of the '285 patent was mailed for the '1106 reexamination proceeding on January 9, 2009.

5. An order granting reexamination of claims 13, 15, and 16 of the '285 patent was mailed for the '1131 reexamination proceeding on January 22, 2009.

DECISION

I. MERGER OF PROCEEDINGS

Under 37 CFR 1.989(a):

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

As evidenced by the above review of facts, both the '1106 and the '1131 reexamination proceedings are currently pending. An order granting reexamination, limited to claims 13, 15, and 16 of the '285 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 95/001,106 and 95/001,131 reexamination proceedings would address these considerations. Thus, pursuant to 37 CFR 1.989(a), the 95/001,106 and 95/001,131 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 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 requesters are reminded that every paper filed in the merged proceeding subsequent to this Decision must be served on the other parties, including papers filed *via* facsimile transmission.

C. Amendments:

The filing of any amendments to the specification, claims, and drawings must comply with the provisions of 37 CFR 1.530 and the guidelines of MPEP § 2666. 37 CFR 1.121 does not apply to amendments in a reexamination proceeding. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via markings pursuant to 37 CFR 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

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

D. Fees:

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

E. Citation of Patents and Printed Publications:

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

PATENT OWNER'S ADDRESS

The 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 Neil A. Steinberg, Rambus,

Inc., 2465 Latham Street, Mountain View, CA 94040. However, correspondence previously sent to this address in the '1106 and '1131 proceedings has been returned marked undeliverable.

The certificate of service for the 95/001,106 request rendered service upon Neal Steinberg at the patent owner address of record and additionally upon Ann Williams, Rambus, Inc., 4440 El Camino Real, Los Altos, CA 94022. The certificate of service for the 95/001,131 request designated the same mailing address. As a courtesy, this decision is being mailed to both addresses.

The address of Neil A. Steinberg, Rambus, Inc., 2465 Latham Street, Mountain View, CA 94040, will be the sole address used in future correspondence, until a change in correspondence address in the patent and the reexamination is made in accordance with 37 CFR 1.33(c).

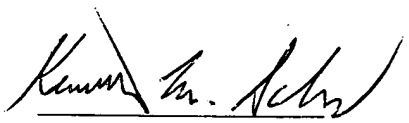
CONCLUSION

1. *Inter partes* Reexamination Control No. 95/001,106 and *inter partes* Reexamination Control No. 95/001,131 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

2. Patent owner is required to file an appropriate change of correspondence address of record in the patent (the same should be done for the reexamination proceedings), if the current address is not correct.

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.

4. Any questions concerning this communication should be directed to the Office of Patent Legal Administration, to Michael Cygan, at (571) 272-7700, or in his absence, to Pinchus M. Laufer, at (571)272-7726.



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

UNITED STATES PATENT AND TRADEMARK OFFICE

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Alexandria, VA 22313-1450
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MAILED

JUN 23 2010

CENTRAL REEXAMINATION UNIT

(For Patent Owner)

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

(For '1106 Requester)

HAYNES AND BOONE, LLP
IP SECTION
2323 VICTORY AVENUE
SUITE 700
DALLAS, TX 75219

(For '1131 Requester)

NOVAK DRUCE & QUIGG, LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET
FIFTY-THIRD FLOOR
HOUSTON, TX 77002

In re: Farmwald *et alia*
Reexamination Proceeding
Control No. 95/001,106
Request Deposited: November 6, 2008
For: U.S. Patent No. 6,266,285

In re: Farmwald *et alia*
Reexamination Proceeding
Control No. 95/001,131
Request Deposited: December 31, 2008
For: U.S. Patent No. 6,266,285

DECISION DISMISSING PETITION TO WITHDRAW ACP

The merged *inter partes* reexamination proceeding is before the Director of the Central Reexamination Unit to address the patent owner petition filed November 23, 2009 entitled "PETITION TO WITHDRAW THE ACTION CLOSING PROSECUTION OF OCTOBER 23, 2009" and a third-party paper filed December 23, 2009 entitled "RESPONSE TO RAMBUS'S PETITION TO WITHDRAW THE ACTION CLOSING PROSECUTION OF OCTOBER 23, 2009".

The patent owner petition is timely filed and considered pursuant to 37 CFR §1.181. 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.

BACKGROUND

After inter partes reexamination control numbers 95/001,106 (the '1106 proceeding) and 95/001,131 (the '1131 proceeding) were merged, a non-final office action was mailed on March 13, 2009. Patent Owner responded with arguments and no amendments to the claims on June 15, 2009. After both requesters filed comments, the office issued an Action Closing Prosecution (ACP) on October 23, 2009. On November 23, 2009, Patent Owner (PO) filed a petition to withdraw the ACP. On December 22, 2009, the '1106 Requester filed a paper entitled "RESPONSE TO RAMBUS'S PETITION TO WITHDRAW THE ACTION CLOSING PROSECUTION OF OCTOBER 23, 2009".

DECISION

Petitioner argues the merits of the rejections or characterizes points raised by the examiner in the response to arguments section of the ACP as new positions taken by the office.

Arguing the merits of a rejection is subject to appeal to the Board of Patent Appeals and Interferences and it thus not a petitionable issue. This decision takes no position as to the merits of any rejection.

Petitioner argues that the examiner has raised "new issues" by responding to some of the arguments presented by PO. Petitioner takes the position that answering arguments presented by the PO should be construed as the examiner not having fully developed the grounds of rejection. For example, petitioner argues that the examiner defines the term "memory device" for the first time on pages 18-21 of the ACP. However, the examiner fully developed the rejections of the claims in the non-final office action of March 13, 2009. The section referenced in the petition is a rebuttal of PO's arguments as to the claim rejections. The key point is that the examiner has not altered the grounds of rejection and has not given a new thrust to the rejections. The position taken in the response to arguments is consistent with the manner in which the examiner applied art against the claim term "memory device" in the non-final rejection. The examiner is simply

rebutting PO's argument that the references do not disclose a "memory device". Therefore, closing prosecution in the ACP was not done prematurely.

Therefore, the petition is **dismissed**.

Regarding the third-party paper filed December 22, 2009 entitled "RESPONSE TO RAMBUS'S PETITION TO WITHDRAW THE ACTION CLOSING PROSECUTION OF OCTOBER 23, 2009", 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 December 22, 2009 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 ACP be withdrawn. 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 from an action of an examiner. No mechanism has been provided for the third party requester to file a paper, such as the December 22, 2009 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 from an action of an examiner 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 to provide a limited reopening of prosecution. 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 withdraw the ACP 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 December 22, 2009 opposition to the patent owner's November 23, 2009 petition requesting entry of an amendment 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 for revival 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 withdraw the ACP is **dismissed**.

2. The December 22, 2009 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.

Gregory Morse
Director, Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,132	12/31/2008	6,314,051	896.002.051	1502

7590 03/06/2009

EXAMINER	

NEIL A. STEINBERG ESQ.
RAMBUS INC.
2465 LATHAM STREET
MOUNTAIN VIEW, CA 94040

ART UNIT	PAPER NUMBER

DATE MAILED: 03/06/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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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.
95/001,132	12/31/08	6,314,051	896.002.051

EXAMINER
ESCALANTE, OVIDIO

ANN WILLIAMS
RAMBUS, INC.
4440 EL CAMINO REAL
LOS ALTOS, CA 94022

ART UNIT	PAPER
3992	

DATE MAILED:

03/06/09

INTER PARTES REEXAMINATION COMMUNICATION

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/001,132	12/31/08	6,314,051	896.002.051

EXAMINER
ESCALANTE, OVIDIO

Tracy W. Druce
NOVAK, DRUCE AND QUIGG LLP
1000 LOUISIANA AVEUNE
53 rd FLOOR
HOUSTON, TX 77002

ART UNIT	PAPER
3992	

DATE MAILED:

03/06/09

INTER PARTES REEXAMINATION COMMUNICATION

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COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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Neil A. Steinberg (For Patent Owner)
Rambus, Inc.
2465 Latham Street
Mountain View, CA 94040

David M. O'Dell, Esq. (For 95/001,107 Requester)
Haynes and Boone, LLP
IP Section
2323 Victory Avenue, Suite 700
Dallas, TX 75219

Tracy W. Druce (For 95/001,132 Requester)
Novak, Druce, and Quigg, LLP
1000 Louisiana Ave.
53rd Floor
Houston, TX 77002

MAILED

MAR 06 2009

CENTRAL REEXAMINATION UNIT

Ann Williams (Courtesy Copy - Patent Owner)
Rambus, Inc.
4440 El Camino Real
Los Altos, CA 94022

In re Farmwald et al.
Inter partes Reexamination Proceeding
Control No. 95/001,107
Filed: November 7, 2008
For: U.S. Patent No. 6,314,051

In re Farmwald et al.
Inter partes Reexamination Proceeding
Control No. 95/001,132
Filed: December 31, 2008
For: U.S. Patent No. 6,314,051

DECISION, *SUA SPONTE*,
TO MERGE REEXAMINATION
PROCEEDINGS

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

REVIEW OF FACTS

1. United States Patent Number 6,314,051 (the '051 patent) issued to Farmwald et al. on November 6, 2001, with 43 claims.

2. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/001,107 ('1107), was filed by third party requester Samsung Electronics Co., Ltd. on November 7, 2008 and received a filing date of November 7, 2008.

3. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/001,132 ('1132), was filed by third party requester Micron Technology on December 31, 2008.

4. An order granting reexamination of claims 27, 34, and 43 of the '051 patent was mailed for the '1107 reexamination proceeding on January 9, 2009.

5. An order granting reexamination of claims 27, 34, and 43 of the '051 patent was mailed for the '1132 reexamination proceeding on January 22, 2009.

DECISION

I. MERGER OF PROCEEDINGS

Under 37 CFR 1.989(a):

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

As evidenced by the above review of facts, both the '1107 and the '1132 reexamination proceedings are currently pending. An order granting reexamination, limited to claims 27, 34, and 43 of the '051 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 95/001,107 and 95/001,132 reexamination proceedings would address these considerations. Thus, pursuant to 37 CFR 1.989(a), the 95/001,107 and 95/001,132 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 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 requesters are reminded that every paper filed in the merged proceeding subsequent to this Decision must be served on the other parties, including papers filed *via* facsimile transmission.

C. Amendments:

The filing of any amendments to the specification, claims, and drawings must comply with the provisions of 37 CFR 1.530 and the guidelines of MPEP § 2666. 37 CFR 1.121 does not apply to amendments in a reexamination proceeding. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via markings pursuant to 37 CFR 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

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

D. Fees:

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

E. Citation of Patents and Printed Publications:

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

PATENT OWNER'S ADDRESS

The 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 Neil A. Steinberg, Rambus, Inc., 2465 Latham Street, Mountain View, CA 94040. However, correspondence previously sent to this address in the '1107 and '1132 proceedings has been returned marked undeliverable.

The certificate of service for the 95/001,107 request rendered service upon Neal Steinberg at the patent owner address of record and additionally to Ann Williams, Rambus, Inc., 4440 El Camino Real, Los Altos, CA 94022, as the patent owner address. The certificate of service for the 95/001,132 request designated the same mailing address. As a courtesy, this decision is being mailed to both addresses.

The address of Neil A. Steinberg, Rambus, Inc., 2465 Latham Street, Mountain View, CA 94040, will be the sole address used in future correspondence, until a change in correspondence address in the patent and the reexamination is made in accordance with 37 CFR 1.33(c).

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/001,107 and *inter partes* Reexamination Control No. 95/001,132 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

2. Patent owner is required to file an appropriate change of correspondence address of record in the patent (the same should be done for the reexamination proceedings), if the current address is not correct.

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.

4. Any questions concerning this communication should be directed to the Office of Patent Legal Administration, to Michael Cygan, at (571) 272-7700, or in his absence, to Pinchus M. Laufer, at (571)272-7726.

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

March 3, 2008
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UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,132	12/31/2008	6,314,051	896.002.051	1502

22852 7590 11/12/2009

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

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 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.
95/001,132	12/31/08	6314051	896.002.051

TRACY W. DRUCE, ESQ.
NOVAK DRUCE & QUIGG, LLP
1000 LOUISIANA AVE, 53rd FLOOR
HOUSTON, TX 77002

EXAMINER
ESCALANTE, OVIDIO

ART UNIT	PAPER
3992	

DATE MAILED:

11/12/09

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

(For Patent Owner)

MAILED

NOV 12 2009

CENTRAL REEXAMINATION UNIT

David M O'Dell
HAYNES AND BOONE, LLP
IP SECTION
2323 VICTORY AVENUE
SUITE 700
DALLAS, TX 75219

(For Third Party Requester)

Tracy W Druce
NOVAK DRUCE & QUIGG, LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET
FIFTY-THIRD FLOOR
HOUSTON, TX 77002

(For Third Party Requester)

DECISION
DISMISSING
PETITION FOR EXTENSION
OF TIME
[37 CFR § 1.956 and § 1.181]

In re: Farmwald *et alia*
Inter Partes Reexamination Proceeding
Control No. 95/001,107
Deposited on: 07 November 2008
For: US Patent No. 6,314,051

In re: Farmwald *et alia*
Inter Partes Reexamination Proceeding
Control No. 95/001,132
Deposited on: 31 December 2008
For: US Patent No. 6,314,051

This is a decision on the 06 November 2009, "Patent Owner's Petition for Extension of Time Pursuant to 37 CFR 1.956" requesting that the time for responding to the Action Closing Prosecution mailed 23 October 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 action mailed 23 October 2009, which set a two (2) months time for filing a response thereto. The petition for extension of time was timely filed on 06 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 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.

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 action was mailed 23 October 2009. The patent owner submitted a timely filed the petition on 06 November 2009 with the appropriate fee and certificate of service.

The petition dated 06 November 2009 cites the length of the Office action as well as interpretation issues among multiple prior art rejections, the petitioner further notes a large number of co-pending proceedings. The possible need for declarations was also noted. The previously granted petition for extension of time recited essentially the same reasoning. On balance, the petitioner has not demonstrated "sufficient cause" to grant an extension of time.

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 Action Closing Prosecution dated 23 October 2009 is hereby **dismissed.**

2 The Patent Owner's response is due **23 November 2009.**

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

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

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

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

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

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

/Mark Reinhart/
for

Gregory Morse,
Director,
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,132	12/31/2008	6,314,051	896.002.051	1502

22852 7590 06/21/2010

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/21/2010

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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

MAILED

JUN 21 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NUMBER 95/001,132, 95/001,107

PATENT NUMBER 6,314,051.

TECHNOLOGY CENTER 3900.

ART UNIT 3992.

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

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

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

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

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

HAYNES AND BOONE, LLP
IP SECTION
2323 VICTORY AVENUE
SUITE 700
DALLAS TX 75219

MAILED

JUN 2 1 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NUMBER *95/001,107*, *95/001,132*

PATENT NUMBER *6,314,051*.

TECHNOLOGY CENTER *3900*.

ART UNIT *3992*.

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

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

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

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

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(For Patent Owner)

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MAILED

JUN 2 1 2010

CENTRAL REEXAMINATION UNIT

(For '1132 Requester)

NOVAK DRUCE & QUIGG, LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET
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HOUSTON, TX 77002

In re: Farmwald *et alia*
Reexamination Proceeding
Control No. 95/001,107
Request Deposited: November 7, 2008
For: U.S. Patent No. 6,314,051

In re: Farmwald *et alia*
Reexamination Proceeding
Control No. 95/001,132
Request Deposited: December 31, 2008
For: U.S. Patent No. 6,314,051

DECISION DISMISSING PETITION TO WITHDRAW ACP

The merged *inter partes* reexamination proceeding is before the Director of the Central Reexamination Unit to address the patent owner petition filed November 23, 2009 entitled "PETITION TO WITHDRAW THE ACTION CLOSING PROSECUTION OF OCTOBER 23, 2009" and a third-party paper filed December 22, 2009 entitled "THIRD PARTY REQUESTER'S OPPOSITION TO PATENT OWNER'S PETITION TO WITHDRAW THE ACTION CLOSING PROSECUTION OF OCTOBER 23, 2009".

The patent owner petition is timely filed and considered pursuant to 37 CFR §1.181. 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.

BACKGROUND

After inter partes reexamination control numbers 95/001,107 (the '1107 proceeding) and 95/001,132 (the '1132 proceeding) were merged, a non-final office action was mailed on March 13, 2009. Patent Owner responded with arguments and no amendments to the claims on June 15, 2009. After both requesters filed comments, the office issued an Action Closing Prosecution (ACP) on October 23, 2009. On November 23, 2009, Patent Owner (PO) filed a petition to withdraw the ACP. On December 22, 2009, the '1132 Requester filed a paper entitled "THIRD PARTY REQUESTER'S OPPOSITION TO PATENT OWNER'S PETITION TO WITHDRAW THE ACTION CLOSING PROSECUTION OF OCTOBER 23, 2009".

DECISION

Petitioner either argues the merits of the rejections or characterizes points raised by the examiner in the response to arguments section of the ACP as new positions taken by the office.

Arguing the merits of a rejection is subject to appeal to the Board of Patent Appeals and Interferences and it thus not a petitionable issue. This decision takes no position as to the merits of any rejection.

Petitioner argues that the examiner has raised "new issues" by responding to some of the arguments presented by PO. Petitioner takes the position that answering arguments presented by the PO should be construed as the examiner not having fully developed the grounds of rejection. For example, petitioner argues that the examiner defines the term "memory device" for the first time on pages 18-21 of the ACP. However, the examiner fully developed the rejections of the claims in the non-final office action of March 13, 2009. The section referenced in the petition is a rebuttal of PO's arguments as to the claim rejections. The key point is that the examiner has not altered the grounds of rejection and has not given a new thrust to the rejections. The position taken in the response to arguments is consistent with the manner in which the examiner applied art against the claim term "memory device" in the non-final rejection. The examiner is simply

rebutting PO's argument that the references do not disclose a "memory device". Therefore, closing prosecution in the ACP was not done prematurely.

Therefore, the petition is **dismissed**.

Regarding the third-party paper filed December 22, 2009 entitled "THIRD PARTY REQUESTER'S OPPOSITION TO PATENT OWNER'S RENEWED PETITION UNDER 37 CFR §1.181 REQUESTING ENTRY OF AMENDMENT", 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 December 22, 2009 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 ACP be withdrawn. 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 from an action of an examiner. No mechanism has been provided for the third party requester to file a paper, such as the December 22, 2009 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 from an action of an examiner 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 to provide a limited reopening of prosecution. 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 withdraw the ACP 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 December 22, 2009 opposition to the patent owner's November 23, 2009 petition requesting entry of an amendment 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 for revival 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 withdraw the ACP is **dismissed**.

2. The December 22, 2009 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.

Gregory Morse
Director, Central Reexamination Unit

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CENTRAL REEXAMINATION UNIT

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In re Farmwald et al.	
Inter partes Reexamination Proceeding	
Control No. 95/001,105	
Filed: November 6, 2008	DECISION, *SUA SPONTE*,
For: U.S. Patent No. 6,751,696	TO MERGE REEXAMINATION
	PROCEEDINGS
In re Farmwald et al.	
Inter partes Reexamination Proceeding	
Control No. 95/001,133	
Filed: December 31, 2008	
For: U.S. Patent No. 6,751,696	

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 6,751,696 (the '696 patent) issued to Farmwald et al. on June 15, 2004, with 60 claims.

2. A request for *inter partes* reexamination of the '696 patent, assigned Reexamination Control No. 95/001,105 ('1105), was filed by third party requester Samsung Electronics Co., Ltd. on November 6, 2008.

3. A request for *inter partes* reexamination of the '696 patent, assigned Reexamination Control No. 95/001,133 ('1133), was filed by third party requester Micron Technology on December 31, 2008.

4. An order granting reexamination of claims 1 and 4 of the '696 patent was mailed for the '1105 reexamination proceeding on January 9, 2009.

5. An order granting reexamination of claims 1 and 4 of the '696 patent was mailed for the '1133 reexamination proceeding on January 22, 2009.

DECISION

I. MERGER OF PROCEEDINGS

Under 37 CFR 1.989(a):

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

As evidenced by the above review of facts, both the '1105 and the '1133 reexamination proceedings are currently pending. An order granting reexamination, limited to claims 1 and 4 of the '696 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 95/001,105 and 95/001,133 reexamination proceedings would address these considerations. Thus, pursuant to 37 CFR 1.989(a), the 95/001,105 and 95/001,133 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 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 requesters are reminded that every paper filed in the merged proceeding subsequent to this Decision must be served on the other parties, including papers filed *via* facsimile transmission.

C. Amendments:

The filing of any amendments to the specification, claims, and drawings must comply with the provisions of 37 CFR 1.530 and the guidelines of MPEP § 2666. 37 CFR 1.121 does not apply to amendments in a reexamination proceeding. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via markings pursuant to 37 CFR 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

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

D. Fees:

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

E. Citation of Patents and Printed Publications:

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

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/001,105 and *inter partes* Reexamination Control No. 95/001,133 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 Michael Cygan, at (571) 272-7700, or in his absence, to Pinchus M. Laufer, at (571)272-7726.

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

March 3, 2008
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CENTRAL REEXAMINATION UNIT

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(For Third Party Requester)

In re Farmwald et al.
Inter Partes Reexamination Proceeding
Control No. 95/001,105
Filed: November 6, 2008
For U.S. Patent Number 6,751,696 B2

In re Farmwald et al.
Inter Partes Reexamination Proceeding
Control No. 95/001,133
Filed: December 31, 2008
For U.S. Patent Number 6,751,696 B2

DECISION DISMISSING PATENT OWNER'S PETITION TO WAIVE THE PAGE LIMIT FOR ITS APPELLANTS' BRIEF, AND DISMISSING PETITIONS TO WAIVE THE PAGE LIMITS FOR RESPONDENT'S BRIEFS

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

(1) Petition filed March 16, 2010 by patent owner entitled "EXPEDITED PETITION SEEKING WAIVER OF 37 CFR § 1.943."

(2) Petition filed March 29, 2010 by patent owner entitled "SECOND PETITION SEEKING WAIVER OF 37 CFR § 1.943."

(3) Petition filed April 28, 2010, by third party requester entitled "THIRD PARTY REQUESTER'S PETITION UNDER 37 C.F.R. § 1.183 FOR LIMITED WAIVER OF 37 C.F.R. § 1.943(C)."

(4) Petition filed April 29, 2010 by patent owner entitled "PETITION SEEKING WAIVER OF 37 C.F.R. § 1.943 FOR PATENT OWNER'S RESPONDENT APPEAL BRIEF."

This decision also addresses the third party requester's May 14, 2010 opposition paper entitled "THIRD PARTY REQUESTER'S OPPOSITION TO PATENT OWNER'S PETITION SEEKING WAIVER OF 37 C.F.R. § 1.943 FOR PATENT OWNER'S RESPONDENT APPEAL BRIEF."

The proceeding, the patent owner's petitions, and the third party requestor's petition and opposition paper, 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 C.F.R. § 1.183 has been received.

SUMMARY

(1) The patent owner's March 16, 2010, and March 29, 2010 petitions requesting waiver of its appellant brief page limit restrictions under 37 C.F.R. § 1.943(c) are dismissed as the situation has not been shown to be extraordinary as explained below. The appellant brief filed March 29, 2010 is expunged as improper, since it does not comply with 37 CFR 1.943(c). The patent owner's brief shall not exceed 30 pages. The patent owner is given 15 days from the date of this decision to file a compliant appellant that that does not exceed 30 pages.[1]

(2) The third party requester's April 28, 2010 petition requesting waiver of its respondent brief page limit restrictions under 37 C.F.R. § 1.943(c) is dismissed as the situation has not been shown to be extraordinary as explained below. The respondent brief filed April 29, 2010 is expunged as improper as it does not comply with 37 CFR 1.943(c). Third party requester's brief shall not exceed 15 pages. The third party requester may file a corrected or redacted respondent brief that does not exceed 15 pages in response to patent owner appellant brief once filed, within one month from the date of service of the appellant brief.

(3) The patent owner's April 29, 2010 petition requesting waiver of its respondent brief page limit restrictions under 37 C.F.R. § 1.943(c) is dismissed as the situation has not been shown to be extraordinary as explained below. The respondent brief filed April 29, 2010 is expunged as improper as it does not comply with 37 C.F.R. § 1.943(c). Patent owner's respondent brief shall not exceed 15 pages. Patent owner may file a corrected or redacted respondent brief that does not exceed 15 pages in response to third party requester's appeal brief within 15 days of the date of this decision.

(4) The third party requester's May 14, 2010 opposition paper to patent owner's April 29, 2010 petition is dismissed and expunged as having no right of entry in this proceeding.

---

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

REVIEW OF THE RELEVANT FACTS

1. On June 15, 2004, U.S. Patent No. 6,751,696 B2 ('the '696 patent) issued with sixty claims to Farmwald *et al.* and assigned on its face to Rambus, Inc.

2. On November 6, 2008, the filing date requirements for a request for *inter partes* reexamination of claims 1 and 4 of the '696 patent was submitted by a third party requester, Samsung Electronics, which request was assigned control number 95/001,105 ("the '1105 proceeding").

3. On December 31, 2008, the filing date requirements for a second request for *inter partes* reexamination of claims 1 and 4 of the '696 patent was submitted by a third party requester, Micron Technology, which request was assigned control number 95/001,133 ("the '1133 proceeding").

4. On January 9, 2009, an Order was granted for *inter partes* reexamination of claims 1 and 4 of the '696 patent in the '1105 proceeding.

5. On January 22, 2009, an Order was granted for *inter partes* reexamination of claims 1 and 4 of the '696 patent in the '1133 proceeding.

6. On March 9, 2009, the '1105 and '1133 proceedings were merged.

7. The merged proceeding has progressed to the point where, on December 18, 2009, a Right of Appeal Notice (RAN) was mailed in the merged proceeding.

8. On January 15, 2010, patent owner filed a Notice of Appeal for claims 1 and 4.

9. On January 29, 2010, third party requester Micron Technology filed a Notice of Cross Appeal for claims 1 and 4.

10. On March 16, 2010, patent owner filed a petition under 37 C.F.R. § 1.183 requesting waiver of the page limit requirements of 37 CFR 1.943(c).

11. On March 29, 2010, patent owner filed an appellant's brief, along with a second petition under 37 C.F.R. § 1.183 requesting waiver of the page limit requirements of 37 CFR 1.943(c).

12. On March 29, 2010, third party requester filed an appellant's brief.

13. On April 28, 2010 third party requester filed a petition under 37 C.F.R. § 1.183 requesting waiver of page limit requirements of 37 CFR 1.943(c). On April 29, 2010, third party requester filed the respondent's brief.

14. On April 29, 2010, patent owner filed a respondent's brief, along with a petition under 37 C.F.R. § 1.183 requesting waiver of the page limit requirements of 37 CFR 1.943(c).

15. On May 14, 2010, third party requester filed an opposition paper, citing no authority for its entry, requesting dismissal of patent owner's April 29, 2010 petition.

RELEVANT AUTHORITY

37 CFR 1.183 provides:

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

37 CFR 1.943(c) provides:

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

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 Petitions of March 16, 2010 and March 29, 2010.

The patent owner requests waiver of 37 C.F.R. § 1.943(c), which limits patent owner's appellant brief to thirty (30) pages or 14,000 words in length. The patent owner states that the brief as filed is 23,240 words.

Waiver is requested for the following reasons, which according to the patent owner, present an extraordinary situation:

(1) The extensive arguments made by the Office in the RAN, which is over 100 pages in length.

(2) The size of the applied Bennett reference, in combination with the other applied references.

(3) The number of issues raised by the Office in the RAN, including claim rejections, secondary considerations, and claim construction issues.

II. Third Party Requester Petition of April 29, 2010

The third party requester Micron Technology requests waiver of 37 C.F.R. § 1.943(c), which limits third party requester's respondent brief to fifteen (15) pages or 7,000 words in length. The third party requester desires waiver to 33 pages or 15,400 words.

Waiver is requested for the sole reason that patent owner's appellant's brief exceeded the page limit requirements, which according to the third party requester, presents an extraordinary situation.

III. Patent Owner Petition of April 29, 2010

The patent owner requests waiver of 37 C.F.R. § 1.943(c), which limits the respondent brief to fifteen (15) pages or 7,000 words in length. The patent owner states that the respondent brief as filed is 9,389 words.

Waiver is requested for the reason that Micron's appellant's brief raises numerous (three) issues, which according to the patent owner, present an extraordinary situation.

IV. Third Party Requester's Opposition Paper of May 14, 2010

The third party requester Micron Technology requests that the patent owner petition of April 29, 2010 be dismissed as not meeting the requirements of 37 C.F.R. § 1.183 because the patent owner should not need extra pages in a respondent brief to address issues raised in a third party requester appellant brief which did not exceed the normal page length requirements.

V. Analysis and findings

A. Determining Page Length

As noted in MPEP 2667(I)(A)(2), the provisions of 37 C.F.R. § 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 C.F.R. § 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 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.

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

B. Patent Owner Has Not Shown the Existence of an Extraordinary Situation Requiring Waiver of the Page Limit Rule For Patent Owner's Appellant's Brief

Patent owner's petition rests upon three facts supporting an unfairness in application of the page limit rules. First, the RAN, which is over 100 pages in length, includes extensive arguments made by the Office requiring treatment at some length in the appellant's brief. Second, the size of the applied Bennett reference, in combination with the other applied references, presents an unusual situation. Third, the number of issues raised by the Office in the RAN, including claim rejections, secondary considerations, and claim construction issues, necessarily requires treatment at some length in the appellant's brief.

The content of patent owner's appellant's brief has been considered, in view of the prosecution history, to determine the necessity of page limit waiver on the arguments presented by patent owner. Prior to appeal, the claims and rejections/issues were adequately addressed in significantly fewer pages than in the appellant's brief. Furthermore, the appellant's brief addresses fewer grounds of rejection than were addressed in earlier patent owner responses, as some rejections have been adopted but not maintained. Additionally, it is noted that only one independent claim, and a total of two claims, are under appeal. Nevertheless, patent owner has devoted over 50 pages to the obviousness rejections of claim 1.[3] It is further noted that the RAN addresses these rejections primarily over a 12 page span, and although significant additional treatment of claim construction issues is present, it is clear that a significant number of the 105 pages in the RAN are not the subject of patent owner's appellant brief.[4]

Despite the simplification of issues, and the fact that the regulations contemplate an appellate brief to be 40% shorter than an response to an Office action, patent owner has here submitted an appellant brief having a number of pages that is longer than the permitted page limit for a response to an action, and indeed, over 50% greater than that contemplated under the regulations even when measured by the word count. No reason why an increase in pages, relative to the length of patent owner's previous responses to Office actions, is now warranted has been provided.

The appeal rules for reexamination have been structured such that treatment of issues is expected to be compressed relative to responses during prosecution. As patent owner filed responses within the 50 page limit for responses, it should be expected that, barring extraordinary circumstances, patent owner's appellant's brief should remain within the 30 page limit for appellant's briefs. None of the above facts, viewed in context of the circumstances of the proceeding, give rise to an extraordinary situation such that waiver of the page limit rules would be necessary to satisfy the requirements of justice in the instant proceeding. Therefore, patent

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[3] Patent owner's appellant brief, at ii-iii, indicating that pages 6-57 address the rejection of claim 1. Pages 58-60 address the rejection of claim 4, and pages 61-64 address secondary considerations of nonobviousness.

[4] Patent owner's appellant's brief cites primarily to pages 89-101 of the RAN; however, the brief also cites to additional pages of the RAN , particularly pages 9, 21-26, 36-38, 53-57, and 60-67 for claim construction issues. It is further noted that approximately the first eight pages of the argument in the appellant's brief are devoted towards a general discussion of the claimed invention and the Bennett reference; the discussion merits of the rejection appear to begin at page 13 of the brief; *e.g.*, at the section entitled "e. *Bennett* Does Not Read on the Claimed Inventions."

owner's request to waive 37 C.F.R. § 1.943(c), to the extent necessary to permit the March 29, 2010 patent owner's appellant's brief, is **dismissed**.

C. Third Party Requester Has Not Shown the Existence of an Extraordinary Situation Requiring Waiver of the Page Limit Rule For Third Party Requester's Respondent's Brief

Third party requester Micron Technology's petition rests on the sole ground that a waiver of page limit requirements for an appellant's brief necessarily requires a waiver of page limit requirements for the corresponding respondent's brief. However, the rationale for waiver of page limit requirements for the appellant's brief rest upon the combination of a lengthy RAN, lengthy references, and numerous issues requiring treatment by the patent owner. The third party requester has not set forth any facts supporting a contention that the respondent's brief could not fairly be written within the standard page limits. Furthermore, it is not apparent from the prosecution history that a combination of factors exists such that an extraordinarily lengthy respondent's brief would be necessitated to satisfy the requirements of justice.

Third party requester Micron Technology has failed to persuasively establish the existence of an extraordinary situation requiring waiver of the page limit requirements for its yet-to-be-filed respondent's brief. Therefore, third party requester's request to waive 37 C.F.R. § 1.943(c), to permit a respondent brief of up to 14,000 words or 30 pages, is **dismissed**.

D. Patent Owner Has Not Shown the Existence of an Extraordinary Situation Requiring Waiver of the Page Limit Rule For Patent Owner's Respondent's Brief

Patent Owner's petition requests waiver of the page limit requirement for patent owner's respondent's brief based upon the fact that the third party requester's appellant's brief raises numerous (three) issues. However, it is noted that the third party requester's appellant's brief presents these issues and yet remains within the page limit requirements set forth in 37 C.F.R. § 1.943(c). No reason why an increase in pages is now warranted has been provided. Furthermore, it is not apparent from the prosecution history that a combination of factors exists such that an extraordinarily lengthy respondent's brief would be necessitated to satisfy the requirements of justice.

Patent owner has failed to persuasively establish the existence of an extraordinary situation requiring waiver of the page limit requirements for its yet-to-be-filed respondent's brief. Therefore, third party requester's request to waive 37 C.F.R. § 1.943(c), to permit a respondent brief of 9,885 words is **dismissed**.

E. 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.

Both parties 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. 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 with the brief.

F. Third Party Requester's Opposition Paper Has No Right Of Entry

With respect to the May 14, 2010 requester paper opposing patent owner's petition under 37 C.F.R. § 1.183, no statute or regulation provides any right for the third party requester to file an opposition to, or comment on, the patent owner's petition to request waiver of respondent brief page limits. A request for waiver of respondent brief page limits 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 equities as to the "special dispatch" requirement and 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 not expressly provided for by the rules. 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 waiver of respondent brief page limits. No mechanism has been provided for the third party requester to file a paper, such as the present 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 waiver of respondent brief page limits is a paper that is not permitted by the statute governing *inter partes* reexamination proceedings, and accordingly it was not provided for (i.e., was not permitted) in the regulations that implemented the *inter partes* reexamination statute. Third party requester's opposition to patent owner's petition for waiver of respondent brief page limits is therefore not enterable into the record.

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 opposition, filed on May 14, 2010 to the patent owner's

petition for waiver of respondent brief page limits filed on April 29, 2010 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 for revival will be 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. The patent owner petitions filed on March 16, 2010 and March 29, 2010 under 37 C.F.R. § 1.183 to waive the provisions of 37 C.F.R. § 1.943(c) for the appeal brief are **dismissed**. The appellant brief filed March 29, 2010 is expunged from IFW by closing it in IFW and marking it as non-public. Patent owner has 15 days from the date of this decision to file a compliant appellant brief pursuant to 37 C.F.R. § 41.67(d). The time for filing an appeal brief may not be extended.

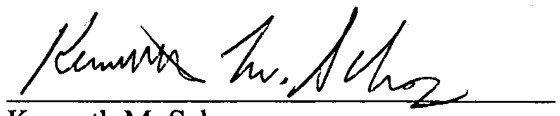
2. The third party requester petition filed April 28, 2010 under 37 C.F.R. § 1.183 to waive the provisions of 37 C.F.R. § 1.943(c) for the respondent brief is **dismissed**. The respondent brief filed April 29, 2010 is expunged from IFW by closing it in IFW and marking it non-public. Third party requester has one month from the date of service of patent owner's appellant brief to file a compliant respondent brief pursuant to 37 C.F.R. § 41.68(c). The time for filing a respondent brief may not be extended. Failure to timely file a respondent brief will result in the respondent brief not being considered.

3. The patent owner petition filed April 29, 2010 under 37 CFR 1.183 to waive the provisions of 37 C.F.R. § 1.943(c) for the respondent brief is **dismissed**. The respondent brief filed April 29, 2010 is expunged from IFW by closing it in IFW and marking it non-public. Patent owner has 15 days from the date of this decision to file a compliant respondent brief pursuant to 37 C.F.R. § 41.68(c). The time for filing a respondent brief may not be extended. Failure to timely file a respondent brief will result in the respondent brief not being considered.

4. The May 14, 2010 requester opposition petition paper is **refused entry**, as it is an improper paper. The opposition paper is being expunged by closing the paper in the Image File Wrapper (IFW) for the proceeding and marking it "not public." It will not constitute part of the record of the present reexamination proceeding.

5. Jurisdiction over the merged reexamination proceeding is hereby returned to the Central Reexamination Unit.

6. Any questions concerning this communication should be directed to Michael Cygan, Legal Advisor, at 571-272-7700.



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

May 26, 2010

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In re Farmwald et al.
Inter Partes Reexamination Proceeding
Control No. 95/001,105
Filed: November 6, 2008
For U.S. Patent Number 6,751,696 B2

In re Farmwald et al.
Inter Partes Reexamination Proceeding
Control No. 95/001,133
Filed: December 31, 2008
For U.S. Patent Number 6,751,696 B2

DECISION DISMISSING PETITIONS

This is a decision on the following papers:

(1) Petition filed March 4, 2010 by patent owner entitled "PETITION TO SIMPLIFY ISSUES FOR APPEAL," by striking portions of the third party requester's Notice of Cross Appeal.

(2) Opposition filed March 19, 2010 by the '1133 third party requester entitled "THIRD PARTY REQUESTER'S OPPOSITION TO PATENT OWNER'S PETITION TO SIMPLIFY ISSUES FOR APPEAL."

(3) Petition filed April 29, 2010, by patent owner entitled "PETITION TO DISMISS THIRD PARTY REQUESTER'S CROSS APPEAL."

(4) Opposition filed June 1, 2010 by the '1133 third party requester entitled "THIRD PARTY REQUESTER'S OPPOSITION AND REQUEST TO EXPUNGE IMPROPER PAPER."

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

The petitions and oppositions are dismissed as moot.

FEES

The fee set forth in 37 CFR 1.17(f) for both patent owner petitions is $400, which was charged to Patent Owner's credit card on March 5, 2010 and April 30, 2010 pursuant to the authorizations for same in Patent Owner's EFS-WEB fee transmittals filed on March 4, 2010 and April 29, 2010.

The '1133 third party requester oppositions are being taken as petitions under 37 CFR 1.182/1.183. The fee set forth in 37 CFR 1.17(f) for these petitions is $400.

Regarding the March 19, 2010 opposition, the $400 fee will be charged to the '1133 requester's deposit account no. 14-1437, pursuant to the authorization on page two of requester's March 19, 2010 petition.

Regarding the June 1, 2010 opposition, the $400 was charged to the '1133 requester's deposit account no. 14-1437 on June 2, 2010, pursuant to the authorization on page one of requester's June 1, 2010 opposition.

REVIEW OF THE RELEVANT FACTS

1. On June 15, 2004, U.S. Patent No. 6,751,696 B2 ('the '696 patent) issued with sixty claims to Farmwald *et al.* and assigned on its face to Rambus, Inc.

2. On November 6, 2008, the filing date requirements for a request for *inter partes* reexamination of claims 1 and 4 of the '696 patent was submitted by a third party requester, Samsung Electronics, which request was assigned control number 95/001,105 ("the '1105 proceeding").

3. On December 31, 2008, the filing date requirements for a second request for *inter partes* reexamination of claims 1 and 4 of the '696 patent was submitted by a third party requester, Micron Technology, which request was assigned control number 95/001,133 ("the '1133 proceeding").

4. On January 9, 2009, an Order granted *inter partes* reexamination of claims 1 and 4 of the '696 patent in the '1105 proceeding.

5. On January 22, 2009, an Order granted *inter partes* reexamination of claims 1 and 4 of the '696 patent in the '1133 proceeding.

6. On March 9, 2009, the '1105 and '1133 proceedings were merged.

7. The merged proceeding has progressed to the point where, on December 18, 2009, a Right of Appeal Notice (RAN) was mailed in the merged proceeding.

8. On January 15, 2010, patent owner filed a Notice of Appeal for claims 1 and 4.

9. On January 29, 2010, the '1133 third party requester, Micron Technology, filed a Notice of Cross Appeal for claims 1 and 4.

10. On March 4, 2010, patent owner filed a petition under 37 CFR 1.182 requesting issues be stricken from the '1133 third party requester's January 29, 2010 Notice of Cross Appeal.

11. On March 19, 2010, the '1133 third party requester filed an opposition paper, citing no authority for its entry, requesting dismissal of patent owner's March 4, 2010 petition.

12. On March 29, 2010, patent owner filed an appeal brief.

13. On March 29, 2010, the '1133 third party requester filed a cross appeal brief.

14. On April 29, 2010, patent owner filed a respondent brief, along with a petition under 37 CFR 1.182 requesting dismissal of the '1133 third party requester's cross appeal.

15. On April 29, 2010, third party requester filed a respondent brief.

16. On May 27, 2010, the Office issued a decision expunging patent owner's March 29, 2010 appeal brief and April 29, 2010 respondent brief and third party requester's April 29, 2010 respondent brief.

17. On June 1, 2010, the '1133 third party requester filed an opposition paper, requesting dismissal and expungement of patent owner's April 29, 2010 petition.

18. On June 11, 2010, patent owner filed a revised appeal brief and a revised respondent brief.

19. On July 2, 2010, the Office reopened prosecution of the merged proceeding by issuing an Action Closing Prosecution (ACP).

DECISION

On March 4, 2010, and April 29, 2010, patent owner filed its present petitions. On March 19, 2010, the '1133 third party requester filed its opposition to patent owner's March 4, 2010 petition. On June 1, 2010, the '1133 third party requester filed its opposition to patent owner's April 29, 2010 petition. In the March 4, 2010 petition, patent owner requests that the Office strike from the record specific issues for appeal in the '1133 third party requester's January 29, 2010 notice of cross appeal. In the April 29, 2010 petition, patent owner requests that the Office strike from the record the '1133 third party requester's March 29, 2010 cross appeal brief and dismiss the cross appeal. The '1133 third party requester opposes patent owner's March 4, 2010 request to strike issues raised on cross appeal and opposes patent owner's April 29, 2010 request to strike the March 29, 2010 cross appeal brief and dismissal of the cross appeal.

On July 2, 2010, the Office issued an ACP, reopening prosecution in the merged proceeding and removing the merged proceeding from appeal. The Office's reopening of prosecution renders the petitions and oppositions regarding the propriety of '1133 third party requester's appeal moot. Accordingly, the all the present petitions and oppositions are DISMISSED AS MOOT.

ADDITIONAL DISCUSSION

In the '1133 third party requester's June 1, 2010 opposition the position that patent owner's April 29, 2010 is an improper paper was advanced. The '1133 requester asserts patent owner's April 29, 2010 petition is a "renewal" of patent owner's March 4, 2010 petition and responsive to the '1133 requester's March 19, 2010 oppositions. The '1133 requester therefore concludes patent owner's April 29, 2010 petition is an improper, iterative paper that should be expunged from the record of the proceeding. The '1133 requester is in error. Patent owner's March 4, 2010 petition is in response to the '1133 requester's notice of cross appeal filed on January 29, 2010 and asks for the relief of striking from the record all issues listed in the notice of cross appeal that were not raised by the '1133 requester. Patent owner's April 29, 2010 petition is in response to the '1133 requester's cross appeal brief filed on March 29, 2010 and asks for the relief of expungement of the brief and dismissal of the appeal. As the April 29, 2010 petition is responding to a different submission, it is neither a renewal of the March 4, 2010 petition nor an improper iterative response to the '1133 requester's March 19, 2010 opposition. Therefore, patent owner's April 29, 2010 petition submission is not an improper paper. Accordingly, patent owner's April 29, 2010 petition submission is not subject to expungement.

CONCLUSION

1. The petitions and oppositions are **dismissed as moot**.

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

3. Any questions concerning this communication should be directed to Joseph F. Weiss, Jr., Legal Advisor, at 571-272-7759.

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

July 9, 2010

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,134	01/09/2009	6260097	42940.4	8506

86497 7590 03/11/2010

Paul M. Anderson, PLLC
P.O. Box 160006
Austin, TX 78716

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/11/2010

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.
95/001,134	01/09/09	6260097	42940.4

EXAMINER
ESCALANTE, OVIDIO

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IP SECTION
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DALLAS, TX 75219

ART UNIT	PAPER
3992	

DATE MAILED:

03/11/10

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.
95/001,134	01/09/09	6260097	42940.4

EXAMINER
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ART UNIT	PAPER
3992	

DATE MAILED:

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(For Patent Owner)

MAILED

MAR 11 2010

CENTRAL REEXAMINATION UNIT

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(For Third Party Requester)

In re: Farmwald *et alia*
Inter Partes Reexamination Proceeding
Control No. 95/001,134
Deposited on: 09 January 2009
For: US Patent No. 6,260,097

DECISION
GRANTING IN PART
PETITION FOR EXTENSION
OF TIME
[37 CFR §§ 1.965 & 1.181]

This is a decision on the 03 March 2010, "Patent Owner's Request for Extension of Time Pursuant to 37 CFR § 1.956," requesting that the time for responding to the Action Closing Prosecution mailed 19 February 2010, be extended by one-month. The petition was timely filed with the petition fee. The petition indicates the required certificate of service.

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

The petition is granting in part 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 a one- month time for filing a response thereto. The petition seeks a one-month extension of time for which to respond to the outstanding Office action. The petition for extension of time was timely filed on 03 March 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-in-part.

> **37 CFR § 1.956. Patent owner extensions of time in inter partes reexamination.** *The time for taking any action by a patent owner in an inter partes reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified. Any request for such extension must be filed on or before the day on which action by the patent owner is due, but in no case will the mere filing of a request effect any extension. Any request for such extension must be accompanied by the petition set forth in § 1.17(g). See § 1.304(a) for extensions of time for filing a notice of appeal to the U.S. Court of Appeals for the Federal Circuit.*

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

> As noted above, a request for extension of time under 37 CFR § 1.956 will be granted only for sufficient cause, ...
>
> Evaluation of whether "sufficient cause" has been shown for an extension must be made by **balancing** the desire to provide the patent owner with a fair opportunity to respond, **against** the requirement of the statute, 35 U.S.C. § 314(c), that the proceedings be conducted with special dispatch. ...

Any petition request must include the required petition fee as set forth according to 37 CFR § 1.17 (g) and 37 CFR § 1.956.

MPEP § 2665 Extension of Time for Patent Owner Response (in-part)

> Requests for an extension of time in an inter partes reexamination proceeding will be considered only after the first Office action on the merits in the reexamination is mailed. Any request for an extension of time filed prior to the first action will be denied.
>
> ...
>
> Evaluation of whether "sufficient cause" has been shown for an extension must be made by balancing the desire to provide the patent owner with a fair opportunity to respond, against the requirement of the statute, 35 U.S.C. § 314(c), that the proceedings be conducted with special dispatch.

Decision

The patent owner's representative petitions under 37 CFR § 1.956 to extend the period for response by adding two (2) 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 Action Closing Prosecution was mailed 19 February 2010. The patent owner submitted a timely filed the petition on 03 March 2010 with the appropriate fee and certificate of service.

The petition dated 03 March 2010 articulates largely the same reasons as those given in the earlier granted petition for extension of time in addition to various other concurrent proceedings. The patent owner has not articulated what events are different that would have been unexpected since the earlier granted petition for extension of time. Further, pursuant to MPEP § 2265, "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." 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.

The petitioner does however note that there was a delay in receipt of the Office action. On balance, the petitioner has not demonstrated "sufficient cause" to grant a one (1) month extension of time. In light of the delay in receipt, the time is extended one week

The petition request to extend the response time is hereby granted-in-part for a period of one-week

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 **granted in part.**

2. The period for response is extended one-week.

3. The response date is extended to 28 March 2010.

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

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

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

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

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

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

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

/Mark Reinhart/
for

Gregory Morse,
Director,
Central Reexamination Unit

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Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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APR 14 2010

CENTRAL REEXAMINATION UNIT

KING & SCHICKLI, PLLC
247 NORTH BROADWAY
LEXINGTON, KY 40507

: FOR PATENT OWNER

LAURA A. CRUZ
CHRISTENSEN, O'CONNOR
JOHNSON, KINDNESS, PLLC
1420 FIFTH AVE., SUITE 2800
SEATTLE, WA 98101-2347

: FOR THIRD PARTY
: REQUESTER

In re Bloomer
Reexamination Proceeding
Control No. : 95/001,136
Filed: January 23, 2009
Patent No. 6,416,684

: DECISION ON
: PETITION UNDER 37 CFR 1.181
: AND
: RETURN OF
: UNAUTHORIZED PAPER

This is a decision addressing Patent Owner's petition, filed October 30, 2009, under 37 CFR 1.181 requesting that prosecution be reopened. This decision also addresses the third party requester's comments, dated October 21, 2009.

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

SUMMARY

Patent Owner's petition is denied.

The third party requester's comments, dated October 21, 2009, are returned as an improper paper.

STATEMENT OF RELEVANT FACTS

1. Patent No. 6,416,684 (the '684 patent) issued on July 9, 2002.

2. A request for reexamination, assigned Control No. 95/001,136 (the '136 proceeding), was filed by a third party requester on January 23, 2009.

3. Reexamination was ordered in the '136 reexamination proceeding on March 27, 2009.

4. An Office action on the merits was mailed on the next day, March 28, 2009.

5. On June 1, 2009, patent owner timely filed a response to the Office action by the examiner. The response included proposed amendments to patent claims 1, 9, 12, 15, 26, 38, cancelled patent claims 6, 7, 11, 13, 14, 20, 21, 25, 31, 32, 36, 37, and added proposed new claims 39-47.

6. On September 22, 2009, patent owner filed a duplicate of the June 1, 2009 response.

7. On September 29, 2009, the Office mailed an Action Closing Prosecution (ACP).

8. On October 21, 2009, third party requester filed comments in response to the September 22, 2009 paper.

9. On October 30, 2009, patent owner filed a response to the ACP and the instant petition under 37 CFR 1.181.

10. On November 25, 2009, the requester filed comments on the patent owner's response.

DECISION

The patent owner (petitioner) states that they are seeking relief under 37 C.F.R. § 1.181 to have prosecution be reopened because the ACP was premature. Patent owner specifically states the follow reasons to support their request to reopen prosecution:

1. A new prior art rejection was made to claim 1 and relied upon a reference that was not previously of record;
2. The rejection for claim 43 provides no articulated reasoning;
3. The rejections under 35 U.S.C. 112 are improper; and
4. The ACP did not consider the third party requester's comments of October 21, 20099.

See pages 2-3 of the petition.

In response to Patent Owner's general arguments for reopening prosecution in this reexamination proceeding, the Director finds there are not good and sufficient reasons to do so. First, 35 U.S.C. 314(c) requires that all *inter partes* reexamination proceedings to be acted upon with "special dispatch." The rules and procedures of the Office were

established through notice and comment in order to achieve special dispatch in a reasonable manner. The Office rules and procedures encourage examiners to look at the facts involved in a particular proceeding and to weigh the equities before issuing an action closing prosecution (ACP). The petition states that the examiner failed to follow Office policies and procedures because the ACP did not abide by the guidance in MPEP 2673.01. MPEP 2673.01, however, states guidelines for examiners in responding to a submission **after** ACP. MPEP 2671 *et seq.* provides the guidelines for examiners in responding to a response after the first Office action, which is the situation under review in this proceeding. As stated below, upon review of the record, the record shows that the examiner followed the appropriate guidelines in MPEP 2671 *et seq.* Therefore, petitioner's argument that the ACP is premature because the examiner did not follow guidelines in MPEP 2673.01 is not persuasive.

The record shows that the first Office action, which issued March 28, 2009, clearly stated the position of the examiner regarding the art cited by the requestor against the claims. Patent owner was informed that submissions after the next Office action, which is intended to be an Action Closing Prosecution (ACP), will be governed by 37 CFR 1.116(b) and (d), which will be strictly enforced. The next Office action was, as intended, an ACP and included new rejections in response to patent owner's amendment of June 1, 2009, which was resubmitted again on September 22, 2009. Patent owner's argument that the new rejections render the ACP premature is without merit. The record shows that substantially the same body of prior art was applied against the claims in both the first Office action and the ACP. The ACP did have to address the amendment of June 1, 2009, including the amendment to independent claim 1 and the new proposed claims 39-47. Specifically, the record shows that the new prior art rejection for claim 1 was made in response to the amendment of claim 1. See page 17 of the ACP. The record also shows that the rejections under 35 U.S.C. 112 were applied only to new proposed claims 40-42, and therefore, could not have been made in the first Office action. See pages 15-17 of the ACP. Therefore, the ACP did not present any new rejections that were not necessitated by the amendment filed on June 1, 2009.

Furthermore, many grounds of argument (e.g., Grounds 1-3 listed above) presented in the petition address the merits of the examiner's determinations, which are appealable (and not petitionable) issues. See MPEP 1201 and 1002. For example, the issues of whether the rejection of claim 43 presents sufficient rationale or whether the rejections under 35 U.S.C. 112 were proper are appealable issues, and therefore, cannot be addressed by petitions. Therefore, the merits of the examiner's decisions will not be addressed in this decision.

The record shows that the examiner appropriately followed Office rules and procedures in the determination to issue an ACP, and did not categorically deprive the patent owner of its statutory rights to present amendments and arguments in reexamination proceedings.

Third Party Requester's Comments of October 21, 2009

37 CFR 1.947 states, in part:

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

MPEP 2666.60 states, in part:

> After the patent owner or the third party requester has provided a submission directed solely to correcting the defect, the other party is not permitted to comment on the submission correcting the defect, since the submission correcting the defect is directed to form and does not go to the merits of the case.

The third party requester's papers dated October 21, 2009 are untimely. 37 CFR 1.947 requires that any comments from the third party requester must be filed within 30 days from the certificate of service from the patent owner. As stated above in the relevant facts, the papers filed September 22, 2009 were duplicative papers of the June 1, 2009 response.[1] Therefore, in accordance with 37 CFR 1.947 and MPEP 2666.06, the filing of the duplicative papers on September 22, 2009 did not give the third party requester a new time period to file comments. In other words, the third party requester must have responded within the 30 days from the date of service of the June 1, 2009 response. As part of the June 1, 2009 response, the patent owner included a certification of service that the third party requester was served on May 27, 2009. Therefore, the third party requester had until June 26, 2009 to timely submit comments. The record does not show that third party requester filed any comments prior to June 26, 2009. Accordingly, the papers filed on October 21, 2009 are not timely because they were filed after June 26, 2009, and the refiling of duplicative papers on September 22, 2009 did not give the third party requester a new thirty day time period to file comments. See MPEP 2666.60.

In view of the above, the third party requester's comments, dated October 21, 2009, do not have an entry right under the rules. Therefore, the comments will not

[1] It is recognized that the examiner in the ACP stated that the September 22, 2009 papers were the June 1, 2009 resubmitted in "compliant form." See, e.g., page 2 of the ACP. However, upon review of the record, the June 1, 2009 and September 22, 2009 papers appear to be identical. It is particularly noted that the amendments to the claims are identical so it cannot be said that the September 22, 2009 papers were correcting a noncompliant amendment to the claims. This is the only situation in which Office policies and regulations grant the third party requester a new thirty day time period to respond to a corrected response by the patent owner.

be made of record in the reexamination proceeding, and are being "returned" to the third party requester ***without consideration of the substance of the comments***. 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. See also MPEP 2667.

Petitioner's ground that the ACP was premature because it issued prior to the filing of the third party requester's comments, dated October 21, 2009, is not persuasive. As stated above, the October 21, 2009 papers are not authorized to be entered into the record, and therefore, the examiner was not required to consider and address the October 21, 2009 comments in the ACP.

In summary, the examiner appropriately followed Office rules and procedures in deciding to issue the ACP, and closed prosecution in the interest of "special dispatch" in accordance with Office rules and procedures. Accordingly, good and sufficient reasons to reopen prosecution in the reexamination proceeding have not been provided and the Patent Owner's petition, as it relates to reopening prosecution of the instant reexamination proceeding, is denied.

CONCLUSION

1. Patent Owner's petition under 37 CFR 1.181, filed October 30, 2009, is denied for the reasons discussed above.

2. The papers dated October 21, 2009 are returned to the third party requester with this decision as not having a right of entry. No copy of the papers will be maintained in the electronic Image File Wrapper for the proceeding.

3. Telephone inquiries related to this decision should be directed to Deborah Jones, Supervisory Patent Examiner, at (571) 272-1535, or in her absence to the undersigned at (571) 272-3838.

Gregory A. Morse
Director
Central Reexamination Unit

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.
95/001,139	04/06/2009	7085566	2454.1041REX	1785

21171 7590 11/04/2009

STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 11/04/2009

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

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Date: NOV 0 4 2009

CENTRAL REEXAMINATION UNIT

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
CRESTRON ELECTRONICS, INC.
ATTN: PHILIP KIRKPATRICK
15 VOLVO DRIVE
ROCKLEIGH, NJ 07647-2507

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001139
PATENT NO. : 7085566
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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Mark J. Henry
Staas & Halsey, LLP
1201 New York Ave. N.W., 7th Floor
Washington, D.C. 20005

(For Patent Owner)

MAILED

NOV 0 4 2009

Philip L. Kirkpatrick
Creston Electronics, Inc.
15 Volvo Dr.
Rockleigh, N.J. 07647

(For Requester)

CENTRAL REEXAMINATION UNIT

In re Burchard et al.
Inter Partes Reexamination Proceeding
Control No. 95/001,139
Filed: April 6, 2009
For: U.S. Patent No. 7,085,566

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

This is a decision on the August 24, 2009, third party requester petition presented in the Notice of Appeal under 37 CFR 41.61. The third party requester petitions under 37 CFR 1.183 to accept additional proposed rejections, which are outlined in the Notice of Appeal and discussed in detail in an attached Request for Reexamination Substitute Sheets, and reopen prosecution. On September 24, 2009, the patent owner filed an opposition to the August 24, 2009 petition.

The petition, opposition, and the reexamination proceeding, are before the Office of Patent Legal Administration.

The fee for the petition has been received.

The petition is **dismissed**, and is found to be an unauthorized paper.

Under 37 CFR 1.939(a), and in accordance with MPEP § 2667(I), the unauthorized paper:

(a) has not been entered into the reexamination file;
(b) will not be considered by the examiner; and
(c) is being **expunged** from the record.

Requester is given 15 days from the date of this decision to file a corrected Notice of Appeal. This 15-day period is not extendable.

BACKGROUND

1. U.S. Patent 7,085,566 (the '566 patent) issued on Aug. 1, 2006 with nine claims.

2. On January 22, 2009, an incomplete request for *inter partes* reexamination of claims 1-9 of the '566 patent was filed by the third party requester, and the resulting reexamination proceeding was assigned control number 95/001,139 ("the '1139 proceeding").

3. A complete request was subsequently filed by the third party requester and accorded a filing date of April 6, 2009.

4. On May 15, 2009, reexamination of claims 1-9 of the '566 patent was ordered.

5. An action closing prosecution was mailed on May 15, 2009 along with the order.

6. On July 24, 2009, a right to appeal notice was issued.

7. On August 24, 2009, third party requester filed a Notice of Appeal under 37 CFR 41.61 combined with a petition under 37 CFR 1.183 requesting the examiner to accept additional proposed rejections presented on substitute sheets for the request for reexamination. This petition is the subject of the present decision.

8. On September 24, 2009, the patent owner filed an opposition to the August 24, 2009 petition.

9. The third party requester filed its Appeal Brief on October 19, 2009.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 CFR 1.182 provides:

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

37 CFR 1.183 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)

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.

35 U.S.C. 134(c)

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

35 U.S.C. 314(b)(2)

Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.

DECISION

The first page of the petition provides as follows:

> Third party requester for *inter parte* [sic] reexamination of U.S. Patent 7,085,566 hereby gives **notice that he will be filing an Appeal Brief** in response to the Right of Appeal Notice of 24 July 2009. In addition, in the interest of justice, the third party requester hereby submits recently discovered prior art (See Section II "Other Prior Art References") for consideration. In light of this new prior art, requester petitions the examiner to accept additional Proposed Rejections (PR7- PR16), outlined in this Notice and discussed more thoroughly in the attached Request for Reexamination "Substitute Sheets", and reopen examination to treat them on their merits. This **petition is made in accordance with 37 CFR § 1.183**. The required fee of $510.00 for filing a **Notice of Appeal** as prescribed by 37 CFR §41.20 is enclosed herewith. In addition, a fee of $400.00 is enclosed for the **petition to reopen examination** as prescribed in 37 CFR §41.20. [Emphasis added in bold]

Combined with the Notice of Appeal, the third party petitions under 37 CFR 1.183 to add new proposed rejections and reopen prosecution after the issuance of the Right to Appeal. First, it is not permissible to combine a petition with the Notice of Appeal, as every distinct subject, inquiry or order must be contained in a separate paper in accordance with 37 CFR 1.4(c). As such the petition is an improper paper.

Second, the third party requester may only file written comments in response to a filing of a response by the patent owner on the merits. The petition requests relief, and contains information, not authorized by the statute, as it is requesting entry of a paper (the combined petition-appeal) which seeks to add proposed rejections; yet, it is not written comments filed within 30 days of a patent owner response to an Office action on the merits as is required under 35 USC 314(b).

Third, the third party requester petitions under 37 CFR 1.183; however, a petition under 37 CFR 183 is appropriately made only in an extraordinary situation in which justice requires waiver of a requirement of the regulations. The third party requester has not presented any evidence that this

is an extraordinary situation and has not requested waiver of a specific regulation. As such, the substance of the petition submitted in the Notice of Appeal is being treated under 37 CFR 1.182 for situations not specifically provided for as a request to reopen prosecution.

In this instance, the petition request that prosecution be reopened has been made by the third party requester, not the patent owner. Additionally, the request presents newly proposed rejections and is not made in an effort to advance prosecution of the proceeding to define issues for appeal or advance toward the issuance of a reexamination certificate. It is not proper to submit such a petition in a Notice of Appeal. Moreover, the third party requester has since filed its appeal brief in an advancement of the appeal proceedings.

There is no mechanism in the *inter partes* reexamination statute or rules to permit the third party requester to request that prosecution be reopened or to raise new proposed rejections well after filing the request for reexamination. Further, permitting such would not advance the proceedings and would be counter to the statutory mandate of 35 U.S.C. 314(c) to conduct reexamination proceedings "with special dispatch within the Office."

The petition has not been filed in proper form, requests relief not authorized by the statute, contains information not authorized by the statute, and does not present an extraordinary situation in which justice requires waiver of the rules and regulations. In view of the above, and the facts and circumstances presented by the present record, the petition is dismissed, and is found to be an unauthorized 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 third party requester's August 24, 2009 combined petition-appeal paper does not have a right of entry into the record of the present reexamination proceeding, and, as such, is not an authorized paper. Because the August 24, 2009 paper was incorporated into the electronic Image File Wrapper (IFW) for the proceeding before discovery of the impropriety of the paper, the August 24, 2009 paper is being expunged from the record by marking it "non-public" and "closed" in the IFW. See MPEP § 2667. A copy of the present decision will be made of record in the IFW.

Because the Notice of Appeal is part of the combined petition-appeal paper, the Notice of Appeal is being expunged from the record. Requester is given 15 days from the date of this decision to file a corrected Notice of Appeal.

CONCLUSION

1. The petition is **dismissed**, and the combined petition-appeal is expunged from the record.

2. Requester is given **15 days from the date of this decision** to file a corrected Notice of Appeal. This 15-day period is not extendable.

3. A copy of this decision will be made of record in the reexamination file.

4. Any inquiry concerning this decision should be directed to Caroline Dennison, Acting Deputy Director, at (571) 272-7729.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

Nov. 2, 2009

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.
95/001,143	02/11/2009	7343414	4292.01REX01	4158

24113 7590 12/16/2009

PATTERSON, THUENTE, SKAAR & CHRISTENSEN, P.A.
4800 IDS CENTER
80 SOUTH 8TH STREET
MINNEAPOLIS, MN 55402-2100

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 12/16/2009

Please find below and/or attached an Office communication concerning this application or proceeding.

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
NOVAK DRUCE & QUIGG, LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET, FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date:

MAILED

DEC 16 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001143
PATENT NO. : 7343414
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

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(For Patent Owner)

MAILED

DEC 16 2009

CENTRAL REEXAMINATION UNIT

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NOVAK DRUCE & QUIGG, LLP
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1000 LOUISIANA STREET
FIFTY-THIRD FLOOR
HOUSTON, TX 77002

(For Patent Owner)

In re: Lipscomb *et alia*
Inter Partes Reexamination Proceeding
Control No. 95/001,143
Deposited on: 11 February 2009
For: US Patent No. 7,343,414

DECISION
GRANTING-IN-PART
PETITION FOR EXTENSION
OF TIME
[37 CFR §§ 1.956 & 1.181]

This is a decision on the 11 December 2009, "Request for Clarification and 1-Month Extension of Time to Respond to Action Closing Prosecution Under 37 CFR § 1.956 and Petition Under 37 CFR § 1.17(g)" requesting clarification of the response period and extension of time for responding to the Action Closing Prosecution mailed 20 November 2009, be extended by one (1) month. The petition submitted 11 December 2009 was timely filed with certificate of service.

The petition is before the Director of the Central Reexamination Unit for consideration.

The petition is granted-in-part for the reasons set forth below.

DISCUSSION

The Patent Owner's representative requests clarification of the period of time as well as the time be extended in which to file a response to the Action Closing Prosecution mailed 20 November 2009, which set one (1) month's time for filing a response thereto. The petition for extension of time was timely filed on 11 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 request is granted-in-part.

> **37 CFR § 1.956. Patent owner extensions of time in inter partes reexamination.** *The time for taking any action by a patent owner in an inter partes reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified. Any request for such extension must be filed on or before the day on which action by the patent owner is due, but in no case will the mere filing of a request effect any extension. Any request for such extension must be accompanied by the petition set forth in § 1.17(g). See § 1.304(a) for extensions of time for filing a notice of appeal to the U.S. Court of Appeals for the Federal Circuit.*

Addressing the requirement of 37 CFR § 1.956 to make a showing of "sufficient cause" to grant an extension request, MPEP § 2665 states, in pertinent part:

> As noted above, a request for extension of time under 37 CFR § 1.956 will be granted only for sufficient cause, ...
>
> Evaluation of whether "sufficient cause" has been shown for an extension must be made by **balancing** the desire to provide the patent owner with a fair opportunity to respond, **against** the requirement of the statute, 35 U.S.C. § 314(c), that the proceedings be conducted with special dispatch. ...

Any petition request must include the required petition fee as set forth according to 37 CFR § 1.17 (g) and 37 CFR § 1.956.

MPEP § 2665 Extension of Time for Patent Owner Response (in-part)

> Requests for an extension of time in an inter partes reexamination proceeding will be considered only after the first Office action on the merits in the reexamination is mailed. Any request for an extension of time filed prior to the first action will be denied.
>
> The certificate of mailing and the certificate of transmission procedures (37 CFR § 1.8), and the "Express Mail" mailing procedure (37 CFR § 1.10), may be used to file a request for extension of time, as well as any other paper in an existing *inter partes* reexamination proceeding (see MPEP § 2666).
>
> As noted above, a request for extension of time under 37 CFR § 1.956 will be granted only for sufficient cause, and the request must be filed on or before the day on which

action by the patent owner is due. In no case, will the mere filing of a request for extension of time automatically effect any extension, because the showing of cause may be insufficient or incomplete. In the prosecution of an *ex parte* reexamination, an automatic 1-month extension of time to take further action is granted upon filing a first timely response to a final Office action (see MPEP § 2272). The automatic extension given in *ex parte* reexamination does not apply to the first response to an Action Closing Prosecution (ACP) in an inter partes reexamination. The reason is that in *inter partes* reexamination, parties do not file an appeal in response to an ACP, and a further Office action (Right of Appeal Notice) will issue even if the parties make no response at all. Thus, there is no time period to appeal running against the parties after the ACP is issued, unlike ex parte reexamination where an appeal is due after final rejection and the time is thus automatically extended one month to provide time for the patent owner to review the Office's response to the amendment before deciding whether to appeal.

Evaluation of whether "sufficient cause" has been shown for an extension must be made by balancing the desire to provide the patent owner with a fair opportunity to respond, against the requirement of the statute, 35 U.S.C. § 314(c), that the proceedings be conducted with special dispatch.

MPEP § 2662 Time for Response and Comments (in-part)

...

(L) Litigation. Where the reexamination results from a court order or litigation is stayed for purposes of reexamination, the shortened statutory period will generally be set at one month or thirty days, whichever is longer. In addition, if (1) there is litigation concurrent with an inter partes reexamination proceeding and (2) the reexamination proceeding has been pending for more than one year, the Director of the Office of Patent Legal Administration (OPLA), Director of the Central Reexamination Unit (CRU), Director of the Technology Center (TC) in which the reexamination is being conducted, or a Senior Legal Advisor of the OPLA, may approve Office actions in such reexamination proceeding setting a one-month or thirty days, whichever is longer, shortened statutory period for response rather than the two months usually set in reexamination proceedings. A statement at the end of the Office action – "One month or thirty days, whichever is longer, shortened statutory period approved, " followed by the signature of one of these officials, will designate such approval.

DECISION

The patent owner's representative petitions to clarify and extend the period for response by adding in total two (2) months to the given response period. The decision to extend the period for response is

evaluated based upon a showing of "sufficient cause." There is always the consideration to balance the need for the patent owner to have a fair opportunity to respond to the Office action between the need for special dispatch.

The Action Closing Prosecution was mailed 20 November 2009. The patent owner submitted a timely filed the petition on 11 December 2009 with the appropriate fee and certificate of service.

The petition dated 11 December 2009 notes that the shortened statutory period was not properly given since it requires the signature of a certain specified approving officials. The Office action lacks such signature pursuant to MPEP § 2262 (L). Further the petitioner requests an additional month for the purpose of allowing the preparation and submission of a petition for premature Action Closing Prosecution. The mere filing of a petition will not act as a stay of other proceedings.

The petition request to extend the response time is hereby granted-in-part.

A one (1) month extension of time to clarify the response period is hereby granted-in-part.

CONCLUSION

1. The patent owner's petition for extension for two (2) months time in which to file a response to the Action Closing Prosecution dated 20 November 2009 is hereby **granted–in-part.**

2. The period for response is extended by one (1) month.

3. The response is extended to **20 January 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
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Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,144	02/11/2009	7020704	4292.02REX01	4234

24113 7590 12/18/2009

PATTERSON, THUENTE, SKAAR & CHRISTENSEN, P.A.
4800 IDS CENTER
80 SOUTH 8TH STREET
MINNEAPOLIS, MN 55402-2100

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 12/18/2009

Please find below and/or attached an Office communication concerning this application or proceeding.

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United States Patents and Trademark Office
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Alexandria, VA 22313-1450
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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:

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001144
PATENT NO. : 7020704
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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United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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Brad Pedersen
PATTERSON, THUENTE, SKAAR
& CHRISTENSEN, P.A.
4800 IDS CENTER
80 SOUTH 8TH STREET
MINNEAPOLIS MN 55402-2100

(For Patent Owner)

MAILED

DEC 18 2009

CENTRAL REEXAMINATION UNIT

Tracy W Druce
NOVAK DRUCE & QUIGG, LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET
FIFTY-THIRD FLOOR
HOUSTON, TX 77002

(For Patent Owner)

In re: Lipscomb *et alia*
Inter Partes Reexamination Proceeding
Control No. 95/001,144
Deposited on: 11 February 2009
For: US Patent No. 7,020,704

DECISION
GRANTING-IN-PART
PETITION FOR EXTENSION
OF TIME
[37 CFR §§ 1.956 & 1.181]

This is a decision on the 11 December 2009, "Request for Clarification and 1-Month Extension of Time to Respond to Action Closing Prosecution Under 37 CFR § 1.956 and Petition Under 37 CFR § 1.17(g)" requesting clarification of the response period and extension of time for responding to the Action Closing Prosecution mailed 20 November 2009, be extended by one (1) month. The petition submitted 11 December 2009 was timely filed with certificate of service.

The petition is before the Director of the Central Reexamination Unit for consideration.

The petition is granted-in-part for the reasons set forth below.

DISCUSSION

The Patent Owner's representative requests clarification of the period of time as well as the time be extended in which to file a response to the Action Closing Prosecution mailed 20 November 2009, which set one (1) month's time for filing a response thereto. The petition for extension of time was timely filed on 11 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 request is granted-in-part.

> **37 CFR § 1.956. Patent owner extensions of time in inter partes reexamination.** *The time for taking any action by a patent owner in an inter partes reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified. Any request for such extension must be filed on or before the day on which action by the patent owner is due, but in no case will the mere filing of a request effect any extension. Any request for such extension must be accompanied by the petition set forth in § 1.17(g). See § 1.304(a) for extensions of time for filing a notice of appeal to the U.S. Court of Appeals for the Federal Circuit.*

Addressing the requirement of 37 CFR § 1.956 to make a showing of "sufficient cause" to grant an extension request, MPEP § 2665 states, in pertinent part:

> As noted above, a request for extension of time under 37 CFR § 1.956 will be granted only for sufficient cause, ...
>
> Evaluation of whether "sufficient cause" has been shown for an extension must be made by **balancing** the desire to provide the patent owner with a fair opportunity to respond, **against** the requirement of the statute, 35 U.S.C. §.314(c), that the proceedings be conducted with special dispatch. ...

Any petition request must include the required petition fee as set forth according to 37 CFR § 1.17 (g) and 37 CFR § 1.956.

MPEP § 2665 Extension of Time for Patent Owner Response (in-part)

> Requests for an extension of time in an inter partes reexamination proceeding will be

considered only after the first Office action on the merits in the reexamination is mailed. Any request for an extension of time filed prior to the first action will be denied.

The certificate of mailing and the certificate of transmission procedures (37 CFR § 1.8), and the "Express Mail" mailing procedure (37 CFR § 1.10), may be used to file a request for extension of time, as well as any other paper in an existing *inter partes* reexamination proceeding (see MPEP § 2666).

As noted above, a request for extension of time under 37 CFR § 1.956 will be granted only for sufficient cause, and the request must be filed on or before the day on which action by the patent owner is due. In no case, will the mere filing of a request for extension of time automatically effect any extension, because the showing of cause may be insufficient or incomplete. In the prosecution of an *ex parte* reexamination, an automatic 1-month extension of time to take further action is granted upon filing a first timely response to a final Office action (see MPEP § 2272). The automatic extension given in *ex parte* reexamination does not apply to the first response to an Action Closing Prosecution (ACP) in an inter partes reexamination. The reason is that in *inter partes* reexamination, parties do not file an appeal in response to an ACP, and a further Office action (Right of Appeal Notice) will issue even if the parties make no response at all. Thus, there is no time period to appeal running against the parties after the ACP is issued, unlike ex parte reexamination where an appeal is due after final rejection and the time is thus automatically extended one month to provide time for the patent owner to review the Office's response to the amendment before deciding whether to appeal.

Evaluation of whether "sufficient cause" has been shown for an extension must be made by balancing the desire to provide the patent owner with a fair opportunity to respond, against the requirement of the statute, 35 U.S.C. § 314(c), that the proceedings be conducted with special dispatch.

MPEP § 2662 Time for Response and Comments (in-part)

(C) After an Action Closing Prosecution (ACP). The patent owner may once file written comments and /or present a proposed amendment to the claims within the time period set in the ACP. 37 CFR § 1.951(a). Normally, the ACP will set a period of 30 days or one month (whichever is longer) from the mailing date of the ACP. Where the patent owner files comments and /or a proposed amendment, the third party requester may once file comments responsive to the patent owner 's submission within 30 days from the date of service of the patent owner 's submission on the third party requester. 37 CFR § 1.951(b). (emphasis added)

...

(L) Litigation. Where the reexamination results from a court order or litigation is stayed for purposes of reexamination, the shortened statutory period will generally be set at one month or thirty days, whichever is longer. In addition, if (1) there is litigation concurrent with an inter partes reexamination proceeding and (2) the reexamination proceeding has been pending for more than one year, the Director of the Office of Patent Legal Administration (OPLA), Director of the Central Reexamination Unit (CRU), Director of the Technology Center (TC) in which the reexamination is being conducted, or a Senior Legal Advisor of the OPLA, may approve Office actions in such reexamination proceeding setting a one-month or thirty days, whichever is longer, shortened statutory period for response rather than the two months usually set in reexamination proceedings. A statement at the end of the Office action – "One month or thirty days, whichever is longer, shortened statutory period approved, " followed by the signature of one of these officials, will designate such approval.

DECISION

The patent owner's representative petitions to clarify and extend the period for response by adding in total two (2) months to the given response period. The decision to extend the period for response is evaluated based upon a showing of "sufficient cause." There is always the consideration to balance the need for the patent owner to have a fair opportunity to respond to the Office action between the need for special dispatch.

The Action Closing Prosecution was mailed 20 November 2009. The patent owner submitted a timely filed the petition on 11 December 2009 with the appropriate fee and certificate of service.

The petition dated 11 December 2009 notes that the shortened statutory period was not properly given since it requires the signature of a certain specified approving officials. While the petitioner is correct that MPEP 2663 (L) does require directors signature, MPEP 2662(C) is the correct section for setting the time for Action Closing Prosecution. It is noted that the examiner in the action dated 20 November 2009 cited the correct section. However, there is confusion with the cover sheet which states 2 months time for response. Further the petitioner requests an additional month for the purpose of allowing the preparation and submission of a petition for premature Action Closing Prosecution. The mere filing of a petition will not act as a stay of other proceedings.

The petition request to extend the response time is hereby granted-in-part.

A one (1) month extension of time to clarify the response period is hereby granted-in-part.

CONCLUSION

1. The patent owner's petition for extension for two (2) months time in which to file a response to the Action Closing Prosecution dated 20 November 2009 is hereby **granted –in-part.**

2. The period for response is extended by one (1) month.

3. The response is extended to **20 January 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
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,144	02/11/2009	7020704	4292.02REX01	4234

24113 7590 12/31/2009

PATTERSON, THUENTE, SKAAR & CHRISTENSEN, P.A.
4800 IDS CENTER
80 SOUTH 8TH STREET
MINNEAPOLIS, MN 55402-2100

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 12/31/2009

Please find below and/or attached an Office communication concerning this application or proceeding.

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
NOVAK DRUCE & QUIGG, LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET, FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date: MAILED

DEC 3 1 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001144
PATENT NO. : 7020704
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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Brad Pedersen
PATTERSON, THUENTE, SKAAR
& CHRISTENSEN, P.A.
4800 IDS CENTER
80 SOUTH 8TH STREET
MINNEAPOLIS MN 55402-2100

(For Patent Owner)

MAILED

DEC 3 1 2009

CENTRAL REEXAMINATION UNIT

Tracy W Druce
NOVAK DRUCE & QUIGG, LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET
FIFTY-THIRD FLOOR
HOUSTON, TX 77002

(For Third Party Requester)

In re: Lipscomb *et alia*
Inter Partes Reexamination Proceeding
Control No. 95/001,144
Deposited on: 11 February 2009
For: US Patent No. 7,020,704

CORRECTED
DECISION
GRANTING-IN-PART
PETITION FOR EXTENSION
OF TIME
[37 CFR §§ 1.956 & 1.181]

This is a corrected decision on the 11 December 2009, "Request for Clarification and 1-Month Extension of Time to Respond to Action Closing Prosecution Under 37 CFR § 1.956 and Petition Under 37 CFR § 1.17(g)" requesting clarification of the response period and extension of time for responding to the Action Closing Prosecution mailed 01 December 2009, be extended by one (1) month. The petition submitted 11 December 2009 was timely filed with certificate of service.

This decision corrects the response date error in the decision mailed 18 December 2009.

The petition is before the Director of the Central Reexamination Unit for consideration.

The petition is granted-in-part for the reasons set forth below.

DISCUSSION

The Patent Owner's representative requests clarification of the period of time as well as the time be extended in which to file a response to the Action Closing Prosecution mailed 01 December 2009, which set one (1) month's time for filing a response thereto. The petition for extension of time was timely filed on 11 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 request is granted-in-part.

> **37 CFR § 1.956. Patent owner extensions of time in inter partes reexamination.** *The time for taking any action by a patent owner in an inter partes reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified. Any request for such extension must be filed on or before the day on which action by the patent owner is due, but in no case will the mere filing of a request effect any extension. Any request for such extension must be accompanied by the petition set forth in § 1.17(g). See § 1.304(a) for extensions of time for filing a notice of appeal to the U.S. Court of Appeals for the Federal Circuit.*

Addressing the requirement of 37 CFR § 1.956 to make a showing of "sufficient cause" to grant an extension request, MPEP § 2665 states, in pertinent part:

> As noted above, a request for extension of time under 37 CFR § 1.956 will be granted only for sufficient cause, ...
>
> Evaluation of whether "sufficient cause" has been shown for an extension must be made by **balancing** the desire to provide the patent owner with a fair opportunity to respond, **against** the requirement of the statute, 35 U.S.C. § 314(c), that the proceedings be conducted with special dispatch. ...

Any petition request must include the required petition fee as set forth according to 37 CFR § 1.17 (g) and 37 CFR § 1.956.

MPEP § 2665 Extension of Time for Patent Owner Response (in-part)

> Requests for an extension of time in an inter partes reexamination proceeding will be

considered only after the first Office action on the merits in the reexamination is mailed. Any request for an extension of time filed prior to the first action will be denied.

The certificate of mailing and the certificate of transmission procedures (37 CFR § 1.8), and the "Express Mail" mailing procedure (37 CFR § 1.10), may be used to file a request for extension of time, as well as any other paper in an existing *inter partes* reexamination proceeding (see MPEP § 2666).

As noted above, a request for extension of time under 37 CFR § 1.956 will be granted only for sufficient cause, and the request must be filed on or before the day on which action by the patent owner is due. In no case, will the mere filing of a request for extension of time automatically effect any extension, because the showing of cause may be insufficient or incomplete. In the prosecution of an *ex parte* reexamination, an automatic 1-month extension of time to take further action is granted upon filing a first timely response to a final Office action (see MPEP § 2272). The automatic extension given in *ex parte* reexamination does not apply to the first response to an Action Closing Prosecution (ACP) in an inter partes reexamination. The reason is that in *inter partes* reexamination, parties do not file an appeal in response to an ACP, and a further Office action (Right of Appeal Notice) will issue even if the parties make no response at all. Thus, there is no time period to appeal running against the parties after the ACP is issued, unlike ex parte reexamination where an appeal is due after final rejection and the time is thus automatically extended one month to provide time for the patent owner to review the Office's response to the amendment before deciding whether to appeal.

Evaluation of whether "sufficient cause" has been shown for an extension must be made by balancing the desire to provide the patent owner with a fair opportunity to respond, against the requirement of the statute, 35 U.S.C. § 314(c), that the proceedings be conducted with special dispatch.

MPEP § 2662 Time for Response and Comments (in-part)

(C) After an Action Closing Prosecution (ACP). The patent owner may once file written comments and /or present a proposed amendment to the claims within the time period set in the ACP. 37 CFR § 1.951(a). Normally, the ACP will set a period of 30 days or one month (whichever is longer) from the mailing date of the ACP. Where the patent owner files comments and /or a proposed amendment, the third party requester may once file comments responsive to the patent owner 's submission within 30 days from the date of service of the patent owner 's submission on the third party requester. 37 CFR § 1.951(b). (emphasis added)

...

(L) Litigation. Where the reexamination results from a court order or litigation is stayed for purposes of reexamination, the shortened statutory period will generally be set at one month or thirty days, whichever is longer. In addition, if (1) there is litigation concurrent with an inter partes reexamination proceeding and (2) the reexamination proceeding has been pending for more than one year, the Director of the Office of Patent Legal Administration (OPLA), Director of the Central Reexamination Unit (CRU), Director of the Technology Center (TC) in which the reexamination is being conducted, or a Senior Legal Advisor of the OPLA, may approve Office actions in such reexamination proceeding setting a one-month or thirty days, whichever is longer, shortened statutory period for response rather than the two months usually set in reexamination proceedings. A statement at the end of the Office action – "One month or thirty days, whichever is longer, shortened statutory period approved, " followed by the signature of one of these officials, will designate such approval.

DECISION

The patent owner's representative petitions to clarify and extend the period for response by adding in total two (2) months to the given response period. 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 01 December 2009. The patent owner submitted a timely filed the petition on 11 December 2009 with the appropriate fee and certificate of service.

The petition dated 11 December 2009 notes that the shortened statutory period was not properly given since it requires the signature of a certain specified approving officials. While the petitioner is correct that MPEP 2663 (L) does require directors signature, MPEP 2662(C) is the correct section for setting the time for Action Closing Prosecution. It is noted that the examiner in the action dated 01 December 2009 cited the correct section. However, there is confusion with the cover sheet which states 2 months time for response. Further the petitioner requests an additional month for the purpose of allowing the preparation and submission of a petition for premature Action Closing Prosecution. The mere filing of a petition will not act as a stay of other proceedings.

The petition request to extend the response time is hereby granted-in-part.

A one (1) month extension of time to clarify the response period is hereby granted-in-part.

CONCLUSION

1. The patent owner's petition for extension for two (2) months time in which to file a response to the Action Closing Prosecution dated 01 December 2009 is hereby **granted –in-part.**

2. The period for response is extended by one (1) month.

3. The response is extended to **01 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
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5. Telephone inquiries with regard to this decision should be directed to Mark Reinhart, at (571) 272-1611, in the absence of Mark Reinhart calls may be directed to Eric Keasel, at (571) 272-4929, or Jessica Harrison, at (571) 272-4449, all are Supervisory Patent Examiners in the Central Reexamination Unit, Art Unit 3992.

/Mark Reinhart/

_____

Mark Reinhart,
Supervisory Patent Examiner,
AU 3992,
Central Reexamination Unit
571-272-1611

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,148	02/19/2009	6542660	29776.149	2485

20786 7590 09/14/2009

KING & SPALDING
1180 PEACHTREE STREET , NE
ATLANTA, GA 30309-3521

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 09/14/2009

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.
95/001,148	02/19/09	6542660	29776.149

EXAMINER
NGUYEN, TUAN

HAYNES AND BOONE, LLP
IP SECTION
2323 VICTORY AVENUE, SUITE 700
DALLAS, TX 75219

ART UNIT	PAPER
3992	

MAILED

DATE MAILED:

SEP 14 2009

CENTRAL REEXAMINATION UNIT

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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King & Spalding
1180 Peachtree Street , NE
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(For Patent Owner)

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SEP 14 2009

CENTRAL REEXAMINATION UNIT

Haynes and Boone, LLP
IP Section
2323 Victory Avenue, Suite 700
Dallas, TX75219

(For *Inter Partes* Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,148
Filed: February 19, 2009
For: US Patent No. 6,542,660

DECISION GRANTING PETITION

This is a decision on the patent owner paper entitled "COMBINED PETITION TO EXCEED THE PAGE LIMIT FOR PATENT OWNER'S RESPONSE IN AN *INTER PARTES* REEXAMINATION AND DECLARATION IN SUPPORT," filed on July 6, 2009.

The patent owner petition is before the Office of Patent Legal Administration for consideration and will be treated as a petition under 37 CFR 1.183 for waiver of the page limit requirements of 37 CFR 1.943(b).

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. 11-0980, as authorized on page 3 of the petition.

The patent owner petition under 37 CFR 1.183 is granted for the concurrently submitted (July 6, 2009) patent owner response under 37 CFR 1.945 for the reasons set forth herein.

REVIEW OF THE RELEVANT FACTS

1. United States Patent Number 6,542,660 (the '660 patent) issued on April 1, 2003.

2. On February 19, 2009, a request for *inter partes* reexamination of the '660 patent was filed by a third party requester, and assigned Reexamination Control No. 95/001,148 (the '1148 proceeding).

3. On May 4, 2009, the Office issued an order granting *inter partes* reexamination in the '1148 proceeding with an accompanying first Office action on the merits.

4. On July 6, 2009, patent owner filed the instant petition paper in the '1148 proceeding entitled, "COMBINED PETITION TO EXCEED THE PAGE LIMIT FOR PATENT OWNER'S RESPONSE IN AN *INTER PARTES* REEXAMINATION AND DECLARATION IN SUPPORT" (petition under 37 CFR 1.183).

5. Concurrently on July 6, 2009, patent owner filed, as a separate paper, a response under 37 CFR 1.945 to the May 4, 2009 Office action entitled "AMENDMENT AND 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.

Discussion

On July 6, 2009, patent owner concurrently filed, with the instant petition, a response under 37 CFR 1.945 to the May 4, 2009 Office action. As patent owner asserts in the instant petition under 37 CFR 1.183, the July 6, 2009 response includes identification information, claim amendments, remarks/arguments, claim listing (Appendix A), reference materials (Exhibits B, C, E, F, and G) and declarations (Exhibit A and Exhibit D) and exceeds the 50-page limit set forth in 37 CFR 1.943(b).[1] In particular, patent owner asserts that approximately 75 pages are required for a "full and complete response to the Office action" and requests waiver of the 50-page limit of 37 CFR 1.943(b) for the 25 pages of the portions of patent owner's July 6, 2009 response that are included in the regulatory page count that exceed the 50-page limit.[2]

---

[1] *See* petition under 37 CFR 1.183 at page 2, paragraph 4

[2] *See* id. 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). Patent owner states on page 2, paragraph 4 of the petition under 37

In support of waiver of the rule, patent owner asserts that "enforcing the page limit would prevent the patent Owner from making a full and complete response to the Office Action as required by the patent statute and rules."[3] In particular, patent owner states that its request for entry of 75-pages "is less than one-third of the total number of pages relied on by the Examiner in the Office Action and the materials incorporated by reference."[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. In addition, patent owner has provided explanation of how the submitted response economizes, excludes extraneous material, and is arranged so as not to repeat information already of record.[5]

Based on the specific facts set forth in patent owner's 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 the portions of patent owner's July 6, 2009 response that are included in the regulatory page count that exceed the 50-page limit by 25 pages.

Accordingly, patent owner's petition under 37 CFR 1.183 is **granted** to the extent that the page limit of 37 CFR 1.943(b) is waived as to **25 pages** of the portions of patent owner's July 6, 2009 response that are included in the regulatory page count exceed the 50-page limit.

CONCLUSION

1. The patent owner July 6, 2009 petition under 37 CFR 1.183 is granted. The page limit of 37 CFR 1.943(b) is waived as to 25 pages of the portions of patent owner's July 6, 2009 response that are included in the regulatory page count that exceed the 50-page limit.

CFR 1.183 that the page limit count excludes the pages of the response that include amendments (and explanations of support in the specification for those amendments), appendices of claims, and reference materials, but includes the declarations.

[3] Petition under 37 CFR 1.183 at page 2, paragraph 5.

[4] *See* petition under 37 CFR 1.183 at page 2, paragraph 4. *See also* petition under 37 CFR 1.183 at pages 1-2, paragraph 2 (stating, "The Office Action mailed on May 4, 2009 was 41 pages and adopted 21 grounds for rejecting the claims of U.S. Patent No. 6,542,660. The Examiner incorporates approximately 104 pages of the Request for *Inter Partes* Reexamination. Additionally, the Examiner incorporates by reference all of Exhibit M, which is 58 pages, all of Exhibit N, which is 46 pages, at least 14 pages of Exhibit O, and all of Exhibit P, which is 10 pages, a total of 128 pages. Together, the Examiner relies on 273 pages forming the basis for the Request.").

[5] Petition under 37 CFR 1.183 at page 2, paragraph 3 (stating "Patent Owner's undersigned representative has attempted in good faith to comply with the page limit in preparing this response. For example, where possible, remarks that apply to multiple claims rejected by the same teachings have made reference to other portions of the Response. As another example, certain arguments have been omitted when other presented remarks were sufficient to distinguish a claim element over the cited prior art.").

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
Senior Legal Advisor
Office of Patent Legal Administration

Ken/pet7/IP/length/grant
Sept. 11, 2009

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.
95/001,148	02/19/2009	6542660	29776.149	2485

20786 7590 12/10/2009

KING & SPALDING
1180 PEACHTREE STREET , NE
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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 12/10/2009

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.
95/001,148	02/19/09	6542660	29776.149

EXAMINER
NGUYEN, TUAN

HAYNES AND BOONE, LLP
IP SECTION
2323 VICTORY AVENUE, SUITE 700
DALLAS, TX 75219

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3992	

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CENTRAL REEXAMINATION UNIT

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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 Patent Owner)

HAYNES AND BOONE, LLP
IP SECTION
2323 VICTORY AVENUE, SUITE 700
DALLAS, TX 75219

(For *Inter Partes* Requester)

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CENTRAL REEXAMINATION UNIT

Inter Partes Reexamination Proceeding
Control No. 95/001,148
Filed: February 19, 2009
For: US Patent No. 6,542,660

: **DECISION**
: **GRANTING**
: **PETITION**

This is a decision on the third party requester petition paper entitled "PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE PAGE LIMIT REQUIREMENT FOR THIRD PARTY REQUESTER COMMENTS UNDER 37 C.F.R. § 1.943(b)," filed on October 12, 2009.

The petition under 37 CFR 1.183 is before the Office of Patent Legal Administration for consideration.

The petition fee of $400.00 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183 was charged to third party requester's Deposit Account No. 08-1394, as authorized on page 2 of the petition.

The petition under 37 CFR 1.183 is granted for the concurrently submitted (October 12, 2009) third party requester comments under 37 CFR 1.947 for the reasons set forth herein.

REVIEW OF THE RELEVANT FACTS

1. United States Patent Number 6,542,660 (the '660 patent) issued on April 1, 2003.

2. On February 19, 2009, a request for *inter partes* reexamination of the '660 patent was filed by a third party requester, and assigned Reexamination Control No. 95/001,148 (the '1148 proceeding).

3. On May 4, 2009, the Office issued an order granting *inter partes* reexamination in the '1148 proceeding with an accompanying first Office action on the merits.

4. On July 6, 2009, patent owner filed a petition paper in the '1148 proceeding entitled, "COMBINED PETITION TO EXCEED THE PAGE LIMIT FOR PATENT OWNER'S RESPONSE IN AN *INTER PARTES* REEXAMINATION AND DECLARATION IN SUPPORT."

5. Concurrently on July 6, 2009, patent owner filed, as a separate paper, a response under 37 CFR 1.945 to the May 4, 2009 Office action entitled "AMENDMENT AND RESPONSE."

6. On September 14, 2009, the Office mailed a decision granting patent owner's July 6, 2009 petition under 37 CFR 1.183, waiving the page limit of 37 CFR 1.943(b) as to patent owner's July 6, 2009 response.

7. On October 12, 2009, third party requester filed the instant petition paper in the '1148 proceeding entitled, "PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE PAGE LIMIT REQUIREMENT FOR THIRD PARTY REQUESTER COMMENTS UNDER 37 C.F.R. § 1.943(b)."

8. Concurrently on October 12, 2009, third party requester filed, as a separate paper, in the '1148 proceeding "COMMENTS BY THIRD PARTY REQUESTER PURSUANT TO 37 C.F.R. §1.947" with accompanying declarations under 37 CFR 1.132.

DECISION

Relevant Statutes, Regulations and Procedures

37 CFR 1.183 provides:

> In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.943(b) provides:

> Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

37 CFR 1.947 provides:

> Each time the patent owner files a response to an Office action on the merits pursuant to § 1.945, a third party requester may once file written comments within a period of 30 days from the date of service of the patent owner's response. These comments shall be limited to issues raised by the Office action or the patent owner's response. The time for submitting comments by the third party requester may not be extended. For the purpose of filing the written comments by the third party requester, the comments will be considered as having been received in the Office as of the date of deposit specified in the certificate under § 1.8.

Discussion

On October 12, 2009, third party requester concurrently filed, with the instant petition under 37 CFR 1.183, comments under 37 CFR 1.947 (accompanied by two declarations under 37 CFR 1.132) responsive to the May 4, 2009 Office action and to the patent owner's July 6, 2009 response (which was entered on September 14, 2009). As third party requester asserts in the instant petition under 37 CFR 1.183, the October 12, 2009 comments total 69 pages in length, thereby exceeding the 50-page limit set forth in 37 CFR 1.943(b) by 19 pages.[1] Accordingly, third party requester requests waiver of 37 CFR 1.943(b) for the October 12, 2009 comments.

In support of waiver of the rule, third party requester asserts that patent owner added 51 new claims to the pending 21 claims in its July 6, 2009 response and that "[i]n order to effectively address the patentability of each of the 51 new claims and rebut issues raised in the Patent Owner's Reply, the Third Party Requester has found it necessary to exceed the page limit ...."[2] Further, third party requester noted that the Office granted patent owner's July 6, 2009 petition under 37 CFR 1.183, waiving 37 CFR 1.943(b) for patent owner's July 6, 2009 response.[3] Additionally, 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 comments in compliance with the 50-page limit, and submitting the resulting comments, which are in excess of 50 pages. In view of the foregoing, third party requester asserts "that the granting of the subject petition is in keeping with the substantial interest of justice in that the Requester should have the opportunity to effectively address each of the 51 new claims and all of the issues raised by the lengthy Patent Owner's Reply. Furthermore, allowing the Third Party Requester to adequately respond to the patentability of each of the new claims will help the Examiner expedite the subsequent examination which is to be conducted with special dispatch in accordance with 37 C.F.R. § 1.937."[4]

---

[1] *See* petition under 37 CFR 1.183 at page 1 (asserting that the October 12, 2009 comments total 62 pages (excluding listings of exhibits and certificate of service) and the accompanying declarations total 7 pages).

[2] Petition under 37 CFR 1.183 at page 1.

[3] *See* petition under 37 CFR 1.183 at page 1 and the September 14, 2009 decision granting patent owner's July 6, 2009 petition under 37 CFR 1.183 (waiving the page limit of 37 CFR 1.943(b) as to 25 pages of the portions of patent owner's July 6, 2009 response, which are included in the regulatory page count, that exceed the 50-page limit).

[4] Petition under 37 CFR 1.183 at page 2.

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 comments in compliance with the 50-page limit and submitting the resulting 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 12, 2009 comments, which exceed the 50-page limit by 19 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 **19 pages** of the portions of third party requester's October 12, 2009 comments (including the accompanying declarations under 37 CFR 1.132), which are included in the regulatory page count, that exceed the 50-page limit.

CONCLUSION

1. Third party requester's October 12, 2009 petition under 37 CFR 1.183 is granted. The page limit of 37 CFR 1.943(b) is waived as to 19 pages of the portions of third party requester's October 12, 2009 comments (including the accompanying declarations under 37 CFR 1.132), which are included in the regulatory page count, that exceed the 50-page limit.

2. Jurisdiction for the instant reexamination proceeding is returned to the Central Reexamination Unit (CRU).

3. Any questions concerning this communication should be directed to Nicole Dretar, Legal Advisor, at 571-272-7717.

Kenneth M. Schor

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

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Ann Williams
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Garrett & Dunner, L.L.P.
901 New York Avenue, NW
Washington, DC 20001-4413

(Courtesy Copy - Patent Owner)

In re Farmwald et al.
Inter partes Reexamination Proceeding
Control No. 95/000,178
Filed: October 6, 2006
For: U.S. Patent No. 6,324,120

In re Farmwald et al.
Inter partes Reexamination Proceeding
Control No. 95/001,152
Filed: February 27, 2009
For: U.S. Patent No. 6,324,120

DECISION, *SUA SPONTE*,
TO MERGE REEXAMINATION
PROCEEDINGS

The above-captioned reexamination proceedings are before the Office of Patent Legal Administration for *sua sponte* consideration of whether the proceedings should be merged under 37 CFR 1.989 at this time.

REVIEW OF FACTS

1. United States Patent Number 6,324,120 (the '120 patent) issued to Farmwald et al. on November 27, 2001 with 39 claims.

2. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/000,178 ('018), was initially deposited by third party requester, identifying Samsung Electronics Co., Ltd. as the real party in interest, on September 15, 2006 and received a filing date of August 22, 2007.[1]

3. An order granting reexamination of claims 1-39 of the '120 patent was mailed for the '178 reexamination proceeding on October 19, 2007.

4. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/001,152 ('1152), was initially deposited by third party requester Micron Technology on February 27, 2009 and received a filing date of February 27, 2009.

5. Prosecution proceeded in the '178 proceeding to the point that an action closing prosecution was issued on February 13, 2009, patent owner filed comments under 37 CFR 1.951(a) on March 16, 2009, and third party filed comments under 37 CFR 1.951(b) on April 15, 2009.

6. An order granting reexamination of claims 26, 29, and 33 of the '120 patent was mailed for the '1152 reexamination proceeding on April 22, 2009.

7. No Office action has been mailed in the '1152 proceeding, and no amendments to the claims have been made in either of the '178 and the '1152 *inter partes* reexamination proceedings.

DECISION

I. MERGER OF PROCEEDINGS

Under 37 CFR 1.989(a):

> If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the merged examination will normally result in the issuance of a single reexamination certificate under § 1.997.

[1] A decision mailed August 14, 2007 vacated an earlier granted October 6, 2006 filing date and an order granting reexamination issued on December 26, 2006.

As evidenced by the above review of facts, both the '178 and the '1152 reexamination proceedings are currently pending. The order to reexamine has been mailed for both reexamination proceedings, and a decision under 37 CFR 1.989(a) is timely.

The general policy of the Office is that two reexamination proceedings will not be conducted separately, and at the same time, as to a particular patent. The rationale for this policy is (1) to prevent inconsistent, and possibly conflicting, amendments from being introduced into the two proceedings on behalf of the patent owner, (2) to provide a comprehensive examination of the patent based on the issues raised in both of the proceedings, and (3) to expedite the prosecution of both proceedings. In the present instance, where there is overlap in the claims subject to reexamination in the two proceedings, merger of the 95/000,178 and 95/001,152 reexamination proceedings would address these considerations. Thus, pursuant to 37 CFR 1.989(a), the 95/000,178 and 95/001,152 reexamination proceedings are hereby merged. The merged proceeding will be conducted in accordance with the guidelines and requirements which follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

The claims are identical in both proceedings. The patent owner is required to continue to maintain the same claims (and specification) in both files *throughout the merged proceeding.*

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

The present decision merges an *inter partes* reexamination proceeding with another *inter partes* reexamination proceeding. Pursuant to 37 CFR 1.989(b), the merged proceeding is governed by 37 CFR 1.902 through 1.997.

B. Papers mailed/filed:

All papers mailed by the Office throughout the merged proceeding will take the form of a single action which applies to both proceedings. All papers issued by the Office or filed by the patent owner and the third party requesters will contain the identifying data for both proceedings and will be entered in each reexamination file. All papers filed by the patent owner and the third party requesters must consist of a single paper, **filed in duplicate**, each bearing a signature and identifying data for both proceedings, for entry into the file for each proceeding.

All papers that are filed by the patent owner and the third party requesters should be directed:

By U.S. Postal Service Mail:

Mail Stop *Inter Partes* Reexam
Central Reexamination Unit
Commissioner for Patents
United States Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX to:

(571) 273-9900
Central Reexamination Unit

By hand (or delivery service):

Customer Service Window
Attn: Central Reexamination Unit
Randolph Building
401 Dulaney St.
Alexandria, VA 22314

The patent owner and the requesters are reminded that every paper filed in the merged proceeding subsequent to this Decision must be served on the other parties, including papers filed *via* facsimile transmission.

C. Amendments:

The filing of any amendments to the specification, claims, and drawings must comply with the provisions of 37 CFR 1.530 and the guidelines of MPEP § 2666. 37 CFR 1.121 does not apply to amendments in a reexamination proceeding. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via markings pursuant to 37 CFR 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

Pursuant to 37 CFR 1.530(i), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the request for reexamination. Amendments are not to be made relative to previous amendments. Thus, for all amendments, all words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets.

D. Fees:

Where a paper is filed which requires payment of a fee (e.g., extension of time fee, excess claims fee, petition fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For example, only one fee need be paid for patent owner's appellant brief (or that of one of the *inter partes* reexamination requesters), even though the brief relates to merged multiple proceedings and even though copies must be filed (as pointed out above) for each file in the merged proceeding.

E. Citation of Patents and Printed Publications:

Upon return of the present merged proceeding to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.

PATENT OWNER'S ADDRESS

The current correspondence address of record for the patent file is the proper patent owner address for reexamination mailings pursuant to 37 CFR 1.33(c), and it is that of Ann Williams, Rambus, Inc., 4440 El Camino Real, Los Altos, CA 94022.

A change of correspondence address was filed in each of the reexamination proceedings designating the Finnegan Henderson address noted above for all future correspondence to patent owner. As a courtesy, this decision is being mailed to both patent owner addresses.

The address of Ann Williams, Rambus, Inc., 4440 El Camino Real, Los Altos, CA 94022, will be the sole address for patent owner used in future correspondence, until a change in correspondence address in the patent and the reexamination is made in accordance with 37 CFR 1.33(c).

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/000,178 and *inter partes* Reexamination Control No. 95/001,152 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

2. Jurisdiction over the merged reexamination is being forwarded via the Central Reexamination Unit Director to the examiner for the preparation of an Office action, to be issued in due course for the merged proceeding.

3. Any questions concerning this communication should be directed to Pinchus M. Laufer, Legal Advisor at (571)272-7726.

Kenneth M. Schor
Senior Legal Advisor
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UNITED STATES PATENT AND TRADEMARK OFFICE

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JUL 21 2009

CENTRAL REEXAMINATION UNIT

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(For Patent Owner)

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(For 95/001,108 Requester)

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1000 LOUISIANA STREET 53rd FLOOR
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(For 95/001,154 Requester)

In re Farmwald et al.
Inter partes Reexamination Proceeding
Control No.: 95/001,108
Filed: November 7, 2008
For: U.S. Patent No. 6,584,037

In re Farmwald et al.
Inter partes Reexamination Proceeding
Control No. 95/001,154
Filed: March 3, 2009
For: U.S. Patent No. 6,584,037

DECISION, *SUA SPONTE*, TO MERGE REEXAMINATION PROCEEDINGS

The above-captioned reexamination proceedings are before the Office of Patent Legal Administration for *sua sponte* consideration of whether the proceedings should be merged under 37 CFR 1.989 at this time.

REVIEW OF RELEVANT FACTS

1. U. S. Patent Number 6,584,037 (the '037 patent) issued to Farmwald et al. on June 24, 2003, with 45 claims.

2. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/001,108 ('1108 proceeding), was filed by third party requester on November 7, 2008. Samsung Electronics, Co. Ltd. is identified as the real party in interest.

3. An order granting reexamination of claim 34 of the '037 patent was mailed for the '1108 reexamination proceeding on January 9, 2009.

4. An Office action containing at least one rejection of claim 34 of the '037 patent was mailed for the '1108 reexamination proceeding on February 13, 2009.

5. Patent owner filed a timely response on May 13, 2009, retaining original patent claims 1-45 as unamended.

6. Third party requester filed timely comments on June 12, 2009, pursuant to 37 CFR 1.947.

7. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/001,154 ('1154 proceeding), was filed March 3, 2009, by third party requester Micron Technology, Inc.

8. An order granting reexamination of claim 34 of the '037 patent was mailed for the '1154 reexamination proceeding on April 22, 2009.

9. No Office action has been mailed, and no amendments to the claims have been made, in the '1154 *inter partes* reexamination proceeding.

DECISION

I. MERGER OF PROCEEDINGS

Under 37 CFR 1.989(a):

> If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the merged examination will normally result in the issuance of a single reexamination certificate under § 1.997.

As evidenced by the above review of facts, both the '1108 and the '1154 reexamination proceedings are currently pending. The order to reexamine has been mailed for both reexamination proceedings, and a decision under 37 CFR 1.989(a) is timely.

The general policy of the Office is that two reexamination proceedings will not be conducted separately, and at the same time, as to a particular patent. The rationale for this policy is (1) to prevent inconsistent, and possibly conflicting, amendments from being introduced into the two proceedings on behalf of the patent owner, (2) to provide a comprehensive examination of the patent based on the issues raised in both of the proceedings, and (3) to expedite the prosecution of both proceedings. In the present instance, merger of the 95/001,108 and 95/001,154 reexamination proceedings would address these considerations. Thus, pursuant to 37 CFR 1.989(a), the 95/001,108 and 95/001,154 reexamination proceedings are hereby merged. The merged proceeding will be conducted in accordance with the guidelines and requirements which follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

The claims are identical in both proceedings. The patent owner is required to continue to maintain the same claims (and specification) in both files *throughout the merged proceeding*.

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

The present decision merges an *inter partes* reexamination proceeding with another *inter partes* reexamination proceeding. Pursuant to 37 CFR 1.989(b), the merged proceeding is governed by 37 CFR 1.902 through 1.997.

B. Papers mailed/filed:

All papers mailed by the Office throughout the merged proceeding will take the form of a single action which applies to both proceedings. All papers issued by the Office or filed by the patent owner and the third party requesters will contain the identifying data for both proceedings and will be entered in each reexamination file. All papers filed by the patent owner and the third party requesters must consist of a single paper, **filed in duplicate**, each bearing a signature and identifying data for both proceedings, for entry into the file for each proceeding.

All papers that are filed by the patent owner and the third party requesters should be directed:

By EFS: Registered users may submit via the electronic filing system EFS-Web, at https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html.

By Mail to: Mail Stop *Inter Partes* Reexam
Attn: Central Reexamination Unit
Commissioner for Patents
United States Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX to: (571) 273-9900
Central Reexamination Unit

By hand (or delivery service):

Customer Service Window
Attn: Central Reexamination Unit
Randolph Building, Lobby Level
401 Dulany Street
Alexandria, VA 22314

For EFS-Web transmissions, 37 CFR 1.8(a)(1)(i) (C) and (ii) states that correspondence (except for a request for reexamination and a corrected or replacement request for reexamination) will be considered timely filed if (a) it is transmitted via the Office's electronic filing system in accordance with 37 CFR 1.6(a)(4), and (b) includes a certificate of transmission for each piece of correspondence stating the date of transmission, which is prior to the expiration of the set period of time in the Office action.

The patent owner and the requesters are reminded that every paper filed in the merged proceeding subsequent to this Decision must be served on the other parties, including papers filed *via* facsimile transmission.

C. Amendments:

The filing of any amendments to the specification, claims, and drawings must comply with the provisions of 37 CFR 1.530 and the guidelines of MPEP § 2666. 37 CFR 1.121 does not apply to amendments in a reexamination proceeding. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via markings pursuant to 37 CFR 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

Pursuant to 37 CFR 1.530(i), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the request for reexamination. Amendments are not to be made relative to previous amendments. Thus, for all amendments, all words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets.

D. Fees:

Where a paper is filed which requires payment of a fee (e.g., extension of time fee, excess claims fee, petition fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For example, only one fee need be paid for patent owner's appellant brief (or that of one of the *inter partes* reexamination requesters), even though the brief relates to merged multiple proceedings

and even though copies must be filed (as pointed out above) for each file in the merged proceeding.

E. Citation of Patents and Printed Publications:

Upon return of the present merged proceeding to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/001,108 and *inter partes* Reexamination Control No. 95/001,154 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

2. Jurisdiction over the merged reexamination is being forwarded via the Central Reexamination Unit Director to the examiner for the preparation of an Office action, to be issued in due course for the merged proceeding.

3. Any questions concerning this communication should be directed to Pinchus M. Laufer, Legal Advisor, at (571) 272-7726.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

July 10, 2009
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UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,154	03/03/2009	6,584,037	8963.002.RXUS00	7630

22852 7590 07/27/2010

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 07/27/2010

Please find below and/or attached an Office communication concerning this application or proceeding.

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/001,154	03/03/2009	6584037	

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EXAMINER
OVIDIO, ESCALANTE

ART UNIT	PAPER
3992	

DATE MAILED:

07/27/10

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.
95/001,154	03/03/2009	6584037	

EXAMINER
OVIDIO, ESCALANTE

ART UNIT	PAPER
3992	

TRACY W. DRUCE
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HOUSTON, TX 77002

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 patent owner)

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(For the '1108 *inter partes* requester)

Tracy W. Druce
NOVAK, DRUCE & QUIGG, LLP
1000 Louisiana Avenue, 53rd Floor
Houston, TX 77002

(For the '1154 *inter partes* requester)

MAILED

JUL 27 2010

CENTRAL REEXAMINATION UNIT

In re Farmwald *et al.*
Inter Partes Reexamination Proceeding
Control No.: 95/001,108
Filed: November 7, 2008
For: U.S. Patent No.: 6,584,037

In re Farmwald *et al.*
Inter Partes Reexamination Proceeding
Control No.: 95/001,154
Filed: March 3, 2009
For: U.S. Patent No.: 6,584,037

DECISION DISMISSING PETITION

This is a decision on the June 10, 2010 patent owner petition entitled "PETITION TO STRIKE PORTIONS OF THE THIRD PARTY REQUESTER'S APPEAL BRIEF AND UNMERGE THE MERGED REEXAMINATION PROCEEDING."

The petition is before the Office of Patent Legal Administration of the United States Patent and Trademark Office.

The petition is dismissed.

BACKGROUND

1. On June 24, 2003 the Office issued U.S. Patent No. 6,584,037 to Farmwald *et al.*

2. On November 7, 2008, a request for *inter partes* reexamination was filed, which was assigned reexamination proceeding control No. 95/001,108 ("the '1108 proceeding"), by third party requester Samsung Electronics, Co. Ltd., the real party in interest.

3. On January 9, 2009, the Office issued an order granting the request for *inter partes* reexamination in the '1108 proceeding.

4. On February 13, 2009, the Office issued a first Office action on the merits in the '1108 proceeding.

5. On March 9, 2009, a request for *inter partes* reexamination was filed, which was assigned reexamination proceeding control no. 95/001,154 ("the '1154 proceeding"), by third party requester Micron Technology, the real party in interest.

6. On April 22, 2009, the Office issued an order granting the request for *inter partes* reexamination in the '1154 proceeding.

7. On May 13, 2009, patent owner timely filed a response to the February 13, 2009 Office action of the '1108 proceeding.

8. On June 12, 2009, third party requester timely filed comments after the May 13, 2009 patent owner response.

9. On July 21, 2009, the Office *sua sponte* issued a decision merging the '1108 and '1154 proceedings ("the merged proceeding").

10. On February 19, 2010, prosecution in the merged proceeding advanced to where the Office issued a Right of Appeal Notice (RAN).

11. On March 10, 2010, the '1154 third party requester filed a Notice of Appeal.

12. On May 10, 2010, the '1154 third party requester filed an Appellant's Brief.

13. On June 10, 2010, patent owner filed the present petition concurrently with a Respondent's Brief.

RELEVANT RULE AND GUIDANCE

37 CFR 1.4(c) states:

> Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects.

37 CFR 1.181(f) states:

> The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

DECISION

I. Improper Petition under 37 CFR 1.4(c)

The present petition requests multiple forms of relief. When two different forms of relief are being requested in a single petition, such petition is improper under 37 CFR 1.4(c). However, in the interest of special dispatch, pursuant to 35 U.S.C. 314, patent owner's petition to demerge ("unmerge") the merged *inter partes* reexamination proceeding is being addressed in this decision. Patent owner's petition under 37 CFR 1.182 to strike portions of the third party requester's appeal brief 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. If patent owner wishes to renew the petition under 37 CFR 1.182 to strike, it should be filed as a petition under 37 CFR 1.181 to challenge the Central Reexamination Unit's (CRU's) placement of the requester's appeal brief in the Image File Wrapper (IFW) record of the two merged proceedings, based on the asserted improper content as to portions to the appeal brief. Patent owner is actually requesting that the appeal brief be expunged and replaced by a redacted or revised appeal brief to exclude the portions of the paper argued to be improper.

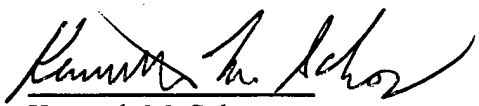
II. Untimely Petition under 37 CFR 1.181(f)

37 CFR 1.181(f) provides that any petition submitted under part 1 of 37 C.F.R. that is not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely. Patent owner's June 10, 2010 petition is challenging the July 21, 2009 Office decision to merge *inter partes* proceedings 95/001,108 and 95/001,154. Patent owner's June 10, 2009 petition requesting demerger of proceedings was submitted almost a year after the decision to merge was issued, and more important, after the appeal has be initiated and briefed for the merged proceeding. It would be inequitable to delay the proceeding and possibly need to regress the proceeding at this time. The petition is untimely; accordingly, the June 10, 2010 petition to demerge is dismissed as untimely.

CONCLUSION

1. Patent owner's June 10, 2010 petition is **dismissed**.

2. Telephone inquiries related to this decision should be directed to Joseph F. Weiss, Jr., Legal Advisor, at (571) 272-7759.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

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Kenpetmerger/reexreex/pet to demerge

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,159	03/24/2009	7177998	2805.001REX7	2219

26111 7590 12/16/2009

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
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WASHINGTON, DC 20005

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 12/16/2009

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,159	03/24/2009	7177998	2805.001REX7	2219

26111 7590 12/16/2009

EXAMINER

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DALLAS, TX 75219

ART UNIT	PAPER NUMBER

DATE MAILED: 12/16/2009

Please find below and/or attached an Office communication concerning this application or proceeding.

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HAYNES & BOONE, LLP IP SECTION (For *inter partes* Requester)
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DALLAS, TX 75219

ORRICK, HERRINGTON & SUTCLIFFE, LLP (For *ex parte* Requester)
Attn: Fabio E. Marino
1000 Marsh Road
Menlo Park, CA 94025

MAILED

DEC 16 2009

CENTRAL REEXAMINATION UNIT

In re Ware *et al.*
Inter partes Reexamination Proceeding
Control No.: 95/001,159
Filed: March 24, 2009
For: U.S. Patent No. 7,177,998

In re Ware *et al.*
Ex Parte Reexamination Proceeding
Control No.: 90/009,358
Filed: December 8, 2008
For: U.S. Patent No. 7,177,998

: DECISION
: DISMISSING
: PETITION TO
: PREVENT MERGER
: AND
: MERGER OF
: REEXAMINATION
: PROCEEDINGS

This is a decision on patent owner's October 14, 2009 patent owner petition entitled "PETITION UNDER 37 C.F.R. §§ 1.182 and 1.183 REGARDING MERGER OF CO-PENDING REEXAMINATION PROCEEDINGS" filed in *ex parte* reexamination proceeding 90/009,358.

The Patent Owner petition 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 was charged to Patent Owner's credit card on October 15, 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 for decision.

Patent Owner's petition is dismissed, and the above captioned proceedings are merged in accordance with 37 CFR 1.989 for the reasons set forth below.

REVIEW OF FACTS

1. On February 13, 2007, the Office issued U.S. Patent No. 7,177,998 (the '998 patent) to Ware *et al.*

2. The '998 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-SI}. The initial complaint was filed July 10, 2008. Based upon the record, patent owner is enforcing at least one of claims 1-24 against the requester in the litigation.

3. On November 6, 2008, an International Trade Commission (ITC) action was filed. The ITC investigation is docketed as *Certain Semiconductor Chips Having Synchronous Random Access Memory Controllers and Products Containing Same, Including Graphics Cards and Motherboards*, Docket No. 2637.

4. On December 8, 2008, a request for *ex parte* reexamination of claims 7, 13, 21 and 22 of the '998 patent was filed by third party requester, NVIDIA Corporation. The request was assigned Control No. 90/009,358 (the '9358 proceeding).

5. On January 16, 2009, the Office issued an order granting the '9358 request for *ex parte* reexamination and setting a two month time period for a Patent Owner's Statement. The order indicated that claims 7, 13, 21 and 22 of the '998 patent, would be subject to reexamination.

6. The time for filing a patent owner's statement pursuant to 37 CFR 1.530 in the '9358 *ex parte* reexamination proceeding expired on March 16, 2009.[1]

7. On March 24, 2009, a request for *inter partes* reexamination of all the claims (claims 1-24) of the '998 patent was filed by the same third party requester (NVIDIA Corporation). The request was assigned Control No. 95/001,159 (the '1159 proceeding).

8. On May 8, 2009, the Office issued a first Office action on the merits in the '9358 *ex parte* reexamination proceeding.

9. On May 26, 2009, the Office issued an order granting the '1159 request for *inter partes* reexamination and stating that a first action on the merits would be issued in due course. The order indicated that all the claims of the '998 patent, claims 1-24, would be subject to reexamination.

---

[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 August 10, 2009, Patent Owner filed a response in the '9358 *ex parte* reexamination proceeding. The response did not amend, cancel or add new claims.

11. On October 14, 2009, patent owner filed the present petition in the '9358 proceeding to prevent merger with the '1159 *inter partes* proceeding.

12. This decision addresses Patent Owner's petition to prevent merger.

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 1.181 (in pertinent part) states

> (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;
>
> (f) The mere filing of a petition will not stay any period for reply that may be

running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

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 1.948 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.

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 2240 II states (in part):

In certain situations, after a grant of a second or subsequent request for *ex parte* reexamination, where (A) the patent owner files a petition under 37 CFR 1.182 as part of the statement or as the statement, and (B) it appears clear that the second or subsequent request was filed for purposes of harassment of the patent owner, if the petition is granted, prosecution on the second or subsequent reexamination would be suspended. Merger of such a second or subsequent request with the already pending reexamination proceeding(s) would unduly prolong the conclusion of the pending reexamination and be inconsistent with the requirement

that reexamination proceeding be conducted with special dispatch.

MPEP 2246 II states (in part):

> A petition under 37 CFR 1.181 may, however, be filed to vacate an *ultra vires* reexamination order, such as where the order for reexamination is not based on prior art patents and printed publications. In cases where no discretion to grant a request for reexamination exists, a petition to vacate the decision to grant, or a request for reconsideration, will be entertained.

MPEP 2248 states (in part):

> 37 CFR 1.515(c) applies only where reexamination is denied; it does not apply to a grant of reexamination where either the patent owner or the requester is not satisfied with one or more findings made in a decision granting reexamination. Except for the limited exception described in MPEP § 2246, no petition may be filed requesting review of a decision granting a request for reexamination, even if the decision grants the request as to a specific claim for reasons other than those advanced by the requester. No right to review exists as to that claim, because it will be reexamined in view of all prior art during the reexamination under 37 CFR 1.550.

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 2646 II states (in part):

> A petition under 37 CFR 1.181 may, however, be filed to vacate an *ultra vires* reexamination order, such as where the order for reexamination is not based on prior art patents and printed publications. In cases where no discretion to grant a request for reexamination exists, a petition to vacate the decision to grant, or a request for reconsideration, will be entertained.

MPEP 2648 states (in part):

> Except for the limited *ultra vires* exception described in MPEP § 2646, no petition may be filed requesting review of a decision granting a request for reexamination even if the decision grants the request as to a specific claim for

> reasons other than those advanced by the third party requester. No right to review exists as to that claim, because it will be reexamined in view of all prior art during the reexamination under 37 CFR 1.937.

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 (2) - The earlier (pending) reexamination is an *ex parte* reexamination:
>
> (2)(a) The subsequent request is an *inter partes* reexamination request. ***Any party*** other than the patent owner can file the subsequent *inter partes* reexamination request. (Emphasis added)

DECISION

Findings and Analysis

Patent owner asserts the filing of an *ex parte* reexamination request followed by the filing of an *inter partes* reexamination request on the same patent, is precluded by statute, 35 U.S.C. 317(a). Patent owner further asserts this reexamination filing pattern combined with a subsequent merger of the two reexamination proceedings will deny Patent Owner of "*ex parte* reexamination rights". Finally Patent owner asserts that merging of the two present proceedings is improper because the later filed *inter partes* reexamination request was granted based upon the same substantial new question of patentability (SNQ) granted in the earlier filed *ex parte* reexamination request. Patent owner requests the remedies of: (1) Suspension of the *inter partes* reexamination proceeding; (2) Non-merger of the *inter partes* and *ex parte* reexamination proceedings; or (3) Waiver of 37 CFR 1.989(b) to permit interviews, if the *inter partes* and *ex parte* reexamination proceedings are merged.

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 not

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. However, any *ex parte* reexamination filing must contain a substantial, new and non-cumulative question of patentability. 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 §§ 1.33(a) and 1.560 provide guidelines for conducting and making a record of interviews, 37 CFR §§ 1.33(a) and 1.560 do not confer an absolute 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, use of one set of rules, namely the *inter partes* rules and relevant MPEP guidance, is necessary to facilitate the statutory mandate of special dispatch. The arrangement proposed by Patent Owner, 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.

Circumvention of 35 U.S.C. 317(a). Patent Owner alleges that merging the '1159 *inter partes* reexamination proceeding with the '9358 *ex parte* reexamination proceeding circumvents the statutory prohibition of 35 U.S.C. 317(a) that precludes a single third party requester of an

---

[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

ordered *inter partes* reexamination from filing a subsequent *inter partes* reexamination requests 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 of an *ex parte* reexamination with an *inter partes* reexamination, under 37 CFR 1.989(b), converts the *ex parte* reexamination proceeding into a "*de facto*" *inter partes* reexamination proceeding. Patent owner then extrapolates this logic to multiple *ex parte* filings by the same requester upon the same patent to conclude that such a strategy would result in multiple "*de facto*" *inter partes* reexamination proceedings. As the Office as a matter of routine practice always merges in such instance, Patent Owner asserts that the statutory mandate of special dispatch will be challenged. Patent Owner goes on to note that the requester in the present proceeding has employed a multiple filing strategy on eight other different but related patents in Patent Owner's portfolio. 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 for denying merger between the present proceedings. The logic of the Sony cases asserted is that the subsequent filing of an *ex parte* reexamination proceeding merged with a previously filed *inter partes* reexamination by the same requester converts the *ex parte* proceeding into a "*de facto*" *inter partes* reexamination proceeding, and hence a violation of the statute. Patent Owner concedes that the present proceedings are not under suspension, as was the case in the '093 and '094 proceedings. Patent Owner requests thus that the proceedings not be merged, or if merged that 37 CFR 1.989(b) be waived so that Patent Owner may retain "*ex parte* rights" to those issues raised in the *ex parte* reexamination proceeding.

The statutory prohibition of 35 U.S.C. 317(a) is not implicated by requester's filing of an *ex parte* reexamination request prior to the filing of an *inter partes* reexamination request. The plain language of the statute states, in part:

> . . . [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 prior to filing an *inter partes* reexamination request. The statute does not prohibit the filing of *inter partes* reexamination requests by a requester, that previously filed an *ex parte* reexamination request on the same patent. The non-merge 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 *per se* 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.

Finally, Patent Owner's "parade of horribles" argument that the confluence of an *inter partes* reexamination with multiple *ex parte* reexamination filings and the Office's routine practice of granting merger will result in a frustration of special dispatch is misplaced. Patent Owner's "parade of horribles" will not come about due the statutory, regulatory and policy protections put in place to prevent such a strategy from being employed against a Patent Owner in a reexamination proceeding. By statute, any reexamination requests must contain a substantial, new and non-cumulative question of patentability. By regulation the Office permits a third party requester to file prior art during an *inter partes* reexamination proceeding in very specific circumstances, in a manner that precludes harassment of the Patent Owner. Finally, MPEP §§ 2240 II and 2640 II both set forth an appropriate procedure for petitioning the suspension of any second or subsequently ordered request for reexamination if the Patent Owner can clearly show an intent to harass the Patent Owner. Therefore, Patent Owner's "parade of horribles" filing strategy will not occur, due to these statutory, regulatory and policy mechanisms, which deters and prevents harassment of a patent owner.

In view of the above, Patent Owner's argument that merger violates 35 U.S.C. 317(a) is not persuasive.

Prevention of Merger or Waiver of 37 CFR 1.989(b). Patent Owner asserts that, based upon the facts and circumstances surrounding the filings of the '1159 *inter partes* reexamination proceeding and the '9358 *ex parte* reexamination proceeding, merger should not be granted. Patent Owner further asserts that, based upon the facts and circumstances surrounding the filings even if merger occurs, 37 CFR 1.989(b) should be waived to permit Patent Owner's retention of full *ex parte* reexamination rights. Patent Owner states that merger of the proceedings without waiver of 37 CFR 1.989(b) both expands the requester's rights while curtailing the patent owner's rights. Finally, Patent Owner states that rout merger of proceedings filed in this manner

only encourages this pattern of filing reexamination requests, which encourages piecemeal reexamination, resulting in a waste of Office resources, a frustration of the statutory mandate of special dispatch and a removal of the distinction between *inter partes* and *ex partes* reexamination proceedings.[5]

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, as based upon the statutory mandate of special dispatch, facilitates the timely and efficient disposition of reexamination proceedings, and does not create a burden on the Office as argued by Patent Owner. The very basis of the policy of merger is to reduce the burden upon the Office that separate, concurrent reexamination proceedings on the same patent present. Patent Owner's proposed arrangement of either not merging or merging, but permitting Patent Owner *ex parte* interviews in a merged proceeding, will burden the Office and frustrate the statutory mandate of special dispatch. The conduct of two concurrent proceedings on the same patent with two disparate sets of procedural rules instead of one will result in a burden on the Office relative to a single merged proceeding. Merging, but permitting Patent Owner *ex parte* interviews on the *ex parte* SNQs will also burden the Office in the form of additional monitoring and administration of interview to protect the rights of all the parties. And, as pointed out above, 37 CFR §§ 1.133(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.

Asserted Improvident SNQ Analysis. Patent Owner alleges the Office improvidently granted the '1159 *inter partes* reexamination request. Patent Owner alleges that the same substantial new question (SNQ), based upon the Coteus reference, was previously raised in the '9358 *ex parte* reexamination request. Patent owner alleges that the examiner did not comply with the procedures outlined in MPEP 2640 II, by ordering the '1159 reexamination request. Patent owner argues that to now merge the '1159 *inter partes* reexamination with the '9358 *ex parte* reexamination would "endorse" the improvident granting of the '1159 reexamination request and "eviscerate" the Patent Owner's ability to challenge the subsequently field and granted *inter*

[5] Presumably intimating the previously asserted argument of a statutory violation of 35 U.S.C. 317(a)

partes reexamination under its "*ex parte* reexamination rights."

The issue is moot as any Patent Owner *ultra vires* petition regarding the propriety of granting the '1159 request would be untimely in accordance with 37 CFR 1.181(f). Furthermore, even if timely, Patent owner's argument is in error. As noted above, outside of the right to submit a statement in accordance with 35 U.S.C. 304, *ex parte* reexamination does not confer any other statutory *ex parte* reexamination rights upon a patent owner that is not conferred by *inter partes* reexamination. Merger does not occur in an *ex parte* reexamination proceeding until the time for submission of a Patent Owner statement has passed. Therefore merger does not derogate any *ex parte* reexamination unique right. Any challenge to the grant of a reexamination request would have needed to have been made in the proceeding that was granted second. In this instance that would be the '1159 *inter partes* proceeding, which would be devoid of any "*ex parte* rights". The procedure for challenging the granting of a request for reexamination is the same for both *ex parte* reexamination and *inter partes* reexamination, an *ultra vires* petition under 37 CFR 1.181. See MPEP §§ 2246 II, 2646 II; See also MPEP §§ 2248, 2648. Therefore, as 37 CFR 1.989 places any merged proceeding that contains at least one *inter partes* proceeding under the *inter partes* rules, Patent Owner rights regarding challenge to the grant of the *inter partes* proceeding could not be altered by merger. However, as noted previously, the filing of an *ultra vires* petition under 37 CFR 1.181 would be untimely.

Accordingly, the petition to stay the *inter partes* proceeding, prevent merger or modify any merged proceeding to preserve "*ex parte* rights" is dismissed.

III. Merger of the Proceedings

As reexamination has been ordered for both proceedings, and there is no longer an opportunity for filing a patent owner's statement and/or requester's reply, consideration of merger is ripe at this point in time.

Under 37 CFR 1.989(a):

> If any reexamination is ordered while a prior inter partes reexamination proceeding is pending for the same patent and prosecution in the prior inter partes reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the merged examination will normally result in the issuance of a single reexamination certificate under § 1.997.

In accordance with 37 CFR 1.989 (a), the 95/001,159 and 90/009,358 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

A. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

Patent owner is required to maintain the same claims (and specification) in both files throughout

the merged proceeding. Since the claims are the same in both files, a "housekeeping amendment" is NOT needed.

B. CONDUCT OF MERGED PROCEEDING

1. Governing regulations for the merged proceeding:

The present decision merges an *ex parte* reexamination proceeding with an *inter partes* reexamination proceeding. Pursuant to 37 CFR 1.989(b), the merged proceeding is governed by 37 CFR 1.902 through 1.997, except that the rights of the third party requester of the *ex parte* reexamination are governed by 37 CFR 1.510 through 1.560. In this instance, however, the *ex parte* reexamination was requested by the same third party as in the *inter partes* reexamination. And, that third party has full *inter partes* reexamination participation rights.

2. Papers mailed/filed:

All papers mailed by the Office throughout the merged proceeding will take the form of a single action that applies to both reexamination proceedings. All papers issued by the Office or filed by the patent owner and the third party requester will contain the identifying data for both files and will be physically entered in each reexamination file. All papers filed by the patent owner and the third party requester must consist of a single paper, filed in duplicate, each bearing a signature and identifying data for both files, for entry into each file.

All papers filed by the patent owner and the third party requester should be directed:

By EFS:

> Registered users may submit the response via the electronic filing system EFS-Web, at: https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html

By U.S. Postal Service Mail:

> Mail Stop *Inter Partes* Reexam
> Central Reexamination Unit
> Commissioner for Patents
> United States Patent & Trademark Office
> P.O. Box 1450
> Alexandria, VA 22313-1450

By FAX to:

(571) 273-9900
Central Reexamination Unit

By hand (or delivery service):

Customer Service Window
Attn: Central Reexamination Unit
Randolph Building
401 Dulany St.
Alexandria, VA 22314

Patent owner and requester are reminded that every paper filed in the merged proceeding subsequent to this Decision must be served on the other party, including any papers filed via facsimile transmission.

3. Amendments:

The filing of any amendments to the drawings, specification or claims must comply with the provisions of 37 CFR 1.530 and the guidelines of MPEP § 2250. 37 CFR 1.121 does not apply to amendments in reexamination. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via markings pursuant to paragraph 37 CFR 1.530(f) of this section, except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

Pursuant to 37 CFR 1.530(i), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the request for reexamination. Amendments are not to be made relative to previous amendments. Thus, for all amendments, all words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets.

4. Fees:

Where a paper is filed which requires payment of a fee (e.g., petition fee, excess claims fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For example, only one fee need be paid for any patent owner's appellant brief (or that of the inter partes requester) which may be filed, even though the brief relates to merged multiple proceedings and copies must be filed (as pointed out above) for each file in the merged proceeding.

5. Citation of Patents and Printed Publications:

Upon return of the present merged proceeding to the examiner, the examiner will review the files to insure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.

CONCLUSION

1. The October 14, 2009 Patent Owner petition is dismissed.

2. *Inter partes* Reexamination Control No. 95/001,159 and *ex parte* Reexamination Control No. 90/009,358 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

3. Jurisdiction over the merged reexamination files is being forwarded via the Director of the Central Reexamination Unit (CRU) to the examiner, for the preparation of an Office action, to be issued in due course.

4. Telephone inquiries related to the present decision should be directed to Joseph F. Weiss, Jr., Reexamination Legal Advisor, at 571-272-7759.

Kenneth M. Schor
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.
95/001,160	03/24/2009	7210016	2805.001REX6	2351

26111 7590 12/16/2009

HAYNES AND BOONE, LLP IP SECTION
2323 VICTORY AVENUE
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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 12/16/2009

Please find below and/or attached an Office communication concerning this application or proceeding.

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95/001,160	03/24/2009	7210016	2805.001REX6	2351

26111 7590 12/16/2009

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1100 NEW YORK AVENUE, N.W.
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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 12/16/2009

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ORRICK, HERRINGTON & SUTCLIFFE, LLP (For *ex parte* Requester)
Attn: Fabio E. Marino
1000 Marsh Road
Menlo Park, CA 94025

MAILED

DEC 16 2009

CENTRAL REEXAMINATION UNIT

In re Ware *et al.*
Inter partes Reexamination Proceeding
Control No.: 95/001,160
Filed: March 24, 2009
For: U.S. Patent No. 7,210,016

In re Ware *et al.*
Ex Parte Reexamination Proceeding
Control No.: 90/009,357
Filed: December 8, 2008
For: U.S. Patent No. 7,210,016

: DECISION
: DISMISSING
: PETITION TO
: PREVENT MERGER
: AND
: MERGER OF
: REEXAMINATION
: PROCEEDINGS

This is a decision on patent owner's October 14, 2009 patent owner petition entitled "PETITION UNDER 37 C.F.R. §§ 1.182 and 1.183 REGARDING MERGER OF CO-PENDING REEXAMINATION PROCEEDINGS" filed in *ex parte* reexamination proceeding 90/009,357.

The Patent Owner petition 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 was charged to Patent Owner's credit card on October 15, 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 for decision.

Patent Owner's petition is dismissed, and the above captioned proceedings are merged in accordance with 37 CFR 1.989 for the reasons set forth below.

REVIEW OF FACTS

1. On April 24, 2007, the Office issued U.S. Patent No. 7,210,016 (the '016 patent) to Ware *et al.*

2. The '016 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-SI}. The initial complaint was filed July 10, 2008. Based upon the record, patent owner is enforcing at least one of claims 1-24 against the requester in the litigation.

3. On November 6, 2008, an International Trade Commission (ITC) action was filed. The ITC investigation is docketed as *Certain Semiconductor Chips Having Synchronous Random Access Memory Controllers and Products Containing Same, Including Graphics Cards and Motherboards*, Docket No. 2637.

4. On December 8, 2008, a request for *ex parte* reexamination of claims 7, 13, 21 and 22 of the '016 patent was filed by third party requester NVIDIA Corporation. The request was assigned Control No. 90/009,357 (the '9357 proceeding).

5. On January 16, 2009, the Office issued an order granting the '9357 request for *ex parte* reexamination and setting a two month time period for a Patent Owner's Statement. The order indicated that claims 7, 13, 21 and 22 of the '016 patent, would be subject to reexamination.

6. The time for filing a patent owner's statement pursuant to 37 CFR 1.530 in the '9357 *ex parte* reexamination proceeding expired on March 16, 2009.[1]

7. On March 24, 2009, a request for *inter partes* reexamination of all the claims (claims 1-24) of the '016 patent was filed by the same third party requester (NVIDIA Corporation). The request was assigned Control No. 95/001,160 (the '1160 proceeding).

8. On May 8, 2009, the Office issued a first Office action on the merits in the '9357 *ex parte* reexamination proceeding.

9. On May 26, 2009, the Office issued an order granting the '1160 request for *inter partes* reexamination and stating that a first action on the merits would be issued in due course. The order indicated that all the claims of the '016 patent, claims 1-24, would be subject to reexamination.

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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 August 10, 2009, Patent Owner filed a response in the '9357 *ex parte* reexamination proceeding. The response did not amend, cancel or add new claims.

11. On October 14, 2009, patent owner filed the present petition in the '9357 proceeding to prevent merger with the '1160 *inter partes* proceeding.

12. This decision addresses Patent Owner's petition to prevent merger.

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 1.181 (in pertinent part) states

> (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;
>
> (f) The mere filing of a petition will not stay any period for reply that may be

running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

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 1.948 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.

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 2240 II states (in part):

In certain situations, after a grant of a second or subsequent request for *ex parte* reexamination, where (A) the patent owner files a petition under 37 CFR 1.182 as part of the statement or as the statement, and (B) it appears clear that the second or subsequent request was filed for purposes of harassment of the patent owner, if the petition is granted, prosecution on the second or subsequent reexamination would be suspended. Merger of such a second or subsequent request with the already pending reexamination proceeding(s) would unduly prolong the conclusion of the pending reexamination and be inconsistent with the requirement

that reexamination proceeding be conducted with special dispatch.

MPEP 2246 II states (in part):

> A petition under 37 CFR 1.181 may, however, be filed to vacate an *ultra vires* reexamination order, such as where the order for reexamination is not based on prior art patents and printed publications. In cases where no discretion to grant a request for reexamination exists, a petition to vacate the decision to grant, or a request for reconsideration, will be entertained.

MPEP 2248 states (in part):

> 37 CFR 1.515(c) applies only where reexamination is denied; it does not apply to a grant of reexamination where either the patent owner or the requester is not satisfied with one or more findings made in a decision granting reexamination. Except for the limited exception described in MPEP § 2246, no petition may be filed requesting review of a decision granting a request for reexamination, even if the decision grants the request as to a specific claim for reasons other than those advanced by the requester. No right to review exists as to that claim, because it will be reexamined in view of all prior art during the reexamination under 37 CFR 1.550.

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 2646 II states (in part):

> A petition under 37 CFR 1.181 may, however, be filed to vacate an *ultra vires* reexamination order, such as where the order for reexamination is not based on prior art patents and printed publications. In cases where no discretion to grant a request for reexamination exists, a petition to vacate the decision to grant, or a request for reconsideration, will be entertained.

MPEP 2648 states (in part):

> Except for the limited *ultra vires* exception described in MPEP § 2646, no petition may be filed requesting review of a decision granting a request for reexamination even if the decision grants the request as to a specific claim for

> reasons other than those advanced by the third party requester. No right to review exists as to that claim, because it will be reexamined in view of all prior art during the reexamination under 37 CFR 1.937.

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 (2) - The earlier (pending) reexamination is an *ex parte* reexamination:
>
> (2)(a) The subsequent request is an *inter partes* reexamination request. ***Any party*** other than the patent owner can file the subsequent *inter partes* reexamination request. (Emphasis added)

DECISION

Findings and Analysis

Patent owner asserts the filing of an *ex parte* reexamination request followed by the filing of an *inter partes* reexamination request on the same patent, is precluded by statute, 35 U.S.C. 317(a). Patent owner further asserts this reexamination filing pattern combined with a subsequent merger of the two reexamination proceedings will deny Patent Owner of "*ex parte* reexamination rights". Finally Patent owner asserts that merging of the two present proceedings is improper because the later filed *inter partes* reexamination request was granted based upon the same substantial new question of patentability (SNQ) granted in the earlier filed *ex parte* reexamination request. Patent owner requests the remedies of: (1) Suspension of the *inter partes* reexamination proceeding; (2) Non-merger of the *inter partes* and *ex parte* reexamination proceedings; or (3) Waiver of 37 CFR 1.989(b) to permit interviews, if the *inter partes* and *ex parte* reexamination proceedings are merged.

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 not

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. However, any *ex parte* reexamination filing must contain a substantial, new and non-cumulative question of patentability. 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 §§ 1.33(a) and 1.560 provide guidelines for conducting and making a record of interviews, 37 CFR §§ 1.33(a) and 1.560 do not confer an absolute 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, use of one set of rules, namely the *inter partes* rules and relevant MPEP guidance, is necessary to facilitate the statutory mandate of special dispatch. The arrangement proposed by Patent Owner, 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.

Circumvention of 35 U.S.C. 317(a). Patent Owner alleges that merging the '1160 *inter partes* reexamination proceeding with the '9357 *ex parte* reexamination proceeding circumvents the statutory prohibition of 35 U.S.C. 317(a) that precludes a single third party requester of an

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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

ordered *inter partes* reexamination from filing a subsequent *inter partes* reexamination requests 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 of an *ex parte* reexamination with an *inter partes* reexamination, under 37 CFR 1.989(b), converts the *ex parte* reexamination proceeding into a "*de facto*" *inter partes* reexamination proceeding. Patent owner then extrapolates this logic to multiple *ex parte* filings by the same requester upon the same patent to conclude that such a strategy would result in multiple "*de facto*" *inter partes* reexamination proceedings. As the Office as a matter of routine practice always merges in such instance, Patent Owner asserts that the statutory mandate of special dispatch will be challenged. Patent Owner goes on to note that the requester in the present proceeding has employed a multiple filing strategy on eight other different but related patents in Patent Owner's portfolio. 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 for denying merger between the present proceedings. The logic of the Sony cases asserted is that the subsequent filing of an *ex parte* reexamination proceeding merged with a previously filed *inter partes* reexamination by the same requester converts the *ex parte* proceeding into a "*de facto*" *inter partes* reexamination proceeding, and hence a violation of the statute. Patent Owner concedes that the present proceedings are not under suspension, as was the case in the '093 and '094 proceedings. Patent Owner requests thus that the proceedings not be merged, or if merged that 37 CFR 1.989(b) be waived so that Patent Owner may retain "*ex parte* rights" to those issues raised in the *ex parte* reexamination proceeding.

The statutory prohibition of 35 U.S.C. 317(a) is not implicated by requester's filing of an *ex parte* reexamination request prior to the filing of an *inter partes* reexamination request. The plain language of the statute states, in part:

> . . . [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 prior to filing an *inter partes* reexamination request. The statute does not prohibit the filing of *inter partes* reexamination requests by a requester, that previously filed an *ex parte* reexamination request on the same patent. The non-merge 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 *per se* 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.

Finally, Patent Owner's "parade of horribles" argument that the confluence of an *inter partes* reexamination with multiple *ex parte* reexamination filings and the Office's routine practice of granting merger will result in a frustration of special dispatch is misplaced. Patent Owner's "parade of horribles" will not come about due the statutory, regulatory and policy protections put in place to prevent such a strategy from being employed against a Patent Owner in a reexamination proceeding. By statute any reexamination requests must contain a substantial, new and non-cumulative question of patentability. By regulation the Office permits a third party requester to file prior art during an *inter partes* reexamination proceeding in very specific circumstances, in a manner that precludes harassment of the Patent Owner. Finally, MPEP §§ 2240 II and 2640 II both set forth an appropriate procedure for petitioning the suspension of any second or subsequently ordered request for reexamination if the Patent Owner can clearly show an intent to harass the Patent Owner. Therefore, Patent Owner's "parade of horribles" filing strategy will not occur, due to these statutory, regulatory and policy mechanisms, which deters and prevents harassment of a patent owner.

In view of the above, Patent Owner's argument that merger violates 35 U.S.C. 317(a) is not persuasive.

Prevention of Merger or Waiver of 37 CFR 1.989(b). Patent Owner asserts that, based upon the facts and circumstances surrounding the filings of the '1160 *inter partes* reexamination proceeding and the '9357 *ex parte* reexamination proceeding, merger should not be granted. Patent Owner further asserts that, based upon the facts and circumstances surrounding the filings even if merger occurs, 37 CFR 1.989(b) should be waived to permit Patent Owner's retention of full *ex parte* reexamination rights. Patent Owner states that merger of the proceedings without waiver of 37 CFR 1.989(b) both expands the requester's rights while curtailing the patent owner's rights. Finally, Patent Owner states that rout merger of proceedings filed in this manner

only encourages this pattern of filing reexamination requests, which encourages piecemeal reexamination, resulting in a waste of Office resources, a frustration of the statutory mandate of special dispatch and a removal of the distinction between *inter partes* and *ex partes* reexamination proceedings.[5]

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, as based upon the statutory mandate of special dispatch, facilitates the timely and efficient disposition of reexamination proceedings, and does not create a burden on the Office as argued by Patent Owner. The very basis of the policy of merger is to reduce the burden upon the Office that separate, concurrent reexamination proceedings on the same patent present. Patent Owner's proposed arrangement of either not merging or merging, but permitting Patent Owner *ex parte* interviews in a merged proceeding, will burden the Office and frustrate the statutory mandate of special dispatch. The conduct of two concurrent proceedings on the same patent with two disparate sets of procedural rules instead of one will result in a burden on the Office relative to a single merged proceeding. Merging, but permitting Patent Owner *ex parte* interviews on the *ex parte* SNQs will also burden the Office in the form of additional monitoring and administration of interview to protect the rights of all the parties. And, as pointed out above, 37 CFR §§ 1.133(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.

Asserted Improvident SNQ Analysis. Patent Owner alleges the Office improvidently granted the '1160 *inter partes* reexamination request. Patent Owner alleges that the same substantial new question (SNQ), based upon the Coteus reference, was previously raised in the '9357 *ex parte* reexamination request. Patent owner alleges that the examiner did not comply with the procedures outlined in MPEP 2640 II, by ordering the '1160 reexamination request. Patent owner argues that to now merge the '1160 *inter partes* reexamination with the '9357 *ex parte* reexamination would "endorse" the improvident granting of the '1160 reexamination request and "eviscerate" the Patent Owner's ability to challenge the subsequently field and granted *inter*

[5] Presumably intimating the previously asserted argument of a statutory violation of 35 U.S.C. 317(a)

partes reexamination under its "*ex parte* reexamination rights".

The issue is moot as any Patent Owner *ultra vires* petition regarding the propriety of granting the '1160 request would be untimely in accordance with 37 CFR 1.181(f). Furthermore, even if timely, Patent owner's argument is in error. As noted above, outside of the right to submit a statement in accordance with 35 U.S.C. 304, *ex parte* reexamination does not confer any other statutory *ex parte* reexamination rights upon a patent owner that is not conferred by *inter partes* reexamination. Merger does not occur in an *ex parte* reexamination proceeding until the time for submission of a Patent Owner statement has passed. Therefore merger does not derogate any *ex parte* unique right. Any challenge to the grant of a reexamination request would have needed to have been made in the proceeding that was granted second. In this instance that would be the '1160 *inter partes* proceeding, which would be devoid of any "*ex parte* rights". The procedure for challenging the granting of a request for reexamination is the same for both *ex parte* reexamination and *inter partes* reexamination, an *ultra vires* petition under 37 CFR 1.181. See MPEP §§ 2246 II, 2646 II; See also MPEP §§ 2248, 2648. Therefore, as 37 CFR 1.989 places any merged proceeding that contains at least one *inter partes* proceeding under the *inter partes* rules, Patent Owner rights regarding challenge to the grant of the *inter partes* proceeding could not be altered by merger. However, as noted previously, the filing of an *ultra vires* petition under 37 CFR 1.181 would be untimely.

Accordingly, the petition to stay the *inter partes* proceeding, prevent merger or modify any merged proceeding to preserve "*ex parte* rights" is dismissed.

III. Merger of the Proceedings

As reexamination has been ordered for both proceedings, and there is no longer an opportunity for filing a patent owner's statement and/or requester's reply, consideration of merger is ripe at this point in time.

Under 37 CFR 1.989(a):

> If any reexamination is ordered while a prior inter partes reexamination proceeding is pending for the same patent and prosecution in the prior inter partes reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the merged examination will normally result in the issuance of a single reexamination certificate under § 1.997.

In accordance with 37 CFR 1.989 (a), the 95/001,160 and 90/009,357 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

A. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

Patent owner is required to maintain the same claims (and specification) in both files throughout

the merged proceeding. Since the claims are the same in both files, a "housekeeping amendment" is NOT needed.

B. CONDUCT OF MERGED PROCEEDING

1. Governing regulations for the merged proceeding:

The present decision merges an *ex parte* reexamination proceeding with an *inter partes* reexamination proceeding. Pursuant to 37 CFR 1.989(b), the merged proceeding is governed by 37 CFR 1.902 through 1.997, except that the rights of the third party requester of the *ex parte* reexamination are governed by 37 CFR 1.510 through 1.560. In this instance, however, the *ex parte* reexamination was requested by the same third party as in the *inter partes* reexamination. And, that third party has full *inter partes* reexamination participation rights.

2. Papers mailed/filed:

All papers mailed by the Office throughout the merged proceeding will take the form of a single action that applies to both reexamination proceedings. All papers issued by the Office or filed by the patent owner and the third party requester will contain the identifying data for both files and will be physically entered in each reexamination file. All papers filed by the patent owner and the third party requester must consist of a single paper, filed in duplicate, each bearing a signature and identifying data for both files, for entry into each file.

All papers filed by the patent owner and the third party requester should be directed:

By EFS:

> Registered users may submit the response via the electronic filing system EFS-Web, at: https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html

By U.S. Postal Service Mail:

> Mail Stop *Inter Partes* Reexam
> Central Reexamination Unit
> Commissioner for Patents
> United States Patent & Trademark Office
> P.O. Box 1450
> Alexandria, VA 22313-1450

By FAX to:

(571) 273-9900
Central Reexamination Unit

By hand (or delivery service):

Customer Service Window
Attn: Central Reexamination Unit
Randolph Building
401 Dulany St.
Alexandria, VA 22314

Patent owner and requester are reminded that every paper filed in the merged proceeding subsequent to this Decision must be served on the other party, including any papers filed via facsimile transmission.

3. Amendments:

The filing of any amendments to the drawings, specification or claims must comply with the provisions of 37 CFR 1.530 and the guidelines of MPEP § 2250. 37 CFR 1.121 does not apply to amendments in reexamination. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via markings pursuant to paragraph 37 CFR 1.530(f) of this section, except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

Pursuant to 37 CFR 1.530(i), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the request for reexamination. Amendments are not to be made relative to previous amendments. Thus, for all amendments, all words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets.

4. Fees:

Where a paper is filed which requires payment of a fee (e.g., petition fee, excess claims fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For example, only one fee need be paid for any patent owner's appellant brief (or that of the inter partes requester) which may be filed, even though the brief relates to merged multiple proceedings and copies must be filed (as pointed out above) for each file in the merged proceeding.

5. Citation of Patents and Printed Publications:

Upon return of the present merged proceeding to the examiner, the examiner will review the files to insure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.

CONCLUSION

1. The October 14, 2009 Patent Owner petition is dismissed.

2. *Inter partes* Reexamination Control No. 95/001,160 and *ex parte* Reexamination Control No. 90/009,357 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

3. Jurisdiction over the merged reexamination files is being forwarded via the Director of the Central Reexamination Unit (CRU) to the examiner, for the preparation of an Office action, to be issued in due course.

4. Telephone inquiries related to the present decision should be directed to Joseph F. Weiss, Jr., Reexamination Legal Advisor, at 571-272-7759.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

UNITED STATES PATENT AND TRADEMARK OFFICE

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MAR 08 2010

OFFICE OF PETITIONS

DUANE MORRIS LLP - HOUSTON
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SUITE 3150
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(For Requester)

In re Howe et al. :
Reexamination Proceeding : DECISION ON PETITION
Control No. 95/001,161 :
Request Deposited: 04/09/2009 :
Attorney Docket Number: D5433-590 :

This is a decision on the "PETITION FOR LATE ENTRY OF RESPONSE - UNAVOIDABLE DELAY (MPEP §2668)," filed on February 4, 2010, under 37 CFR 1.137(a),[1] and, in the alternative under 37 CFR 1.137(b) to excuse to the delay in filing a response in the above-identified reexamination proceeding.

The petition is before the Office of Patent Legal Administration for a decision.

The petition under 37 CFR 1.137(a) is **dismissed**.

The petition under 37 CFR 1.137(b) is **granted**.

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[1] A grantable petition under 37 CFR 1.137(a) must be accompanied by:

(1) the required reply, unless previously filed; In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional utility or plant application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof. In an application abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee.

(2) the petition fee as set forth in 37 CFR 1.17(l);

(3) a showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and

(4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c)).

BACKGROUND

1. On March 27, 2009, a request for *inter partes* reexamination of U.S. Patent No. 6,435,279 was deposited. The request stated that a copy of the request was served on the patent owner at the correspondence address listed in the aforementioned patent: Robert Groover, Arter & Hadden LLP, 1100 Huntington Bldg., 925 Euclid Ave, Cleveland OH 44115 on March 27, 2009. A control number of 95/001,161 was assigned to the request.

2. On April 9, 2009, a Corrected Original *Inter Partes* Reexamination Request was filed. The request contained a Certificate of Service stating that a copy of the request was served on the patent owner at the following address: Robert O. Groover, III, Esq., Groover & Associates, P.O. Box 802889, Dallas TX 75380.

3. On April 14, 2009, a Notice of Assignment of *Inter Partes* Reexamination Request and a Notice of *Inter Partes* Rexamination Request Filing Date were mailed to the address listed in paragraph 1, *supra*. A filing date of April 9, 2009 was accorded to the 95/001,161 reexamination proceeding (the '161 proceeding).

4. On June 12, 2009, a non-final Office action in *Inter Partes* Reexamination was mailed to the address listed in paragraph 1, *supra*.

5. On June 19, 2009, the copy of the Office action mailed to the address listed in paragraph 1, *supra*, was returned to the Office as undeliverable.

6. On January 4, 2010, an Action Closing Prosecution under 37 CFR 1.949 (ACP) was mailed, setting a one (1)-month period for response. A copy of the ACP was mailed to the patent owner at the address listed in paragraph 1, *supra*. A copy was also mailed to the address listed in paragraph 2, *supra*, as well as to a third address for the patent owner.

7. On January 12, 2010, the copy of the Office communication mailed to the address listed in paragraph 1, *supra*, was returned by the USPS as undeliverable.

8. On January 15, 2010, the copy of the Office communication mailed to the third address referenced in paragraph 6, *supra*, was returned by the USPS as undeliverable.

9. On February 4, 2010, the subject petition and a proposed response to the Office action were filed.

10. Petitioner avers that the reexamination proceeding was "completely unknown to the patent owner" and his attorney prior to receipt of the Office action of January 4, 2010.

11. Specifically, petitioner avers that the original and amended Requests, including the Certificate(s) of Service, served on March 27, 2009 and April 9, 2009, were never received by the patent owner. Petitioner asserts that the firm at the correspondence address of record in paragraph 1, *supra*, dissolved and ceased operations in the year 2003, and that the above-referenced address was no longer valid as of March, 2009. Petitioner further states that "[t]he April 9, 2009 filing was allegedly sent to the undersigned attorney by first class mail, but (as shown by the attached Declarations) no such mailing was ever received. First class mail, of course, is not normally used as the sole channel of communication for matters of importance."

12. Since patent owner petitioner avers that the reexamination proceeding was "completely unknown to the patent owner" and his attorney prior to receipt of the Office action of January 4, 2010, the present petition is taken as a petition to excuse to the delay in filing a response to the June 12, 2009 non-final Office action (first action on the merits).

PETITION UNDER 37 CFR 1.137(a)

Petitioner's arguments have been considered, but are not persuasive.

At the outset, petitioners' apparent argument that service by first-class mail is insufficient is contrary to USPTO regulations. 37 CFR 1.248(a)(4) permits service of papers in an *inter partes* reexamination by transmission by first class mail.

Moreover, as pointed out by petitioner, MPEP 2630 states, in pertinent part, that if all efforts to correspond with the patent owner fail, the reexamination proceeding will proceed without the patent owner. The publication in the *Official Gazette* of the notice of the filing of the *inter partes* reexamination request will serve as constructive notice to the patent owner in such an instance.

In this case, the showing of record does not indicate that the two correspondence items mailed on March 27, 2009 and April 9, 2009, were ever returned to the requester as undeliverable by the USPS, nor that the Office communication of April 14, 2009, was returned to the USPTO as undeliverable by the USPS. Therefore, neither the requester nor the USPTO would have had reason to believe that the correspondence had not been received, and, consequently, no reason to make additional efforts to reach petitioner. Furthermore, notice was provided of the filing of the subject reexamination in the *Official Gazette* on June 2, 2009.[2]

Nevertheless, pursuant to 37 CFR 1.137(a)(3), the Director may revive an abandoned application, or accept a late reply by a patent owner in a reexamination proceeding if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Director to be "unavoidable".[3] Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

> The word 'unavoidable'...is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.[4]

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[2] 1343 O.G. 31

[3] 35 U.S.C. § 133.

[4] In re Mattullath, 38 App. D.C. 497, 514-15 (1912)(quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

The showing of record is inadequate to establish unavoidable delay within the meaning of 35 U.S.C. § 133 and 37 CFR 1.137(a).[5] Specifically, an application is "unavoidably" abandoned only where petitioner, or counsel for petitioner, takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, such as failure of mail, telegraph, facsimile, or the negligence of otherwise reliable employees, the response is not timely received in the Office.[5]

A review of the record indicates no irregularity in the mailing of the *inter partes* reexamination requests and Certificates of Service mailed on March 27, 2009 and April 9, 2009, or the Office letter mailed to the patent owner on April 14, 2009. In the absence of any irregularity in the mailing, there is a strong presumption that the above-referenced communications were properly mailed to the patent owner This presumption may be overcome by a showing that the above-referenced communications were not in fact received.

MPEP 711.03(c) states, in pertinent part:

> In Delgar v. Schulyer, 172 USPQ 513 (D.D.C. 1971), the court decided that the Office should mail a new Notice of Allowance in view of the evidence presented in support of the contention that the applicant's representative did not receive the original Notice of Allowance. Under the reasoning of Delgar, an allegation that an Office action was never received may be considered in a petition to withdraw the holding of abandonment. If adequately supported, the Office may grant the petition to withdraw the holding of abandonment and remail the Office action. That is, the reasoning of Delgar is applicable regardless of whether an application is held abandoned for failure to timely pay the issue fee (35 U.S.C. 151) or for failure to prosecute (35 U.S.C. 133).
>
> To minimize costs and burdens to practitioners and the Office, the Office has modified the showing required to establish nonreceipt of an Office action. The showing required to establish nonreceipt of an Office communication must include a statement from the

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[5] Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887).

practitioner describing the system used for recording an Office action received at the correspondence address of record with the USPTO. The statement should establish that the docketing system is sufficiently reliable. It is expected that the record would include, but not be limited to, the application number, attorney docket number, the mail date of the Office action and the due date for the response.

Practitioner must state that the Office action was not received at the correspondence address of record, and that a search of the practitioner's record(s), including any file jacket or the equivalent, and the application contents, indicates that the Office action was not received. A copy of the record(s) used by the practitioner where the non-received Office action would have been entered had it been received is required.

A copy of the practitioner's record(s) required to show non-receipt of the Office action should include the master docket for the firm. That is, if a three month period for reply was set in the nonreceived Office action, a copy of the master docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action. If no such master docket exists, the practitioner should so state and provide other evidence such as, but not limited to, the following: the application file jacket; incoming mail log; calendar; reminder system; or the individual docket record for the application in question.

(emphasis added)

Petitioner has not provided a statement from the practitioner to the effect that a search of the practitioner's record(s), including any file jacket or the equivalent, and the application contents, indicates that the correspondence mailed March 27, 2009, April 9, 2009, and April 14, 2009 (hereinafter, collectively, "the correspondence") was not received.

A copy of the record(s) used by the practitioner where the non-received correspondence would have been entered had it been received is required to be provided. A copy of the practitioner's

record(s) required to show non-receipt of the correspondence should include the master docket for the firm. If no such master docket exists, the practitioner should so state and provide other evidence such as, but not limited to, the following: the application file jacket; incoming mail log; calendar; reminder system; or the individual docket record for the application in question.

As no docket records have been provided, petitioner has not shown to the satisfaction of the Director that the delay in responding to the correspondence filed on March 27, 2009, April 9, 2009, and April 14, 2009, was unavoidable.

Lastly, it is noted that the correspondence address listed in Patent No. 6,435,279, is still the old address of Artur & Hadden, LLP, 1100 Huntington Bldg., 925 Euclid Ave., Cleveland OH 44115. It is further noted that this address also appears as the correspondence address on the Electronic Acknowledgement Receipt sent by petitioner. Accordingly, the showing of record is that petitioner failed to properly and timely inform the Office of a change in the correspondence address. A delay caused by a failure on the part of petitioner, or petitioner's representative, to provide the Patent and Trademark Office with a current correspondence address does not constitute an unavoidable delay.[6]

Accordingly, the petition under 37 CFR 1.137(a) is **dismissed**.

PETITION UNDER 37 CFR 1.137(b)

The petition is **granted**.

The statement contained in the instant petition does not set forth that the entire delay from the due date of the required reply to the date of the filing of a grantable petition was unintentional as required by 37 CFR 1.137(b)(3). However, the statement contained in the instant petition is being so construed. Petitioner **must** notify the Office if this is not a correct interpretation.

Receipt of the February 4, 2010 response to the Office action mailed on January 4, 2010, is acknowledged.

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[6] See Ray v. Lehman, 55 F.3d 606, 34 USPQ2d 1786 (Fed. Cir. 1995).

In view of the statements provided in the petition that the patent owner's address contained in Office records is no longer valid, this paper is also being treated as a change of correspondence address. The correspondence address for the patent owner has been changed.

The petition fee required under 37 CFR 1.137(b) will be charged to counsel's deposit account as authorized in the subject petition.

Further prosecution and examination:

As pointed out above, the present petition is taken as a petition to excuse to the delay in filing a response to the June 12, 2009 non-final Office action (first action on the merits). Rather than "backing-up" the prosecution and examination to require a response to the June 12, 2009 first Office action, as opposed to a response to the Office action mailed on January 4, 2010, the following is effected:

The February 4, 2010 response to the January 4, 2010 Office action will be entered by the Central Reexamination Unit in the reexamination proceeding, and the proceeding will be forwarded to the CRU to await submission of any third party comments under 37 C.F.R. § 1.947 after the February 4, 2010 patent owner response. Following the submission of third party requester comments, or the lapse of the time period for third party comment, the proceeding will be forwarded to the examiner for action consistent with this decision. The examiner will consider the February 4, 2010 patent owner response and any third party comments that comply with 37 C.F.R. § 1.947. The examiner will then issue an Office action treating the patent owner papers as a response and comments received after a first Office action. This decision takes no position on the propriety/formality 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.

CONCLUSION

1. The petition under 37 CFR 1.137(a) is **dismissed**.

2. The petition under 37 CFR 1.137(b) is **granted**.

3. The petition fee will be charged to counsel's deposit account as authorized in the subject petition.

4. The closing of prosecution rendered via the January 4, 2010 ACP is hereby withdrawn, and prosecution of the proceeding is reopened.

5. Third party requester has thirty (30) days from the date of mailing of this decision to submit comments pursuant to 37 CFR 1.947.

6. The February 4, 2010 patent owner response 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 for consideration of both the amendment and any third party comments.

7. The reexamination proceeding file is being forwarded to the Central Reexamination Unit for further handling, and examination in due course not inconsistent with this decision.

8. Telephone inquiries related to this decision only should be directed to Senior Petitions Attorney Douglas I. Wood at (571) 272-3231.

9. Inquiries regarding petition status or general petition information are handled by the Office of Petitions staff at (571) 272-9282.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

January 7, 2009
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UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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P.O. Box 1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,163	03/31/2009	6985569	2746.004REX0	3205

39600 7590 12/14/2009

SOFER & HAROUN LLP.
317 MADISON AVENUE, SUITE 910
NEW YORK, NY 10017

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 12/14/2009

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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DEC 14 2009

SOFER & HAROUN LLP : (For Patent Owner)
317 MADISON AVENUE SUITE 910 :
NEW YORK, NY 10017 :

STERNE, KESSLER, GOLDSTEIN & FOX PLLC : (For Third Party Requester)
1100 NEW YORK AVENUE, NW :
WASHINGTON, DC 20005 :

In re: BAKER : DECISION
Inter partes Reexamination Proceeding : GRANTING PETITION
Control No. 95/001,163 : FOR EXTENSION OF TIME
Deposited: MARCH 31, 2009 : (37 CFR § 1.956)
For: U.S. Patent No. 6,985,569 :

This is a decision on the December 4, 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.

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 November 14, 2009 office action is ongoing and patent owner requests additional time to review and prepare a comprehensive reply. Details are set forth on pages 1-2 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 16, 2009 is hereby **granted**.

2. The period for response is hereby extended to **January 14, 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