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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,165	04/01/2009	7016481	29776.178	5241

7590 03/23/2010

EXAMINER	

NIRO, SCAVONE, HALLER & NIRO
181 W. Madison
Suite 4600
Chicago, IL 60602

ART UNIT	PAPER NUMBER

DATE MAILED: 03/23/2010

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

David L. McCombs
HAYNES & BOONE, LLP, IP SECTION
2323 Victory Lane, SUite 700
Dallas, TX 75219

Date:

MAILED

MAR 2 3 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001165
PATENT NO. : 7016481
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,503	08/31/2009	7016481	007458.0001	6222

7590 03/23/2010

NIRO, SCAVONE, HALLER & NIRO
181 W. MADISON
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CHICAGO, IL 60602

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/23/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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TEN SOUTH WACKER DRIVE
SUITE 3000
CHICAGO, IL 60606

Date:
MAILED

MAR 2 3 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000503
PATENT NO. : 7016481
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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Chicago, IL 60602

(For Patent Owner)

MAILED

MAR 23 2010

CENTRAL REEXAMINATION UNIT

Haynes and Boone, LLP
IP Section
2323 Victory Avenue
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(For 95/001,165 Requester)

Banner & Witcoff, Ltd.
Ten South Wacker Drive
Suite 3000
Chicago, IL 60606

(For 95/000,503 Requester)

In re David McElvaney
Inter Partes Reexamination Proceeding
Control No.: 95/001,165
Filed: April 1, 2009
For: U.S. Patent No. 7,016,481

In re David McElvaney
Inter Partes Reexamination Proceeding
Control No.: 95/000,503
Filed: August 31, 2009
For: U.S. Patent No.: 7,016,481

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

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

REVIEW OF FACTS

1. United States Patent Number 7,016,481 ("the '481 patent") issued to David McElvaney on March 21, 2006, with 16 claims.

2. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/001,165 (" '1165"), was filed April 1, 2009, by third party requester David L. McCombs identifying Cisco Systems, Incorporated as the real party in interest.

3. An order granting reexamination of claims 1-16 of the '481 patent was mailed for the '1165 reexamination proceeding on May 8, 2009; the order was accompanied by a first Office action on the merits.

4. Patent owner filed an Information Disclosure Statement (listing 327 documents) in the '1165 proceeding on June 29, 2009.

5. Patent owner filed a paper titled "Response to Office Action Mailed May 8, 2009" on July 13, 2009; the July 13, 2009 response did not include an amendment to the claims (or specification).

6. The '1165 requester filed a paper titled "Comments By Third Party Requester Under 37 C.F.R. § 1.947" on August 6, 2009.

7. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/000,503 (" 503") was filed August 31, 2009, by third party requester Shawn P. Gorman identifying RTX Telecom and Skype Technologies SA as the real parties in interest.

8. An order granting reexamination of claims 1-16 of the '481 patent was mailed for the '503 reexamination proceeding on November 25, 2009. No Office action has been issued in the '503 reexamination proceeding.

DECISION

I. MERGER OF PROCEEDINGS

Under 37 CFR 1.989(a):

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

As evidenced by the above review of facts, both the '1165 and '503 reexamination proceedings are currently pending. The order to reexamine has been mailed for both reexamination proceedings, and a decision under 37 CFR 1.989(a) is timely.

The general policy of the Office is that two reexamination proceedings will not be conducted separately, and at the same time, as to a particular patent. The reason for this policy is (1) to prevent inconsistent, and possibly conflicting, amendments from

being introduced into the two proceedings on behalf of the patent owner, (2) to provide a comprehensive examination of the patent based on the issues raised in both of the proceedings, and (3) to expedite the prosecution of both proceedings. In the present instance, merger of the 95/001,165 and 95/000,503 reexamination proceedings would address these considerations. Thus, pursuant to 37 CFR 1.989(a), the 95/001,165 and 95/000,503 reexamination proceedings are hereby merged. The merged proceeding will be conducted in accordance with the guidelines and requirements which follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

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

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

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

B. Papers mailed/filed:

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

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

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

For EFS-Web transmissions, 37 CFR 1.8(a)(1)(i) (C) and (ii) states that correspondence (except for a request for reexamination and a corrected or replacement request for reexamination) will be considered timely filed if (a) it is

transmitted via the Office's electronic filing system in accordance with 37 CFR 1.6(a)(4), and (b) includes a certificate of transmission for each piece of correspondence stating the date of transmission, which is prior to the expiration of the set period of time in the Office action.

By U.S. Postal Service Mail:

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

By FAX to:

(571) 273-9900
Central Reexamination Unit

By hand (or delivery service):

Customer Service Window
Attn: Central Reexamination Unit
Randolph Building
401 Dulany Street
Alexandria, VA 22314

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

C. Amendments:

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

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

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

D. Fees:

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

E. Citation of Patents and Printed Publications:

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

F. Appeal Procedure Reminders for *Inter Partes* Reexamination

The parties are reminded of the procedures for taking appeal in an *inter partes* reexamination as explained in MPEP 2674 and 2675. The appeal must only be taken from (1) the rejection(s) of the claims in the Right of Appeal Notice (RAN) that the *patent owner* proposes to contest, or (2) the finding(s) of patentability of claims in the RAN that the *third party requester* proposes to contest. Therefore, in the notice of appeal, the patent owner must identify each claim rejected by examiner that the patent owner intends to contest and the third party requester must identify each rejection *that was previously proposed by that third party requester* that the third party requester intends to contest. (37 CFR 41.61) The appellant's brief shall present a concise statement of each issue. Further, no new ground of rejection can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection. (37 CFR 41.67(c)(1)(vi))

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/001,165 and *inter partes* Reexamination Control No. 95/000,503 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

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

3. Any questions concerning this communication should be directed to Raul Tamayo in the Office of Patent Legal Administration, at (571) 272-7728.

Pinchus M. Laufer
Legal Advisor
Office of Patent Legal Administration

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CENTRAL REEXAMINATION UNIT

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
1100 NEW YORK AVENUE, N.W.
WASHINGTON DC 20005

(For Patent Owner)

David M. O'Dell
HAYNES AND BOONE, LLP
IP SECTION
2323 VICTORY AVENUE
SUITE 700
DALLAS, TX 75219

(For Third Party Requester)

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

In re: Barth *et alia*
Inter Partes Reexamination Proceeding
Control No. 95/001,166
Deposited on: 03 April 2009
For: US Patent No. 7,287,109

This is a decision on the 18 June 2009, "Petition for Extension of Time to File Response to First Office Action Pursuant to 37 CFR § 1.956," requesting that the time for responding to the Office action mailed 15 May 2009, be extended by two (2) months. 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 23 October 2007 US patent No. 7,287,109 was granted to Barth *et alia*.

2. On 03 April 2009 a request for reexamination was deposited by a third party requester for *inter partes* Reexamination with the Office identified by control number 95/001,166.

3. On 15 May 2009 an Order granting request for *inter partes* Reexamination 95/001,166 was mailed.

7. On 15 May 2009 a non-Final Office action was mailed setting a two month shortened statutory period for which to respond..

8. On 18 June 2009 the instant petition seeking a two (2) month 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 15 May 2009, which set a two (2) month time for filing a response thereto. The petition seeks a two (2) month extension of time for which to respond to the outstanding Office action. The petition for extension of time was timely filed on 18 June 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 two (2) months to the period for response. The decision to extend the period for response is evaluated based upon a showing of "sufficient cause." There is always the consideration to balance the need for the patent owner to have a fair opportunity to respond to the Office action between the need for special dispatch.

The non-final Office action was mailed 15 May 2009. The patent owner submitted a timely filed the petition on 18 June 2009 with the appropriate fee and certificate of service.

The petition dated 18 June 2009 articulates that the patent owner requires time to review depositions and expert reports, ITC discovery inhibiting access to inventors experts and key patent personnel, and that the Office action is lengthy. 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-month 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 non-final Office action dated 15 May 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 **15 August 2009.**

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

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

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

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

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

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

/Mark Reinhart/
for

Gregory Morse,
Director,
Central Reexamination Unit

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CENTRAL REEXAMINATION UNIT

Robert Greene Sterne
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WASHINGTON DC 20005

(For Patent Owner)

David M O'Dell
HAYNES AND BOONE, LLP
IP SECTION
2323 VICTORY AVENUE
SUITE 700
DALLAS, TX 75219

(For Third Party Requester)

In re: Barth *et alia*
Inter Partes Reexamination Proceeding
Control No. 95/001,166
Deposited on: 03 April 2009
For: US Patent No. 7,287,109

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

This is a decision on the 19 November 2009, "Petition for Extension of Time to File Response to Action Closing Prosecution Pursuant to 37 CFR § 1.956," requesting that the time for responding to the action closing prosecution mailed 14 November 2009, be further extended by one (1) month. The petition was timely filed with certificate of service.

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

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

DISCUSSION

The Patent Owner's representative requests the period of time be further extended in which to file a response to the action closing prosecution mailed 14 November 2009, which set one (1)

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

The request is granted-in-part.

CITATION OF RELEVANT AUTHORITY

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

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

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

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

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

> Requests for an extension of time in an inter partes reexamination proceeding will be

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

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

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

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

DECISION

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

The action closing prosecution was mailed 14 November 2009. The patent owner submitted a timely filed the petition on 19 November 2009 with the appropriate fee and certificate of service.

The petition dated 19 November 2009 cites several reasons for the need for additional time. The delay in receipt of the action both by USPS and availability on public PAIR as well as the unavailability of the patent owner's expert declarants are the most persuasive in evaluating "sufficient cause." On balance, the petitioner has demonstrated "sufficient cause" to grant a fourteen (14) days extension of time.

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

CONCLUSION

1. The patent owner's petition for further extension for one (1) month time in which to file a response to the action closing prosecution dated 14 November 2009 is hereby **granted-in-part.**

2. The period for response is further extended by fourteen (14) days.

3. The response is extended to **28 December 2009.**

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

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

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

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

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

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

/Mark Reinhart/

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.
95/001,167	04/14/2009	6784873	1659401-0011	1207

74162 7590 08/11/2009

Law Office of Scott C Harris Inc
PO Box 1389
Rancho Santa Fe, CA 92067

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 08/11/2009

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.
95/001,167	04/14/09	6784873	1659401-0011

EXAMINER
KOSOWSKI, ALEXANDER

ART UNIT	PAPER
3992	

WHITE & CASE LLP
PATENT DEPARTMENT
1155 AVENUE OF THE AMERICAS
NEW YORK, NY 10036

DATE MAILED:
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AUG 11 2009
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INTER PARTES REEXAMINATION COMMUNICATION

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PO Box 1389
Rancho Santa Fe CA 92067

(For Patent Owner)

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AUG 11 2009

CENTRAL REEXAMINATION UNIT

WHITE & CASE LLP
PATENT DEPARTMENT
1155 AVENUE OF THE AMERICAS
NEW YORK, NY 10036

(For Requester)

In re Boesen *et alia*
Reexamination Proceeding
Control No. 95/001,167
Request Deposited: April 6, 2009
For: U.S. Patent No. 6,784,873

: DECISION DISMISSING
: PETITION
: FOR EXTENSTION OF TIME
: 37 CFR 1.956
:

This is a decision on the August 5, 2009, patent owner Petition for Extension of Time requesting that the time to submit a response to the office action mailed June 16, 2009 be extended an additional two months.

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

The petition is dismissed for a two-month extension of time for the reasons set forth below.

REVIEW OF RELEVANT FACTS

1. United States Patent Number 6,784,873 (the '873 patent) issued to Boesen *et alia* on August 31, 2004.

2. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/001,167 ('1167), was deposited by a third party requester on April 6, 2009.

3. An order granting reexamination of the '873 patent was mailed June 1, 2009.

4. A non-final office action was mailed on June 16, 2009 setting a two-month period for response.

DECISION

The Patent Owner requests an extension of time in which to file a response to the office action mailed June 16, 2009. The request for extension is the first request for an extension of time. The present petition for extension of time was timely filed on August 5, 2009. The petition includes the petition fee required by 37 CFR 1.956.

37 CFR 1.956 states:

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

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

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

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

Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. The reasons must include (A) a statement of what action the patent owner has taken to provide a response, to date as of the date the request for extension is submitted, and (B) why, in spite of the action taken thus far, the requested additional time is needed...

Analysis and Findings

On balance, the Patent Owner's showing of "sufficient cause" is insufficient to justify an extension of time. The request does not include a statement of what action the patent owner has taken to provide a response, to date as of the date the request for extension is submitted.

Therefore, the request for a two-month extension of time is **dismissed**.

CONCLUSION

1. Petitioner's request is **dismissed**.

2. The dismissal is without prejudice to a request for reconsideration or higher-level review.

3. The Patent Owner's response is due August 17, 2009 (August 16 being a Sunday).

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

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

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

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

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

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

5. Telephone inquiries related to this decision should be directed to Eric Keasel, at (571) 272-4929, or Mark Reinhart, at (571) 272-1611, Jessica Harrison, at (571) 272-4449.

Eric Keasel
SPE, AU 3992

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95/001,167	04/14/2009	6784873	1659401-0011	1207

74162 7590 10/20/2009

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Rancho Santa Fe, CA 92067

(For Patent Owner)

White & Case LLP
Patent Department
1155 Avenue of the Americas
New York, NY 10036

(For Third Party Requester)

In re Boesen et al.
Inter Partes Reexamination Proceeding
Control No. 95/001,167
Filed: April 14, 2009
For: U.S. Patent No. 6,784,873

: **DECISION DISMISSING**
: **PETITION TO TERMINATE**
: **REEXAMINATION**
: **PROCEEDING**

This is a decision on the July 23, 2009 paper entitled "Petition To Terminate Inter Partes Reexamination Under 35 U.S.C. §314(c)/317(b)" requesting termination of *inter partes* reexamination proceeding control number 95/001,167, which is treated as a petition under 37 CFR 1.182 (hereinafter, "the petition to terminate").

The July 23, 2009 petition to terminate is before the Office of Patent Legal Administration for consideration.

FEES

The petition is properly filed under 37 CFR 1.182, because the rules do not provide for the filing of a petition requesting that an *inter partes* reexamination proceeding be dismissed, stayed, or terminated. The petition fee required by 37 CFR 1.182 is being charged to Deposit Account No. 50-4376, as authorized in the petition.

SUMMARY

The July 23, 2009 petition to terminate and conclude the instant *inter partes* reexamination proceeding 95/001,167 is dismissed.

REVIEW OF RELEVANT FACTS

1. U.S. Patent number 6,784,873 (the '873 patent) issued on August 31, 2004.

2. On July 1, 2008, the patent owner, SP Technologies, LLC, filed suit against Samsung Group, Samsung Telecommunications America, Samsung Electronics America, Inc., HTC Corporation and HTC America, Inc. for infringement of the '873 patent in the United States District Court for the Northern District of Illinios.[1]

3. A request for reexamination of claims 1-10 of the '873 patent was deposited on April 6, 2009. The request was assigned control No. 95/001,167 (the '1167 proceeding) and was accorded a filing date of April 14, 2009, the date compliance with the filing requirements of 37 CFR 1.915 was completed. The request identifies HTC Corporation and HTC America, Inc. as the real party in interest.

4. Reexamination was ordered for the '1167 proceeding on June 1, 2009. A first action on the merits was mailed on June 16, 2009.

5. On July 23, 2009, the patent owner filed the instant petition requesting termination of the '1167 proceeding, based on the July 15, 2009 stipulation of dismissal and consent judgment order, issued from the U.S. District Court, Northern District of Illinois, in the litigation between SP Technologies, LLC and HTC Corporation and HTC America, Inc (HTC).

6. On August 5, 2009, the patent owner filed a request for extension of time under 37 CFR 1.956.

7. On August 7, 2009, a notification of prior and concurrent litigation under 37 CFR 1.985 was filed by counsel for Garmin International, Inc. and TomTom, Inc.

8. On August 10, 2009, patent owner filed a paper titled "Request to Remove Inappropriate Papers Under 37 CFR 1.939/MPEP 2667" requesting the Office to remove the notification under 37 CFR 1.985 filed August 7, 2009. The August 10, 2009 request is being treated in a separate decision mailed concurrently with the instant decision.

9. On August 11, 2009, the Office mailed a decision dismissing the August 5, 2009 petition for extension of time.

10. On August 13, 2009, patent owner filed a request for reconsideration of the request for extension of time.

11. On August 17, 2009, the patent owner filed a response to the June 16, 2009 Office action.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

35 U.S.C. 317(b) provides (emphasis added):

> Once a final decision has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party **has not sustained its burden of proving the invalidity of any patent claim in suit** or if a final decision in an inter partes reexamination proceeding

[1] *SP Technologies, LLC v. Samsung Electronics Co., Ltd. et al.*, Civil Action No. 1:08 cv 03760 (N.D. Ill. July 1, 2008)

instituted by a third-party requester is favorable to the patentability of any original or proposed amended or new claim of the patent, then neither that party nor its privies may thereafter request an inter partes reexamination of **any such patent claim** on the basis of issues which that party or its privies raised or could have raised in such civil action or inter partes reexamination proceeding, and an inter partes reexamination requested by that party or its privies **on the basis of such issues** may not thereafter be maintained by the Office, notwithstanding any other provision of this chapter. This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the inter partes reexamination proceedings.

37 CFR 1.907(b) provides:

Once a final decision has been entered against a party in a civil action arising in whole or in part under 28 U.S.C. 1338 that the party has not sustained its burden of proving invalidity of any patent claim-in-suit, then neither that party nor its privies may thereafter request *inter partes* reexamination of any such patent claim on the basis of issues which that party, or its privies, raised or could have raised in such civil action, and an *inter partes* reexamination requested by that party, or its privies, on the basis of such issues may not thereafter be maintained by the Office.

37 CFR 1.985(a) provides:

In any *inter partes* reexamination proceeding, the patent owner shall call the attention of the Office to any prior or concurrent proceedings in which the patent is or was involved, including but not limited to interference, reissue, reexamination, or litigation and the results of such proceedings.

MPEP 2686.04 V., Discussion Of Affect Of Litigation Where Requester Was A Party To The Litigation, provides, in pertinent part:

Where a final decision was entered against a party in a Federal Court civil action (arising in whole or in part under 28 U.S.C. 1338) that the party did not sustain its burden of proving invalidity of a patent claim in suit, then that party and its privies may not request *inter partes* reexamination of any such patent claim on the basis of issues which that party or its privies raised or could have raised in the civil action. Further, an *inter partes* reexamination already requested by that party, or its privies, on the basis of such issues will not be maintained by the Office; in such an instance, the prosecution will be terminated and the proceeding will be concluded.

DECISION

Patent owner petitions the Director to terminate the '1167 proceeding pursuant to 35 U.S.C. 317(b) and 37 CFR 1.907(b), based on the July 15, 2009 stipulation of dismissal and consent judgment order issued from the U.S. District Court, Northern District of Illinois. Patent owner states in the petition that "HTC has indicated that they will join in this petition." It is noted that HTC has not submitted anything in writing to this effect.

Patent owner contends in the petition that good cause exists to stop the reexamination proceedings. Patent owner states that "HTC will never again be allowed to litigate the validity of

the '873 Patent" and that "HTC no longer challenges the validity and enforceability of the '873 Patent." Therefore, patent owner concludes that the issues raised by this *inter partes* reexamination proceeding have been mooted by the settlement of the litigation and there is no need for the Office to continue with the *inter partes* reexamination of the '873 patent.

Pursuant to 35 U.S.C. 317(b) and 37 CFR 1.907(b), once a final decision has been entered against a party in a civil action arising in whole or in part under 28 U.S.C. 1338, that the party has not sustained its burden of proving the invalidity of any patent claim in suit, an *inter partes* reexamination requested by that party on the basis of issues that the party raised, or could have raised, in the civil action must not thereafter be maintained by the Office.

A copy of the July 15, 2009 stipulation of dismissal and consent judgment accompanied the July 23, 2009 petition. The July 15, 2009 judgment states, in particular, the following:

> HTC challenged the validity and enforceability of the '873 Patent. HTC no longer challenges the validity and enforceability of the '873 Patent, and therefore, HTC's defenses and counterclaims of invalidity and unenforceability of the '873 Patent are dismissed with prejudice.

The instant petition to terminate has been fully considered. It has not been established that the July 15, 2009 consent judgment is "a final decision...entered against a party in a civil action...that the party has not sustained its burden of proving the invalidity of any patent claim in suit..." as required in 35 U.S.C. 317(b). The consent judgment merely states that HTC no longer challenges the validity and enforceability of the '873 patent. It does not state, for example, that HTC was unable to sustain its burden of proving invalidity of the '873 patent claims or that HTC has not sustained its burden of proving invalidity of the '873 patent claims. It also does not state that the parties agreed that HTC had not sustained or could not sustain its burden of proving invalidity of the '873 patent claims. Thus, the consent judgment entered in the civil action does not constitute a final decision against HTC that HTC has not sustained its burden of proving the invalidity of any patent claim in suit, as required by 35 U.S.C. 317(b) for termination and conclusion of the reexamination proceeding.

In addition, SP Technologies, LLC appears to only have asserted that HTC infringed claims 1, 4, 9 and 10 of the '873 patent, since SP Technologies alleged that "HTC has infringed, and is now infringing, at least claims 1, 4, 9, and 10 of the '873 Patent." See Attachment A to the petition at page 5. HTC raised as an affirmative defense (and counterclaim) that "each claim of the '873 patent is invalid and/or unenforceable for failure to meet one or more of the conditions of patentability specified in 35 U.S.C. §§101, 102, 103, and/or 112." See Attachment A at page 7. However, it has not been established that HTC had a "burden of proving the invalidity" of any of the non-asserted claims (i.e., claims 2, 3, and 5-8). Claims 1-10 of the '873 patent are subject to reexamination in the instant *inter partes* reexamination proceeding, and thus, there are claims undergoing reexamination that were apparently not part of the litigation. The statute attaches the § 317(b) estoppel on a claim-by-claim basis. The estoppel provisions of 35 U.S.C. 317(b) attach to any given claim only if that claim was involved in the suit and the defendant did not "sustain its burden" of proving invalidity of the claim. Patent owner has not established that each and

every claim of the patent was involved in the suit and that HTC had the burden of showing invalidity of all of the patent claims.

Accordingly, the petition to terminate the '1167 proceeding is dismissed.

CONCLUSION

1. The petition is dismissed.

2. Jurisdiction over the '1167 *inter partes* reexamination proceeding is being forwarded to the Central Reexamination Unit (CRU).

3. Any inquiry concerning this communication should be directed to Eugenia Jones, Senior Legal Advisor, at (571) 272-7727, or in her absence, to the undersigned at (571) 272-7710.

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

10-16-09
Kenpet7/IP/...

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(For Patent Owner)

White & Case LLP
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(For Third Party Requester)

In re Boesen et al.
Inter Partes Reexamination Proceeding
Control No. 95/001,167
Filed: April 14, 2009
For: U.S. Patent No. 6,784,873

: **DECISION DISMISSING**
: **PETITION TO REMOVE**
: **PAPER**

This is a decision on the August 10, 2009 paper entitled "Request to Remove Inappropriate Filed Papers Under 37 CFR 1.939/MPEP 2667," which is treated as a petition under 37 CFR 1.182 (hereinafter, "petition").

The August 10, 2009 petition is before the Office of Patent Legal Administration for consideration.

FEES

The petition fee required by 37 CFR 1.182 is being charged to Deposit Account No. 50-4376, as authorized in the petition.

SUMMARY

The August 10, 2009 petition is dismissed.

REVIEW OF RELEVANT FACTS

1. U.S. Patent number 6,784,873 (the '873 patent) issued on August 31, 2004.
2. On July 1, 2008, the patent owner, SP Technologies, LLC, filed suit against Samsung Group, Samsung Telecommunications America, Samsung Electronics America, Inc., HTC

Corporation and HTC America, Inc. for infringement of the '873 patent in the United States District Court for the Northern District of Illinios.[1]

3. A request for reexamination of claims 1-10 of the '873 patent was deposited on April 6, 2009. The request was assigned control No. 95/001,167 (the '1167 proceeding) and was accorded a filing date of April 14, 2009, the date compliance with the filing requirements of 37 CFR 1.915 was completed. The request identifies HTC Corporation and HTC America, Inc. as the real party in interest.

4. Reexamination was ordered for the '1167 proceeding on June 1, 2009. A first action on the merits was mailed on June 16, 2009.

5. On July 23, 2009, the patent owner filed a petition requesting termination of the '1167 proceeding, based on the July 15, 2009 stipulation of dismissal and consent judgment order, issued from the U.S. District Court, Northern District of Illinois, in the litigation between SP Technologies, LLC and HTC Corporation and HTC America, Inc (HTC). The July 23, 2009 petition is being treated in a separate decision mailed concurrently with this decision.

6. On August 5, 2009, the patent owner filed a request for extension of time under 37 CFR 1.956.

7. On August 7, 2009, a notification of prior and concurrent litigation under 37 CFR 1.985 was filed by counsel for Garmin International, Inc. and TomTom, Inc.

8. On August 10, 2009, patent owner filed the instant petition, entitled "Request to Remove Inappropriate Papers Under 37 CFR 1.939/MPEP 2667", requesting the Office to remove the notification under 37 CFR 1.985 filed August 7, 2009.

9. On August 11, 2009, the Office mailed a decision dismissing the August 5, 2009 petition for extension of time.

10. On August 13, 2009, patent owner filed a request for reconsideration of the request for extension of time.

11. On August 17, 2009, the patent owner filed a response to the June 16, 2009 Office action.

REGULATIONS AND PATENT EXAMINING PROCEDURES

37 CFR 1.939(a) states:

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

37 CFR 1.985(a) states:

In any *inter partes* reexamination proceeding, the patent owner shall call the attention of the Office

---

[1] *SP Technologies, LLC v. Samsung Electronics Co., Ltd. et al.*, Civil Action No. 1:08 cv 03760 (N.D. Ill. July 1, 2008)

to any prior or concurrent proceedings in which the patent is or was involved, including but not limited to interference, reissue, reexamination, or litigation and the results of such proceedings.

37 CFR 1.985(b) states:

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

MPEP 2667, I.C., states in pertinent part:

A paper submitted by a third party other than the third party requester must be (1) a 37 CFR 1.501 art citation...or (2) bare notice of suits or other proceedings involving the patent (see MPEP § 2686 and § 2686.04) which may include copies of decisions or other court papers, or papers filed in the court, from litigations or other proceedings involving the patent. Such submissions must be without additional comment and cannot include further arguments or information. If the submission by the third party is not one of the above-described two types of papers, it will be returned to an identified third party or destroyed if the submitter is unidentified. If a submission by the third party of either of the above-described two types of papers contains additional material that goes beyond the scope of what is permitted, the paper will be returned to an identified third party, or destroyed if the third party submitter is unidentified.

MPEP 2686 states in pertinent 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...Further, papers filed in the court from the litigation or other proceedings involving the patent will not be entered into the record (and will be expunged if already entered) if they provide a party's arguments, such as a memorandum in support of summary judgment.

*****

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.

DECISION

Patent owner requests that the Office remove the August 7, 2009 paper (entitled "Notification Of Prior And Concurrent Litigation Under 37 C.F.R. 1.985") that was filed by a third party who is not the third party requester of this *inter partes* reexamination proceeding. Patent owner alleges that the paper violates 37 CFR 1.939 and MPEP 2667. Patent owner refers to a few statements in the August 7, 2009 paper and alleges that these statements are improper because they are additional comments that are filed by a non-party to this reexamination.

A review of the August 7, 2009 paper reveals that the entirety of its content is limited to notification of prior and concurrent litigation in accordance with 37 CFR 1.985(b); it does not contain any information that is prohibited by the rules or the MPEP. The statements that patent owner alleges are improper are not arguments or a discussion of the issues and are not considered improper by the Office. Therefore, the paper has been entered into the record of the reexamination file and it will not be expunged from the reexamination file. Accordingly, the petition is dismissed.

Patent owner is reminded of its requirement under 37 CFR 1.985(a) to notify the Office of any prior or concurrent proceedings in which the patent is or was involved and the results of such proceedings. The record does not indicate that patent owner has notified the Office of the prior or concurrent proceedings and the results of such proceedings.

CONCLUSION

1. The petition is dismissed.

2. Jurisdiction over the '1167 *inter partes* reexamination proceeding is being forwarded to the Central Reexamination Unit (CRU).

3. Any inquiry concerning this communication should be directed to Eugenia Jones, Senior Legal Advisor, at (571) 272-7727, or in her absence, to the undersigned at (571) 272-7710.

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

10-16-09
Kimprop\3PR

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/001,167	04/14/09	6784873	1659401-0011

WHITE & CASE LLP
PATENT DEPARTMENT
1155 AVENUE OF THE AMERICAS
NEW YORK, NY 10036

EXAMINER
KOSOWSKI, ALEXANDER

ART UNIT	PAPER
3992	

DATE MAILED:

MAILED

FEB 24 2010

CENTRAL REEXAMINATION UNIT

INTER PARTES REEXAMINATION COMMUNICATION

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

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

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COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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Law Office of Scott C. Harris, Inc.
P.O. Box 1389
Rancho Santa Fe, CA 92067

(For Patent Owner)

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FEB 24 2010

CENTRAL REEXAMINATION UNIT

White & Case LLP
Patent Department
1155 Avenue of the Americas
New York, NY 10036

(For Third Party Requester)

In re Boesen et al.
Inter Partes Reexamination Proceeding
Control No. 95/001,167
Filed: April 14, 2009
For: U.S. Patent No. 6,784,873

: **DECISION GRANTING**
: **PETITION TO TERMINATE**
: **REEXAMINATION**
: **PROCEEDING**

This is a decision on the December 15, 2009 paper entitled "Renewed Petition To Terminate Inter Partes Reexamination Under 35 U.S.C. §314(c)/317(b) (and under 37 CFR 1.182)" requesting termination of the prosecution of, and conclusion of *inter partes* reexamination proceeding control number 95/001,167, (hereinafter, "renewed petition to terminate").

The December 15, 2009 renewed petition to terminate is before the Office of Patent Legal Administration for consideration.

SUMMARY

The December 15, 2009 renewed petition to terminate prosecution and conclude the instant *inter partes* reexamination proceeding 95/001,167 is granted.

REVIEW OF RELEVANT FACTS

1. U.S. Patent number 6,784,873 (the '873 patent) issued on August 31, 2004.

2. On July 1, 2008, the patent owner, SP Technologies, LLC, filed suit against Samsung Group, Samsung Telecommunications America, Samsung Electronics America, Inc., HTC Corporation and HTC America, Inc. for infringement of the '873 patent in the United States District Court for the Northern District of Illinios.[1]

[1] *SP Technologies, LLC v. Samsung Electronics Co., Ltd. et al.*, Civil Action No. 1:08 cv 03760 (N.D. Ill. July 1, 2008)

3. A request for reexamination of claims 1-10 of the '873 patent was deposited on April 6, 2009. The request was assigned control No. 95/001,167 (the '1167 proceeding) and was accorded a filing date of April 14, 2009, the date compliance with the filing requirements of 37 CFR 1.915 was completed. The request identifies HTC Corporation and HTC America, Inc. as the real party in interest.

4. Reexamination was ordered for the '1167 proceeding on June 1, 2009. A first action on the merits was mailed on June 16, 2009.

5. On July 23, 2009, the patent owner filed a petition requesting termination of the '1167 proceeding, based on the July 15, 2009 stipulation of dismissal and consent judgment order, issued from the U.S. District Court, Northern District of Illinois, in the litigation between SP Technologies, LLC and HTC Corporation and HTC America, Inc (HTC).

6. On August 5, 2009, the patent owner filed a request for extension of time under 37 CFR 1.956.

7. On August 7, 2009, a notification of prior and concurrent litigation under 37 CFR 1.985 was filed by counsel for Garmin International, Inc. and TomTom, Inc.

8. On August 10, 2009, the patent owner filed a paper titled "Request to Remove Inappropriate Papers Under 37 CFR 1.939/MPEP 2667" requesting the Office to remove the notification under 37 CFR 1.985 filed August 7, 2009.

9. On August 11, 2009, the Office mailed a decision dismissing the August 5, 2009 petition for extension of time.

10. On August 13, 2009, the patent owner filed a request for reconsideration of the request for extension of time.

11. On August 17, 2009, the patent owner filed a response to the June 16, 2009 Office action.

12. On October 20, 2009, the Office mailed a decision dismissing the July 23, 2009 petition to terminate. The Office also mailed a decision dismissing the August 10, 2009 petition to remove the August 7, 2009 paper.

13. On December 7, 2009, the Office mailed a "Notice Re Defective Paper In Inter Partes Reexamination" which stated that the amendment filed on August 17, 2009 does not comply with 37 CFR 1.530.

14. On December 15, 2009, the patent owner filed a "Renewed Petition To Terminate Inter Partes Reexamination Under 35 U.S.C. §314(c)/317(b) (and under 37 CFR 1.182)."

15. On December 30, 2009, the third party requester filed a paper entitled "Third Party Requester's Response to Patent Owner's Renewed Petition to Terminate Inter Partes Reexamination."

16. On January, 5, 2010, the third party requester filed a certificate of service for the third party requester's response paper filed December 30, 2009.

17. On January 8, 2010, a "Notification of Prior and Concurrent Litigation Under 37 CFR 1.985" was filed by counsel for Garmin International, Inc and TomTom, Inc. via the Office's electronic filing system, EFS-Web.

18. On January 11, 2010, a copy of the paper filed on January 8, 2010 was filed.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

35 U.S.C. 317(b) provides (emphasis added):

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

37 CFR 1.907(b) provides:

> Once a final decision has been entered against a party in a civil action arising in whole or in part under 28 U.S.C. 1338 that the party has not sustained its burden of proving invalidity of any patent claim-in-suit, then neither that party nor its privies may thereafter request *inter partes* reexamination of any such patent claim on the basis of issues which that party, or its privies, raised or could have raised in such civil action, and an *inter partes* reexamination requested by that party, or its privies, on the basis of such issues may not thereafter be maintained by the Office.

37 CFR 1.985(a) provides:

> In any *inter partes* reexamination proceeding, the patent owner shall call the attention of the Office to any prior or concurrent proceedings in which the patent is or was involved, including but not limited to interference, reissue, reexamination, or litigation and the results of such proceedings.

MPEP 2686.04 V., Discussion Of Affect Of Litigation Where Requester Was A Party To The Litigation, provides, in pertinent part:

> Where a final decision was entered against a party in a Federal Court civil action (arising in whole or in part under 28 U.S.C. 1338) that the party did not sustain its burden of proving invalidity of a patent claim in suit, then that party and its privies may not request *inter partes* reexamination of any such patent claim on the basis of issues which that party or its privies raised or could have raised in the civil action. Further, an *inter partes* reexamination already requested by that party, or its privies, on the basis of such issues will not be maintained by the Office; in such an instance, the prosecution

will be terminated and the proceeding will be concluded.

DECISION

The July 23, 2009 petition to terminate was dismissed because it had not been established that the July 15, 2009 consent judgment was "a final decision...entered against a party in a civil action...that the party has not sustained its burden of proving the invalidity of any patent claim in suit..." as required by 35 U.S.C. 317(b). The petition decision also stated that patent owner had not established that each and every patent claim was involved in the suit and that HTC had the burden of showing invalidity of all of the patent claims, because it appeared that SP Technologies, LLC only asserted that HTC infringed claims 1, 4, 9, and 10 of the '873 patent and it had not been established that HTC had the burden of proving invalidity of any of the non-asserted claims (i.e., claims 2, 3, and 5-8).

Patent owner now renews its petition to terminate the '1167 proceeding pursuant to 35 U.S.C. 317(b) and 37 CFR 1.907(b), based on the December 8, 2009 amended stipulation of dismissal and consent judgment order, issued from the U.S. District Court, Northern District of Illinois, Eastern Division. In third party requester's December 30, 2009 response to patent owner's renewed petition, requester states that "HTC...does not oppose the Renewed Petition and agrees with the patent owner that this *inter partes* reexamination should be terminated pursuant to 35 U.S.C. §317(b)."

Pursuant to 35 U.S.C. 317(b) and 37 CFR 1.907(b), once a final decision has been entered against a party in a civil action arising in whole or in part under 28 U.S.C. 1338, that the party has not sustained its burden of proving the invalidity of any patent claim in suit, an *inter partes* reexamination requested by that party on the basis of issues that the party raised, or could have raised, in the civil action must not thereafter be maintained by the Office.

A copy of the December 8, 2009 amended stipulation of dismissal and consent judgment order of the district court accompanied the December 15, 2009 renewed petition to terminate. The December 8, 2009 consent judgment order states, in particular:

> The Court further orders and decrees that the original Consent Judgment Order of July 15, 2009 and this Amended Consent Judgment Order are intended and shall constitute, for purposes of 35 U.S.C. § 317(b), a final decision entered against a party (*i.e.*, HTC) in a civil action arising in whole or in part under section 1338 of title 28, that the party (*i.e.*, HTC) has not sustained its burden of proving the invalidity of any patent claim in suit, with all claims (1-10) of the '873 patent having been in suit.

The December 8, 2009 amended stipulation of dismissal and consent judgment order was entered against the third party requester of the instant '1167 proceeding, that the third party requester did not sustain its burden of proving invalidity of any of the patent claims of the '873 patent, which are identical to the claims under reexamination in the instant '1167 proceeding.

Accordingly, based upon 35 U.S.C. 317(b), the prosecution of the '1167 *inter partes* reexamination proceeding is hereby terminated.

Jurisdiction over the '1167 *inter partes* reexamination proceeding is being forwarded to the Central Reexamination Unit (CRU) for conclusion of the proceeding. The CRU will mail the present decision, and process the reexamination file to update the Image File Wrapper (IFW) records for this proceeding. The file will be assigned an 820 status. A copy of the PALM "Application Number Information" screen and the "Contents" screen will be printed, the printed copy will be annotated by adding the comment "PROCEEDING CONCLUDED," and the annotated copy will then be scanned into Image File Wrapper (IFW) using the miscellaneous letter document code.

CONCLUSION

1. The renewed petition to terminate is granted.

2. The prosecution of the '1167 *inter partes* reexamination proceeding is terminated, and the '1167 proceeding will be concluded.

3. Jurisdiction over the '1167 *inter partes* reexamination proceeding is being forwarded to the Central Reexamination Unit (CRU) for further processing to conclude the '1167 proceeding, as set forth above.

4. Any inquiry concerning this communication should be directed to Eugenia Jones, Senior Legal Advisor, at (571) 272-7727, or in her absence, to the undersigned at (571) 272-7710.

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

2-24-10
Kenpet7/

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.
95/001,169	04/21/2009	6591353	2805.003REX9	7283

26111 7590 12/02/2009

EXAMINER

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

ART UNIT	PAPER NUMBER

DATE MAILED: 12/02/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
HAYNES AND BOONE, LLP IP SECTION
2323 VICTORY AVENUE
SUITE 700
DALLAS, TX 75219

Date:
MAILED
DEC 0 2 2009
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001169
PATENT NO. : 6591353
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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Robert Greene Sterne
STERNE, KESSLER, GOLDSTEIN
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(For Patent Owner)

MAILED

DEC 0 2 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)

In re: Barth *et alia*
Inter Partes Reexamination Proceeding
Control No. 95/001,169
Deposited on: 21 April 2009
For: US Patent No. 6,591,353

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

This is a decision on the 19 November 2009, "Petition for Extension of Time to File Response to Action Closing Prosecution Pursuant to 37 CFR § 1.956," requesting that the time for responding to the action closing prosecution mailed 14 November 2009, be further extended by one (1) month. The petition was timely filed with certificate of service.

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

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

DISCUSSION

The Patent Owner's representative requests the period of time be further extended in which to file a response to the action closing prosecution mailed 14 November 2009, which set one (1)

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

The request is granted-in-part.

CITATION OF RELEVANT AUTHORITY

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

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

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

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

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

> Requests for an extension of time in an inter partes reexamination proceeding will be

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

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

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

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

DECISION

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

The action closing prosecution was mailed 14 November 2009. The patent owner submitted a timely filed the petition on 19 November 2009 with the appropriate fee and certificate of service.

The petition dated 19 November 2009 cites several reasons for the need for additional time. The delay in receipt of the action both by USPS and availability on public PAIR as well as the unavailability of the patent owner's expert declarants are the most persuasive in evaluating "sufficient cause." On balance, the petitioner has demonstrated "sufficient cause" to grant a fourteen (14) days extension of time.

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

CONCLUSION

1. The patent owner's petition for further extension for one (1) month time in which to file a response to the action closing prosecution dated 14 November 2009 is hereby **granted-in-part.**

2. The period for response is further extended by fourteen (14) days.

3. The response is extended to **28 December 2009.**

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

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

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

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

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

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

/Mark Reinhart/

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.
95/001,169	04/21/2009	6591353	2805.003REX9	7283

26111 7590 07/23/2010

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 07/23/2010

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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95001169	4/21/09	6591353	

EXAMINER

RAMBUS, INC.
C/O ANN WILLIAMS
4440 EL CAMINO REAL
LOS ALTOS, CA 94022

ART UNIT	PAPER
3999	20100723

DATE MAILED: MAILED

JUL 23 2010

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2323 VICTORY AVENUE
SUITE 700
DALLAS, TX 75219

Date:

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JUL 23 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001169
PATENT NO. : 6591353
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)

Hanes and Boone, LLP
IP Section
2323 Victory Avenue
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Dallas, TX 75219

(For Requester)

MAILED

JUL 23 2010

Sterne, Kessler, Goldstein, & Fox P.L.L.C.
1100 New York Avenue, N.W.
Washington, D.C. 20005

(Courtesy Copy)

CENTRAL REEXAMINATION UNIT

In re Barth et al
Inter Partes Reexamination Proceeding
Control No. 95/001,169
Filed: April 21, 2009
For: U.S. Patent No. 6,591,353

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

This is a decision on the June 9, 2010 patent owner petition entitled "Patent Owner's Petition under 37 C.F.R. § 1.183 to Waive § 41.63 and Admit Evidence" (the June 9, 2010 patent owner petition).

This decision also addresses the June 11, 2009 change of correspondence address filed by the patent owner.

The June 9, 2010 patent owner petition, the June 11, 2010 change of correspondence address, and the record as a whole are before the Office of Patent Legal Administration for consideration.

The $400 fee pursuant to 37 CFR 1.17(f) for the June 9, 2010 petition under 37 CFR 1.183 has been received.

SUMMARY

The June 9, 2010 patent owner petition under 37 CFR 1.183 to waive the provisions of 37 CFR 41.63(c) is **dismissed as premature**.

The change of correspondence address for the patent owner that was filed on June 11, 2009, is **ineffective**.

REVIEW OF FACTS

- On July 8, 2003, U.S. Patent No. 6,591,353 (the '353 patent) issued to Barth et al.
- On April. 21, 2009, a request for *inter partes* reexamination was filed, and the resulting reexamination proceeding was assigned control number 95/001169 (the '1169 proceeding).
- On June 11, 2009, the patent owner filed a power of attorney and change of correspondence address (the June 11, 2009 change of correspondence address).
- Prosecution progressed until November 11, 2009, when an action closing prosecution was mailed.
- On December 22, 2009, the patent owner filed a response to the November 11, 2009 action closing prosecution.
- On January 15, 2010, the requester filed comments on the December 22, 2009 patent owner response.
- On February 26, 2010, a right of appeal notice (RAN) was mailed.
- On March 12, 2010, the requester filed a petition entitled "Petition by Third Party Requester to Reopen Prosecution after RAN".
- On March 23, 2010, the patent owner filed an opposition to the requester's March 12, 2010 petition.
- On March 26, 2010, the requester filed a notice of appeal.
- On April 9, 2010, the patent owner filed a notice of cross appeal.
- On May 26, 2010, the requester filed an appellant brief.
- On June 9, 2010, the patent owner filed an appellant brief.
- Also on June 9, 2010, the patent owner filed the present petition under 37 CFR 1.183 to waive the provisions of 37 CFR 41.63(c) and enter the second supplemental declaration under 37 CFR 1.132 of Robert J. Murphy and the reference identified as "An American National Standard IEEE Standard 696 Interface Devices" (696 Device Interface), the petition being entitled "Patent Owner's Petition Under 37 C.F.R. § 1.183 to Waive § 41.63 and Admit Evidence" (the June 9, 2010 patent owner petition).
- On June 28, 2010, the patent owner filed a respondent brief after the May 26, 2010 requester appellant brief (June 26, 2010 was a Saturday).

- Also on June 28, 2010, the patent owner filed a petition entitled "Emergency Petition under 37 C.F.R. § 1.183 to Suspend Rule 37 C.F.R. § 1.943(c)" to the extent of the length of its concurrently-filed respondent brief.

- Also on June 28, 2010, the patent owner filed a petition entitled "Patent Owner's Petition under 37 C.F.R. § 1.182 to Strike Portions of the Third-Party Requester's Brief on Appeal".

- On July 9, 2010, the requester filed a respondent brief after the June 9, 2010 patent owner appellant brief.

- On July 22, 2010, the requester filed an opposition to the June 28, 2010 patent owner petition.

DECISION

The patent owner requests waiver of the provisions of 37 CFR 41.63(c) prohibiting the admission of "[a]ffidavits or other evidence filed after the date of filing an appeal pursuant to § 41.61", and entry of the second supplemental declaration under 37 CFR 1.132 of Robert J. Murphy and the reference "An American National Standard IEEE Standard 696 Interface Devices" (696 Device Interface), which are filed concurrently with patent owner's appellant brief. In the present case, the requester filed a notice of appeal on March 26, 2010, and the patent owner filed a notice of cross appeal on April 9, 2010. The patent owner's appellant brief following the cross-appeal, accompanied by the proffered evidence, as well as the present petition, were filed on June 9, 2009.

The requester, however, has filed a petition on March 12, 2010, entitled "Petition by Third Party Requester to Reopen Prosecution after RAN", to which the patent owner has filed an opposition on March 23, 2010. Accordingly, the present petition under 37 CFR 1.183 to waive the provisions of 37 CFR 41.63(c) is **dismissed as premature**, pending the decision by the Office whether to reopen prosecution after RAN. If prosecution is reopened, the present petition would become moot, since the proffered materials would be entered and considered without waiver of the rules.

The patent owner alternatively requests that "the new evidence" submitted by the requester in its comments filed on January 15, 2010 be struck. When two different forms of relief are being requested in a single petition, however, such petition is improper under 37 CFR 1.4(c). Pursuant to 37 CFR 1.4(c), the issue of striking "the new evidence" should have been submitted via a separate petition. More important, the issue had to have been submitted via petition within two months of the February 26, 2010 mailing date of the right of appeal notice-see 37 CFR 1.181(f).

The June 11, 2009 Change of Correspondence Address is Ineffective

The change of correspondence address, filed by the patent owner on June 11, 2009, is **ineffective**. The address for the patent owner in a reexamination proceeding is the official

correspondence address of the patent owner *in the patent file*. See MPEP 2622 and 37 CFR 1.33(c). In the present case, the official correspondence address for the patent owner, that is of record in the patent file, application no. 09/561,868, is shown in the caption of this decision

A courtesy copy of this decision will be mailed to the practitioner who submitted the present patent owner petition, Mr. Robert G. Sterne. Absent the filing of a proper change of correspondence address in the patent file, application no. 09/561,868, however, all future correspondence will be mailed to the current address of record for the patent owner, as shown in the caption of this decision.

CONCLUSION

- The June 9, 2010 petition under 37 CFR 1.183 to waive the provisions of 37 CFR 41.63(c) and to enter the second supplemental declaration under 37 CFR 1.132 of Robert J. Murphy, and the reference "An American National Standard IEEE Standard 696 Interface Devices" (696 Device Interface) is **dismissed as premature**.

- The June 11 2009 change of correspondence address of the patent owner is **ineffective**. A courtesy copy of this decision will be mailed to the practitioner who submitted the present petition, Mr. Robert G. Sterne. Absent the filing of a proper change of correspondence address in the patent file, application no. 09/561,868, all future correspondence will be mailed to the current address of record for the patent owner, as shown in the caption of this decision.

- Jurisdiction over the proceeding is being returned to the Central Reexamination Unit for appropriate action, including addressing the March 12, 2010 requester petition entitled "Petition by Third Party Requester to Reopen Prosecution after RAN".

- Any inquiry concerning this communication should be directed to Cynthia Nessler, Senior Legal Advisor, at (571) 272-7724, or in her absence, to the undersigned at (571) 272-7710.

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

7-23-10

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Rambus, Inc.
C/O Ann Williams
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Los Altos, CA 94022

(For Patent Owner)

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JUL 23 2010

CENTRAL REEXAMINATION UNIT

Hanes and Boone, LLP
IP Section
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Dallas, TX 75219

(For Requester)

Sterne, Kessler, Goldstein, & Fox P.L.L.C.
1100 New York Avenue, N.W.
Washington, D.C. 20005

(Courtesy Copy)

In re Barth et al
Inter Partes Reexamination Proceeding
Control No. 95/001,169
Filed: April 21, 2009
For: U.S. Patent No. 6,591,353

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

This is a decision on the June 28, 2010 patent owner petition entitled "Emergency Petition Under 37 C.F.R. § 1.183 to Suspend Rule 37 C.F.R. § 1.943(c)" (the June 28, 2010 patent owner petition).

This decision also addresses the June 11, 2009 change of correspondence address filed by the patent owner.

The June 28, 2010 patent owner petition, the June 11, 2010 change of correspondence address, and the record as a whole are before the Office of Patent Legal Administration for consideration.

The $400 fee pursuant to 37 CFR 1.17(f) for the June 28, 2010 petition under 37 CFR 1.183 has been received.

SUMMARY

The June 28, 2010 patent owner petition under 37 CFR 1.183 to waive the provisions of 37 CFR 1.943(c) is **dismissed as premature**.

The change of correspondence address for the patent owner that was filed on June 11, 2009, is **ineffective**.

REVIEW OF FACTS

- On July 8, 2003, U.S. Patent No. 6,591,353 (the '353 patent) issued to Barth et al.
- On April. 21, 2009, a request for *inter partes* reexamination was filed, and the resulting reexamination proceeding was assigned control number 95/001169 (the '1169 proceeding).
- On June 11, 2009, the patent owner filed a power of attorney and change of correspondence address (the June 11, 2009 change of correspondence address).
- Prosecution progressed until November 11, 2009, when an action closing prosecution was mailed.
- On December 22, 2009, the patent owner filed a response to the November 11, 2009 action closing prosecution.
- On January 15, 2010, the requester filed comments on the December 22, 2009 patent owner response.
- On February 26, 2010, a right of appeal notice (RAN) was mailed.
- On March 12, 2010, the requester filed a petition entitled "Petition by Third Party Requester to Reopen Prosecution after RAN".
- On March 23, 2010, the patent owner filed an opposition to the requester's March 12, 2010 petition.
- On March 26, 2010, the requester filed a notice of appeal.
- On April 9, 2010, the patent owner filed a notice of cross appeal.
- On May 26, 2010, the requester filed an appellant brief.
- On June 9, 2010, the patent owner filed an appellant brief.
- Also on June 9, 2010, the patent owner filed a petition under 37 CFR 1.183 to waive the provisions of 37 CFR 41.63(c) and enter the second supplemental declaration under 37 CFR 1.132 of Robert J. Murphy and the reference identified as "An American National Standard IEEE Standard 696 Interface Devices" (696 Device Interface), the petition being entitled "Patent Owner's Petition Under 37 C.F.R. § 1.183 to Waive § 41.63 and Admit Evidence".
- On June 28, 2010, the patent owner filed a respondent brief after the May 26, 2010 requester appellant brief (June 26, 2010 was a Saturday).

- Also on June 28, 2010, the patent owner filed the present petition entitled "Emergency Petition under 37 C.F.R. § 1.183 to Suspend Rule 37 C.F.R. § 1.943(c)" to the extent of the length of its concurrently-filed respondent brief (the June 28, 2010 patent owner petition).

- Also on June 28, 2010, the patent owner filed a petition entitled "Patent Owner's Petition under 37 C.F.R. § 1.182 to Strike Portions of the Third-Party Requester's Brief on Appeal".

- On July 9, 2010, the requester filed a respondent brief after the June 9, 2010 patent owner appellant brief.

- On July 22, 2010, the requester filed an opposition to the June 28, 2010 patent owner petition.

DECISION

The patent owner requests waiver of the page length provisions of 37 CFR 1.943(c) to the extent of the length of its concurrently-filed respondent brief.

The requester, however, has filed a petition on March 12, 2010, entitled "Petition by Third Party Requester to Reopen Prosecution after RAN", to which the patent owner has filed an opposition on March 23, 2010. Furthermore, concurrently with the present petition, the patent owner has filed a petition to strike portions of the requester's appellant brief that is addressed by the patent owner's respondent brief, the length of which is at issue. Accordingly, the present petition under 37 CFR 1.183 to waive the provisions of 37 CFR 41.63(c) is **dismissed as premature**, pending the decision by the Office whether to reopen prosecution after RAN, and whether to strike requester's appellant brief. If a) prosecution is reopened after RAN, or b) if prosecution is not reopened after RAN, but the requester's appellant brief is expunged, the present petition would become moot, since in either case requester's appellant brief, as well as patent owner's corresponding respondent brief, will not be treated on the merits.

The June 11, 2009 Change of Correspondence Address is Ineffective

The change of correspondence address, filed by the patent owner on June 11, 2009, is **ineffective**. The address for the patent owner in a reexamination proceeding is the official correspondence address of the patent owner *in the patent file*. See MPEP 2622 and 37 CFR 1.33(c). In the present case, the official correspondence address for the patent owner, that is of record in the patent file, application no. 09/561,868, is shown in the caption of this decision

A courtesy copy of this decision will be mailed to the practitioner who submitted the present patent owner petition, Mr. Robert G. Sterne. Absent the filing of a proper change of correspondence address in the patent file, application no. 09/561,868, however, all future correspondence will be mailed to the current address of record for the patent owner, as shown in the caption of this decision.

CONCLUSION

- The June 28, 2010 petition under 37 CFR 1.183 to waive the provisions of 37 CFR 1.943(c) is **dismissed as premature**.

- The June 11 2009 change of correspondence address of the patent owner is **ineffective**. A courtesy copy of this decision will be mailed to the practitioner who submitted the present petition, Mr. Robert G. Sterne. Absent the filing of a proper change of correspondence address in the patent file, application no. 09/561,868, all future correspondence will be mailed to the current address of record for the patent owner, as shown in the caption of this decision.

- Jurisdiction over the proceeding is being returned to the Central Reexamination Unit for appropriate action, including addressing the March 12, 2010 requester petition entitled "Petition by Third Party Requester to Reopen Prosecution after RAN".

- Any inquiry concerning this communication should be directed to the undersigned at (571) 272-7724.

Cynthia L. Nessler
Senior Legal Advisor
Office of Patent Legal Administration

7-23-10

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,171	04/23/2009	6,768,999	8157.012.999	9376

23432 7590 03/22/2010

COOPER & DUNHAM, LLP
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NEW YORK, NY 10112

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/22/2010

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

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(For Patent Owner)

MAILED

MAR 22 2010

CENTRAL REEXAMINATION UNIT

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(NDQ REEXAMINATION GROUP)
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HOUSTON, TX 77002

(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,171
Filed: April 23, 2009
For: U.S. Patent No. 6,768,999

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

This is a decision on the December 22, 2009 patent owner petition entitled "PETITION UNDER CFR 1.181, 1.182 AND/OR 1.183 TO STAY REEXAMINATION PROCEEDINGS UNTIL DETERMINATION OF REQUEST TO CORRECT INVENTORSHIP" (hereinafter "the petition to suspend") for suspension of *inter partes* reexamination proceeding control number 95/001,171.

In addition, on December 28, 2009, third party requester filed a paper entitled "THIRD PARTY REQUESTER'S OPPOSITION TO PATENT OWNER'S PETITION TO STAY REEXAMINATION PROCEEDINGS" (hereinafter "requester opposition paper"); and, on January 6, 2010, the patent owner filed a paper entitled "OBJECTION TO ENTRY OF THIRD PARTY REQUESTER'S OPPOSITION TO PATENT OWNER'S PETITION TO STAY REEXAMINATION PROCEEDINGS" (hereinafter "patent owner reply").

Patent owner's petition to suspend, and the above-described two follow-on papers, are before the Office of Patent Legal Administration.

Because the rules do not provide for the filing of a petition requesting that an *inter partes* reexamination proceeding be suspended, patent owner's petition to suspend is taken as a petition under 37 CFR 1.182 for suspension of reexamination proceeding control number 95/001,171. Third party requester's opposition paper is taken as a petition under 37 CFR 1.182 to oppose the patent owner's petition to suspend.

Patent owner's petition under 37 CFR 1.182 to suspend the present reexamination proceeding is dismissed, for the reasons set forth below.

Third party requester's opposition paper has been considered.

Patent owner's reply is an improper paper and is being expunged from the record of the 95/001,171 reexamination proceeding.

FEES

The petition fee of $400.00 pursuant to 37 CFR 1.17(f) for patent owner's petition under 37 CFR 1.182 will be charged to patent owner's Deposit Account No. 03-3125, as authorized by patent owner on page 4 of the instant petition to suspend.

The petition fee of $400.00 pursuant to 37 CFR 1.17(f) for third party requester's opposition paper, which is treated as a petition under 37 CFR 1.182, will be charged to third party requester's Deposit Account No. 14-1437, as authorized by third party requester on page 1 of the instant opposition paper.

BACKGROUND

1. U.S. Patent No. 6,768,999 ("the '999 patent") issued to Prager *et al.* on July 27, 2004.

2. A request for *inter partes* reexamination of the '999 patent was filed by third party requester on April 23, 2009, which request was assigned control number 95/001,171 ("the '1171 proceeding").

3. On May 22, 2009, an order granting *inter partes* reexamination in the '1171 proceeding was mailed. A non-final Office action on the merits accompanied the order on May 22, 2009.

4. The '1171 proceeding continued to the point when, on July 27, 2009, patent owner filed a "REQUEST TO CORRECT INVENTORSHIP" ("request to correct inventorship").

5. On December 2, 2009, the Office mailed an Action Closing prosecution in the '1171 proceeding.

6. On December 22, 2009, patent owner filed the instant petition to suspend, requesting suspension of the '1171 proceeding pending a decision on patent owner's July 27, 2009 request to correct inventorship.

7. On December 28, 2009, a third party requester opposition paper was filed, opposing patent owner's December 22, 2009 petition to suspend.

8. On January 4, 2010, patent owner filed an "AMENDMENT IN RESPONSE TO OFFICE ACTION CLOSING PROSECUTION IN *INTER PARTES* REEXAMINATION" ("submission under 37 CFR 1.951(a)").

9. On January 6, 2010, a patent owner reply paper was filed responsive to requester's December 28, 2009 opposition paper.

10. On February 3, 2010, third party requester filed "THIRD PARTY REQUESTER'S COMMENTS AFTER PATENT OWNER'S RESPONSE TO ACTION CLOSING PROSECUTION UNDER 37 CFR § 1.951" ("responsive comments under 37 CFR 1.951(b)").

DECISION

The instant patent owner petition for suspension of the '1171 reexamination proceeding and the third party requester's opposition paper have been fully considered.

I. RELEVANT STATUTES, REGULATIONS, AND EXAMINING PROCEDURE

35 USC 314(c) states:

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

37 CFR 1.103(a) states (in part):

> *Suspension for cause*. On request of the applicant, the Office may grant a suspension of action by the Office under this paragraph for good and sufficient cause. The Office will not suspend action if a reply by applicant to an Office action is outstanding. Any petition for suspension of action under this paragraph must specify a period of suspension not exceeding six months.

37 CFR 1.182 states (in part):

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

37 CFR 1.937(a) states:

> All *inter partes* reexamination proceedings, including any appeals to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within

> the Office, unless the Director makes a determination that there is good cause for suspending the reexamination proceeding.

37 CFR 1.939(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.

The Manual of Patent Examining Procedure (MPEP) 2667(I)(B)(4) provides (in-part):

> Note that after an opposition to any patent owner petition is filed by a third party requester (regardless of whether such opposition has an entry right or not), any further paper in opposition/rebuttal/response to the third party opposition paper will not be considered and will be returned. There must be a limitation on party iterations of input, especially given the statutory mandate for special dispatch in reexamination. (emphasis added)

MPEP 2686.01(II) provides (in-part):

> A suspension will only be granted in exceptional (extraordinary) instances because of the statutory requirements that examination proceed with "special dispatch", and the express written approval by the OPLA must be obtained. Suspension will not be granted when there is an outstanding Office action.

II. DISCUSSION

In the instant petition to suspend, patent owner requests suspension of the '1171 proceeding pending a decision by the Central Reexamination Unit (CRU) on patent owner's July 22, 2009 request to correct inventorship.[1] As an initial matter, it is noted that patent owner's petition to suspend was filed on December 22, 2009, at which time the December 2, 2009 Action Closing Prosecution (ACP) was outstanding. Pursuant to MPEP 2686.04 (III), "suspension will not be considered on its merits when there is an outstanding Office action." [2] However, because patent owner subsequently filed its comments submission under 37 CFR 1.951(a) on January 4, 2010 and third party requester filed its responsive comments under 37 CFR 1.951(b) on February 3, 2010, patent owner's petition to suspend is now ripe for consideration.

35 USC 314(c) expressly allows for the suspension of an *inter partes* reexamination proceeding within the Office "for good cause," notwithstanding that *inter partes* reexamination proceedings are to be conducted with "special dispatch." Pursuant to 35 USC 314(c) and 37 CFR 1.937(a), the USPTO Director has authority to determine circumstances amounting to "good cause" for suspension of an *inter partes* reexamination proceeding, and to do so on a case-by-case basis. For example, under certain circumstances, there may be good cause to suspend an *inter partes* re-

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[1] Petition to suspend at page 1.

[2] In this instance, a response to an ACP is not required; thus, even if two comments submissions had not been filed, the petition would have been ripe for consideration after the time for filing them had expired.

examination proceeding when concurrent litigation involving the patent being reexamined is near its final resolution.[3] In such a situation there may be good cause to suspend when there is a strong possibility that the conclusion of the litigation would obviate the reexamination.[4]

In the December 2, 2009 Action Closing Prosecution, claims 1-5 stand rejected. Claim 1 has been rejected under 35 USC 102(e) as being anticipated by Freeman (US Patent No. 6,006,227) and has also been rejected under 35 USC 102(e) as being anticipated by Mander (US Patent No. 6,243,724). Claims 2, 4 and 5 have been rejected under 35 USC 103(a) as being unpatentable over Mander in view of Lucas (US Patent No. 5,499,330). In support of its request for suspension of the '1171 proceeding pending a decision on the request to correct inventorship, patent owner asserts that "[a] grant of the Request to Correct Inventorship would remove the Freeman '227 patent as a reference against claim 1 of the '999 Patent, and therefore would overcome the rejection of claim 1 as anticipated by the Freeman '227 Patent."[5] Patent owner asserts, therefore, that a stay would "promote efficiency of the reexamination proceeding" and "avoid undue prejudice to the Patentee because the likely grant of the Request [sic] would obviate any need for the Patentee to argue for patentable differences between the Freeman '227 Patent and claim 1 of the '999 Patent."[6] Patent owner further asserts reasons why it believes the request to correct inventorship "is likely to be granted."[7]

Patent owner's arguments for suspending the '1171 proceeding are not persuasive. Even if the CRU decided patent owner's request to correct inventorship in patent owner's favor, that decision would not obviate all of the outstanding claim rejections of the '999 patent. While a favorable decision on the inventorship issue would enable patent owner to disqualify the Freeman reference and overcome the rejection of claim 1 with respect to Freeman, the anticipation rejection of claim 1 and the obviousness rejection of claims 2-5 with respect to the Mander reference would remain outstanding. Accordingly, the claim rejection in the '1171 proceeding would not be completely dealt with upon resolution of the inventorship issue by the CRU. On the balance, therefore, the facts and circumstances in this case do not establish "good cause" to suspend the '1171 proceeding to await a decision by the CRU on patent owner's request for correction of inventorship. Accordingly, the patent owner petition to suspend, requesting suspension of the '1171 reexamination proceeding, is **dismissed**.

III. ADDITIONAL DISCUSSION

Patent owner's January 6, 2010 reply paper, responsive to requester's December 28, 2009 opposition paper, is an unauthorized paper in the '1171 proceeding. After an opposition to a

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[3] *See* MPEP 2686.04(V) (discussing reexamination control numbers 95/000,093 and 95/000,094 in which, action was suspended based on ongoing litigation. After a District Court decision adverse to requester, it was determined that "good cause" existed to wait for the outcome of the Federal Circuit appeal, because the reexamination proceedings were only at their beginning stages, while the concurrent litigation was potentially near its final resolution.).

[4] *See* MPEP 2686.04(V) (explaining that the there was a strong possibility that the Federal Circuit's decision would estop the Office from issuing any decision at all in the 95/000,093 and 95/000,094 proceedings).

[5] Petition to suspend at page 2.

[6] Petition to suspend at pages 2-3.

[7] Petition to suspend at page 3.

patent owner petition is filed by a third party requester (regardless of whether such opposition has an entry right or not) any further paper in opposition, rebuttal or response to the third party requester opposition paper is improper and will not be considered, as there is a limitation on party iterations of input, especially given the statutory mandate for special dispatch in reexamination. *See* MPEP 2667(I)(B)(4). There is no indication anywhere in the reexamination statute, or its legislative history, nor in the case law, that multiple iterations of input in petitionable matters prior to decision on the base petition was ever contemplated as an exception to the statutory mandate for special dispatch in reexamination.

Moreover, the patent owner can only file once under 37 CFR 1.951(a). Any second or supplemental submission after ACP by the patent owner will be returned, unless prosecution has been reopened. *See* MPEP § 2667 (I)(A)(3).

In view of the above, patent owner's January 6, 2010 reply paper is an improper paper, and it will not be made of record in the file of the '1171 proceeding. Because patent owner's January 6, 2010 reply 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 '1171 proceeding. *See* MPEP 2267. No copy of the August January 6, 2010 patent owner reply paper will be maintained of record in the Office. A copy of this decision will be made of record in the IFW of the '1171 proceeding.

CONCLUSION

1. The patent owner December 22, 2009 petition to suspend is dismissed.

2. Patent owner's January 6, 2010 reply paper is an improper paper, and it will not be made of record in the file of the '1171 proceeding. 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 '1171 proceeding.

3. Jurisdiction over the '1171 proceeding is returned to the Central Reexamination Unit for decision on the July 27, 2009 patent owner "REQUEST TO CORRECT INVENTORSHIP."

4. 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

Kenpet8/IP/suspend
3-19-10

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COOPER & DUNHAM, LLP
30 Rockefeller Plaza
20th Floor
NEW YORK, NY 10112

: (For Patent Owner)

MAILED

MAR 24 2010

CENTRAL REEXAMINATION UNIT

: (For Requester)

Novak Druce & Quigg, LLP
(NDQ Reexamination Group)
1000 Louisiana Street Fifty-Third Floor
Houston, TX 77002

In re Patent No. 6,768,999
Issue Date: July 27, 2004
Appl No.: 95/001,171
Filed: April 23, 2009
For: ENTERPRISE, STREAM-BASED INFORMATION MANAGEMENT SYSTEM

DECISION GRANTING PETITION
37 CFR 1.324

This is a decision on the petition filed July 27, 2009 to correct inventorship under 37 CFR 1.324.

The petition is **granted**.

Review of the instant petition shows it meets the requirements proscribed under 37 CFR 1.324. The fee of $ 130 under 37 CFR 1.20 (b) has been charged to Deposit Account No. 03-3125.

Pursuant to MPEP 2250.02, a certificate of correction indicating the change of inventorship will **not** be issued as the reexamination certificate that will ultimately issue will contain the appropriate change of inventorship information. The certificate of correction will be, in effect, merged with the reexamination certificate. In the rare event the reexamination proceeding concludes but not result in a reexamination certificate under 37 CFR 1.570 (e.g., reexamination is vacated), the patent owner may, after the conclusion of the proceeding, request that the inventorship be corrected by a certificate of correction.

/J. Harrison/

J. Harrison
Supervisory Patent Examiner
Art Unit 3992
Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,175	04/24/2009	6415082	29776.184	1652

20786 7590 12/23/2009

KING & SPALDING
1180 PEACHTREE STREET , NE
ATLANTA, GA 30309-3521

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 12/23/2009

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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Dallas, TX 75219

Date:

MAILED

DEC 23 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001175
PATENT NO. : 6415082
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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DEC 29 2009

CENTRAL REEXAMINATION UNIT

David L. McCombs
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DALLAS, TX 75219

(For Third Party Requester)

In re: Wach
Inter Partes Reexamination Proceeding
Control No. 95/001,175
Deposited on: 24 April 2009
For: US Patent No. 6,415,082

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

This is a decision on the 11 December 2009, "Petition for One-Month Extension of Time Under 37 CFR § 1.550(c)" (sic) requesting the response period be extended by one-month for the non-Final Office action mailed 06 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 for the reasons set forth below.

DISCUSSION

The Patent Owner's representative requests the period for response be extended by one-month for the non-final Office action mailed 06 November 2009, which set two (2) 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 patent owner is reminded that *inter partes* reexaminations extensions of time are petitioned pursuant to 37 CFR § 1.956. While the petition was submitted under 37 CFR § 1.550(c) which is for *ex parte* reexaminations, the petition will be treated under 37 CFR § 1.956.

The request is granted.

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

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

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

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

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

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

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

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

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

DECISION

The patent owner's representative petitions to extend the period for response by adding one (1) month to the response period under 37 CFR § 1.550(c) but is handled in the instant decision under 37 CFR § 1.956. The decision to extend the period for response is evaluated based upon a showing of "sufficient cause." There is always the consideration to balance the need for the patent owner to have a fair opportunity to respond to the Office action between the need for special dispatch.

The non-final Office action was mailed 06 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 several reasons for extension, among them, the large number of outstanding rejections to the claims as well as the need for time to obtain evidence and affidavits. On balance, the petitioner has demonstrated "sufficient cause" for the purpose of granting one (1) month extension of time.

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

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

CONCLUSION

1. The patent owner's petition for extension for one (1) month time in which to file a response to the non-final Office action dated 06 November 2009 is hereby **granted.**

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

3. The response is extended to **06 February 2010.**

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

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

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

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

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

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

/Mark Reinhart/

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

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CENTRAL REEXAMINATION UNIT

KING & SPALDING
1180 PEACHTREE STREET, NE
ATLANTA, GA 30309-3521

(For Patent Owner)

DAVID L. MCCOMBS
HAYNES AND BOONE, LLP, IP SECTION
2323 VICTORY AVENUE, SUITE 700
DALLAS, TX 75219

(For Third Party Requester)

Inter Partes Reexamination Proceeding	:	**DECISION**
Control No. 95/001,175	:	**DISMISSING**
Filed: April 24, 2009	:	**PETITION**
For: U.S. Patent No. 6,415,082	:	**UNDER 37 CFR 1.183**

This is a decision on the patent owner paper entitled "PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE PAGE LIMIT REQUIREMENT FOR THIRD PARTY REQUESTER COMMENTS UNDER 37 C.F.R. § 1.943(b)," filed on March 10, 2010.

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

The $400.00 petition fee pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183 was charged to requester's deposit account on March 11, 2010.

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

BACKGROUND

1. On July 2, 2002, United States Patent No. 6,415,082 ("the '082 patent") issued to Michael L. Wach.

2. On April 24, 2009, a request for *inter partes* reexamination of the '082 patent was filed by a third party requester, which request was assigned Reexamination Control No. 95/001,175 ("the '1175 proceeding").

3. On July 2, 2009, the Office mailed an order granting *inter partes* reexamination in the '1175 proceeding.

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4. On November 6, 2009, the Office mailed a non-final Office action on the merits in the '1175 proceeding.

5. On December 11, 2009, patent owner filed a request for extension of time to respond to the November 6, 2009 Office action.

6. On December 23, 2009, the Office mailed a decision granting the patent owner's December 11, 2009 request for extension of time, extending the time period for responding to the November 6, 2009 office action by one month.

7. On February 8, 2010, patent owner filed a response to the November 6, 2009 Office action.

8. On March 10, 2010, third party requester filed "COMMENTS BY THIRD PARTY REQUESTER PURSUANT TO 37 C.F.R. §1.947" responsive to patent owner's February 8, 2010 response and the November 6, 2009 Office action.

9. Concurrently, on March 10, 2010, third party requester filed the instant 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)" ("the 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 1.943(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.

Requester's Petition under 37 CFR 1.183

On March 10, 2010, requester filed the instant petition under 37 CFR 1.183, concurrently with its comments responsive to patent owner's February 8, 2010 response and the November 6, 2009

Office action. In the petition under 37 CFR 1.183, requester requests waiver of 37 CFR 1.943(b) to permit entry of its comments, which requester asserts exceed the 50 page limit by 36 pages.[1] In this instance, requester has drafted comments that include "42 pages of comments directed to issues raised by the Office action or the Patent Owner's Reply," in addition to a declaration under 37 CFR 1.132 ("the Tomlinson declaration"), which "includes 3 pages directed to the issues raised by the Office action or the Patent Owner's Reply," for a combined total of 45 pages.[2] However, requester seeks waiver of the 37 CFR 1.943(b) to permit entry of a 41-page claim chart (Exhibit I) such that the total page count for requester's comments would exceed the 50-page limit by 36 pages.[3]

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. In this instance, requester has substantiated its request for waiver of the 50-page limit of 37 CFR 1.943(b) for entry of its 41-page claim chart (Exhibit I) with specific facts regarding the nature of patent owner's February 8, 2010 response.

In particular, requester asserts that patent owner's February 8, 2010 response includes an amendment presenting 87 new claims in the '1175 proceeding.[4] Requester asserts that it seeks to file the 41-page claim chart with its March 10, 2010 comments "for the Examiner's convenience in examining the large number of (87) new claims," and that "[a]lthough the contents of the claims chart is summarized in the 42 pages of comments, the Examiner will likely find the format of the claims chart simplifies and expedites the examination of these new claims."[5] Requester further asserts that "waiver is in keeping with the substantial interest of justice, in that the Requester should have the opportunity to effectively address each of the 87 new claims and all of the issues raised by the Patent Owner's Reply. Furthermore, allowing the Third Party Requester to adequately respond to the patentability of each of the new claims and providing the explanation for the proposed rejections in a claims chart format 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."[6]

Analysis and Findings

To obtain a waiver of the 50-page length requirement of 37 CFR 1.943(b), any grantable petition under 37 CFR 1.183 must be accompanied by a patent owner response submission or a requester comments submission that:

---

[1] Petition under 37 CFR 1.183 at page 2.
[2] Id. at page 1.
[3] Id.
[4] Id. Claims 1-34 were previously pending in the '1175 proceeding, and patent owner presented new claims 35-121 in the February 8, 2010 amendment.
[5] Id.
[6] Id. at page 2.

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1) is double-spaced;
2) is in a non-script type font (e.g., Arial, Times New Roman, or Courier);
3) has a font size no smaller than 12-point;
4) conforms to the margin requirements of 37 CFR 1.52(a)(1)(ii); and
5) has sufficient clarity and contrast to permit direct reproduction, and electronic capture by digital imaging and optical character recognition.

See, generally, 37 CFR 1.943(a) and 37 CFR 1.52.

In this instance, the 42 pages of comments, and the entire Tomlinson declaration, submitted as part of requester's March 10, 2010 comments submission, do not satisfy the formatting guidelines set forth above for a grantable petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b).[7] Accordingly, requester's March 10, 2010 petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b) is dismissed.

Requester is hereby given a time period of **fifteen (15) days from the mailing date of this decision** to file a renewed petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b) with a comments submission that complies with the formatting guidelines set forth herein; otherwise, requester's March 10, 2010 comments submission will be deemed defective as not being page-length compliant and will not be considered. In the event requester files a renewed petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), no additional fee need be submitted.

It is noted that, in the event requester files a renewed petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b) with a comments submission, the content of which is identical to that of the presently submitted comments submission, with the exception that the (currently, 42) pages of comments and the entire Tomlinson declaration **also** comply with the formatting guidelines set forth herein, such renewed petition would be grantable. In this instance, the specific facts set forth in requester's March 10, 2010 petition under 37 CFR 1.183, and the individual facts and circumstances of this case, such as, e.g., the incorporation by reference, in the November 6, 2009 Office action, of approximately 276 pages of claim charts from the April 24, 2009 request for *inter partes* reexamination, demonstrate an extraordinary situation in which justice requires suspension the 50-page limit of 37 CFR 1.943(b).

CONCLUSION

1. Requester's March 10, 2010 petition under 37 CFR 1.183 is **dismissed**.

2. Requester is hereby given a time period of **fifteen (15) days from the mailing date of this decision** to file a renewed petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b) with a comments submission that complies with the formatting guidelines set forth herein; otherwise, requester's March 10, 2010 comments submission will be deemed defective as not being page-length compliant and will not be considered.

[7] The 41-page claim chart need not be double-spaced. The format, i.e., the font type, font size, line spacing, and margins of the 41-page claim chart are deemed to be compliant.

3. Jurisdiction for the '1175 proceeding is being returned to the Central Reexamination Unit (CRU).

4. Any questions concerning this communication should be directed to Nicole Dretar, Legal Advisor, Office of Patent Legal Administration, at (571) 272-7717.

Kenneth M. Schor

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

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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.
95/001,178	04/24/2009	6470405	2805.003REXA	2039

26111 7590 12/02/2009

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 12/02/2009

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/001,178	04/24/09	6470405	2805.003REXA

David M. O'Dell
HAYNES AND BOONE, LLP
IP SECTION
2323 VICTORY AVENUE
SUITE 700
DALLAS, TX 75219

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ESCALANTE, OVIDIO	
ART UNIT	**PAPER**
3992	

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12/02/09

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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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Alexandria, VA 22313-1450
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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/001,178	04/24/09	6470405	2805.003REXA

David M. O'Dell
HAYNES AND BOONE, LLP
IP SECTION
2323 VICTORY AVENUE
SUITE 700
DALLAS, TX 75219

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ESCALANTE, OVIDIO	
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3992	

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Robert Greene Sterne
STERNE, KESSLER, GOLDSTEIN
& FOX P.L.L.C.
1100 NEW YORK AVENUE, N.W.
WASHINGTON DC 20005

(For Patent Owner)

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DEC 02 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)

In re: Barth *et alia*
Inter Partes Reexamination Proceeding
Control No. 95/001,178
Deposited on: 24 April 2009
For: US Patent No. 6,470,405

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

This is a decision on the 24 November 2009, "Petition for Extension of Time to File Response to Action Closing Prosecution Pursuant to 37 CFR § 1.956," requesting that the time for responding to the action closing prosecution mailed 14 November 2009, be further extended by one (1) month. The petition was timely filed with certificate of service.

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

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

DISCUSSION

The Patent Owner's representative requests the period of time be further extended in which to file a response to the action closing prosecution mailed 14 November 2009, which set one (1)

month time for filing a response thereto. The petition for extension of time was timely filed on 24 November 2009, together with electronic fee transmittal for the $200.00 petition fee as required by 37 CFR § 1.956 and 37 CFR § 1.17 (g). A certificate of service was provided with the petition.

The request is granted-in-part.

CITATION OF RELEVANT AUTHORITY

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

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

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

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

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

> Requests for an extension of time in an inter partes reexamination proceeding will be

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

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

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

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

DECISION

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

The action closing prosecution was mailed 14 November 2009. The patent owner submitted a timely filed the petition on 24 November 2009 with the appropriate fee and certificate of service.

The petition dated 24 November 2009 cites several reasons for the need for additional time. The delay in receipt of the action both by USPS and availability on public PAIR as well as the unavailability of the patent owner's expert declarants are the most persuasive in evaluating "sufficient cause." On balance, the petitioner has demonstrated "sufficient cause" to grant a fourteen (14) days extension of time.

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

CONCLUSION

1. The patent owner's petition for further extension for one (1) month time in which to file a response to the action closing prosecution dated 14 November 2009 is hereby **granted-in-part.**

2. The period for response is further extended by fourteen (14) days.

3. The response is extended to **28 December 2009.**

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

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

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

By Hand: Customer Service Window
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401 Dulany Street
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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.

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.
95/001,183	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.
95/001,080	09/09/2008	7321783	RIK107440A	9118

40401 7590 12/30/2009

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2845 Duke Street
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EXAMINER	
ART UNIT	PAPER NUMBER

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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

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2845 Duke Street
Alexandria, VA 22314

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ART UNIT	PAPER NUMBER

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(NDQ REEXAMINATION GROUP)
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HOUSTON, TX 77002

Date MAILED

DEC 30 2009

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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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Date: MAILED
DEC 30 2009
CENTRAL REEXAMINATION UNIT

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COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Hershkovitz & Associates, LLC
2845 Duke Street
Alexandria, VA 22314

(For Patent Owner)

MAILED
DEC 30 2009
CENTRAL REEXAMINATION UNIT

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(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.

---

[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.

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[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.
95/001,184	04/30/2009	7068668	027639.0021-US02	9102

26181 7590 03/23/2010

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PO BOX 1022
MINNEAPOLIS, MN 55440-1022

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/23/2010

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
COVINGTON & BURLING, LLP
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1201 PENNSYLVANIA AVENUE, N.W.
WASHINGTON, DC 20004-2401

Date:
MAILED
MAR 2 3 2010
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001184
PATENT NO. : 7068668
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,239	10/01/2009	7068668	2001417.132-US1	2456

26181 7590 03/23/2010

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/23/2010

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

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Date:

MAILED

MAR 2 3 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001239
PATENT NO. : 7068668
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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COMMISSIONER FOR PATENTS
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ALEXANDRIA, VA 22313-1450
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CENTRAL REEXAMINATION UNIT

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Inter Partes Reexamination Proceeding
Control No. 95/001,184
Filed: April 30, 2009
For: U.S. Patent No. 7,068,668

Inter Partes Reexamination Proceeding
Control No. 95/001,239
Filed: October 1, 2009
For: U.S. Patent No. 7,068,668

DECISION TO *SUA SPONTE* 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. 7,068,668 (the '668 patent) issued to Feuer on June 27, 2006.

2. A request for *inter partes* reexamination of claims 1-37 of the '668 patent was filed on April 30, 2009, by third party requester Verizon Long Distance LLC, et al., and the request was assigned control number 95/001,184 (the '1184 *inter partes* proceeding).

3. On June 22, 2009, *inter partes* reexamination was ordered for claims 1-9, 11-16 and 18-37 of the '668 patent based on the examiner's determination that the April 30, 2009 request raised a substantial new question of patentability affecting these claims.

4. On June 22, 2009, a non-final Office action was mailed in the '1184 *inter partes* proceeding, rejecting claims 1-9, 11-16, and 18-37 of the '668 patent.

5. On August 24, 2009, patent owner filed a response to the June 22, 2009 Office action requesting reconsideration of the rejections of the claims and proposing amendments to claims 1, 3, 10, 12, 17, 18, and 21 and submitting new claims 38-43.

6. On September 22, 2009, the third party requester filed comments on the June 22, 2009 Office action and patent owner's August 24, 2009 response.

7. A request for *inter partes* reexamination of claims 1-37 of the '6668 patent was filed on October 1, 2009, by third party requester Vonage Holdings Corp., and the request was assigned control number 95/001,239 (the '1239 *inter partes* proceeding).

8. On December 16, 2009, *inter partes* reexamination was ordered for claims 10, 17, 24, 26-29, and 31-32 of the '668 patent based on the examiner's determination that the October 1, 2009 request raised a substantial new question of patentability affecting these claims.

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:

> (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 95/001,184 and 95/001,239 proceedings are merged. The merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

Patent owner is required to maintain the same claims (and specification) in both files throughout the merged proceeding. Amendments to claims 1, 3, 10, 12, 17, 18, and 21 and new claims 38-43 have been proposed in the '1184 proceeding, while there is no amendment in the '1239

proceeding. Thus, the claims are not currently the same in both files. An Office action requiring an amendment placing the claims in identical form is being issued concurrently with this decision. Patent owner must respond to the Office action in accordance with the procedures in 37 CFR 1.111. The third party requesters will then have an opportunity to comment on patent owner's response in accordance with the procedures in 37 CFR 1.947.

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

The present decision merges two *inter partes* reexamination proceedings. Pursuant to 37 CFR 1.989(a), the merged examination will normally result in the issuance and publication of a single reexamination certificate under 37 CFR 1.997.

It is noted that reexamination was ordered for claims 1-9, 11-16, and 18-37 of the '668 patent in the '1184 *inter partes* proceeding, while reexamination was ordered for claims 10, 17, 24, 26-29, 31, and 32 of the '668 patent in the '1239 *inter partes* proceeding. The examiner will conduct reexamination in the merged proceeding for claims 1-37 of the '668 patent (all the claims of the 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 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.

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

C. Amendments:

The filing of any amendments to the drawings, specification or claims must comply with 37 CFR 1.943 and the guidelines of MPEP § 2666.01.

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.

F. Appeal Procedure Reminders for *Inter Partes* Reexamination

The parties are reminded of the procedures for taking appeal in an *inter partes* reexamination as explained in MPEP 2674 and 2675. The appeal must only be taken from (1) the rejection(s) of the claims in the Right of Appeal Notice (RAN) that the *patent owner* proposes to contest, or (2) the finding(s) of patentability of claims in the RAN that the *third party requester* proposes to contest. Therefore, in the notice of appeal, the patent owner must identify each claim rejected by examiner that the patent owner intends to contest and the third party requester must identify each rejection *that was previously proposed by that third party requester* that the third party requester intends to contest. (37 CFR 41.61) The appellant's brief shall present a concise statement of each issue. Further, no new ground of rejection can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection. (37 CFR 41.67(c)(1)(vi))

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/001,184 and *inter partes* Reexamination Control No. 95/001,239 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.

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

March 15, 2010

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,184	04/30/2009	7068668	027639.0021-US02	9102

26181 7590 03/23/2010

FISH & RICHARDSON P.C.
PO BOX 1022
MINNEAPOLIS, MN 55440-1022

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/23/2010

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
COVINGTON & BURLING, LLP
ATTN: PATENT DOCKETING
1201 PENNSYLVANIA AVENUE, N.W.
WASHINGTON, DC 20004-2401

Date:

MAILED

MAR 2 3 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001184
PATENT NO. : 7068668
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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FISH & RICHARDSON P.C.
PO BOX 1022
MINNEAPOLIS, MN 55440-1022

(For Patent Owner)

MAILED

MAR 23 2010

CENTRAL REEXAMINATION UNIT

ANDREA G. REISTER
COVINGTON & BURLING LLP
1201 PENNSYLVANIA AVE., N.W.
WASHINGTON, D.C. 20004

(For *Inter Partes* Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,184
Filed: April 30, 2009
For: U.S. Patent No. 7,068,668

: **DECISION DISMISSING**
: **PETITION REQUESTING**
: **MERGER**

This is a decision on third party requester Verizon's January 26, 2010 request captioned "PETITION TO MERGE MULTIPLE COPENDING REEXAMINATION PROCEEDINGS UNDER MPEP § 2686.01(VI)". The request is being treated as a petition under 37 CFR 1.182 (question not specifically provided for).

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

A petition fee in the amount of $400 under 37 C.F.R. 1.17(f) has been charged to third party requester's deposit account as authorized on page 2 of the subject petition.

The petition is dismissed as moot as the reexamination proceedings for U.S. Patent 7,068,668 have been *sua sponte* merged.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 7,068,668 (the '668 patent) issued to Feuer on June 27, 2006.

2. A request for *inter partes* reexamination of claims 1-37 of the '668 patent was filed on April 30, 2009, by third party requester Verizon Long Distance LLC, et al., and the request was assigned control number 95/001,184 (the '1184 *inter partes* proceeding).

3. On June 22, 2009, *inter partes* reexamination was ordered for claims 1-9, 11-16 and 18-37 of the '668 patent based on the examiner's determination that the April 30, 2009 request raised a substantial new question of patentability affecting these claims.

4. On June 22, 2009, a non-final Office action was mailed in the '1184 *inter partes* proceeding, rejecting claims 1-9, 11-16, and 18-37 of the '668 patent.

5. On August 24, 2009, patent owner filed a response to the June 22, 2009 Office action requesting reconsideration of the rejections of the claims and proposing amendments to claims 1, 3, 10, 12, 17, 18, and 21 and submitting new claims 38-43.

6. On September 22, 2009, the third party requester filed comments on the June 22, 2009 Office action and patent owner's August 24, 2009 response.

7. A request for *inter partes* reexamination of claims 1-37 of the '6668 patent was filed on October 1, 2009, by third party requester Vonage Holdings Corp., and the request was assigned control number 95/001,239 (the '1239 *inter partes* proceeding).

8. On December 16, 2009, *inter partes* reexamination was ordered for claims 10, 17, 24, 26-29, and 31-32 of the '668 patent based on the examiner's determination that the October 1, 2009 request raised a substantial new question of patentability affecting these claims.

9. On January 26, 2010, third party requester Verizon Long Distance LLC et al. filed a petition to merge multiple copending reexamination proceedings under MPEP 2686.01(VI) in the '1184 proceeding.

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 1.985 Notification of prior or concurrent proceedings in inter partes reexamination.

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

37 CFR 1.989(a) Merger of concurrent reexamination proceedings.

> (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.

II. DECISION

In accordance with 37 CFR 1.989(a), the Office has made a *sua sponte* decision to merge the '1184 and the '1239 proceedings. The merger decision is being mailed concurrently with this decision. Therefore, petitioner's request for merger is moot. Accordingly, the third party requester's petition requesting merger is dismissed.

In general, it is recommended that the third party requester simply file a notification of concurrent proceedings pursuant to 37 CFR 1.985(b) so that the Office may *sua sponte* consider any action to be taken when merger and suspension options become ripe. However, in this instance, as the Office is aware of the concurrent proceedings, it is not necessary for the third party requester to file the notice of concurrent proceedings in this proceeding.

CONCLUSION

1. The petition filed January 26, 2010 is dismissed.

2. Jurisdiction over the reexamination file in the '1184 proceeding is being forwarded via the Director of the Central Reexamination Unit (CRU) to the examiner.

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

March 15, 2010

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APR 3 0 2010

CENTRAL REEXAMINATION UNIT

In re Application of :
DONALD S. FEUER :
Control No. 95/001,239 (US PAT 7,068,668) : DECISION ON PETITION
Filed: October 01, 2009 : TO WITHDRAW
Attorney Docket No. 24862-0002RX3 : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed April 28, 2010.

The request is **APPROVED**.

A grantable request to withdraw as attorney/agent of record must be signed by every attorney/agent seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. The Office requires the practitioner(s) requesting withdrawal to certify that he, she, or they have: (1) given reasonable notice to the client, prior to the expiration of the response period, that the practitioner(s) intends to withdraw from employment; (2) delivered to the client or a duly authorized representative of the client all papers and property (including funds) to which the client is entitled; and (3) notified the client of any responses that may be due and the time frame within which the client must respond, pursuant 37 CFR 10.40(c).

The request was signed by Stephen R. Schaefer on behalf of all attorneys of record.

All attorneys/agents associated with Customer Number 26181 have been withdrawn.

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

The correspondence address of record has been changed and the new correspondence address is the first copied address indicated below.

Copied from 95001239 on 06/28/2010

Telephone inquiries concerning this decision should be directed to Patricia Volpe at 571-272-6825.

RVolpe for

Eric S. Keasel
Supervisory Patent Examiner
CRU 3992

cc: DONALD S. FEUER
CENTRE ONE
2938 CALLE FRONTERA
SAN CLEMENTE, CA 92673

cc: LAURA A. SHERIDAN (Third Party Requester)
WILMER CUTLER PICKERING HALE AND DORR LLP
399 PARK AVENUE
NEW YORK, NY 10022

Enclosure:

Copy of request for withdrawal as attorney or agent and change of correspondence address filed on April 28, 2010. There is no indication it was served on the Third Party Requester.

Copied from 95001239 on 06/28/2010

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,188	05/12/2009	6304937	9278.002.937	2299

86497 7590 12/11/2009

Paul M. Anderson, PLLC
P.O. Box 160006
Austin, TX 78716

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 12/11/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/001,188	05/12/09	6304937	9278.002.937

EXAMINER
ESCALANTE, OVIDIO

ART UNIT	PAPER
3992	

TRACY DRUCE
NOVAK DRUCE & QUIGG LLP
1000 LOUISIANA AVE
53rd FLOOR
HOUSTON, TX 77002

DATE MAILED:

12/11/09

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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Paul M. Anderson, PLLC (For Patent Owner)
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Austin TX 78716

NOVAK, DRUCE & QUIGG, LLP (For Third Party Requester)
(NDQ Reexamination Group)
1000 Louisiana Avenue
Fifty-Third Floor
Houston, TX 77002

MAILED

DEC 11 2009

CENTRAL REEXAMINATION UNIT

In re Farmwald *et al.*
Reexamination Proceeding
Control No. 95/001,188
Filed: May 12, 2009
For: U.S. Patent No. 6,304,937

: DECISION
: DISMISSING
: PETITION

This is a decision on Patent Owner's October 6, 2009 petition entitled "PETITION TO SUSPEND PROCEEDINGS." On November 5, 2009, third party Requester filed an opposition to Patent Owner's October 6, 2009 petition, which has also been considered.

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, and it was charged to Patent Owner's credit card on October 7, 2009 pursuant to the authorization for same in Patent Owner's EFS-WEB fee transmittal.

The Third Party Requester opposition is being taken as a petition under 37 CFR 1.182. The fee set forth in 37 CFR 1.17(f) for this petition is $400, and it will be charged to Requester's deposit account no. 14-1437 pursuant to the authorization on page one of Requester's November 5, 2009 petition.

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

Patent Owner's petition is dismissed for the reasons set forth below.

REVIEW OF FACTS

1. On October 16, 2001, the Office issued U.S. Patent No. 6,304,937 (the '937 patent) to Farmwald *et al.*

2. On May 12, 2009, a request for *inter partes* reexamination of all the claims (claims 1-40) of the '937 patent was filed by third party Requester (Requester) NVIDIA Corporation. The request was assigned Control No. 95/001,188 (the '1188 proceeding).

3. On May 13, 2009, a request for *ex parte* reexamination of all the claims (claims 1-40) of the '937 patent was filed by the same Requester (NVIDIA Corporation). The request was assigned Control No. 90/010,537 (the '10537 proceeding).

4. The '937 patent is subject to litigation in the United States District Court for the District of Northern California, in *Rambus Inc. v. Nvidia Corp.*, {Civil Action No. 3:08-cv-3343}. The initial complaint was filed July 10, 2008. Based upon the initial complaint, Patent Owner appears to be enforcing at least one of claims 1-40 against the Requester in the litigation.

5. On July 7, 2009, the Office issued an order granting the '1188 request for *inter partes* reexamination and stating that a first action on the merits would be issued in due course. The order stated that all the claims of the '937 patent, claims 1-40, would be subject to reexamination.

6. Also on July 7, 2009, the Office issued an order granting the '10537 request for *ex parte* reexamination and setting a two month time period for a Patent Owner's Statement. The order stated that all the claims of the '937 patent, claims 1-40, would be subject to reexamination.

7. On October 6, 2009, Patent Owner filed the present petition, citing 35 U.S.C. § 314 and 37 CFR 1.939, requesting waiver of 37 CFR 1.939 and suspension of the '1188 *inter partes* reexamination proceeding. Concurrently, Patent Owner filed a petition requesting a prevention of merger between the '1188 and the '10537 reexamination proceedings.

8. On November 5, 2009, third party Requester filed an opposition to Patent Owner's October 6, 2009 petition to suspend. Concurrently, third party Requester filed an opposition to Patent Owner's request to prevent merger of the '1188 and the '10537 reexamination proceedings.

9. This decision addresses the Patent Owner petition to stay the '1188 proceeding and the Requester's opposition to the staying of the '1188 proceeding. The Patent Owner petition to prevent merger and the Requester's opposition to the request to prevent merger are addressed in a separate decision issued on even date with this decision.

10. As of the date of this decision, an Office action on the merits has not issued.

RELEVANT STATUTES, RULES AND GUIDANCE

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. 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.

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 1.935 states:

> The order for *inter partes* reexamination will usually be accompanied by the initial Office action on the merits of the reexamination.

37 CFR 1.937(a) states:

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

37 CFR 1.939 states:

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

> (b) Unless otherwise authorized, no paper shall be filed prior to the initial Office action on the merits of the inter partes reexamination.

37 CFR 1.987 states:

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

MPEP 2640 II states (in part):

> Where reexamination is granted on a second or subsequent request, but the Patent Owner can clearly show that the second or subsequent request was filed for purposes of harassment, the Patent Owner can petition under 37 CFR 1.182 that the second or subsequent request should be suspended.

MPEP 2686.04 III states (in part with respect to suspension of *inter partes* reexamination):

> "...35 U.S.C. 314 provides for *inter partes* reexamination the clause "[u]nless otherwise provided by the Director for good cause", this clause is not present in 35 U.S.C. 305 for *ex parte* reexamination. Accordingly, where there is good cause for the Director of the USPTO to suspend (stay) reexamination proceedings pending the conclusion of litigation, a suspension will be effected. This matter will be approached on a case-by-case basis."

DECISION

I. Preliminary Matters

A. Waiver of 37 CFR 1.939

As noted, *supra*, the present request for reexamination of the '937 patent was filed on May 12, 2009, and reexamination was granted on July 7, 2009. The language of 37 CFR 1.935 makes the concurrent sending of an Office action on the merits permissive. As noted above, the Examiner of record has not issue an Office action. In accordance with 37 CFR 1.939(a) unauthorized papers will not be considered in *inter partes* reexamination. Furthermore 37 CFR 1.939(b) does not permit the filing of any papers prior to the filing of the first office action on the merits. Therefore, both Patent Owner's petition dated October 6, 2009 and Requester's opposition dated November 5, 2009 are not authorized. However, based upon the unique facts and circumstances of the present proceeding, in the interests of justice and special dispatch, to the extent necessary 37 CFR 1.939 is waived.

B. Proper Legal Authority and Procedural Matters Regarding the Petition

In regard to Patent Owner's attempts to stay the '1188 reexamination proceeding, 37 CFR 1.987 provides that "[I]f a patent in the process of *inter partes* reexamination is or becomes involved in litigation, the Director shall determine whether or not to suspend the *inter partes* reexamination proceeding." Also, 37 CFR 1.937(a) provides that, "All *inter partes* reexamination proceedings . . . will be conducted with special dispatch within the Office, unless the Director makes a determination that there is good cause for suspending the reexamination proceeding."

Thus, both 37 CFR 1.987 and 37 CFR 1.937(a) provide authority for *sua sponte* suspension of an *inter partes* reexamination proceeding by the Office. However, neither rule authorizes the filing of a petition to suspend an *inter partes* reexamination proceeding. No regulation authorizes the filing of a petition to suspend an *inter partes* reexamination proceeding. Therefore, the Patent Owner's petition is being considered pursuant to 37 CFR 1.182 (questions not specifically provided for in the regulations), as petitioner's proposed suspension of an *inter partes* reexamination proceeding is a situation not specifically provided for in the regulations. The fee set forth in 37 CFR 1.17(f) for a § 1.182 petition is $400, and it has been charged to petitioner's deposit account as stated above.

II. Findings and Analysis

Patent Owner asserts the filing of multiple voluminous requests for reexamination on the same patent, and related patents, in a very narrow time frame constitutes harassment to justify suspension the '1188 *inter partes* reexamination proceeding. Patent Owner also argues that suspension of the '1188 *inter partes* reexamination proceeding is appropriate because the Requester should be held to non-binding MPEP 904.03 guidance directed *towards examiners* to cite only the "best" references when conducting the prior art search for an application. Patent Owner makes no assertion to justify the suspension of reexamination based upon concurrent litigation addressing the '937 patent, being conducted in the U.S. District Court for the Northern District of California. Patent Owner requests the remedy of an indefinite suspension in this *inter partes* reexamination proceeding. The Requester opposes Patent Owner's request, asserting that the request is without legal merit and that the Office should dismiss the petition to stay the '1188 proceeding.

In *Ethicon v. Quigg*,[1] the Federal Circuit addressed the propriety of the Office suspending *ex parte* reexamination proceedings. The court considered whether the Commissioner had "authority to stay reexamination pending the outcome of district court litigation."[2] The Federal Circuit held that an indefinite suspension, granted under the authority of 37 CFR 1.565(b) was

[1] *Ethicon v. Quigg*, 849 F.2d (Fed. Cir. 1988).
[2] *Id.* at 1425.

not consistent with the unequivocal statutory requirement of 35 U.S.C. 305 of conducting reexamination proceedings in the Office with special dispatch. The *inter partes* reexamination statute (35 U.S.C. 314(c)) does provide for a statutory "good cause" exception to special dispatch. Thus, a patent owner may be granted a suspension if a good cause showing to suspend is established on the record. In the present case, however, Patent Owner has not established on the record a good cause showing to suspend the '1188 *inter partes* reexamination proceeding. Accordingly, the requested relief will not be granted.

Petitioner has requested an indefinite suspension in this *inter partes* reexamination proceeding, based upon the existence of a concurrent *ex parte* reexamination proceeding. *Inter partes* reexamination by statute must be conducted with special dispatch in the same manner as *ex parte* reexamination proceedings, unless there is good cause not to do so. As a matter of standard policy, the Office merges concurrent reexamination proceedings on the same patent when it is in furtherance of the statutory mandate of special dispatch, and declines merger when special dispatch would be frustrated by such merger.[3] In this instance, merger at the early stage in both the *ex parte* and *inter partes* reexamination proceedings would clearly further 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. While such a merger will preclude a patent owner interview, such an interview is not a statutory or regulatory[4] right, while special dispatch is clearly desired by the statute. To suspend the present proceeding would complicate the examination and prosecution of the *ex parte* reexamination, as it would be necessary to exclude all matters bearing any relation to the *inter partes* reexamination proceeding, in order not to prejudice the *inter partes* reexamination requester's right to respond to patent owner *re* such matters. Thus, in each instance of a patent owner response, a "fine" distinction and determination would need to be made, and that determination might be subject to requester challenge.

Harassment based Suspension. Patent Owner alleges the existence of "harassment" to justify suspension of the '1188 *inter partes* reexamination proceeding due to the Requester's filing of two allegedly voluminous requests for reexamination in two days for the '937 patent, in addition to multiple reexamination requests filed against patents related to the '937 patent. The filing of *inter partes* and *ex parte* reexamination requests on other patents, albeit patents related to the '937 patent, is not relevant to the issue of harassment toward the Patent Owner in the reexamination of the '937 patent. Therefore, the issue of harassment will focus upon the actions of the Requester with respect to the reexamination of the '937 patent only. The first request filed against the '937 patent was an *inter partes* reexamination, the '1188 proceeding. The second request was an *ex parte* reexamination proceeding, the '10537 proceeding. MPEP 2640 II states

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[3] MPEP 2686.01

[4] While 37 CFR §§ 1.133 and 1.560 provide the guidelines for conducting and making a record of interviews, but do not confer a right to an interview.

that the procedure for filing any petition for suspension based upon harassment is to file the suspension request in the second or subsequently filed reexamination proceeding. It would be the second proceeding that provided harassment, if such were the case, and thus that proceeding would be the one to suspend – not the first proceeding. Petitioner, by filing the petition for suspension in the '1188 proceeding, has erred by petitioning to suspend the first reexamination proceeding, and not the allegedly harassing second or subsequent proceeding.

However, even if Patent Owner had filed the petition in the second proceeding, the allegation of harassment as a basis of suspension of the second proceeding is unsupported. MPEP 2640 II requires that the Patent Owner "clearly show" that the second or subsequent request was filed for purposes of harassment. Patent Owner has stated on the record that the second reexamination, the '10537 proceeding, consisted of less that half the number of substantial new questions (SNQ) and claim chart pages as presented in the '1188 *inter partes* reexamination request. Patent Owner then speculates that Requester "recognized" that a single request containing 123 SNQs would not be granted by the Office; yet, Patent Owner provides no evidence to support this asserted Requester recognition. Furthermore, Patent Owner points to no authority that sets forth that a single request verses a set of two requests containing 123 SNQs is tantamount to *per se* harassment of the Patent Owner. Patent Owner merely sets forth the conclusory statement that such a filing is not reasonable. Patent Owner then goes on to cite *inter partes* reexamination 95/001,134, which is a proceeding to reexamine U.S .Patent No. 6,260,097 and not the present '937 patent. As pointed out previously, the reexaminations of other patents are not relevant to the present proceedings. Finally, Patent Owner alleges that, based upon Office procedure, continuation of both the '1188 *inter partes* and the '10537 *ex parte* reexamination proceeding would be burdensome, whether merged or not, and thus the filings are unreasonable and clearly constitute harassment. However, the degree of burden would be the same if all issues had presented in one reexamination request, and the employment of multiple SNQs has not been shown to be for the purpose of harassment. To the contrary, estoppel attaches in *inter partes* reexamination to all issues that requester could have raised (35 U.S.C. 315(c) and 35 U.S.C. 317(b)), and bringing all issues to the table could have easily been Requester's motive, as opposed to harassment.

Patent Owner has not made an evidentiary showing that the '10537 *ex parte* reexamination proceeding was filed with an intent to harass. Patent Owner has not shown that the Requester intentionally withheld the references in the '10537 *ex parte* reexamination request from the '1188 *inter parte* reexamination request with the intent to harass. The Requester has only filed two reexamination requests and has not been shown to have had the intent to withhold references for purposes of harassment. Therefore, Patent Owner's arguments are not persuasive, as no evidence of harassment in the filing of the '10537 *ex parte* reexamination proceeding has been shown. The facts and circumstances surrounding the filing of the *inter partes* and subsequent *ex parte* reexamination proceeding in this instance do not evidence harassment by the Requester of the Patent Owner. Accordingly, Patent Owner's arguments that Requester's filing of two requests for reexamination in two days for the same patent is not persuasive as a basis for

"harassment" on which to base suspension of a reexamination proceeding.

A point to be noted *re* Requester's argument: Requester cites and discusses *Fed. Reg.*, Vol. 65, No. 67 at 18168-69 (PTO Discussion of Specific Rules, Proposed rule 37 CFR 1.948) in support of the assertion that there was no harassment. (Requester's November 5, 2009 opposition, page 4.) 37 CFR 1.948 places regulatory limitations upon the submission of prior art by a third party Requester following the order for *inter partes* reexamination, to prevent harassment of the Patent Owner. The rule does not regulate an *inter partes* Requester's right to file *ex parte* reexamination requests. The Federal Register discussion of then proposed rule 37 CFR 1.948 does acknowledge an *inter partes* Requester's right to file *ex parte* reexamination requests for the purposes of submitting art, when the Requester's art submission is precluded by the rule. However, neither the rule, nor the cited Federal Register discussion, state that an attempt to submit prior art by an *inter partes* Requester via an *ex parte* reexamination request cannot constitute harassment (on which to base suspension). Nor does the rule or discussion intimate that the timing alone of an *ex parte* request relative to the *inter partes* proceeding is determinative on the issue of harassment. Moreover, none of Requester's arguments in the opposition changes the fact that the Office has absolute discretion to either merge or suspend, based upon the equities of each fact situation as it arises, on a case-by-case basis. If the equities were decided to be in favor of suspension in this instance, the relevant proceeding would have been suspended.

Good Cause based Suspension. Patent Owner alleges the existence of "good cause" to suspend the reexamination proceeding due to the Requester's filing of two requests for reexamination consisting of 369 pages, with 123 SNQs supported by approximately 2400 pages of claim charts. Patent Owner asserts that by making such a "voluminous" submission in the form of two requests for reexamination, the Requester has not "focused" the request by using the "best art" in accordance with MPEP 904.03 and thus has forfeited any argument that suspension of the *inter partes* reexamination disadvantages the Requester. MPEP 904.03 is not binding guidance that is not applicable to a third party Requester. As Requester asserts, both requests comply with all relevant statutes, regulations and guidance. Requester notes the Office has granted both requests and concluded that all proposed SNQs in both filings were substantial, non-cumulative and new, in accordance with statutory requirements. The statutory requirements for submission of a request for reexamination of a patent are set forth in 35 U.S.C. §§ 303 and 312, for *ex parte* and *inter partes* requests respectively. The regulatory requirements for submission of a request for reexamination are set forth in 37 CFR 1.510 and 37 CFR 1.915, for *ex parte* and *inter partes* requests respectively. Detailed guidance regarding the submission of requests for patent reexamination is outlined in MPEP §§ 2210 *et seq.* and 2610 *et seq.*, for *ex parte* and *inter partes* requests respectively. None of the relevant statutes, rules or guidance that govern reexamination requests reflect the existence of any "volume," "focused" or "best art" requirements that Patent Owner alleges the Requester to have violated. If there was a statutory or regulatory problem with the focus of the requests in applying the art of describing the SNQs, the Central Reexamination Unit (CRU) could have refused to accord a filing date to the requests; the CRU

compliance, on the part of Requester, with the relevant statutes, rules or guidance that governs reexamination requests and proceedings. Therefore, Patent Owner has not established on the record a "good cause" showing to justify the drastic remedy of an indefinite suspension of the *inter partes* reexamination proceeding. Contravention of the statutory mandate of special dispatch requires more that mere displeasure with the volume of non-cumulative issues raised by the reexamination requests. Accordingly, Patent Owner's arguments as to Requester's filing of two compliant, but "voluminous," requests for reexamination in two days on the same patent is not a persuasive as a basis for "good cause" suspension of the '1188 *inter partes* reexamination proceeding. (And again, if a proceeding were to be suspended, it is the *ex parte* reexamination that was filed second and would be suspended – not the first filed *inter partes* reexamination.)

Accordingly, the petition to stay the '1188 *inter partes* reexamination is dismissed.

CONCLUSION

1. The October 6, 2009 Patent Owner petition for suspension is dismissed.

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

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

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

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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RAMBUS INC.
Morgan Lewis & Bockius, LLP
2 Palo Alto Square
3000 El Camino Real
Palo Alto, CA 94306

(For patent owner)

MAILED

OCT 02 2009

CENTRAL REEXAMINATION UNIT

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(For 95/001,189 Requester)

William H. Wright
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(For 90/010,365 Requester)

Jon E. Wright
Sterne Kessler Goldstein Fox, PLLC
1100 New York Avenue, NW
Washington, DC 20005

(Courtesy Copy)

In re Barth, et al
Ex parte Reexamination Proceeding :
Control No. 90/010,365 :
Filed: December 18, 2008 :
For: U.S. Patent No. 7,287,119 :

In re Barth et al. :
Inter partes Reexamination Proceeding :
Control No.: 95/001,189 :
Filed: May 18, 2009 :
For: U.S. Patent No. 7,287,119 :

DECISION TO MERGE REEXAMINATION PROCEEDINGS

The above-captioned reexamination proceedings are before the Office of Patent Legal Administration for 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 7,287,119 (the '119 patent) issued to Barth et al. on October 23, 2007, with 23 claims.

2. A request for *ex parte* reexamination, assigned Reexamination Control No. 90/010,365 ('365 proceeding), was filed on December 18, 2008, by third party requester NVIDIA Corporation.

3. An order granting reexamination of claims 21-22 of the '119 patent was mailed in the '365 proceeding on February 20, 2009.

4. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/001,189 ('1189 proceeding), was filed on May 18, 2009. NVIDIA Corporation is identified as the real party in interest.

5. An order granting reexamination of claims 1-23 of the '119 patent was mailed in the '1189 reexamination proceeding on August 3, 2009.

6. A First Office action was mailed on April 29, 2009 in the '365 *ex parte* reexamination proceeding. A response to the Office action was filed on July 29, 2009 and a Supplemental response was filed on August 25, 2009. No amendments were made to the claims.

7. No Office action has been mailed, and no amendments to the claims have been made, in the '1189 *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.

Under 37 CFR 1.989(b):

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

As evidenced by the above review of facts, both the '365 and the '1189 reexamination proceedings are currently pending. An order granting reexamination of claims 22 and 23 has been mailed in the '356 reexamination proceedings, an order granting reexamination of claims 1-23 has been mailed in the '1189 proceeding, 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 90/010,365 and 95/001,189 reexamination proceedings would address these considerations. Thus, pursuant to 37 CFR 1.989(a), the 90/010,365 and 95/001,189 reexamination proceedings are hereby merged. The merged proceeding will be conducted in accordance with the guidelines and requirements which follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

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

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

The present decision merges an *ex 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 proceedings are governed by 37 CFR 1.510 through 1.560. In this instance, however, the '365 *ex parte* reexamination was requested by the same third party that requested the *inter partes* reexamination. And, that third party (NVIDIA Corporation) has full *inter partes* reexamination participation rights.

B. Papers mailed/filed:

All papers mailed by the Office throughout the merged proceeding will take the form of a single action which applies to both proceedings. All papers issued by the Office or filed by the patent owner and the third party 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 '365 proceeding and (3) the '1189 proceeding. The current correspondence address of record for the patent file is the proper patent owner address for reexamination mailings pursuant to 37 CFR 1.33(c), and it is that of RAMBUS INC., c/o Morgan Lewis & Bockius, LLP, 2 Palo Alto Square, 3000 El Camino Real, Palo Alto, CA 94306. Accordingly, all future correspondence will be directed to RAMBUS INC., c/o Morgan Lewis & Bockius, LLP, 2 Palo Alto Square, 3000 El Camino Real, Palo Alto, CA 94306, 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).

As a courtesy, this decision is being mailed to both addresses. However, as pointed out above, the address of RAMBUS INC., c/o Morgan Lewis & Bockius, LLP, 2 Palo Alto Square, 3000 El Camino Real, Palo Alto, CA 94306, will be used in future correspondence, unless the address of record is changed as set forth above.

CONCLUSION

1. *Ex parte* Reexamination Control No. 90/010,365 and *inter partes* Reexamination Control No. 95/001,189 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

2. Patent owner is provided with ONE (1) MONTH from the mailing of this decision to file papers to address the correspondence address considerations in both proceedings, as set forth in the last section of this decision.

3. Jurisdiction over the merged reexamination 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 Maria Nuzzolillo, Legal Advisor, at (571) 272-8150.

Pinchus M. Laufer
Legal Advisor
Office of Patent Legal Administration

UNITED STATES PATENT AND TRADEMARK OFFICE

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ROBERT GREENE STERNE
STERNE, KESSLER, GOLDSTEIN
& FOX P.L.L.C.
1100 NEW YORK AVENUE, N.W.
WASHINGTON DC 20005

(For Patent Owner)

DEC 11 2009

WILLIAM H. WRIGHT
ORRICK, HERRINGTON & SUTTCLIFFE, LLP
IP PROSECUTION DEPARTMENT
4 PARK PLAZA
SUITE 1600
IRVINE, CA 92614-2558

(For 90/010,365 Requester)

DAVID O'DELL
HAYNES & BOONE LLP, IP SECTION
2323 VICTORY AVENUE SUITE 700
DALLAS TX 75202-3789

(For 90/001,189 Requester)

In re BARTH *et alia*
Reexamination Proceeding
Control No. 90/010,365
Request Deposited: December 18, 2008
For: U.S. Patent No. 7,287,119

In re BARTH *et alia*
Reexamination Proceeding
Control No. /95/001,189
Request Deposited: May 18, 2009
For: U.S. Patent No. 7,287,119

: DECISION DISMISSING
: PETITION FOR
: EXTENSTION OF TIME
: [37 CFR 1.956]

This is a decision on the December 7, 2009 patent owner's petition titled "Petition for Extension of Time for Respond Under 37 CFR § 1.956." Owner seeks two months additional time for response. The petition is before the Director of the Central Reexamination Unit for consideration of the above petition.

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

REVIEW OF RELEVANT FACTS

1. U.S. Patent Number 7,287,119 (the ' 119 patent) issued to Barth et al. on October 23, 2007, with 23 claims.

2. A request for *ex parte* reexamination, assigned Reexamination Control No. 90/010,365 ('365 proceeding), was filed on December 18, 2008, by third party requester NVIDIA Corporation.

3. An order granting reexamination of claims 21-22 of the '119 patent was mailed in the '365 proceeding on February 20, 2009.

4. A request for reexamination, assigned Reexamination Control No. 95/001,189 ('1189 proceeding), was filed on May 18, 2009. NVIDIA Corporation is identified as the real party in interest.

5. An order granting reexamination of claims 1-23 of the ' 119 patent was mailed in the ' 1189 reexamination proceeding on August 3,2009.

6. A First Office action was mailed on April 29, 2009 in the '365 ex parte reexamination proceeding. A response to the Office action was filed on July 29, 2009 and a supplemental response was filed on August 25, 2009. No amendments were made to the claims.

7. A decision merging proceedings with *inter partes* reexamination 95/001,189 was mailed by the Office on October 2, 2009.

8. A first office action was mailed November 14, 2009.

9. A petition requesting dissolution of merger was filed October 21, 2009 and remains outstanding.

DECISION

Patent Owner petitions the director of the Central Reexamination Unit for a two (2) month extension of time. The petition is filed, together with the online credit card payment authorization of 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.

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.

Analysis and Findings

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 prepare Affidavits/Declarations regarding the status of an applied prior art printed publication, and well as other technical experts. Details are set forth on pages 4-6 and 9 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 outstanding office action granted a two month response period. While owner insists two additional months are needed, on balance it appears fair that one month is sufficient additional time to provide for the preparation of Affidavits and Declaration evidence.

Therefore, an extension of time of one-month is hereby granted.

CONCLUSION

1. Patent owner's petition for a two-month extension of time in which to file a response to the o Office action dated November 14, 2009 is hereby **granted- in- part**. A one-month extension is granted. The period for response is hereby extended to **February 14, 2009.**

2. **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 *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

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.

3. Telephone inquiries related to this decision should be directed to J. Harrison at (517) 272-4449, Eric Keasel, at (571) 272-4929, or Mark Reinhart, at (571) 272-1611.

/J. Harrison/

J. Harrison, SPE AU 3992
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,189	05/18/2009	7287119	2805.002REX8	8867

26111 7590 12/16/2009

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 12/16/2009

MAILED

DEC 16 2009

CENTRAL REEXAMINATION UNIT

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,365	12/18/2008	7287119	2805.002REX4	6415

26111 7590 12/16/2009

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 12/16/2009

MAILED
DEC 16 2009
CENTRAL REEXAMINATION UNIT

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patents and Trademark Office
P.O.Box 1450
Alexandria, VA 22313-1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
HAYNES AND BOONE, LLP IP SECTION
2323 VICTORY AVENUE
SUITE 700
DALLAS, TX 75219

Date: MAILED

DEC 16 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001189
PATENT NO. : 7287119
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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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
ORRICK, HERRINGTON, & SUTCLIFFE, LLP
IP PROSECUTION DEPT.
4 Park Plaza, Suite 1600
Irvine, CA 92614-2558

Date: MAILED
DEC 16 2009
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010365
PATENT NO. : 7287119
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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In re Barth *et al.*
Inter partes Reexamination Proceeding
Control No.: 95/001,189
Filed: May 18, 2009
For: U.S. Patent No. 7,287,119

In re Barth *et al.*
Ex Parte Reexamination Proceeding
Control No.: 90/010,365
Filed: December 18, 2008
For: U.S. Patent No. 7,287,119

: DECISION
: DISMISSING
: PETITION TO
: RECONSIDER
: MERGER OF
: REEXAMINATION
: PROCEEDINGS

This is a decision on patent owner's October 21, 2009 patent owner petition entitled "PETITION UNDER 37 C.F.R. §§ 1.182 and 1.183 TO RECONSIDER MERGER OF CO-PENDING REEXAMINATION PROCEEDINGS".

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 22, 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.

REVIEW OF FACTS

1. On October 23, 2007, the Office issued U.S. Patent No. 7,287,119 (the '119 patent) to Barth *et al.*

2. The '119 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 1-23 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 18, 2008, a request for *ex parte* reexamination of claims 21 and 22 of the '119 patent was filed by third party requester, NVIDIA Corporation. The request was assigned Control No. 90/010,365 (the '10365 proceeding).

5. On February 20, 2009, the Office issued an order granting the '10365 request for *ex parte* reexamination and setting a two month time period for a Patent Owner's Statement. The order indicated that claims 21 and 22 of the '119 patent, would be subject to reexamination.

6. The time for filing a patent owner's statement pursuant to 37 CFR 1.530 in the '10365 *ex parte* reexamination proceeding expired on April 20, 2009.[1]

7. On April 29, 2009, the Office issued a first Office action on the merits in the '10365 *ex parte* reexamination proceeding.

8. On May 18, 2009, a request for *inter partes* reexamination of all the claims (claims 1-23) of the '119 patent was filed by the same third party requester (NVIDIA Corporation). The request was assigned Control No. 95/001,189 (the '1189 proceeding).

9. On June 22, 2009, the ITC granted Patent Owner's motion for partial termination with respect to the '119 patent. Therefore, the '119 patent is no longer involved in the ITC investigation.

10. On July 29, 2009, Patent Owner filed a response in the '10365 *ex parte* 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.

proceeding. The response did not amend, cancel or add new claims.[2]

11. On August 3, 2009, the Office issued an order granting the '1189 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 '119 patent, claims 1-23, would be subject to reexamination.

12. On August 23, 2009, Patent Owner filed a supplemental response in the '10365 *ex parte* reexamination proceeding. The response did not amend, cancel or add new claims.

13. On October 2, 2009, the Office, *sua sponte,* issued a decision merging the '1189 *inter partes* reexamination proceeding with the '10365 *ex parte* reexamination proceeding.

14. On October 21, 2009, patent owner filed the present petition requesting reconsideration of the merger of the '10365 *ex parte* proceeding, with the '1189 *inter partes* proceeding.

15. 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

[2] Patent Owner petitioned for and was granted a one month extension of time to respond to the April 29, 2009 Office action.

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. 314states (in part):

> (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.
>
> (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 requester's reexamination filing pattern combined with a merger of the two reexamination proceedings denies Patent Owner of "*ex parte* reexamination rights" and expands the requester's *inter partes* rights. Therefore, Patent owner requests the remedies of: (1) Vacatur of the merged proceeding; (2) Demerger of the *inter partes* and *ex parte* reexamination proceedings and suspension of the *inter partes* reexamination proceeding; or (3) Waiver of 37 CFR 1.989(b) to permit interviews, if the *inter partes* and *ex parte* reexamination proceedings are neither vacated nor demerged.

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.[3] The relevant sections of the MPEP provide guidance on the conduct of interviews to include denial of an interview.[4] Further, no expansion of the requester's statutory right is precipitated by the merging of the two proceedings. The merger process does not permit the *inter partes* requester, to go beyond the scope of commenting upon issues raised in the examiner's actions or the patent owner's response within thirty days. Therefore, merger of an *inter partes* and *ex parte* reexamination cannot be an *ultra vires* act. Accordingly, merger neither divests Patent Owner of any *ex parte* reexamination rights nor expands the *inter partes* requesters rights, because merger does not implicate any statutory 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[5] 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,

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[3] 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.

[4] See MPEP §§ 713 *et seq.*, 2281 and 2685

[5] Substantial New Question of Patentability

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 '1189 *inter partes* reexamination proceeding with the '10365 *ex parte* reexamination proceeding circumvents the statutory prohibition of 35 U.S.C. 317(a) that precludes a single third party requester of an 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 request 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.

Regarding the requester's strategy of filing reexamination requests, Patent Owner's arguments are more in keeping with an allegation of harassment, rather than violation of 35 U.S.C. 317(a). However, Patent Owner has not established a clear showing that the "filing strategy" was based upon the intent to harass. Therefore, relief in the form of a suspension of the subsequently ordered proceeding for reexamination cannot be granted.

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 the proceeding was filed with 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. Accordingly, Patent Owner's argument that merger violates 35 U.S.C. 317(a) is not persuasive.

Demerger or Waiver of 37 CFR 1.989(b). Patent Owner asserts that, based upon the facts and circumstances surrounding the filings of the '1189 *inter partes* reexamination proceeding and the '10365 *ex parte* reexamination proceeding, merger should not have been granted. Patent Owner further asserts that, based upon the facts and circumstances surrounding the filings, even if merger is maintained, 37 CFR 1.989(b) should be waived to permit Patent Owner's retention of full *ex parte* reexamination 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.[6]

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,

[6] Presumably intimating the previously asserted argument of a statutory violation of 35 U.S.C. 317(a)

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.

Furthermore, merger does not expand the statutory rights of an *inter partes* third party requester. Patent Owner's argument is - that not only does the status of the requester, *inter partes* or *ex parte*, limit a requester's right to comment, but also the source of the issue raised, from an *inter partes* request or an *ex parte* request, limits the requester's right to comment. The statutory rights of an *inter partes* requester are set forth in 35 U.S.C. 314(b)(2). The plain language of the statute 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.

The statute defines the right to comment in the *inter partes* requester. Once the proceedings are merged, all issues are present in the *inter partes* reexamination, and the *inter partes* requester can comment on all such issues provided 35 U.S.C. 314(b)(2) is satisfied. As to the combination of all issues in both the *inter partes* and *ex parte* reexaminations, it is noted that there is nothing in the statute that prevents the combining of the two proceedings to efficiently resolve all issues as to the patent. To the contrary, 35 U.S.C. 312 explicitly permits the Office to consider information not cited in an *inter partes* reexamination (as does 35 U.S.C. 303 for *ex parte* reexamination), and the inclusion of the *ex parte* reexamination issues in the *inter partes* reexamination proceeding to facilitate special dispatch resolution of all issues is an efficient use of the consideration of other information.

In this instance, first, the *inter partes* requester's right to comment is contingent upon the patent owner commenting. Second, the *inter partes* requester's right to comment is limited to issues raised in either the Office action or the Patent Owner's response to the action (hereafter the "issue source limitation"). Finally, the statute only confers this limited right to comment upon an "*inter partes*" requester, (hereafter the "status limitation").[7] While Patent Owner is correct as to the status limitation that only an *inter partes* requester has the right to comment under 35 USC 314(b) (2), Patent owner is in error as to the issue source limitation placed upon the *inter partes*

[7] In an *inter partes-ex parte* reexamination merger where the requesters are different parties the status limitation alone precludes the *ex parte* requester from having any right to comment in the merged proceeding. In an *inter partes-ex parte* reexamination merger where the same party is both the *inter partes* and *ex parte* requester then only the statutory issue source limitation precludes the requester from having a right to comment on a given issue.

requester's right to comment. The issue source limitation is not grounded in what is raised in the *inter partes* request verses an *ex parte* request, but instead by statute based upon what issues are raised in the Office action and the Patent Owner's response to the Office action, which is currently being commented upon. Patent Owner is conflating a requester's status limitation with the issue source limitation to arrive at the misplaced conclusion that an *inter partes* requester's rights are *ultra vires* expanded by merger with an *ex parte* reexamination request. However, merger does not expand the statutory rights of the *inter partes* requester, because merger leaves untouched the requester status and issue source limitations that 35 U.S.C. 314(b)(2) places upon a given requester's right to comment.

Therefore, Patent Owner's arguments to demerge, and for waiver of 37 CFR 1.989(b) if merger remains, are not persuasive. Accordingly, the petition to demerge the proceeding and stay the *inter partes* proceeding, or modify the merged proceeding to preserve "*ex parte* rights" and prevent expansion of requester rights is dismissed.

CONCLUSION

1. The October 14, 2009 Patent Owner petition is dismissed.

2. *Inter partes* Reexamination Control No. 95/001,189 and *ex parte* Reexamination Control No. 90/010,365 remain merged as a single proceeding.

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

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

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,194	05/29/2009	7400858	8282-83120-01	3014

7590 07/13/2010

D. N. HALGREN
35 CENTRAL ST.
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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 07/13/2010

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.
95/001,194	05/29/09	7400858	8282.83120.01

RICHARD D. McLEOD
KLARQUIST SPARKMAN LLP
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PORTLAND, OR 97204

EXAMINER	
FOSTER, ROLAND	
ART UNIT	**PAPER**
3992	

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07/13/10

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.

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MAILED

JUL 13 2010

CENTRAL REEXAMINATION UNIT

In re Crowley, et al :
Reexamination Proceeding : DECISION
Control No.: 95/001,194 : ON §1.182 and § 1.183
Filed: May 29, 2009 : PETITIONS
For: U.S. Patent No.: 7,400,858 :
Title: Radiative Focal Area Antenna :
Transmission Coupling Arrangement :

This is a decision on addressing (1) a November 23, 2009 patent owner "Petition to Vacate the *Inter Partes* Reexamination for Failure to Comply with 37 C.F.R. 1.915(b)(8) (refiled on April 9, 2010)," which will be treated as a petition under § 1.182, and (2) on December 23, 2009 (a) a third party "Petition Under 37 C.F.R. § 1.183 to Suspend the Rules and Enter Third Party Requester's Opposition to the Patent Owner's Petition to Vacate," refiled on May 10, 2010 and (b) a third party requester's Opposition to the Patent Owner's Petition to Vacate *Inter Partes* Re-Examination."

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

Patent owner's § 1.182 petition to vacate the reexamination is dismissed.

Third party requester's petition under § 1.183 for entry is granted, and the Opposition remains entered and was considered in the decision on patent owner's § 1.182 petition.

FEES

The § 1.182 and § 1.183 petition fees of $400.00 fee (as set forth in 37 CFR 1.17(f)) have been paid as indicated in Office PALM records.

BACKGROUND

1. U.S. Patent No. 7,400,858 (the '858 patent) was issued on July 15, 2008.

2. On May 29, 2009, a request for *inter partes* reexamination of the '858 patent was

filed by requester Richard D. McLeod.[1] The request identified as the real party in interest Aircell LLC.[2] The request was assigned reexamination control No. 95/001,194 (the '1,194 reexamination proceeding). The request noted copending litigation of *Ambit Corp. v. Delta Air Lines, Inc., et al.*, Case No. 1:09-cv-10217-WGY, (D. Mass.).[3]

3. On July 24, 2009, the Office issued an Order granting *inter partes* reexamination for the'1,194 reexamination proceeding.

4. On November 23, 2009, patent owner filed the instant petition to vacate the filing date of the present reexamination proceeding,[4] which will be treated as a petition under § 1.182.

5. On December 23, 2009, third party requester filed an opposition to the patent owner's November 23, 2009 petition for vacatur and a petition under § 1.183 for entry of the opposition.[5]

Section 1.182 PETITION FOR VACATUR

Petitioner (Patent Owner) asserts that the real party in interest was not properly identified in the request for reexamination as required by § 1.915(b)(8). [6]

Petitioner points out that (1) Delta Air Lines (Delta) is a joint defendant along with the sole named real party in interest, Aircell LLC (Aircell), in the identified litigation, (2) that both Aircell and Delta have filed joint briefs in the identified litigation, and (3) Aircell and Delta are working together to market Gogo™ and Delta is currently marketing on its website the Gogo™ service of Aircell.[7]

Petitioner further asserts that:

- The fact that Delta is a co-defendant in a pending litigation involving the '858 patent litigation gives Delta a real interest in the *inter partes* reexamination of the patent.

- In filing joint briefs in the litigation[8] Aircell and Delta did not indicate themselves as independent defendants, nor did they indicate that they were represented by separate counsel, and thus this provides further evidence that both are the real parties in interest in the *inter partes* reexamination.

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[1] Request, at page 1, paragraph 2.
[2] Request, at page 2, paragraph 14.
[3] *Id.* at page 2, paragraph 13.
[4] The petition was refiled on April 9, 2010.
[5] On May 10, 2010 requester submitted a § 1.183 petition seemingly merely as a reminder relating to requester's petition and opposition filed on December 23, 2009 (notwithstanding a reference to a December 24, 2009 papers).
[6] Petition, at page 3.
[7] Petition, at page 3 and Appendices A-C.
[8] Petition, at page 3 and Appendix D.

- Both Aircell and Delta are working together to market the Gogo™ service, which is the subject of the infringement asserted in the litigation of the '858 patent. Such cooperation also provides additional evidence that Aircell and Delta are both real parties in interest in the *inter partes* reexamination.

SECTION 1.183 PETITION

Petitioner third party requester seeks suspension of the rules to permit entry of an opposition to patent owner's § 1.182 petition to vacate the *inter partes* reexamination. Third party requester petitioner notes that patent owner petitioner requests extraordinary relief by asking the Commissioner of Patents to vacate the reexamination, after all the claims have been rejected. Entry of the third party opposition by granting third party's petition should allow the Commissioner to expeditiously confirm the status of Delta as not a real party in interest, which expeditious treatment is especially desirable in view of the statutory requirement for "special status"[9] in reexamination.

THIRD PARTY OPPOSITION

The third party requester opposes vacating the *inter partes* reexamination based on a its alleged failure to identify Delta as an additional real party in interest. The Opposition states that Delta has[10]:

- Not provided any financial compensation to the third party requester,
- No right to control, supervise, or review any document that has been prepared or filed in the reexamination,
- Not provided any feedback or technical review to the requester,
- Not contributed or suggested any prior art that has been submitted in the instant reexamination proceeding, and
- Not formulated any of the substantial new questions formulated by the third party requester.

It is conceded by requester that "certain invalidity arguments formulated by the Requester (and presented in the re-examination request) may have been used or adapted for use in the Litigation." However, it is argued that such "events are outside the intent of the statute, and do not transform co-defendant DAL into a real-party-in-interest in the re-examination, based on the current interpretation of the law.[11]

The third party requester finally unequivocally states that it "has not attempted to shield any entity from being named as a real-party-in-interest."[12]

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[9] 35 U.S.C. § 114(c).
[10] Opposition, at page 2.
[11] *Id.*, at page 4.
[12] *Id.*

DECISION ON § 1.183 PETITION BY THIRD PARTY REQUESTER

The § 1.183 petition by third party requester, seeking entry of its opposition to the patent owner's § 1.182 petition, seeking vacatur of the reexamination, is granted.

Justice requires that the requester be given an opportunity, via the present petition, to respond to patent owner's petition to terminate requester's requested reexamination. It is noted that the statements by the third party requester regarding Delta and its lack of relation to the *inter partes* reexamination request are helpful in determining the action to be taken on patent owner's § 1.182 petition in regard to the failure to name Delta as a real party in interest in the reexamination request.

DECISION ON § 1.182 PETITION BY PATENT OWNER

The § 1.182 petition by patent owner seeking vacatur of the *inter partes* reexamination based on the failure to name Delta as a real party in interest is dismissed.

The MPEP [13] makes clear that the Office does not look beyond the required certification in the request for reexamination, except for the rare instance where a challenge to the sufficiency of the certification facially establishes that the identified real party in interest is not accurate. The certification cannot be successfully challenged merely because, at one point, the certified real party in interest was "involved" with another party, or there was some collaboration in a matter other than the request for reexamination.

The instant reexamination was filed noting the pending litigation where Delta is a joint defendant with the sole named real party in interest. The common interest among litigation defendants seeking to invalidate a patent does not translate *ipso facto* into each defendant being a real party in interest where a request for reexamination is filed by only one of the defendants in the litigation. This is not to say that the other defendants cannot be real parties in interest in a request for reexamination, but such result cannot merely be based either on the concomitant use of available common defendant litigation materials in a later request for reexamination or use of publically available material filed in a reexamination that are later introduced into litigation. To be required to be named as a real party in interest, a party must participate in some manner in the request for reexamination. Accordingly, a search for prior art, review of possibly useful prior art, preparation of an invalidity defense based on found and evaluated prior art to support a litigation defense, and financial support to carry out a litigation defense - do not amount to participation in a request for reexamination based on such activities, where the activities are conducted with only an intent to defend the litigation suit. Evidence that the activities were conducted with an intent to file an *inter partes* reexamination

[13] MPEP § 2612.

request is required, in order for a petitioner to establish that other defendants (co-defendants) are real parties in interest in a request for reexamination.

Similarly, joint marketing of an invention covered by the patent subject to litigation and reexamination, does not cause each of the joint marketers to be a real party in interest in the request for reexamination notwithstanding any actual benefit that would result to the joint marketers from a favorable result in the reexamination.

The question of whether a party is a real party in interest must be determined on a case-by-case basis focusing on **the showing** of participation of a party in regard to the filing of a request for reexamination, and not ancillary matters, such as being a co-defendant in a litigation or a joint marketer. For example, if the Office were to follow petitioner's line of reasoning, a patent owner might challenge an identification of the real party in interest in a reexamination, where a third party requester not involved in the litigation (as to a patent) and even ignorant thereof, was to file a request for reexamination utilizing one or more pieces of prior art employed by unrelated defendants in the litigation. The third party requester could be placed in a position of having to prove a negative - that it did not participate in the litigation. Similarly, here, a co-defendant need not prove a negative - that it did not participate in the reexamination. The fact that a first party participated in a joint defense, or utilized the same counsel, and another party defendant later filed a request for reexamination, should not doom the first party to life as a real party in interest for any request for reexamination that may be later filed by another defendant in the joint litigation defense or who utilized joint counsel. Rather, the burden is on the challenging patent owner to provide evidence of participation.

It may be that a particular defendant has decided to proceed with a request for reexamination in the face of hostile opposition by one or more other defendants (who would rather settle the matter in court, than before the Office, based on the nature of their case) who should therefore not be embraced as a real party in interest in the request for reexamination. To do so, would result in estoppel against parties who had no control over the request for reexamination. None-the-less, using petitioner's theory that the co-defendants in litigation must be deemed to be real parties in interest in the reexamination request of the patent in litigation, the other defendants in the litigation may be barred (under 35 U.S.C. § 317(a)) from raising other known prior art that they may feel is better in a subsequent request for reexamination after the first request has been ordered.

In deciding a petition for vacatur, the Office will not engage in conjecture as to the participation in the request for reexamination of any particular alleged unnamed real party in interest. For purposes of this decision, it is not disputed that co-defendant Delta may be impacted[14] and even benefit from the filing of the instant reexamination as is alleged by patent owner petitioner. However, it is incumbent upon petitioner to present objective evidence that a party not identified as a real

[14] Section 1.182 patent owner petition to vacate, at page 4.

party in interest in fact participated in the request for reexamination, or in the reexamination proceeding after the request was filed.

A. The Identification Of The Real Party In Interest Is Not Facially Inaccurate Or Ambiguous. Therefore, The Office Lacks The Authority And The Tools To Question That Identification.

The arguments presented in the § 1.182 petition for vacatur fail to establish that the Office has the authority to question the accuracy of a third party requester's facially accurate and unambiguous identification of the real party in interest in this *inter partes* reexamination proceeding, or the tools to competently conduct an investigation of the matter.

To the extent that patent owner argues that the Office has the ability to investigate the accuracy of the identification of the real party in interest in an *inter partes* reexamination proceeding, or to issue a Show Cause Order requiring the identified real party in interest to confirm that it, and it alone, is the real party in interest, patent owner does not make a persuasive case that the Office is required to do so by either the reexamination statute or the reexamination regulations, when the *inter partes* reexamination as filed contains an unambiguous identification of the identity of the real party in interest. This unambiguous identification has been buttressed in regard to the relationship of Delta by the third party Opposition paper explicitly setting forth the lack of participation of Delta as to the present *inter partes* reexamination.

Patent owner's argument is not persuasive, because it does not reflect the intent of the provisions of 37 CFR 1.915(b)(7) and (b)(8). A certification statement made pursuant to 37 CFR 1.915(b)(7) is a statement by the third party requester to the effect that the third party requester is not itself estopped by the statutory estoppel provisions from filing a request for *inter partes* reexamination of a given patent. The *inter partes* rule making at 65 Fed. Reg. 76756, 76759 (Dec. 7, 2000), provides that:

> It should be noted that the Office generally will not have a need to resolve the factual issue of whether or not one party is a privy of another party. Section 1.915(b)(7) requires a third party requester to certify that the estoppel provisions of §1.907 do not prohibit the filing of the *inter partes* reexamination request, and the Office does not intend to look beyond this required certification. It is only in the rare instance where a challenge to the accuracy of the certification is raised by the patent owner, that the question would then need to be addressed.

A substantially identical statement also appears at 65 Fed. Reg. 76756, 76764. These statements establish that the Office will, only in the rare instance that it is necessary to do so (a facial showing of inaccuracy or an ambiguity), "address" the accuracy of a certification that statutory estoppel does not bar the filing of a request for *inter partes* reexamination. Further, the rule making does not discuss the type or depth of

investigation that can and will be undertaken, and it does not state or imply that a patent owner may trigger an investigation of the accuracy of the certification merely by advancing an unsupported allegation that the third party requester is estopped from filing a request for *inter partes* reexamination.

This is not an instance where the identification of the real party in interest required by 37 CFR 1.915(b)(8) is ambiguous or facially inaccurate, in which instance the third party requester who is before the Office can be queried by the Office, because the record is not clear at that point in time (*i.e.*, the ambiguity causes an issue that is ripe for consideration). Since the present record in the instant reexamination proceeding is not ambiguous as to the identification of the real party in interest (and patent owner has provided no persuasive extrinsic evidence to establish ambiguity), there is no basis to proceed any further in this proceeding as to the matter. Likewise, this is not an instance where all co-defendants have been shown to appear to rely on the request for reexamination as a basis for a joint motion to stay the litigation, where a third party requester who is before the Office can be queried by the Office, to provide an explanation.

Aside from the above, a second reexamination proceeding that would be the subject of the above-cited paragraph of the rule making notice has not yet been filed, nor has a final decision issued in the litigation; thus the issue is not ripe for consideration (see discussion in part B. below). If the issue whether a second reexamination does become ripe for consideration via a second reexamination proceeding filed by a second requester (who is one of the co-defendants), the Office can then query an *ambiguous or facially inaccurate* 37 CFR 1.915(b)(7) certification statement. In that instance, the second third party requester making such statement would become a party appearing before the Office. In other words, a second co-defendant, *i.e.*, the second third party requester, would then be available to be asked by the Office to clarify or support a 37 CFR 1.915(b)(7) certification statement that is ambiguous or facially inaccurate. Presumably, that third party requester would be able to respond based on facts wholly within its knowledge and possession. The Office would be able to obtain information from the patent owner and the second third party requester, and would have no need to obtain information from a party not before the Office by reason of the filing of a first request for *inter partes* reexamination.

Aside from the inherent ability of the Office to issue an Order to Show Cause directed to a party that is before the Office, patent owner does not point to any regulation that would provide a mechanism for conducting an investigation directed to determining whether parties not before the Office are in fact real parties in interest in an *inter partes* reexamination proceeding. For example, 37 CFR 1.105 was promulgated pursuant to 35 U.S.C. §§ 131 and 132, statutes that relate to the examination of applications and (via incorporation by the reexamination statute) the conduct of reexamination proceedings as to patentability. The regulation was promulgated for the purpose of requiring submission of information material to patentability from persons having a duty under 37 CFR 1.56 to disclose information

to the Office that is material to patentability.[15] The identification of the real party in interest has no relationship to the duty to disclose information that is material to patentability (which applies to an applicant for patent and to a patent owner in a reexamination proceeding).[16] With respect to obtaining information from a party who is alleged to be an undisclosed real party in interest in an *inter partes* reexamination proceeding, it is not apparent how 37 CFR 1.105 could be applied to a party who is not before the Office in that proceeding.

Therefore, where a patent owner who is a party in an *inter partes* reexamination proceeding believes that an identification of the real party in interest is inaccurate, even though it is facially unambiguous, the courts are the appropriate venue from which the patent owner should seek relief to obtain evidence extrinsic to the record, for incorporation into the record. It is to be noted that there is precedent on the issue of "real party in interest" in the federal courts, on matters ranging from jurisdiction (*e.g.*, presence of diversity or amount of suit)[17] to actions in which the principle is applied to prevent multiple or conflicting lawsuits by persons such as assignees.[18] These examples of court proceedings resolving "real party in interest" issues demonstrate the reason why the Office cannot perform such a function here. Upon obtaining jurisdiction over the parties, courts may order discovery, taking of testimony with cross examination and use of other evidentiary tools, while enforcing compliance with its requirements via its subpoena power and power to impose sanctions. Accordingly, the courts are the forums best equipped to determine who is, and who is not, the "real party in interest" when there is a reason to doubt the third party requester's identification of a party or parties as being the real party in interest in an *inter partes* reexamination proceeding. Further, courts may provide relief, as appropriate, by enjoining the filing of a further *inter partes* reexamination request by the other parties in a civil action. Even if an *inter partes* reexamination request was filed by one of the other parties in the civil action who is barred from requesting *inter partes* reexamination by statutory estoppel, a court could always enjoin participation by that requester in the proceeding and essentially turn the proceeding into an *ex parte* reexamination proceeding, the filing of which does not require identification of "a real party in interest" (35 U.S.C §§ 301 and 302), and is not prohibited by statute or rule, even after an *inter partes* reexamination was filed by the same real party in interest.[19]

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

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[15] 65 Fed. Reg. 54604, 54633, (Sept. 8, 2000.)

[16] 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.

[17] *Varlotta Construction Corporation v. Carla Development Corporation*, 886 F. Supp 315 (E.D.N.Y. 1995)

[18] *First Hartford Corporation Pension Plan & Trust v. United States*, 194 F.3d 1279 (Fed. Cir. 1999)

[19] 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.

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. The Office may consider that it is "the sole agency that administers the patent statute,"[20] and the Office certainly conducts the *inter partes* proceeding; however, it is common knowledge that the federal courts (which are not an agency in the sense used in the *inter partes* reexamination rule making) routinely adjudicate matters arising under the patent statute. Further, patent owner should appreciate the difference between conducting a reexamination proceeding, which is the province of the Office, and enforcing an estoppel provision of Federal law as a matter of equitable relief. Patent owner has not provided any basis for believing that the district courts lack authority to act as described above.

As a final point in this section of the decision as to the Office lacking the authority to investigate: The reexamination statute requires, *inter alia*, that a request for *inter partes* reexamination proceeding "shall ... include the identity of the real party in interest... ."[21] 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."[22] Requester has clearly stated that Aircell is the real party in interest, and that is an identification to a sufficient extent that "a subsequent person filing an *inter partes* reexamination request" can look into its interaction with the identified Aircell to "determine whether that person is a privy" with the real party in interest that filed the present reexamination. Neither the *inter partes* reexamination statute nor the *inter partes* reexamination rules imposes a duty on the Office to investigate the accuracy of an unambiguous identification of the real party in interest in a third party requester's request for *inter partes* reexamination proceeding.

In the present *inter partes* reexamination proceeding, the real party in interest is unambiguously identified in the current record. The identification of the real party in interest does not appear to be facially inaccurate. The Office will refuse to accord a filing date to a request for *inter partes* reexamination that does not identify the real party in interest, or which provides an identification of the real party in interest that is ambiguous or facially inaccurate. If the Office accords a filing date to a request for *inter partes* reexamination, and later discovers an ambiguity or a facial inaccuracy in the identification of the real party in interest, the Office can, and will, require that a party appearing before it as third party requester in an *inter partes* reexamination proceeding clarify the ambiguity or facial inaccuracy. 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

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[20] 65 Fed. Reg. 76756, 76759 (Dec. 7, 2000), emphasis added.
[21] 35 U.S.C. § 311(b)(1).
[22] 37 CFR 1.915(b)(8).

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 instant reexamination proceeding, because there is no legal reason to do so, even if the Office's ability to do so could be shown (which it has not been, as discussed above).

B. The Office Has No *Present* Duty To Investigate The Identity Of The Real Party In Interest In The Instant *Inter Partes* Reexamination Proceeding.

It is also to be noted that, in the instant reexamination proceeding, patent owner is requesting relief based upon an injury that has not yet occurred, and may never occur, even according to patent owner's view of the situation. Patent owner does not allege that the named real party in interest is itself estopped from filing and participating in the instant reexamination proceeding. Rather, patent owner's concern must be that patent owner might be harassed by the filing of a subsequent request for *inter partes* reexamination of the patent or that the instant reexamination will be inappropriately maintained by a party that should have been identified as a real party in interest in the instant reexamination proceeding, but was not so identified. Such a hypothetical party, as a real party in interest in the instant reexamination proceeding, would be subject to a statutory estoppel that could preclude (if the statutory provisions are satisfied) its filing of another *inter partes* reexamination proceeding, or from maintaining the instant reexamination proceeding if such a party "loses" as a defendant in any litigation of the patent. While a patent owner is statutorily entitled to be protected from harassment by the filing of a subsequent request for *inter partes* reexamination of the patent by a party who is estopped from filing such a request, the record simply does not show that such a circumstance presently exists as to the instant reexamination proceeding. No additional requests for *inter partes* reexamination of the patent have been filed by co-defendant Delta nor is the only identified litigation (as to the patent) final. Thus, 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 patent or inappropriately maintained the instant one. Accordingly, there is no need to consider addressing the relief requested by patent owner in the present *inter partes* reexamination proceeding, since patent owner cannot have been injured by the filing of another request for *inter partes* reexamination for the patent or by maintaining a reexamination that is barred by statutory estoppel.

C. Synopsis

Rather than having presented clear and undisputed evidence establishing that Aircell is not the only real party in interest in the instant reexamination proceeding, the petition is supported only by supposition and conjecture on patent owner's part, which has been rebutted by the third party Opposition paper. Accordingly, patent owner has not demonstrated a persuasive basis for the requested relief of vacatur of the filing date of the instant reexamination proceeding. Therefore, such request for relief is dismissed.

REMAINING PETITIONS TO BE DECIDED

Having acted on the petition for vacatur with a dismissal, the following petitions, which are still pending, will be addressed by the Office in due course:

1. November 23, 2009 patent owner "Petition to Compel the Examiner to Comply with the Limited Scope of Examination Set Forth in 37 CFR 1.906," refiled on April 9, 2010, for which an Opposition and petition to enter Opposition were filed on December 23, 2009 and addressed again in a petition paper of May 10, 2010.
2. May 10, 2010 § 1.183 petition by third party requester to waive the page limit.
3. Two June 17, 2010 petitions related to § 1.59(b).

CONCLUSION

1. The November 23, 2009 patent owner § 1.182 petition seeking vacatur of the reexamination is dismissed.

2. The December 23, 2009 1.183 third party requester petition seeking entry of a December 23, 2009 Opposition to the § 1.182 patent owner petition is granted.

3. Jurisdiction over this proceeding will be exercised by the Office of Patent Legal Administration and the Central Reexamination Unit as appropriate to address the pending petitions identified above.

4. Telephone inquiries related to this decision should be directed to Hiram H. Bernstein, Senior Legal Advisor, at (571) 272-7707 or, in his absence, to the undersigned, at (571) 272-7710.

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

7-12-10
Kenpet8

APPENDIX OF RELEVANT STATUTORY, REGULATORY AND PRACTICE PROVISIONS

35 U.S.C. §§ 311(a) and (b) provide:

(a)IN GENERAL.– Any third-party requester at any time may file a request for inter partes reexamination by the Office of a patent on the basis of any prior art cited under the provisions of section 301.
(b) REQUIREMENTS.– The request shall–
(1) be in writing, include the identity of the real party in interest, and be accompanied by payment of an inter partes reexamination fee established by the Director under section 41; and
(2) set forth the pertinency and manner of applying cited prior art to every claim for which reexamination is requested.

35 U.S.C. § 315(c) provides:

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

35 U.S.C. § 317 provides:

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

newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the inter partes reexamination proceedings.

37 CFR 1.105 provides:

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

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

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

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

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

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

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

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

(viii) *Technical information* known to applicant.

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

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

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

manner, for example:

(i) A requirement for factual information;

(ii) Interrogatories in the form of specific questions seeking applicant's factual knowledge; or

(iii) Stipulations as to facts with which the applicant may agree or disagree.

(4) Any reply to a requirement for information pursuant to this section that states either that the information required to be submitted is unknown to or is not readily available to the party or parties from which it was requested may be accepted as a complete reply.
(b)The requirement for information of paragraph (a)(1) of this section may be included in an Office action, or sent separately.
(c) A reply, or a failure to reply, to a requirement for information under this section will be governed
by §§ 1.135 and 1.136.

37 CFR 1.907 provides:

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

37 CFR 1.913 provides:

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

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

(b) A request for *inter partes* reexamination must include the following parts:
(7) A certification by the third party requester that the estoppel provisions of § 1.907 do not prohibit the inter partes reexamination.
(8) A statement identifying the real party in interest to the extent necessary for a subsequent person filing an *inter partes* reexamination request to determine whether that person is a privy.

...

(d) If *the inter partes* request does not include the fee for requesting *inter partes* reexamination required by paragraph (a) of this section and meet all the requirements of paragraph (b) of this section, then the person identified as requesting *inter partes* reexamination will be so notified and will generally be given an opportunity to complete the request within a specified time. Failure to comply with the notice will result in the *inter partes* reexamination request not being granted a filing date, and will result in placement of the request in the patent file as a citation if it complies with the requirements of § 1.501.

37 CFR 1.919(a) provides:

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

MPEP § 2612 provides, in part:

37 CFR 1.907 defines specific situations where a third party is prohibited from filing a request for an inter partes reexamination. 37 CFR 1.915(b)(7) requires the third party requester to certify that the estoppel provisions of 37 CFR 1.907 do not prohibit the filing of the inter partes reexamination request by the real party in interest (note that it is the real party in interest that is subject to the estoppel provisions and not the party who actually files the request). The certification identified in 37 CFR 1.915(b)(7) will constitute a prima facie showing that the party requesting the inter partes reexamination is not barred from doing so under 37 CFR 1.907. The Office does not intend to look beyond this required certification. It is only in the rare instance where a challenge to the accuracy of the certification is raised by the patent owner, that the question would then need to be addressed. A challenge to the accuracy of the certification must facially establish that the third party requesting the inter partes reexamination is barred from doing so under 37 CFR 1.907. Thus, for example, the challenger cannot rely on an argument that the third party requesting reexamination was, at one point, involved with a party barred under 37 CFR 1.907, and should thus be considered as a real party in interest (and barred from filing the request). Involvement *per se* does not facially establish that the other party is a real party in interest. The fact that a second party may benefit from an earlier reexamination request filed by a first party or a civil action conducted by the first party, or that the second party may have collaborated with the first party in a matter, does not facially evidence the second party was a real party in interest with the first party. With respect to the Office conducting an investigation to uncover whether the second party was a "real party in interest," the statute does not require, nor does it provide the tools, for the Office to investigate such matter. Further, Congress has not provided the Office with subpoena power or discovery tools and has not provided the Office with the ability to conduct hearings for eliciting testimony and cross-examination. The Office has not been authorized to impose punitive sanctions for non-compliance. Such evidentiary tools are, however, available to the courts, which

are the appropriate vehicle to make a factual investigation as to the accuracy of the identification of a "real party in interest."

MPEP § 2614 provides, in part:

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,194	05/29/2009	7400858	8282-83120-01	3014

7590 07/23/2010

EXAMINER	

D. N. HALGREN
35 CENTRAL ST.
MANCHESTER, MA 01944

ART UNIT	PAPER NUMBER

DATE MAILED: 07/23/2010

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
KLARQUIST SPARKMAN, LLP
ONE WORLD TRADE CENTER, SUITE 1600
121 S.W. SALMON STREET
PORTLAND, OR 97204

Date:
MAILED

JUL 23 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001194
PATENT NO. : 7400858
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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D. N. HALGREN
35 CENTRAL ST.
MANCHESTER MA 01944

(For Patent Owner) **MAILED**

JUL 23 2010

CENTRAL REEXAMINATION UNIT

RICHARD D. MC LEOD
KLARQUIST SPARKMAN, LLP
121 SW SALMON STREET, SUITE 1600
PORTLAND, OR 97204

(For *Inter Partes* Requester)

In re Crowley, *et al.*
Inter Partes Reexamination Proceeding
Control No. 95/001,194
Filed: May 29, 2009
For: U.S. Patent No. 7,400,858

DECISION DISMISSING PETITION AS PREMATURE

This is a decision on *inter partes* third party requester's May 10, 2010 petition paper entitled "PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE PAGE LIMIT SET BY 37 C.F.R. § 1.943(B)" (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 May 11, 2010, as authorized in the May 10, 2010 EFS-WEB fee transmittal sheet.

The petition under 37 CFR 1.183 is dismissed as premature.

REVIEW OF THE RELEVANT FACTS

1. On July 15, 2008, the Office issued United States Patent Number 7,400,858 ("the '858 patent") to Crowley, *et al.*

2. On May 29, 2009, a request for *inter partes* reexamination of the '858 patent was filed by a third party requester, which request was assigned Reexamination Control No. 95/001,194 ("the '1194 proceeding").

3. On August 20, 2009, the Office issued an order granting *inter partes* reexamination in the '1194 proceeding.

4. On September 23, 2009, the Office issued a first action on the merits in the '1194 proceeding.

5. On November 23, 2009, patent owner filed a first petition entitled "PETITION TO VACATE THE INTER PARTES REEXAMINATION FOR FAILURE TO COMPLY WITH 37 C.F.R. 1.915(b)(8)," *i.e.* a petition under 37 CFR 1.182 ("the petition under 37 CFR 1.182").

6. Concurrently, on November 23, 2009, patent owner filed a second petition entitled "PETITION TO COMPEL THE EXAMINER TO COMPLY WITH THE LIMITED SCOPE OF EXAMINATION SET FORTH IN 37 CFR 1.906," *i.e.* a petition under 37 CFR 1.181 ("the petition under 37 CFR 1.181").

7. Also, on November 23, 2009, patent owner filed a response to September 23, 2009 Office action.

8. On December 23, 2009, *inter partes* third party requester (hereinafter "requester") filed a first petition under 37 CFR 1.183, requesting entry of a concurrently filed first opposition entitled "THIRD PARTY REQUESTER'S OPPOSITION TO THE PATENT OWNER'S PETITION [*sic*] TO VACATE INTER PARTES RE-EXAMINATION" (hereinafter "the opposition to the petition under 37 CFR 1.182").

9. Concurrently, on December 23, 2009, requester filed a second petition under 37 CFR 1.183, requesting entry of a concurrently filed second opposition entitled "THIRD PARTY REQUESTER'S OPPOSITION TO PATENT OWNER'S PETITION TO COMPEL THE EXAMINER TO COMPLY WITH THE LIMITED SCOPE OF [*sic*-RE] EXAMINATION SET FORTH IN 37 CFR 1.906" (hereinafter "the opposition to the petition under 37 CFR 1.181").

10. Also, on December 23, 2009, requester filed comments after patent owner's November 23, 2009 response.

11. On March 25, 2010, the Office mailed a "NOTICE RE DEFECTIVE PAPER IN INTER PARTES REEXAMINATION" ("the Notice of Defective Paper"), stating that patent owner's November 23, 2009 response exceeded the page limit of 37 CFR 1.943(b) and giving patent owner 15 days to file a re-drafted response that would not exceed the page limit or a redacted supplemental response. The Notice of Defective paper also stated that requester's December 23, 2009 comments are moot and will not be considered.

12. On April 9, 2010, patent owner filed a re-drafted response to the September 23, 2009 Office action.

13. Concurrently, on April 9, 2010, patent owner re-filed the November 23, 2009 petition under 37 CFR 1.182 and the November 23, 2009 petition under 37 CFR 1.181.

14. On May 10, 2010, requester filed comments after patent owner's April 9, 2010 re-drafted response to the September 23, 2009 Office action.

15. Concurrently, on May 10, 2010, requester filed a petition under 37 CFR 1.183, requesting that its petitions, filed on December 23, 2009,[1] in opposition to patent owner's November 23, 2009 petition under 37 CFR 1.182 and in opposition to patent owner's November 23, 2009 petition under 37 CFR 1.181, be considered in opposition to patent owner's April 9, 2010 re-filed petition under 37 CFR 1.182 and patent owner's April 9, 2010 re-filed petition under 37 CFR 1.181.

16. Also, on May 10, 2010, requester filed the instant petition under 37 CFR 1.183, requesting waiver of the page limit of 37 CFR 1.943(b) for the concurrently filed comments submission.

17. On July 13, 2010, the Office mailed a decision dismissing patent owner's November 23, 2009 petition under 37 CFR 1.182 (re-filed on April 9, 2010) and granting requester's December 23, 2009 petition under 1.183 for entry of requester's concurrently filed opposition to patent owner's petition under 37 CFR 1.182, which opposition was considered in that decision.

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).

[1] On page 2 of the instant petition under 37 CFR 1.183, requester, in error, identifies the December 23, 2009 opposition petitions as being filed on December 24, 2009.

The Office issued a non-final Office action in the '1194 proceeding on September 23, 2009. On November 23, 2009, patent owner filed a petition paper entitled "PETITION TO COMPEL THE EXAMINER TO COMPLY WITH THE LIMITED SCOPE OF EXAMINATION SET FORTH IN 37 C.F.R. 1.906," asserting that the September 23, 2009 Office action went beyond the scope of *inter partes* reexamination. Thus, patent owner's November 23, 2009 petition is a petition under 37 CFR 1.181, requesting supervisor review of an action taken by the examiner in the proceeding. *See* 37 CFR 1.181(a)(1).

Concurrently with the petition under 37 CFR 1.181, patent owner filed its response to the September 23, 2009 Office action. On December 23, 2009, requester filed comments after patent owner's November 23, 2009 response. On March 25, 2010, the Office issued a Notice of Defective Paper, stating that patent owner's November 23, 2009 response exceeded the page limit requirement of 37 CFR 1.943(b) and that requester's December 23, 2009 comments are moot and will not be considered. On April 9, 2010, patent owner filed a re-drafted response to the September 23, 2009 Office action, and also re-filed the November 23, 2009 petition under 37 CFR 1.181.

In the instant petition under 37 CFR 1.183, requester is seeking waiver of 37 CFR 1.943(b) for the May 10, 2010 comments submission filed after patent owner's April 9, 2010 re-drafted response to the September 23, 2009 Office action. As of the time of filing the instant petition under 37 CFR 1.183, the Office had not yet rendered a decision on the patent owner's November 23, 2009 petition under 37 CFR 1.181 (re-filed on April 9, 2010), requesting supervisor review of an action taken by the examiner in the September 23, 2009 Office action. Because a decision on the outstanding patent owner petition under 37 CFR 1.181 could result in the withdrawal of the September 23, 2009 Office action (and the issuing of a new Office action), consideration of the instant petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.943(b) for requester's comments after patent owner's response to the September 23, 2009 Office action, would be premature. Until such time as the Office renders a decision on the outstanding petition under 37 CFR 1.181, the issue is not ripe for consideration by the Office.

Accordingly, the petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b) is dismissed as premature.

ADDITIONAL DISCUSSION

In the event the Office issues a decision refusing to grant patent owner's November 23, 2009 petition under 37 CFR 1.181 (re-filed April 9, 2010), requester is advised to immediately renew the instant petition under 37 CFR 1.183.

CONCLUSION

1. *Inter partes* requester's May 10, 2010 petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b) is dismissed.

2. **In the event the Office issues a decision refusing to grant patent owner's November 23, 2009 petition under 37 CFR 1.181 (re-filed April 9, 2010), requester is advised to immediately renew the instant petition under 37 CFR 1.183.**

3. Jurisdiction for the instant reexamination proceeding is being returned to the Central Reexamination Unit (CRU), for consideration of the November 23, 2009 patent owner petition under 37 CFR 1.181 (re-filed on April 9, 2010) and the December 23, 2009 requester opposition to the petition under 37 CFR 1.181.

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

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

7-22-10

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,194	05/29/2009	7400858	8282-83120-01	3014

7590 07/23/2010

D. N. HALGREN
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MANCHESTER, MA 01944

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 07/23/2010

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Date:
MAILED

JUL 23 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001194
PATENT NO. : 7400858
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 23 2010

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KLARQUIST SPARKMAN, LLP
121 SW SALMON STREET, SUITE 1600
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(For *Inter Partes* Requester)

CENTRAL REEXAMINATION UNIT

In re Crowley, *et al.*	:	**DECISION**
Inter Partes Reexamination Proceeding	:	**GRANTING**
Control No. 95/001,194	:	**PETITION UNDER**
Filed: May 29, 2009	:	**37 CFR 1.183**
For: U.S. Patent No. 7,400,858	:	

This is a decision on *inter partes* third party requester's December 23, 2009 petition paper entitled "PETITION UNDER 37 C.F.R. § 1.183 TO SUSPEND THE RULES AND ENTER THIRD PARTY REQUESTER'S OPPOSITION TO THE PATENT OWNER'S PETITION TO COMPEL THE EXAMINER TO COMPLY WITH THE LIMITED SCOPE OF [*sic*-RE] EXAMINATION" (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 December 24, 2009, as authorized in the December 23, 2009 EFS-WEB fee transmittal sheet.

The petition under 37 CFR 1.183 is granted, to the extent that relief is needed for entry of the requester's concurrently filed opposition petition.

REVIEW OF THE RELEVANT FACTS

1. On July 15, 2008, the Office issued United States Patent Number 7,400,858 ("the '858 patent") to Crowley, *et al.*

2. On May 29, 2009, a request for *inter partes* reexamination of the '858 patent was filed by a third party requester, which request was assigned Reexamination Control No. 95/001,194 ("the '1194 proceeding").

3. On August 20, 2009, the Office issued an order granting *inter partes* reexamination in the '1194 proceeding.

4. On September 23, 2009, the Office issued a first action on the merits in the '1194 proceeding.

5. On November 23, 2009, patent owner filed a petition entitled "PETITION TO COMPEL THE EXAMINER TO COMPLY WITH THE LIMITED SCOPE OF EXAMINATION SET FORTH IN 37 CFR 1.906," *i.e.* a petition under 37 CFR 1.181 requesting supervisor review of an action taken by the examiner in the proceeding. Patent owner re-filed the petition under 37 CFR 1.181 on April 9, 2010.

6. On December 23, 2009, *inter partes* third party requester (hereinafter "requester") filed the instant petition under 37 CFR 1.183, requesting entry of a concurrently filed opposition entitled "THIRD PARTY REQUESTER'S OPPOSITION TO PATENT OWNER'S PETITION TO COMPEL THE EXAMINER TO COMPLY WITH THE LIMITED SCOPE OF [*sic*-RE] EXAMINATION SET FORTH IN 37 CFR 1.906," *i.e.* an opposition petition under 37 CFR 1.181 regarding an action taken by the examiner (hereinafter "the opposition petition").

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 November 23, 2009, patent owner filed a petition under 37 CFR 1.181, asserting that the actions taken by the examiner in the September 23, 2009 Office action were not in accordance with the relevant law regarding the conduct of reexamination. On December 23, 2009, requester, exercising its independent participation right under 37 CFR 1.181, filed an opposition to patent owner's November 23, 2009 petition under 37 CFR 1.181. Concurrently, on December 23, 2009, requester filed the instant petition under 37 CFR 1.183 requesting entry and consideration of requester's opposition petition under 37 CFR 1.181. In this instance, requester is supporting the propriety of actions taken by the examiner in the September 23, 2009 Office action that patent owner has challenged in the reexamination proceeding. This is not a situation where patent owner is asking for discretionary relief; this is simply a question of whether or not the action taken by the examiner was in accordance with the relevant law regarding the conduct of reexamination. The requester is entitled to rebut the patent owner's challenge to the actions taken by the examiner in the reexamination proceeding.

Accordingly, requester's petition under 37 CFR 1.183 is granted to the extent that requester's concurrently filed opposition petition has an entry right and will be considered.

CONCLUSION

1. *Inter partes* requester's December 23, 2009 petition under 37 CFR 1.183 is granted, to the extent that relief is needed for entry of requester's concurrently filed opposition petition.

2. Jurisdiction for the instant reexamination proceeding is being returned to the Central Reexamination Unit (CRU), for consideration of the November 23, 2009 patent owner petition under 37 CFR 1.181 (re-filed on April 9, 2010) and the December 23, 2009 requester opposition petition.

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

7-22-10

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,194	05/29/2009	7400858	8282-83120-01	3014

7590 07/23/2010

D. N. HALGREN
35 CENTRAL ST.
MANCHESTER, MA 01944

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 07/23/2010

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
KLARQUIST SPARKMAN, LLP
ONE WORLD TRADE CENTER, SUITE 1600
121 S.W. SALMON STREET
PORTLAND, OR 97204

Date:

MAILED

JUL 23 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001194
PATENT NO. : 7400858
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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D. N. HALGREN
35 CENTRAL ST.
MANCHESTER MA 01944

(For Patent Owner) **MAILED**

JUL 23 2010

CENTRAL REEXAMINATION UNIT

RICHARD D. MC LEOD
KLARQUIST SPARKMAN, LLP
121 SW SALMON STREET, SUITE 1600
PORTLAND, OR 97204

(For *Inter Partes* Requester)

In re Crowley, *et al.*	:	**DECISION**
Inter Partes Reexamination Proceeding	:	**DISMISSING**
Control No. 95/001,194	:	**PETITION UNDER**
Filed: May 29, 2009	:	**37 CFR 1.183**
For: U.S. Patent No. 7,400,858	:	

This is a decision on *inter partes* third party requester's May 10, 2010 petition paper entitled "PETITION UNDER 37 C.F.R. § 1.183 TO CONSIDER OPPOSITION PAPERS FILED DECEMBER 24, 2009 IN OPPOSITION TO PATENT OWNER'S REFILED PETITIONS FILED APRIL 9, 2010" (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 May 11, 2010, as authorized in the May 10, 2010 EFS-WEB fee transmittal sheet.

The petition under 37 CFR 1.183 is dismissed.

REVIEW OF THE RELEVANT FACTS

1. On July 15, 2008, the Office issued United States Patent Number 7,400,858 ("the '858 patent") to Crowley, *et al.*

2. On May 29, 2009, a request for *inter partes* reexamination of the '858 patent was filed by a third party requester, which request was assigned Reexamination Control No. 95/001,194 ("the '1194 proceeding").

3. On August 20, 2009, the Office issued an order granting *inter partes* reexamination in the '1194 proceeding.

4. On September 23, 2009, the Office issued a first action on the merits in the '1194 proceeding.

5. On November 23, 2009, patent owner filed a first petition entitled "PETITION TO VACATE THE INTER PARTES REEXAMINATION FOR FAILURE TO COMPLY WITH 37 C.F.R. 1.915(b)(8)," *i.e.* a petition under 37 CFR 1.182 ("the petition under 37 CFR 1.182").

6. Concurrently, on November 23, 2009, patent owner filed a second petition entitled "PETITION TO COMPEL THE EXAMINER TO COMPLY WITH THE LIMITED SCOPE OF EXAMINATION SET FORTH IN 37 CFR 1.906," *i.e.* a petition under 37 CFR 1.181 ("the petition under 37 CFR 1.181").

7. Also, on November 23, 2009, patent owner filed a response to September 23, 2009 Office action.

8. On December 23, 2009, *inter partes* third party requester (hereinafter "requester") filed a first petition under 37 CFR 1.183, requesting entry of a concurrently filed first opposition entitled "THIRD PARTY REQUESTER'S OPPOSITION TO THE PATENT OWNER'S PETITION [*sic*] TO VACATE INTER PARTES RE-EXAMINATION" (hereinafter "the opposition to the petition under 37 CFR 1.182").

9. Concurrently, on December 23, 2009, requester filed a second petition under 37 CFR 1.183, requesting entry of a concurrently filed second opposition entitled "THIRD PARTY REQUESTER'S OPPOSITION TO PATENT OWNER'S PETITION TO COMPEL THE EXAMINER TO COMPLY WITH THE LIMITED SCOPE OF [*sic*-RE] EXAMINATION SET FORTH IN 37 CFR 1.906" (hereinafter "the opposition to the petition under 37 CFR 1.181").

10. Also, on December 23, 2009, requester filed comments after patent owner's November 23, 2009 response.

11. On March 25, 2010, the Office mailed a "NOTICE RE DEFECTIVE PAPER IN INTER PARTES REEXAMINATION" ("the Notice of Defective Paper"), stating that patent owner's November 23, 2009 response exceeded the page limit of 37 CFR 1.943(b) and giving patent owner 15 days to file a re-drafted response that would not exceed the page limit or a redacted supplemental response. The Notice of Defective paper also stated that requester's December 23, 2009 comments are moot and will not be considered.

12. On April 9, 2010, patent owner filed a re-drafted response to the September 23, 2009 Office action.

13. Concurrently, on April 9, 2010, patent owner re-filed the November 23, 2009 petition under 37 CFR 1.182 and the November 23, 2009 petition under 37 CFR 1.181.

14. On May 10, 2010, requester filed comments after patent owner's April 9, 2010 re-drafted response to the September 23, 2009 Office action.

15. Concurrently, on May 10, 2010, requester filed the instant petition under 37 CFR 1.183, requesting that its petitions, filed on December 23, 2009,[1] in opposition to patent owner's November 23, 2009 petition under 37 CFR 1.182 and in opposition to patent owner's November 23, 2009 petition under 37 CFR 1.181, be considered in opposition to patent owner's April 9, 2010 re-filed petition under 37 CFR 1.182 and patent owner's April 9, 2010 re-filed petition under 37 CFR 1.181.

16. On July 13, 2010, the Office mailed a decision dismissing patent owner's November 23, 2009 petition under 37 CFR 1.182 (re-filed on April 9, 2010) and granting requester's December 23, 2009 petition under 1.183 for entry of requester's concurrently filed opposition to patent owner's petition under 37 CFR 1.182, which opposition was considered in that decision.

DISCUSSION

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 November 23, 2009, patent owner filed a petition under 37 CFR 1.182 and a petition under 37 CFR 1.181. Responsive to the March 25, 2010 Notice of Defective Paper, patent owner filed a re-drafted response to the September 23, 2009 Office action and re-filed the November 23, 2009 petition under 37 CFR 1.182 and the November 23, 2009 petition under 37 CFR 1.181.

Concurrently, with its comments after patent owner's re-drafted April 9, 2010 response, on May 10, 2010, requester filed the instant petition under 37 CFR 1.183, requesting that its December 23, 2009 petitions filed in opposition to patent owner's November 23, 2009 petition under 37 CFR 1.182 and in opposition to patent owner's November 23, 2009 petition under 37 CFR 1.181 be considered in opposition to patent owner's April 9, 2010 re-filed petition under 37 CFR 1.182 and patent owner's April 9, 2010 re-filed petition under 37 CFR 1.181.

[1] On page 2 of the instant petition under 37 CFR 1.183, requester, in error, identifies the December 23, 2009 opposition petitions as being filed on December 24, 2009.

In the July 13, 2010 decision on patent owner's November 23, 2009 petition under 37 CFR 1.182 (re-filed on April 9, 2010), the Office granted requester's December 23, 2009 petition under 1.183 for entry of requester's concurrently filed opposition to the petition under 37 CFR 1.182, which opposition was considered in that decision. Accordingly, the instant petition under 37 CFR 1.183 is dismissed as moot as to entry and consideration of requester's December 23, 2009 petitions that were filed in opposition to patent owner's November 23, 2009 petition under 37 CFR 1.182 (re-filed on April 9, 2010).[2]

On a date even herewith, a decision is being mailed in the '1194 proceeding granting requester's December 23, 2009 petition under 37 CFR 1.183 for entry of requester's concurrently filed opposition to patent owner's November 23, 2009 petition under 37 CFR 1.181. Accordingly, the instant petition under 37 CFR 1.183 is dismissed as unnecessary as to entry and consideration of requester's December 23, 2009 petitions that were filed in opposition to patent owner's November 23, 2009 petition under 37 CFR 1.181 (re-filed on April 9, 2010).[3]

CONCLUSION

1. *Inter partes* requester's May 10, 2010 petition under 37 CFR 1.183 is dismissed.

2. Jurisdiction for the instant reexamination proceeding is being returned to the Central Reexamination Unit (CRU), for consideration of the November 23, 2009 patent owner petition under 37 CFR 1.181 (re-filed on April 9, 2010) and the December 23, 2009 requester opposition to the petition under 37 CFR 1.181.

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

7-22-10

[2] *I.e.*, requester's opposition to the petition under 37 CFR 1.182 and requester's petition under 37 CFR 1.183 for entry of the opposition to the petition under 37 CFR 1.182.
[3] *I.e.*, requester's opposition to the petition under 37 CFR 1.181 and requester's petition under 37 CFR 1.183 for entry of the opposition to the petition under 37 CFR 1.182.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,196	06/04/2009	7330952	2805.002REX9	8788

26111 7590 10/16/2009

EXAMINER	

MORGAN LEWIS & BOCKIUS LLP/RAMBUS INC.
2 PALO ALTO SQUARE
3000 EL CAMINO REAL
PALO ALTO, CA94306

ART UNIT	PAPER NUMBER

DATE MAILED: 10/16/2009

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
David M. O'Dell
HAYNES AND BOONE, LLP, IP SECTION
2323 Victory Avenue, SUite 700
Dallas, TX 75219

Date:
MAILED

OCT 16 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001196
PATENT NO. : 7330952
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.
95/001,196	06/04/2009	7330952	2805.002REX9	8788

26111 7590 10/16/2009

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 10/16/2009

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ALEXANDRIA, VA 22313-1450
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RAMBUS INC.
Morgan Lewis & Bockius, LLP
2 Palo Alto Square
3000 El Camino Real
Palo Alto, CA 94306

(For Patent Owner)

MAILED

OCT 16 2009

CENTRAL REEXAMINATION UNIT

William H. Wright
Orrick, Herrington & Sutcliffe, LLP
IP Prosecution Department
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Irvine, CA 92614-2558

(For *Ex Parte* Requester)

David M. O'Dell
Haynes and Boone, LLP
IP Section
2323 Victory Avenue, Suite 700
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(For *Inter Partes* Requester)

Jon W. Wright
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

(Courtesy Copy)

Ex parte Reexamination Proceeding
Control No. 90/009,371
Filed: December 22, 2008
For: U.S. Patent No. 7,330,952

Inter Partes Reexamination Proceeding
Control No. 95/001,196
Filed: June 4, 2009
For: U.S. Patent No. 7,330,952

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. 7,330,952 (the '952 patent) issued to Barth *et al.* on February 12, 2008.

2. A request for *ex parte* reexamination of claims 21, 22, and 24 of the '952 patent was filed on December 22, 2008, by NVIDIA Corporation, and the request was assigned control number 90/009,371 (the '9371 *ex parte* proceeding).

3. On February 20, 2009, *ex parte* reexamination was ordered for claims 21, 22, and 24 of the '952 patent based on the examiner's determination that the December 22, 2008 request raised a substantial new question of patentability affecting these claims.

4. On April 29, 2009, a non-final Office action was mailed in the '9371 *ex parte* proceeding, rejecting claims 21, 22, and 24 of the '952 patent.

5. On April 30, 2009, patent owner filed a notification of prior or concurrent proceedings under 37 CFR 1.565 in the '9371 *ex parte* proceeding.

6. On May 20, 2009, patent owner filed a first supplemental information disclosure statement in the '9371 *ex parte* proceeding.

7. A request for *inter partes* reexamination of claims 1-28 of the '952 patent was filed on June 4, 2009, in which NVIDIA Corporation was identified as the real party in interest, and the request was assigned control number 95/001,196 (the '1196 *inter partes* proceeding).

8. On June 5, 2009, patent owner filed a petition for extension of time to file a response to the April 29, 2009 Office action in the '9371 *ex parte* proceeding.

9. On June 11, 2009, a decision granting-in-part the petition for extension of time was mailed in the '9371 *ex parte* proceeding. The time for response was extended by one month.

10. On July 29, 2009, patent owner filed a response to the April 29, 2009 Office action in the '9371 *ex parte* proceeding, requesting reconsideration of the rejections of the claims.

11. On August 13, 2009, *inter partes* reexamination was ordered for claims 1-28 of the '952 patent based on the examiner's determination that the June 4, 2009 request raised a substantial new question of patentability affecting these claims.

12. On August 25, 2009, patent owner filed a supplemental reply to the Office action in the '9371 *ex parte* proceeding.

13. On September 29, 2009, patent owner filed a second supplemental information disclosure statement in the '9371 *ex parte* proceeding.

DECISION

I. MERGER OF PROCEEDINGS

37 CFR 1.989 provides:

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

As evidenced by the above review of the facts, both the '9371 and the '1196 reexamination proceedings are currently pending. An order granting reexamination of claims 21, 22, and 24 and a non-final Office action have been mailed in the '9371 *ex parte* proceeding, an order granting reexamination of claims 1-28 has been mailed in the '1196 *inter partes* proceeding, and a decision under 37 CFR 1.989 is timely.

The general policy of the Office is that two reexamination proceedings will not be conducted separately, and at the same time, as to a particular patent. The rationale for this policy is (1) to prevent inconsistent, and possibly conflicting, amendments from being introduced into the two proceedings on behalf of the patent owner, (1) to provide a comprehensive examination of the patent based on the issues raised in both proceedings, and (3) to expedite prosecution of both proceedings. In the present instance, merger of the '9371 and the '1196 reexamination proceedings would address these considerations. Thus, pursuant to 37 CFR 1.989, the 90/009,371 and 95/001,196 proceedings are hereby merged. The merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

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

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

The present decision merges an *ex parte* reexamination proceeding with an *inter partes* reexamination proceeding. Pursuant to 37 CFR 1.989(b), the merged proceeding is governed by 37 CFR 1.902 through 1.997, except that the rights of the third party requester of the *ex parte* reexamination are governed by 37 CFR 1.510 through 1.560. In this instance, however, the '9371 *ex parte* reexamination proceeding was requested by the same third party that requested the *inter partes* reexamination. And, that third party (NVIDIA Corporation) has full *inter partes* reexamination participation rights.

It is noted that reexamination was ordered for claims 21, 22, and 24 of the '952 patent in the '9371 *ex parte* proceeding, while reexamination was ordered for claims 1-28 of the '952 patent in the '1196 *inter partes* proceeding. The examiner will conduct reexamination in the merged proceeding for claims 1-28 of the '952 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 proceedings and will be physically entered in each reexamination file. All papers filed by the patent owner and the third party requester(s) must consist of a single paper, **filed in duplicate**, each bearing a signature and identifying data for both proceedings, for entry into each file.

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

By EFS-Web: Registered users may submit the response via the electronic filing system EFS-Web.

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

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

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

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

C. Amendments:

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

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

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

D. Fees:

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

E. Citation of Patents and Printed Publications:

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

PATENT OWNER'S ADDRESS

The patent owner is called upon to coordinate the proper correspondence addresses in (1) the patent, (2) the '9371 proceeding and (3) the '1196 proceeding. The current correspondence address of record for the patent file is the proper patent owner address for reexamination mailings pursuant to 37 CFR 1.33(c), and it is that of RAMBUS INC., c/o Morgan Lewis &

Bockius, LLP, 2 Palo Alto Square, 3000 El Camino Real, Palo Alto, CA 94306. Accordingly, all future correspondence will be directed to RAMBUS INC., c/o Morgan Lewis & Bockius, LLP, 2 Palo Alto Square, 3000 El Camino Real, Palo Alto, CA 94306, unless, within ONE (1) MONTH of this decision, patent owner changes the correspondence address of record in the patent (the same address should be made of record in the reexamination proceedings).

As a courtesy, this decision is being mailed to both addresses. However, as pointed out above, the address of RAMBUS INC., c/o Morgan Lewis & Bockius, LLP, 2 Palo Alto Square, 3000 El Camino Real, Palo Alto, CA 94306, will be used in future correspondence, unless the address of record is changed as set forth above.

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/001,196 and *ex parte* Reexamination Control No. 90/009,371 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

2. Patent owner is provided with **ONE (1) MONTH** from the mailing of this decision to file papers to address the correspondence address considerations in both proceedings, as set forth in the last section of this decision.

3. Jurisdiction over the merged reexamination files is being forwarded via the Director of the Central Reexamination Unit (CRU) to the examiner for preparation of an Office action, to be issued in due course for the merged proceeding. The examiner should not issue an Office action for the present merged proceeding until after the earlier of:

   (A) The expiration of the one month period set for filing the papers addressing the correspondence address in both proceedings, or

   (B) The receipt of such papers.

4. Any questions concerning this communication should be directed to Eugenia A. Jones, Senior Legal Advisor, at 571-272-7727, or in her absence to the undersigned at 571-272-7726.

Pinchus M. Laufer
Legal Advisor
Office of Patent Legal Administration

10-16-09

UNITED STATES PATENT AND TRADEMARK OFFICE

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CENTRAL REEXAMINATION UNIT

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WASHINGTON DC 20005

HAYNES & BOONE, LLP IP SECTION (For *inter partes* Requester)
2323 VICTORY AVENUE
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DALLAS, TX 75219

ORRICK, HERRINGTON & SUTCLIFFE, LLP (For *ex parte* Requester)
Attn: William H. Wright
IP Prosecution Department
4 Park Plaza, Suite 1600
Irvine, CA 92614

In re Barth *et al.*
Inter partes Reexamination Proceeding
Control No.: 95/001,196
Filed: June 4, 2009
For: U.S. Patent No. 7,330,952

In re Barth *et al.*
Ex Parte Reexamination Proceeding
Control No.: 90/009,371
Filed: December 22, 2008
For: U.S. Patent No. 7,330,952

: DECISION
: DISMISSING
: PETITION TO
: RECONSIDER
: MERGER OF
: REEXAMINATION
: PROCEEDINGS

This is a decision on patent owner's October 16, 2009 patent owner petition entitled "PETITION UNDER 37 C.F.R. §§ 1.182 and 1.183 REGARDING MERGER OF CO-PENDING REEXAMINATION PROCEEDINGS". The petition will be treated as a petition to reconsider merger as on even date the Office issued a decision, *sua sponte*, merging the above noted proceedings.

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 19, 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.

REVIEW OF FACTS

1. On February 12, 2008, the Office issued U.S. Patent No. 7,330,952 (the '952 patent) to Barth *et al.*

2. The '952 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 1-28 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 22, 2008, a request for *ex parte* reexamination of claims 21, 22 and 24 of the '952 patent was filed by third party requester, NVIDIA Corporation. The request was assigned Control No. 90/009,371 (the '9371 proceeding).

5. On February 20, 2009, the Office issued an order granting the '9371 request for *ex parte* reexamination and setting a two month time period for a Patent Owner's Statement. The order indicated that claims 21, 22 and 24 of the '952 patent, would be subject to reexamination.

6. The time for filing a patent owner's statement pursuant to 37 CFR 1.530 in the '9371 *ex parte* reexamination proceeding expired on April 20, 2009.[1]

7. On April 29, 2009, the Office issued a first Office action on the merits in the '9371 *ex parte* reexamination proceeding.

8. On June 4, 2009, a request for *inter partes* reexamination of all the claims (claims 1-28) of the '952 patent was filed by the same third party requester (NVIDIA Corporation). The request was assigned Control No. 95/001,196 (the '1196 proceeding).

9. On June 22, 2009, the ITC granted Patent Owner's motion for partial termination with respect to the '952 patent. Therefore, the '952 patent is no longer involved in the ITC investigation.

10. On July 29, 2009, Patent Owner filed a response in the '9371 *ex parte* 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.

proceeding. The response did not amend, cancel or add new claims.[2]

11. On August 13, 2009, the Office issued an order granting the '1196 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 '952 patent, claims 1-28, would be subject to reexamination.

12. On August 25, 2009, Patent Owner filed a supplemental response in the '9371 *ex parte* reexamination proceeding. The response did not amend, cancel or add new claims.

13. On October 16, 2009, the Office, *sua sponte,* issued a decision merging the '1196 *inter partes* reexamination proceeding with the '9371 *ex parte* reexamination proceeding.

14. On October 16, 2009, patent owner filed the present petition requesting prevent of merger of the '9371 *ex parte* proceeding, with the '1196 *inter partes* proceeding.

15. 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

[2] Patent Owner petitioned for and was granted a one month extension of time to respond to the April 29, 2009 Office action.

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. 314states (in part):

> (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.
>
> (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 requester's reexamination filing pattern combined with a merger of the two reexamination proceedings denies Patent Owner of "*ex parte* reexamination rights" and expands the requester's *inter partes* rights. Therefore, Patent owner requests the remedies of: (1) Demerger of the *inter partes* and *ex parte* reexamination proceedings and suspension of the *inter partes* reexamination proceeding; or (2) Waiver of 37 CFR 1.989(b) to permit interviews, if the *inter partes* and *ex parte* reexamination proceedings are neither vacated nor demerged.

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.[3] The relevant sections of the MPEP provide guidance on the conduct of interviews to include denial of an interview.[4] Further, no expansion of the requester's statutory right is precipitated by the merging of the two proceedings. The merger process does not permit the *inter partes* requester, to go beyond the scope of commenting upon issues raised in the examiner's actions or the patent owner's response within thirty days. Therefore, merger of an *inter partes* and *ex parte* reexamination cannot be an *ultra vires* act. 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[5] 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

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[3] 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.

[4] See MPEP §§ 713 *et seq.*, 2281 and 2685

[5] Substantial New Question of Patentability

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 '1196 *inter partes* reexamination proceeding with the '9371 *ex parte* reexamination proceeding circumvents the statutory prohibition of 35 U.S.C. 317(a) that precludes a single third party requester of an 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 request 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.

Regarding the requester's strategy of filing reexamination requests, Patent Owner's arguments are more in keeping with an allegation of harassment, rather than violation of 35 U.S.C. 317(a). However, Patent Owner has not established a clear showing that the "filing strategy" was based upon the intent to harass. Therefore, relief in the form of a suspension of the subsequently ordered proceeding for reexamination cannot be granted.

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

the proceeding was filed with 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. Accordingly, Patent Owner's argument that merger violates 35 U.S.C. 317(a) is not persuasive.

Demerger or Waiver of 37 CFR 1.989(b). Patent Owner asserts that, based upon the facts and circumstances surrounding the filings of the '1196 *inter partes* reexamination proceeding and the '9371 *ex parte* reexamination proceeding, merger should not have been granted. Patent Owner further asserts that, based upon the facts and circumstances surrounding the filings, even if merger is maintained, 37 CFR 1.989(b) should be waived to permit Patent Owner's retention of full *ex parte* reexamination 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.[6]

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

[6] Presumably intimating the previously asserted argument of a statutory violation of 35 U.S.C. 317(a)

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.

Furthermore, merger does not expand the statutory rights of an *inter partes* third party requester. Patent Owner's argument is - that not only does the status of the requester, *inter partes* or *ex parte*, limit a requester's right to comment, but also the source of the issue raised, from an *inter partes* request or an *ex parte* request, limits the requester's right to comment. The statutory rights of an *inter partes* requester are set forth in 35 U.S.C. 314(b)(2). The plain language of the statute 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.

The statute defines the right to comment in the *inter partes* requester. Once the proceedings are merged, all issues are present in the *inter partes* reexamination, and the *inter partes* requester can comment on all such issues provided 35 U.S.C. 314(b)(2) is satisfied. As to the combination of all issues in both the *inter partes* and *ex parte* reexaminations, it is noted that there is nothing in the statute that prevents the combining of the two proceedings to efficiently resolve all issues as to the patent. To the contrary, 35 U.S.C. 312 explicitly permits the Office to consider information not cited in an *inter partes* reexamination (as does 35 U.S.C. 303 for *ex parte* reexamination), and the inclusion of the *ex parte* reexamination issues in the *inter partes* reexamination proceeding to facilitate special dispatch resolution of all issues is an efficient use of the consideration of other information.

In this instance, first, the *inter partes* requester's right to comment is contingent upon the patent owner commenting. Second, the *inter partes* requester's right to comment is limited to issues raised in either the Office action or the Patent Owner's response to the action (hereafter the "issue source limitation"). Finally, the statute only confers this limited right to comment upon an "*inter partes*" requester, (hereafter the "status limitation").[7] While Patent Owner is correct as to the status limitation that only an *inter partes* requester has the right to comment under 35 USC 314(b) (2), Patent owner is in error as to the issue source limitation placed upon the *inter partes* requester's right to comment. The issue source limitation is not grounded in what is raised in the *inter partes* request verses an *ex parte* request, but instead by statute based upon what issues are raised in the Office action and the Patent Owner's response to the Office action, which is

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[7] In an *inter partes-ex parte* reexamination merger where the requesters are different parties the status limitation alone precludes the *ex parte* requester from having any right to comment in the merged proceeding. In an *inter partes-ex parte* reexamination merger where the same party is both the *inter partes* and *ex parte* requester then only the statutory issue source limitation precludes the requester from having a right to comment on a given issue.

currently being commented upon. Patent Owner is conflating a requester's status limitation with the issue source limitation to arrive at the misplaced conclusion that an *inter partes* requester's rights are *ultra vires* expanded by merger with an *ex parte* reexamination request. However, merger does not expand the statutory rights of the *inter partes* requester, because merger leaves untouched the requester status and issue source limitations that 35 U.S.C. 314(b)(2) places upon a given requester's right to comment.

Therefore, Patent Owner's arguments to demerge, and for waiver of 37 CFR 1.989(b) if merger remains, are not persuasive. Accordingly, the petition to demerge the proceeding and stay the *inter partes* proceeding, or modify the merged proceeding to preserve "*ex parte* rights" and prevent expansion of requester rights is dismissed.

CONCLUSION

1. The October 16, 2009 Patent Owner petition is dismissed.

2. *Inter partes* Reexamination Control No. 95/001,196 and *ex parte* Reexamination Control No. 90/009,371 remain merged as a single proceeding.

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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DEC 17 2009

CENTRAL REEXAMINATION UNIT

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In re Barth *et al.*
Inter partes Reexamination Proceeding
Control No.: 95/001,196
Filed: June 4, 2009
For: U.S. Patent No. 7,330,952

In re Barth *et al.*
Ex Parte Reexamination Proceeding
Control No.: 90/009,371
Filed: December 22, 2008
For: U.S. Patent No. 7,330,952

: DECISION
: DISMISSING
: PETITION TO
: RECONSIDER
: MERGER OF
: REEXAMINATION
: PROCEEDINGS

This is a decision on patent owner's October 16, 2009 patent owner petition entitled "PETITION UNDER 37 C.F.R. §§ 1.182 and 1.183 REGARDING MERGER OF CO-PENDING REEXAMINATION PROCEEDINGS". The petition will be treated as a petition to reconsider merger as on even date the Office issued a decision, *sua sponte*, merging the above noted proceedings.

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 19, 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.

REVIEW OF FACTS

1. On February 12, 2008, the Office issued U.S. Patent No. 7,330,952 (the '952 patent) to Barth *et al.*

2. The '952 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 1-28 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 22, 2008, a request for *ex parte* reexamination of claims 21, 22 and 24 of the '952 patent was filed by third party requester, NVIDIA Corporation. The request was assigned Control No. 90/009,371 (the '9371 proceeding).

5. On February 20, 2009, the Office issued an order granting the '9371 request for *ex parte* reexamination and setting a two month time period for a Patent Owner's Statement. The order indicated that claims 21, 22 and 24 of the '952 patent, would be subject to reexamination.

6. The time for filing a patent owner's statement pursuant to 37 CFR 1.530 in the '9371 *ex parte* reexamination proceeding expired on April 20, 2009.[1]

7. On April 29, 2009, the Office issued a first Office action on the merits in the '9371 *ex parte* reexamination proceeding.

8. On June 4, 2009, a request for *inter partes* reexamination of all the claims (claims 1-28) of the '952 patent was filed by the same third party requester (NVIDIA Corporation). The request was assigned Control No. 95/001,196 (the '1196 proceeding).

9. On June 22, 2009, the ITC granted Patent Owner's motion for partial termination with respect to the '952 patent. Therefore, the '952 patent is no longer involved in the ITC investigation.

10. On July 29, 2009, Patent Owner filed a response in the '9371 *ex parte* 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.

proceeding. The response did not amend, cancel or add new claims.[2]

11. On August 13, 2009, the Office issued an order granting the '1196 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 '952 patent, claims 1-28, would be subject to reexamination.

12. On August 25, 2009, Patent Owner filed a supplemental response in the '9371 *ex parte* reexamination proceeding. The response did not amend, cancel or add new claims.

13. On October 16, 2009, the Office, *sua sponte,* issued a decision merging the '1196 *inter partes* reexamination proceeding with the '9371 *ex parte* reexamination proceeding.

14. On October 16, 2009, patent owner filed the present petition requesting prevent of merger of the '9371 *ex parte* proceeding, with the '1196 *inter partes* proceeding.

15. 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

[2] Patent Owner petitioned for and was granted a one month extension of time to respond to the April 29, 2009 Office action.

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. 314states (in part):

> (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.
>
> (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 requester's reexamination filing pattern combined with a merger of the two reexamination proceedings denies Patent Owner of "*ex parte* reexamination rights" and expands the requester's *inter partes* rights. Therefore, Patent owner requests the remedies of: (1) Demerger of the *inter partes* and *ex parte* reexamination proceedings and suspension of the *inter partes* reexamination proceeding; or (2) Waiver of 37 CFR 1.989(b) to permit interviews, if the *inter partes* and *ex parte* reexamination proceedings are neither vacated nor demerged.

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.[3] The relevant sections of the MPEP provide guidance on the conduct of interviews to include denial of an interview.[4] Further, no expansion of the requester's statutory right is precipitated by the merging of the two proceedings. The merger process does not permit the *inter partes* requester, to go beyond the scope of commenting upon issues raised in the examiner's actions or the patent owner's response within thirty days. Therefore, merger of an *inter partes* and *ex parte* reexamination cannot be an *ultra vires* act. 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[5] 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

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[3] 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.

[4] See MPEP §§ 713 *et seq.*, 2281 and 2685

[5] Substantial New Question of Patentability

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 '1196 *inter partes* reexamination proceeding with the '9371 *ex parte* reexamination proceeding circumvents the statutory prohibition of 35 U.S.C. 317(a) that precludes a single third party requester of an 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 request 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.

Regarding the requester's strategy of filing reexamination requests, Patent Owner's arguments are more in keeping with an allegation of harassment, rather than violation of 35 U.S.C. 317(a). However, Patent Owner has not established a clear showing that the "filing strategy" was based upon the intent to harass. Therefore, relief in the form of a suspension of the subsequently ordered proceeding for reexamination cannot be granted.

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

the proceeding was filed with 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. Accordingly, Patent Owner's argument that merger violates 35 U.S.C. 317(a) is not persuasive.

Demerger or Waiver of 37 CFR 1.989(b). Patent Owner asserts that, based upon the facts and circumstances surrounding the filings of the '1196 *inter partes* reexamination proceeding and the '9371 *ex parte* reexamination proceeding, merger should not have been granted. Patent Owner further asserts that, based upon the facts and circumstances surrounding the filings, even if merger is maintained, 37 CFR 1.989(b) should be waived to permit Patent Owner's retention of full *ex parte* reexamination 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.[6]

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

[6] Presumably intimating the previously asserted argument of a statutory violation of 35 U.S.C. 317(a)

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.

Furthermore, merger does not expand the statutory rights of an *inter partes* third party requester. Patent Owner's argument is - that not only does the status of the requester, *inter partes* or *ex parte*, limit a requester's right to comment, but also the source of the issue raised, from an *inter partes* request or an *ex parte* request, limits the requester's right to comment. The statutory rights of an *inter partes* requester are set forth in 35 U.S.C. 314(b)(2). The plain language of the statute 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.

The statute defines the right to comment in the *inter partes* requester. Once the proceedings are merged, all issues are present in the *inter partes* reexamination, and the *inter partes* requester can comment on all such issues provided 35 U.S.C. 314(b)(2) is satisfied. As to the combination of all issues in both the *inter partes* and *ex parte* reexaminations, it is noted that there is nothing in the statute that prevents the combining of the two proceedings to efficiently resolve all issues as to the patent. To the contrary, 35 U.S.C. 312 explicitly permits the Office to consider information not cited in an *inter partes* reexamination (as does 35 U.S.C. 303 for *ex parte* reexamination), and the inclusion of the *ex parte* reexamination issues in the *inter partes* reexamination proceeding to facilitate special dispatch resolution of all issues is an efficient use of the consideration of other information.

In this instance, first, the *inter partes* requester's right to comment is contingent upon the patent owner commenting. Second, the *inter partes* requester's right to comment is limited to issues raised in either the Office action or the Patent Owner's response to the action (hereafter the "issue source limitation"). Finally, the statute only confers this limited right to comment upon an "*inter partes*" requester, (hereafter the "status limitation").[7] While Patent Owner is correct as to the status limitation that only an *inter partes* requester has the right to comment under 35 USC 314(b) (2), Patent owner is in error as to the issue source limitation placed upon the *inter partes* requester's right to comment. The issue source limitation is not grounded in what is raised in the *inter partes* request verses an *ex parte* request, but instead by statute based upon what issues are raised in the Office action and the Patent Owner's response to the Office action, which is

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[7] In an *inter partes-ex parte* reexamination merger where the requesters are different parties the status limitation alone precludes the *ex parte* requester from having any right to comment in the merged proceeding. In an *inter partes-ex parte* reexamination merger where the same party is both the *inter partes* and *ex parte* requester then only the statutory issue source limitation precludes the requester from having a right to comment on a given issue.

currently being commented upon. Patent Owner is conflating a requester's status limitation with the issue source limitation to arrive at the misplaced conclusion that an *inter partes* requester's rights are *ultra vires* expanded by merger with an *ex parte* reexamination request. However, merger does not expand the statutory rights of the *inter partes* requester, because merger leaves untouched the requester status and issue source limitations that 35 U.S.C. 314(b)(2) places upon a given requester's right to comment.

Therefore, Patent Owner's arguments to demerge, and for waiver of 37 CFR 1.989(b) if merger remains, are not persuasive. Accordingly, the petition to demerge the proceeding and stay the *inter partes* proceeding, or modify the merged proceeding to preserve "*ex parte* rights" and prevent expansion of requester rights is dismissed.

CONCLUSION

1. The October 16, 2009 Patent Owner petition is dismissed.

2. *Inter partes* Reexamination Control No. 95/001,196 and *ex parte* Reexamination Control No. 90/009,371 remain merged as a single proceeding.

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

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

Kenneth M. Schor
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.
95/001,196	06/04/2009	7330952	2805.002REX9	8788

26111 7590 12/23/2009

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 12/23/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patents and Trademark Office
P.O.Box 1450
Alexandria, VA 22313-1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
David M. O'Dell
HAYNES AND BOONE, LLP, IP SECTION
2323 Victory Avenue, SUite 700
Dallas, TX 75219

Date:

MAILED

DEC 23 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001196
PATENT NO. : 7330952
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 Greene Stern
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(For Patent Owner)

William H Wright
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IP PROSECUTION DEPARTMENT
4 PARK PLAZA
SUITE 1600
IRVINE, CA 92614-2558

(For Third Party Requester)

MAILED

DEC 23 2009

CENTRAL REEXAMINATION UNIT

In re: Barth et alia
Ex Parte Reexamination Proceeding
Control No. 90/009,371
Deposited on: 22 December 2008
For: US Patent No. 7,330,952

In re: Barth et alia
Ex Parte Reexamination Proceeding
Control No. 95/001,196
Deposited on: 04 June 2009
For: US Patent No. 7,330,952

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

This is a decision on the 16 December 2009, "Petition for Extension of Time to File Response to First Office Action in Merged Proceedings Pursuant to Under 37 CFR § 1.956" requesting the response period be extended by one-month for the non-Final Office action mailed 02 December 2009, be extended by one (1) month. The petition submitted 16 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 for the reasons set forth below.

DISCUSSION

The Patent Owner's representative requests the period for response be extended by one-month for the non-final Office action mailed 02 December 2009, which set two (2) month's time for filing a response thereto. The petition for extension of time was timely filed on 16 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.

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

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

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

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

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

> Requests for an extension of time in an inter partes reexamination proceeding will be

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

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

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

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

DECISION

The patent owner's representative petitions to extend the period for response by adding one (1) month to the response period under 37 CFR § 1.956. The decision to extend the period for response is evaluated based upon a showing of "sufficient cause." There is always the consideration to balance the need for the patent owner to have a fair opportunity to respond to the Office action between the need for special dispatch.

The non-final Office action was mailed 02 December 2009. The patent owner submitted a

timely filed the petition on 16 December 2009 with the appropriate fee and certificate of service.

The petition dated 16 December 2009 notes several reasons for extension, among them, length of the Office action and need to obtain declaratory and factual evidence pursuant to 37 CFR §§ 1.131 & 1.132. On balance, the petitioner has demonstrated "sufficient cause" for the purpose of granting one (1) month extension of time.

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

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

CONCLUSION

1. The patent owner's petition for extension for one (1) month time in which to file a response to the non-final Office action dated 02 December 2009 is hereby **granted.**

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

3. The response is extended to **02 March 2010.**

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

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

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

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

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

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

/Mark Reinhart/

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. (For Patent Owner)
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WASHINGTON DC 20005

HAYNES & BOONE, LLP IP SECTION (For *inter partes* Requester)
2323 VICTORY AVENUE
SUITE 700
DALLAS, TX 75219

MAILED

DEC 17 2009

CENTRAL REEXAMINATION UNIT

ORRICK, HERRINGTON & SUTCLIFFE, LLP (For *ex parte* Requester)
Attn: William H. Wright
IP Prosecution Department
4 Park Plaza, Suite 1600
Irvine, CA 92614

In re Barth *et al.*
Inter partes Reexamination Proceeding
Control No.: 95/001,201
Filed: June 23, 2009
For: U.S. Patent No. 7,330,953

In re Barth *et al.*
Ex Parte Reexamination Proceeding
Control No.: 90/009,369
Filed: December 23, 2008
For: U.S. Patent No. 7,330,953

: DECISION
: DISMISSING
: PETITION TO
: PREVENT MERGER
: AND
: MERGER OF
: REEXAMINATION
: PROCEEDINGS

This is a decision on patent owner's October 16, 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 90/009,369.

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 19, 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 12, 2008, the Office issued U.S. Patent No. 7,330,953 (the '953 patent) to Barth *et al.*

2. The '953 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 1-28 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 23, 2008, a request for *ex parte* reexamination of claim 25 of the '953 patent was filed by third party requester, NVIDIA Corporation. The request was assigned Control No. 90/009,369 (the '9369 proceeding).

5. On March 6, 2009, the Office issued an order granting the '9369 request for *ex parte* reexamination and setting a two month time period for a Patent Owner's Statement. The order indicated that claim 25 of the '953 patent, would be subject to reexamination.

6. The time for filing a patent owner's statement pursuant to 37 CFR 1.530 in the '9369 *ex parte* reexamination proceeding expired on May 6, 2009.[1]

7. On May 19, 2009, the Office issued a first Office action on the merits in the '9369 *ex parte* reexamination proceeding.

8. On June 22, 2009, the ITC granted Patent Owner's motion for partial termination with respect to the '953 patent. Therefore, the '953 patent is no longer involved in the ITC investigation.

9. On June 23, 2009, a request for *inter partes* reexamination of all the claims (claims 1-28) of the '953 patent was filed by the same third party requester (NVIDIA Corporation). The request was assigned Control No. 95/001,201 (the '1201 proceeding).

10. On August 12, 2009, the Office issued an order granting the '1201 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 '953 patent, claims 1-28, would be

[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.

subject to reexamination.

11. On August 19, 2009, Patent Owner filed a response in the '9369 *ex parte* reexamination proceeding. The response did not amend, cancel or add new claims.[2]

12. On October 16, 2009, patent owner filed the present petition in the '9369 proceeding to prevent merger with the '1201 *inter partes* proceeding.

13. 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.

---

[2] Patent Owner petitioned for and was granted a one month extension of time to respond to the May 19, 2009 Office action.

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". 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.[3] The relevant sections of the MPEP

[3] 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.

provide guidance on the conduct of interviews to include denial of an interview.[4] 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[5] 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 '1201 *inter partes* reexamination proceeding with the '9369 *ex parte* reexamination proceeding circumvents the statutory prohibition of 35 U.S.C. 317(a) that precludes a single third party requester of an 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

[4] See MPEP §§ 713 *et seq.*, 2281 and 2685
[5] Substantial New Question of Patentability

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 '1201 *inter partes* reexamination proceeding and the '9369 *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.[6]

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*

[6] Presumably intimating the previously asserted argument of a statutory violation of 35 U.S.C. 317(a)

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.

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 16, 2009 Patent Owner petition is dismissed.

2. *Inter partes* Reexamination Control No. 95/001,201 and *ex parte* Reexamination Control No. 90/009,369 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

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(For Patent Owner)

MAILED

APR 02 2010

CENTRAL REEXAMINATION UNIT

Justin J. Oliver
FITZPATRICK, CELLA HARPER & SCINTO
30 Rockefeller Plaza
New York, NY 10112

(For *Inter Partes* Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,202
Filed: June 23, 2009
For: U.S. Patent No. 7,207,949

DECISION GRANTING PETITION

This is a decision on third party requester's November 13, 2009 petition entitled "PETITION UNDER 37 C.F.R. § 1.183" requesting waiver of the page limit requirement of 37 CFR 1.943(b).

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

The petition is granted.

FEES

The petition fee of $400 for third party requester's petition under 37 CFR 1.183 pursuant to 37 CFR 1.17(f) was charged to Deposit Account No. 50-3939 on November 16, 2009.

REVIEW OF THE RELEVANT FACTS

1. On April 24, 2007, United States Patent Number 7,207,949 (the '949 patent) issued.

2. On June 23, 2009, a request for *inter partes* reexamination of all the claims (1-38) of the '949 patent, assigned Reexamination Control No. 95/001,202 (the '1202 proceeding), was filed by a third party requester.

3. On August 14, 2009, the Office issued an order granting *inter partes* reexamination and an Office action on the merits in the '1202 proceeding.

4. On October 14, 2009, patent owner filed an "AMENDMENT IN REPLY TO THE ACTION OF AUGUST 14, 2009," which amended original claim 6, added new claims 39-204 (166 new claims) and retained original claims 1-38.

5. On November 13, 2009, third party requester filed a "RESPONSE TO PATENT OWNER'S AMENDMENT," which included a 39 page remarks section, a four page affidavit and 138 pages of claim charts.

6. Concurrently, on November 13, 2009, third party requester filed a petition entitled "PETITION UNDER 37 C.F.R. § 1.183" requesting waiver of the page limit requirement of 37 CFR 1.943(b).

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.

Third Party Requester's Petition under 37 CFR 1.183

Third party requester's petition under 37 CFR 1.183, requests waiver of the 50-page limit of 37 CFR 1.943(b) for the concurrently filed comments, including supplemental claim charts appendices and a declaration under 37 CFR 1.132 executed by Dr. Hallett Mathews ("Mathews declaration").

Requester has concluded, the arguments section of requester's comments, the Mathews declaration and the supplemental claim chart appendices, submitted to address new claims 39-204, exceeds the 50-page limit set forth in 37 CFR 1.943(b). Only those pages of third party requester's November 13, 2009 comments and declarations upon which arguments appear will be included against the page limit count. See MPEP 2667(I)(A)(2). The comments portion is 39 pages in length to include, a cover sheet, a signature page and a two page summary listing of all proposed rejections, which are exclusive of argument. The Mathews declaration appears to be free of any arguments that would be included in the regulatory page count. Therefore the comments and declaration combined contains a total of 35 pages of argument that are counted against the 50 page limit of 37 CFR 1.943(b). Pursuant to MPEP 2667(I)(A)(2), claim charts applying the art to the claims are not excluded from the appeal brief 30-page limit required by 37 CFR 1.943(c). *A fortiori* claim charts applying the art to the claims in a response pursuant to 37 CFR 1.947 likewise are not excluded from the even greater 50-pages authorized by 37 CFR 1.943(b). The November 13, 2009 response under 37 CFR 1.947 contains 138 pages of supplemental claim chart appendices. The November 13, 2009 37 CFR 1.947 response included five supplemental claim chart appendices consisting of a one page continuation of originally filed Claim Chart A, a seven page continuation of originally filed Claim Chart E along with a ten page new Claim Chart H and two sixty page new Claim Charts I and J. Requester's November 13, 2009 response (comments, declaration, and supplemental claim charts), which is included in the regulatory page count amounts to 173 pages. Requester's response exceeds in the regulatory 50-page limit set forth in 37 CFR 1.943(b) by 123 pages.

In this instance, third party requester 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, requester has provided explanation of how the submitted response economizes, excludes extraneous material, and is arranged so as not to repeat information already of record. Requester notes that efforts to be as brief as possible were taken to respond to patent owner's amendment resulting in a 35 page arguments section in the comments. Requester notes that Office guidance indicates that the best way to provide a limitation-by-limitation patentability analysis of claims is by using claim charts. Requester asserts that the therefore inclusion of 166 new claims make it

virtually impossible to both fully respond to all issues of patentability in the new claims and also comply with the 50-page limit regulatory requirement.

Based upon the facts and circumstances of the instant proceeding, specifically in light of the fact that patent owner added 166 new claims, in the interest of justice it is equitable in this case to grant third party requester's petition under 37 CFR 1.183 as to the 123 pages of supplemental claim chart appendices in excess of the 50-page regulatory limit.

CONCLUSION

1. Third party requester's petition under 37 CFR 1.183 is granted to the extent that the page length of third party requester's November 13, 2009 comments, including the claim charts addressing new claims 39-204, will be accepted.

2. Jurisdiction for the '1202 reexamination proceeding is returned to the Central Reexamination Unit (CRU).

3. Any questions concerning this communication should be directed to Joseph F. Weiss, Jr., Legal Advisor, at (571) 272-7759.

Kenneth M. Schor

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examining Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,203	06/24/2009	7410272	27451C-014100US	4902

34026 7590 12/29/2009

JONES DAY
555 SOUTH FLOWER STREET FIFTIETH FLOOR
LOS ANGELES, CA 90071

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/29/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patents and Trademark Office
P.O.Box 1450
Alexandria, VA 22313-1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
TOWNSEND AND TOWNSEND AND CREW LLP
TOW EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

Date:
MAILED

DEC 29 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001203
PATENT NO. : 7410272
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

DEC 29 2009

CENTRAL REEXAMINATION UNIT

Townsend and Townsend and Crew LLP
Tow Embarcadero Center
Eight Floor
San Francisco, CA 94111-3834

(For Third Party Requester)

In re: Halasz
Inter Partes Reexamination Proceeding
Control No. 95/001,203
Deposited on: 24 June 2009
For: US Patent No. 7,410,272

DECISION
DISMISSING
PETITION FOR EXTENSION
OF TIME
[37 CFR § 1.956 and § 1.181]

This is a decision on the 10 December 2009, "Request for Extension of Time [37 CFR 1.956]" requesting that the time for responding to the Non-Final Office action mailed 14 October 2009, be extended by one (1) month. The petition was timely filed with certificate of service.

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

The petition is dismissed for the reasons set forth below.

Discussion

The Patent Owner's representative requests the period of time be extended in which to file a response to the non-final Office action mailed 14 October 2009, which set a two (2) month time for filing a response thereto. The petition for extension of time was timely filed on 10 December 2009, together with electronic fee transmittal for the $200.00 petition fee as required by 37 CFR § 1.956 and 37 CFR § 1.17 (g). A certificate of service was provided

with the petition.

The petition is dismissed for the reasons set forth below.

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

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

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

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

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

> Requests for an extension of time in an inter partes reexamination proceeding will be considered only after the first Office action on the merits in the reexamination is mailed. Any request for an extension of time filed prior to the first action will be denied.
>
> The certificate of mailing and the certificate of transmission procedures (37 CFR

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

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

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

Decision

The patent owner's representative petitions under 37 CFR § 1.956 to extend the period for response by adding one (1) month to the period for response. The decision to extend the period for response is evaluated based upon a showing of "sufficient cause." There is always the consideration to balance the need for the patent owner to have a fair opportunity to respond to the Office action between the need for special dispatch.

The non-final Office action was mailed 14 October 2009. The patent owner submitted a timely filed the petition on 10 December 2009 with the appropriate fee and certificate of service.

The petition dated 10 December 2009 cites various reasons for the extension of time. 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. It is not clear what action has been taken to contact the patent owner, it is not clear why, in spite of the action taken thus far one or more experts must be retained, and consideration of prior art from the litigation has not been addressed from either (A or (B). Lastly the action mailed 14 October is not especially long and it is unclear how the "numerous" rejections require additional time. Again see requirements (A) and (B). On balance, the petitioner has not demonstrated "sufficient cause" to grant an extension of time.

The patent owner is reminded that 37 CFR §1.137 is the appropriate authority for revival of terminated Reexamination proceedings.

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

CONCLUSION

1. The patent owner's petition for extension for time in which to file a response to the non-final Office action dated 14 October 2009 is hereby **dismissed.**

2 The Patent Owner's response was due **10 December 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/

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.
95/001,203	06/24/2009	7410272	27451C-014100US	4902

34026 7590 02/19/2010

EXAMINER	
ART UNIT	PAPER NUMBER

JONES DAY
555 SOUTH FLOWER STREET FIFTIETH FLOOR
LOS ANGELES, CA 90071

RECEIVED
FEB 23 2010
JONES DAY
PATENT PROSECUTION DEPT.

DATE MAILED: 02/19/2010

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
TOWNSEND AND TOWNSEND AND CREW LLP
TOW EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

Date:
MAILED

FEB 19 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001203
PATENT NO. : 7410272
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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Charles A Kertell JONES DAY 555 SOUTH FLOWER STREET FIFTIETH FLOOR LOS ANGELES CA 90071	: : : :	(For Patent Owner)
Roger D Wylie Townsend and Townsend and Crew LLP 1420 Fifth Avenue Suite 4400 Seattle, WA 98101	: : : : :	(For Third Party Requester)
In re: Halasz *Inter Partes* Reexamination Proceeding Control No. 95/001,203 Deposited on: 24 June 2009 For: US Patent No. 7,410,272	: : : : :	DECISION GRANTING-IN-PART PETITION FOR EXTENSION OF TIME [37 CFR § 1.956 and § 1.181]

This is a decision on the 14 January 2010, "Request Reconsideration of the Patent Owner's December 9, 2009 Petition for Extension of Time [37 CFR 1.956]" requesting that the time for responding to the Non-Final Office action mailed 14 October 2009, be extended by one (1) month. The petition was timely filed with certificate of service.

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

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

Discussion

The Patent Owner's representative requests reconsideration of the earlier request that the period of time be extended in which to file a response to the non-final Office action mailed 14 October 2009, which set a two (2) month time for filing a response thereto. The petition for reconsideration of extension of time was timely filed 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 further requests that if the request for reconsideration is not persuasive that the petition be considered under 37 CFR §§ 1.137, 1.182 or 1.183. These additional petitions are dismissed under 37 CFR § 1.4(c) which states, "Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects.

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

One-day is hereby granted.

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

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

> As noted above, a request for extension of time under 37 CFR § 1.956 will be granted only for sufficient cause, ...
>
> Evaluation of whether "sufficient cause" has been shown for an extension must be made by **balancing** the desire to provide the patent owner with a fair opportunity to respond, **against**

the requirement of the statute, 35 U.S.C. § 314(c), that the proceedings be conducted with special dispatch. ...

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

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

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

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

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

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

Decision

The patent owner's representative petitions under 37 CFR § 1.956 to extend the period for response by adding one (1) month to the period for response. The decision to extend the period for response is evaluated based upon a showing of "sufficient cause." There is always the consideration to balance the need for the patent owner to have a fair opportunity to respond to the Office action between the need for special dispatch.

The petition requesting reconsideration dated 14 January 2010 notes that the postmark on the envelope is 15 October 2009 when the date of the transaction in the file history indicated the action was mailed on 14 October 2009. This is persuasive. "Busy time" of the patent owner from mid-October to December is not persuasive as there is no supporting facts for such allegation. The next reason given is the length of the Office action, the petitioner's opinion notwithstanding, this arguments presented are not persuasive. "Difficult" and "time consuming" are relative terms without factual support for specific time. On balance, the petitioner has not demonstrated "sufficient cause" to grant-in-part an extension of time. The petitioner is reminded that Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. The petition for extension of time reasons must include (A) a statement of what action the patent owner has taken to provide a response, to date as of the date the request for extension is submitted, and (B) why, in spite of the action taken thus far, the requested additional time is needed. The statement of (A) must provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period. The need for an expert may be but the petitioner has not set forth what actions have been taken thus far and why the additional time is needed beyond that of ordinary response to an inter partes Office action. The age of an expert has no bearing on sufficient cause, what does have bearing is the steps taken thus far to provide a response and why in spite of the action taken that additional time is needed. The petition notes the difficulty locating the inventor but lacks that facts as to when a search was begun and shat steps were taken at the time the request was granted to locate the inventor, if such was deemed necessary for future prosecution of the proceeding. Copending litigation and district court activity has no bearing on the response time and need for "special dispatch" in the instant proceeding as such cannot be used for sufficient cause to extend a response period.

The petition further requests that if the request for reconsideration is not persuasive that the petition be considered under 37 CFR §§ 1.137, 1.182 or 1.183. These additional petitions are dismissed under 37 CFR § 1.4(c) which states, "Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects.

The patent owner is reminded that 37 CFR §1.137 is the appropriate authority for revival of terminated Reexamination proceedings.

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

An extension of **one-day** is hereby granted so that the response agrees with the postmark of the Office action.

CONCLUSION

1. The patent owner's petition for extension for time in which to file a response to the non-final Office action dated 14 October 2009 is hereby **granted-in-part**

2. A one-day extension of time is hereby granted

3 The Patent Owner's response is due **15 December 2009.**

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

By Mail to: Mail Stop *Ex Parte* Reexam
Central Reexamination Unit
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United States Patent & Trademark Office
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Alexandria, VA 22313-1450

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

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

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

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/

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.
95/001,203	06/24/2009	7410272	27451C-014100US	4902

34026 7590 06/24/2010

JONES DAY
555 SOUTH FLOWER STREET FIFTIETH FLOOR
LOS ANGELES, CA 90071

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/24/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
TOWNSEND AND TOWNSEND AND CREW LLP
TOW EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

Date:

MAILED

JUN 24 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001203
PATENT NO. : 7410272
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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COMMISSIONER FOR PATENTS
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P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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Jerrold B. Reilly : (For Patent Owner)
JONES DAY :
555 SOUTH FLOWER STREET :
FIFTIETH FLOOR :
LOS ANGELES, CA 90071 :

MAILED

JUN 24 2010

CENTRAL REEXAMINATION UNIT

Roger D. Wylie : (For Third Party
TOWNSEND AND TOWNSEND : Requester)
AND CREW LLP :
TWO EMBARCADERO CENTER :
EIGHTH FLOOR :
SAN FRANCISCO, CA 94111 :

In re: Halasz :
Inter Partes Reexamination Proceeding : DECISION ON PETITION
Control No.: 95/001,203 : UNDER 37 CFR § 1.181
Deposited: June 24, 2009 :
For: U.S. Patent No.: 7,410,272 :

This is a decision on a petition filed by the patent owner on April 15, 2010, entitled "AMENDED PETITION TO THE DIRECTOR PURSUANT TO 37 C.F.R. § 1.181 CONCERNING THE PATENT OWNER'S JANUARY 14, 2010 REQUEST FOR RECONSIDERATION."

The petition is a request to the Director to exercise his discretion pursuant to 37 CFR 1.181 to reconsider the petitioner's previous request for extension of time to reply to an Office action.

The petition is before the Director of the Central Reexamination Unit. The petition is denied to the extent that no additional time to respond is granted.

REVIEW OF RELEVANT FACTS

- U.S. Patent No. 6,465,893 issued on August 12, 2008.
- A request for *inter partes* reexamination was filed on June 24, 2009 and assigned control no. 95/001,203. Reexamination was ordered on July 24, 2009.
- A non-final rejection was mailed with a printed mail date of October 14, 2009, setting a two month period to respond. Evidence on the record apparently shows that the actual postage meter date was October 15, 2009.
- On December 10, 2009, the Office received a request by patent owner for a two month extension of time to respond to the Office action.
- The Office dismissed the petition for extension of time in a letter mailed December 29, 2009.
- On January 14, 2010, patent owner filed a request for reconsideration of the dismissal along with a response to the Office action
- On January 27, 2010, the third party requester filed a submission opposing the request for reconsideration.
- On February 16, 2010, the third party filed comments to the patent owner's response.
- On February 19, 2010, the Office responded to patent owner's request for reconsideration, granting a one day extension of time due to the discrepancy between the printed mail date and the postage meter date of the Office action. The other arguments were deemed not persuasive.
- On April 9, 2010, a petition was filed that was not served on the third party. The instant petition, correcting this and replacing that petition, was filed April 15, 2010.
- On April 27, 2010, the third party requester filed a submission opposing the April 15th petition.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 CFR § 1.956 Patent owner extensions of time in *inter partes* reexamination

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

MPEP § 2665 Extension of Time for Patent Owner Response

***

An extension of time in an *inter partes* reexamination proceeding is requested, where applicable, pursuant to 37 CFR 1.956. Any request for extension of time pursuant to 37 CFR 1.956 will be decided by the Central Reexamination Unit (CRU) Director. The request (A) must be filed on or before the day on which action by the patent owner is due, (B) must set forth sufficient cause for the extension, and (C) must be accompanied by the petition fee set forth in 37 CFR 1.17(g).

***

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

Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. The reasons must include (A) a statement of what action the patent owner has taken to provide a response, to date as of the date the request for extension is submitted, and (B) why, in spite of the action taken thus far, the requested additional time is needed. The statement of (A) must provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.

Prosecution will be conducted by initially setting a time period of at least 30 days or one month (whichever is longer), see MPEP § 2662. First requests for extensions of these time

periods will be granted for sufficient cause, and for a reasonable time specified-usually 1 month. The reasons stated in the request will be evaluated, and the request will be favorably considered where there is a factual accounting of reasonably diligent behavior by all those responsible for preparing a response or comments within the statutory time period. Second or subsequent requests for extensions of time, or requests for more than one month, will be granted only in extraordinary situations.

DECISION

Patent owner ("Petitioner") requests reconsideration of its paper filed January 14, 2010, which itself requested reconsideration of the extension of time request filed December 9, 2009. As described above, after reconsidering the request in light of petitioner's request for reconsideration, the Office granted a one day extension of time due to the apparent discrepancy between the printed mail date and the postage meter date. Petitioner requests reconsideration again, arguing that a full month extension should have been granted.

First, it should be made clear what the January 14th paper is not—it is not an extension of time request. 37 CFR § 1.956 requires that any extension of time request must be filed on or before the date in which the response is due. That date was December 14, 2009. The only timely filed extension of time request was the original paper filed December 9, 2009. The January 14th paper is merely what it says it is: a request for reconsideration of the December 9th petition.

MPEP § 2665 further explains that the request must set forth sufficient cause for the extension. There is no indication that sufficient cause may be shown later in separate or additional submissions. The policy behind this is a good one, as it requires petitioners to provide their evidence of sufficient cause as soon as possible, allowing the Office to likewise decide the petition as soon as possible. This requirement is necessary given the balance between giving a patent owner additional time to respond, versus the statutory mandate of special dispatch.

With those things in mind, both the instant petition and the previous request for reconsideration are flawed. Each relies extensively on arguments and evidence submitted on January 14, 2010, a month after the original request for extension and a month after the time period to respond had ended. Indeed, petitioner states at page 2 of the petition that ""sufficient cause" existed for the requested one month extension based on the facts set forth in the Patent Owner's January 14, 2010 Request for Reconsideration." (emphasis added). Such evidence is irrelevant to the inquiry. Furthermore, the instant petition is primarily drawn to arguments as to why the Office's February 19th decision is inadequate, based upon the submissions filed January 14th. Such arguments do not address the petitioner's original request for extension of time. All that is

relevant, as a factual basis for showing sufficient cause, is the original request submitted December 9th.

The instant decision is therefore a determination as to whether the Supervisory Patent Examiner correctly decided the original extension request, based upon the evidence supplied in the original request. The Director determines that the Supervisory Patent Examiner did not abuse his discretion in originally dismissing the request, and in subsequently granting only a one day extension upon reconsideration.

The original request is fairly sparse. The request stated that the patent owner must contact the inventor, must retain one or more experts, and must review additional art identified in the related litigation. Patent owner stated it had "undertaken efforts" to locate the inventor and retain experts, and is "in the process" of compiling and reviewing the additional prior art. More time was requested given the number of cited references and combinations in the Office Action, the allegedly numerous unsupported assertions made in the request, and the effect of holidays during the time to respond.

As described above, section 2665 of the MPEP requires that a request for extension must fully state the reasons therefore, including "(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 . . . . The statement of (A) must provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period." The original request lacks any specificity as to what petitioner had done as of the date of the request. Petitioner's statements that it had "undertaken efforts" to do various things is incredibly vague, and is far from a factual accounting of reasonably diligent behavior. Being "in the process" of compiling and reviewing prior art references does not tell what exactly petitioner has done to provide a response. It was not unreasonable for the Supervisory Examiner to conclude that such vague and non-specific descriptions of petitioner's actions failed to support a finding of "sufficient cause" to grant an extension.

The other factors cited by petitioner in the original request fare no better. The statement of the rejections in the Office Action, in incorporating by reference the request for reexamination, is approximately twenty-five to thirty pages long. This is not unusually long for an *inter partes* reexamination. While there were a number of proposed rejections (sixteen in total), each is drawn to only one claim and many are drawn to the same references. Whether the assertions by the third party were "unsupported" goes to the merits of the rejections, and is simply a part of responding to the Office Action. Lastly, a vague statement that "holidays" have compromised the petitioner's time does not tell us much; Christmas was cited in the original request, a holiday that occurred several weeks after the response was due, and only two days of federal holidays fell within the response period.

Upon reconsideration, the Supervisory Examiner's dismissal and subsequent grant-in-part of the extension of time request was not unreasonable. Accordingly, the petition requesting additional time to respond to the Office Action is denied.

Additional Comments:

The petition having been denied, patent owner's response to the Office Action on 14 January 2010 is not timely. No claims were found patentable in the previous Office Action, therefore this proceeding is terminated pursuant to 37 CFR § 1.957(b). Jurisdiction will return to the examiner, who will issue a Notice of Intent to Issue *Inter Partes* Reexamination Certificate in due course. If patent owner chooses, a petition under 37 CFR § 1.137 to revive the proceeding may be filed.

Petitioner states at page 3 that, if necessary, this petition should be treated as a petition under 37 CFR §§ 1.137 and/or 1.183. To the extent that there are additional petitions, they are dismissed under 37 CFR § 1.4(c), which requires that "each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects." If petitioner wishes to file a petition under some other section it must be filed separately with appropriate supporting documentation.

CONCLUSION

1. The petition filed 15 April 2010 is denied.

2. The 14 January 2010 response is not timely, therefore this proceeding is terminated. A Notice of Intent to Issue *Inter Partes* Reexamination Certificate will be issued in due course.

3. Telephone inquiries related to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner, at (571) 272-1611 or in his absence to the undersigned at (571) 272-3838.

Gregory A. Morse
Director, Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

MAILED

DEC 17 2009

CENTRAL REEXAMINATION UNIT

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STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. (For Patent Owner)
1100 NEW YORK AVENUE, N.W.
WASHINGTON DC 20005

HAYNES & BOONE, LLP IP SECTION (For *inter partes* Requester)
2323 VICTORY AVENUE
SUITE 700
DALLAS, TX 75219

ORRICK, HERRINGTON & SUTCLIFFE, LLP (For *ex parte* Requester)
Attn: William H. Wright
IP Prosecution Department
4 Park Plaza, Suite 1600
Irvine, CA 92614

In re Barth *et al.*	:
Inter partes Reexamination Proceeding	: DECISION
Control No.: 95/001,205	: DISMISSING
Filed: July 1, 2009	: PETITION TO
For: U.S. Patent No. 7,360,050	: PREVENT MERGER
	: AND
In re Barth *et al.*	: MERGER OF
Ex Parte Reexamination Proceeding	: REEXAMINATION
Control No.: 90/009,370	: PROCEEDINGS
Filed: December 23, 2008	:
For: U.S. Patent No. 7,360,050	:

This is a decision on patent owner's October 16, 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 90/009,370.

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 19, 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 15, 2008, the Office issued U.S. Patent No. 7,360,050 (the '050 patent) to Barth *et al.*

2. The '050 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 1-31 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 23, 2008, a request for *ex parte* reexamination of claims 29 and 31 of the '050 patent was filed by third party requester, NVIDIA Corporation. The request was assigned Control No. 90/009,370 (the '9370 proceeding).

5. On March 16, 2009, the Office issued an order granting the '9370 request for *ex parte* reexamination and setting a two month time period for a Patent Owner's Statement. The order indicated that claims 29 and 31 of the '050 patent, would be subject to reexamination.

6. The time for filing a patent owner's statement pursuant to 37 CFR 1.530 in the '9370 *ex parte* reexamination proceeding expired on May 16, 2009.[1]

7. On May 19, 2009, the Office issued a first Office action on the merits in the '9370 *ex parte* reexamination proceeding.

8. On June 22, 2009, the ITC granted Patent Owner's motion for partial termination with respect to the '050 patent. Therefore, the '050 patent is no longer involved in the ITC investigation.

9. On June 23, 2009, a request for *inter partes* reexamination of all the claims (claims 1-31) of the '050 patent was filed by the same third party requester (NVIDIA Corporation). The request was assigned Control No. 95/001,205 (the '1205 proceeding).

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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 13, 2009, the Office issued an order granting the '1205 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 '050 patent, claims 1-31, would be subject to reexamination.

11. On August 19, 2009, Patent Owner filed a response in the '9370 *ex parte* reexamination proceeding. The response did not amend, cancel or add new claims.[2]

12. On October 16, 2009, patent owner filed the present petition in the '9370 proceeding to prevent merger with the '1205 *inter partes* proceeding.

13. 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.

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[2] Patent Owner petitioned for and was granted a one month extension of time to respond to the May 19, 2009 Office action.

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". 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.[3] The relevant sections of the MPEP provide guidance on the conduct of interviews to include denial of an interview.[4] 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[5] 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.

---

[3] 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.

[4] See MPEP §§ 713 *et seq.*, 2281 and 2685

[5] Substantial New Question of Patentability

Circumvention of 35 U.S.C. 317(a). Patent Owner alleges that merging the '1205 *inter partes* reexamination proceeding with the '9370 *ex parte* reexamination proceeding circumvents the statutory prohibition of 35 U.S.C. 317(a) that precludes a single third party requester of an 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 the proceeding was filed with 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 '1205 *inter partes* reexamination proceeding and the '9370 *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.[6]

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.

Accordingly, the petition to stay the *inter partes* proceeding, prevent merger or modify any merged proceeding to preserve "*ex parte* rights" is dismissed.

[6] Presumably intimating the previously asserted argument of a statutory violation of 35 U.S.C. 317(a)

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 95/001,205 and 90/009,370 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 16, 2009 Patent Owner petition is dismissed.

2. *Inter partes* Reexamination Control No. 95/001,205 and *ex parte* Reexamination Control No. 90/009,370 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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Date: **MAILED**

JUN 22 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001206
PATENT NO. : 7272021
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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(For Requester)

MAILED

JUN 22 2010

CENTRAL REEXAMINATION UNIT

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Portland, Oregon 97204

(For Patent Owner)

In re Schlecht, et al
Reexamination Proceeding
Control No.: 95/001,206
Filed: August 19, 2009
For: U.S. Patent No.: 7,272,021
Title: Power Converter With Isolated And Regulated Stages

: DECISION
: DISMISSIING
: PETITION

This is a decision on a November 3, 2009 patent owner § 1.182 "Petition to Vacate Filing Date of *Inter Partes* Reexamination Request and The Order Granting *Inter Partes* Reexamination."

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

The petition is dismissed.

FEES

The § 1.182 petition fee of $400.00 fee (as set forth in 37 CFR 1.17(f)) has been paid as indicated in Office PALM records.

BACKGROUND

1. U.S. Patent No. 7,272,021 (the '021 patent) was issued on September 18, 2007.

2. On July 14, 2009, a request for *inter partes* reexamination of the '021 patent was filed by requester Murata Manufacturing Co., Ltd. (MMC) who was also identified as the real party in interest.[1] The request was assigned reexamination

[1] At page 1, paragraph 2b. of the "Request for *Inter Partes* Reexamination Transmittal Form," MMC was identified as the "real party in interest," pursuant to 37 CFR 1.915(b)(8) and 35 U.S.C. § 311(b).

control No. 95/001,206 (the '1,206 reexamination proceeding). The request noted copending litigation of *SynQor, Inc. v. Artesyn Technologies, Inc. et al.*

3. On August 19, 2009, a revised request for *inter partes* reexamination was filed naming the same real party in interest, MMC, and the proceeding was assigned a filing date of August 19, 2009.

4. On October 15, 2009, the Office issued an Order Granting Request for *Inter Partes* Reexamination for the '1,206 reexamination proceeding.

5. On November 3, 2009, patent owner filed the instant petition under 37 CFR 1.182 to vacate the filing date of the present reexamination proceeding and the Order Granting *Inter Partes* Reexamination. An opposition to the instant petition under 37 CFR 1.182 has not been filed by the requester.

PETITION FOR VACATUR

Petitioner (Patent Owner) asserts that the real party in interest was not properly identified in the request for reexamination as required by 35 U.S.C. § 311(b). Petitioner notes that the Office will not permit the use of a "straw man" or "shill" to file an *inter partes* reexamination request so as to shield a real party in interest from the estoppel provisions, such as in 35 U.S.C. § 315(c) and 35 U.S.C. § 317(b), *e.g.*, barring a real party in interest in a first *inter partes* reexamination from filing a second request for *inter partes* reexamination (after order of the first reexamination) or maintaining an *inter partes* reexamination upon final decision in a civil action (to which the real party in interest was a party) that does not sustain the invalidity of any patent claim.[2]

Petitioner claims that all the defendants to a patent infringement suit based on the '021 patent being reexamined are real parties in interest to the instant '1,206 reexamination proceedings; yet, they have not been identified as such. The reexamination request only identifies one of the defendants in the infringement suit as the real party in interest in filing the request for reexamination, thereby shielding the rest of the defendants in the suit from the estoppel provisions of the reexamination statute. Patent owner petitioner's basis for alleging a failure to identify all the real parties in interest in filing the request for reexamination lies in (1) the art presented by the defendants in the infringement suit as an invalidity defense is also being used as a basis for the reexamination request, which most, if not all, of the defendants in the litigation collaborated in identifying,[3] (2) the existence of a joint defense group by some of the defendants in the suit, and (3) the use of joint defense counsel in the suit by some of the defendants.[4]

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[2] Petition at page 2, citing Decision Vacating Filing Date in 95/001,045, decision copy supplied as part of Exhibit A.

[3] Petition at page 9.

[4] Petition at page 3.

Petitioner highlights the following statement in the reexamination request[5] to establish that the prior art used by the requester in the request for reexamination was not by happenstance duplicative of some of the art used by defendants in the litigation:

> It is noted that Invalidity Contentions have been filed in the above-identified litigation citing numerous prior art references. In order to simplify this Request and to avoid undue burden on the U.S. Patent Office, this Request cites only some of the prior art references submitted in the Invalidity Contentions.

It is therefore argued that, based on the combined set of invalidity contentions for the litigation having been used as the input for the request for reexamination, as admitted in the request for reexamination, all defendants in the litigation are required to be named as real parties in interest in the request for reexamination.

To permit the instant reexamination to go forward without all of the defendants in the infringement litigation being named as real parties in interest in the request for reexamiantion is asserted to thwart the goals of the statutory estoppel provisions. Any of the defendants in the litigation, other than the single defendant named as the real party in interest in the reexamination, could then initiate a subsequent *inter partes* request or argue invalidity of any confirmed claims in the litigation using the same art of record.[6]

Petitioner reminds the Office that it has identified the following actions that, if attributable to a particular party, would require that party to be identified as a real party in interest: [7]

> 1. Accept payment from another group, pay the requester to file the request for *inter partes* reexamination, and have itself named solely as the real party in interest.
>
> 2. Obtain money for foundation grants, file a "*quid pro quo*" request for an *inter partes* reexamination where the foundation wants reexamination on a specific patent that the foundation deems anti-competitive, and name itself solely as real party in interest.
>
> 3. Allow another party to direct or control the content (*e.g.*, provide the prior patents/printed publications on which the reexam is to be based) of the request whether such is termed "technical review" or some other phase.

Petitioner believes that itemized items 1 and 3 would be applicable in this instance.[8] The first item is asserted to be implicated if the joint defense group allocates fee payments, work load, etc between defendants. The third item is asserted to be

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[5] August 19, 2009 revised request for reexamination, page 192.
[6] Petition at page 6.
[7] *Id.*
[8] Petition at page 7.

implicated if the joint defense group prepares a common pool of prior art, but then provides that information to another entity (*e.g.*, another defendant or another law firm). The gravamen of petitioner's contentions is that the litigation defendants (paid for) and created a combined set of invalidity contentions that was also used as the input for the reexamination request. Petitioner further speculates that: "Of course, if any of the other defendants provided a 'technical review' of the request [for reexamination] prior to filing, even silence may constitute a form of direction or control)," that would also require their identification as a real party in interest.[9]

DECISION

The MPEP [10] makes clear that the Office does not intend to look beyond the required certification in the request for reexamination, except for the rare instance where a challenge to the sufficiency of the certification facially establishes that the identified real party in interest is not accurate. The certification cannot be successfully challenged merely because, at one point, the certified real party in interest was "involved" with another (barred) party, or there was some collaboration in a matter other than the request for reexamination.

The common interest among litigation defendants seeking to invalidate a patent does not translate *ipso facto* into each defendant being a real party in interest where a request for reexamination is filed by only one of the defendants in the litigation. This is not to say that the other defendants cannot be real parties in interest in a request for reexamination, but such result cannot merely be based on the concomitant use of common defendant litigation materials in a later request for reexamination. To be required to be named as a real party in interest, a party must participate in some manner in the request for reexamination. Accordingly, a search for prior art, review of possibly useful prior art, preparation of an invalidity defense based on found and evaluated prior art to support a litigation defense, and financial support to carry out a litigation defense do not amount to participation in a request for reexamination based on such activities, where the activities are conducted with only an intent to defend the litigation suit. Evidence that the activities were conducted with an intent to file an *inter partes* reexamination request is required, in order for a petitioner to establish that other defendants are real parties in interest in a request for reexamination

The question of whether a party is a real party in interest must be determined on a case-by-case basis focusing on **the showing** of participation of a party in regard to the filing of a request for reexamination, and not ancillary matters such as being a co-defendant in a litigation. For example, if the Office were to follow petitioner's line of reasoning, a patent owner might challenge an identification of the real party in interest in a reexamination, where a third party requester not involved in the litigation (as to a patent) and even ignorant thereof, was to file a request for reexamination utilizing one or more pieces of prior art employed by unrelated

[9] Petition, page 7.
[10] MPEP § 2612.

defendants in the separate litigation. The third party requester could be placed in a position of having to prove a negative – that it did not participate in the litigation. Similarly, here, the co-defendants need not prove a negative – that they did not participate in the reexamination. The fact that a first party participated in a joint defense, or utilized the same counsel, and a second party later filed a request for reexamination, should not doom the first party to life as a real party in interest for any request for reexamination that may be later filed by another defendant in the joint litigation defense or who utilized joint counsel. Rather, the burden is on the challenging patent owner to provide evidence of participation.

It may be that a particular defendant has decided to proceed with a request for reexamination in the face of hostile opposition by one or more other defendants (who would rather settle the matter in court, than before the Office, based on the nature of their case) who should therefore not be embraced as a real party in interest in the request for reexamination. To do so, would result in estoppel against parties who had no control over the request for reexamination, particularly as in the instant case where the requester acknowledges that not all the prior art identified in the litigation forms the basis of the instant request for reexamination.[11] None-the-less, according to petitioner's theory that the co-defendants must be deemed to be real parties in interest, the other defendants in the litigation would be barred (under 35 U.S.C. § 317(a)) from raising the other prior art that they may feel is better in a subsequent request for reexamination after the first request has been ordered.

In deciding a petition for vacatur, the Office will not engage in conjecture as to the participation in the request for reexamination of any particular alleged unnamed real party in interest. It is incumbent upon petitioner to present objective evidence that a party not identified as a real party in interest in fact participated in the request for reexamination.

A. The Identification Of The Real Party In Interest Is Not Facially Inaccurate Or Ambiguous. Therefore, The Office Lacks The Authority And The Tools To Question That Identification.

The arguments presented in the petition for reconsideration fail to establish that the Office has the authority to question the accuracy of a third party requester's facially accurate and unambiguous identification of the real party in interest in this *inter partes* reexamination proceeding, or the tools to competently conduct an investigation of the matter.

To the extent that patent owner argues that the Office has the ability to investigate the accuracy of the identification of the real party in interest in an *inter partes* reexamination proceeding, or to issue a Show Cause Order requiring the identified real party in interest to confirm that it, and it alone, is the real party in interest,

[11] August 19, 2009 revised request for reexamination, pages 205-6.

patent owner does not make a persuasive case that the Office is required to do so by either the reexamination statute or the reexamination regulations, when the *inter partes* reexamination as filed, or as subsequently corrected by the requester, contains an unambiguous identification of the identity of the real party in interest.

Patent owner's argument is not persuasive, because it does not reflect the intent of the provisions of 37 CFR 1.915(b)(7) and (b)(8). A certification statement made pursuant to 37 CFR 1.915(b)(7) is a statement by the third party requester to the effect that the third party requester is not itself estopped by the statutory estoppel provisions from filing a request for *inter partes* reexamination of a given patent. The *inter partes* rule making at 65 Fed. Reg. 76756, 76759 (Dec. 7, 2000), provides that:

> It should be noted that the Office generally will not have a need to resolve the factual issue of whether or not one party is a privy of another party. Section 1.915(b)(7) requires a third party requester to certify that the estoppel provisions of §1.907 do not prohibit the filing of the *inter partes* reexamination request, and the Office does not intend to look beyond this required certification. It is only in the rare instance where a challenge to the accuracy of the certification is raised by the patent owner, that the question would then need to be addressed.

A substantially identical statement also appears at 65 Fed. Reg. 76756, 76764. These statements establish that the Office will, in the rare instance that it is necessary to do so, "address" the accuracy of a certification that statutory estoppel does not bar the filing of a request for *inter partes* reexamination. However, the rule making does not discuss the type or depth of investigation that can and will be undertaken, and it does not state or imply that a patent owner may trigger an investigation of the accuracy of the certification merely by advancing an unsupported allegation that the third party requester is estopped from filing a request for *inter partes* reexamination.

This is not an instance where the identification of the real party in interest required by 37 CFR 1.915(b)(8) is ambiguous or facially inaccurate, in which instance the third party requester who is before the Office can be queried by the Office, because the record is not clear at that point in time (*i.e.*, the ambiguity causes an issue that is ripe for consideration). Since the present record in the instant reexamination proceeding is not ambiguous as to the identification of the real party in interest (and patent owner has provided no persuasive extrinsic evidence to establish ambiguity), there is no basis to proceed any further in this proceeding as to the matter. Likewise, this is not an instance where all co-defendants have been shown to appear to rely on the request for reexamination as a basis for a joint motion to stay the litigation, where a third party requester who is before the Office can be queried by the Office, to provide an explanation.

Aside from the above, a second reexamination proceeding that would be the subject of the above-cited paragraph of the rule making notice has not yet been filed, nor has a final decision issued in the litigation; thus the issue is not ripe for consideration (see discussion in part B. below). If the issue whether a second reexamination does become ripe for consideration via a second reexamination

proceeding filed by a second requester (who is one of the co-defendants), the Office can then query an *ambiguous or facially inaccurate* 37 CFR 1.915(b)(7) certification statement. The second third party requester making such statement would then be a party appearing before the Office. In other words, a second co-defendant, i.e., the second third party requester, would then be available to be asked by the Office to clarify or support a 37 CFR 1.915(b)(7) certification statement that is ambiguous or facially inaccurate. Presumably, that third party requester would be able to respond based on facts wholly within its knowledge and possession. The Office would be able to obtain information from the patent owner and the second third party requester, and would have no need to obtain information from a party not before the Office by reason of the filing of a first request for *inter partes* reexamination.

Aside from the inherent ability of the Office to issue an Order to Show Cause directed to a party that is before the Office, patent owner does not point to any regulation that would provide a mechanism for conducting an investigation directed to determining whether parties not before the Office are in fact real parties in interest in an *inter partes* reexamination proceeding. For example, 37 CFR 1.105 was promulgated pursuant to 35 U.S.C. §§ 131 and 132, statutes that relate to the examination of applications and (via incorporation by the reexamination statute) the conduct of reexamination proceedings as to patentability. The regulation was promulgated for the purpose of requiring submission of information material to patentability from persons having a duty under 37 CFR 1.56 to disclose information to the Office that is material to patentability.[12] The identification of the real party in interest has no relationship to the duty to disclose information that is material to patentability (which applies to an applicant for patent and to a patent owner in a reexamination proceeding).[13] With respect to obtaining information from a party who is alleged to be an undisclosed real party in interest in an *inter partes* reexamination proceeding, it is not apparent, how 37 CFR 1.105 could be applied to a party who is not before the Office in that proceeding.

Therefore, where a patent owner who is a party in an *inter partes* reexamination proceeding believes that an identification of the real party in interest is inaccurate, even though it is facially unambiguous, the courts are the appropriate venue from which the patent owner should seek relief to obtain evidence extrinsic to the record, for incorporation into the record. It is to be noted that there is precedent on the issue of "real party in interest" in the federal courts, on matters ranging from jurisdiction (*e.g.*, presence of diversity or amount of suit)[14] to actions in which the principle is applied to prevent multiple or conflicting lawsuits by persons such as assignees.[15] These examples of court proceedings resolving "real party in interest" issues demonstrate the reason why the Office cannot perform such a function here. Upon obtaining jurisdiction over the parties, courts may order discovery, taking of

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[12] 65 Fed. Reg. 54604, 54633, (Sept. 8, 2000.)

[13] 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.

[14] *Varlotta Construction Corporation v. Carla Development Corporation*, 886 F. Supp 315 (E.D.N.Y. 1995)

[15] *First Hartford Corporation Pension Plan & Trust v. United States*, 194 F.3d 1279 (Fed. Cir. 1999)

testimony with cross examination and use of other evidentiary tools, while enforcing compliance with its requirements via its subpoena power and power to impose sanctions. Accordingly, the courts are the forums best equipped to determine who is, and who is not, the "real party in interest" when there is a reason to doubt the third party requester's identification of a party or parties as being the real party in interest in an *inter partes* reexamination proceeding. Further, courts may provide relief, as appropriate, by enjoining the filing of a further *inter partes* reexamination request by the other parties in a civil action. Even if an *inter partes* reexamination request was filed by one of the other parties in the civil action who is barred from requesting *inter partes* reexamination by statutory estoppel, a court could always enjoin participation by that requester in the proceeding and essentially turn the proceeding into an *ex parte* reexamination proceeding, the filing of which does not require identification of "a real party in interest" (35 U.S.C §§ 301 and 302), and is not prohibited by statute or rule, even after an *inter partes* reexamination was filed by the same real party in interest.[16]

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. The Office may consider that it is "the sole agency that administers the patent statute,"[17] and the Office certainly conducts the *inter partes* proceeding; however, it is common knowledge that the federal courts (which are not an agency in the sense used in the *inter partes* reexamination rule making) routinely adjudicate matters arising under the patent statute. Further, patent owner should appreciate the difference between conducting a reexamination proceeding, which is the province of the Office, and enforcing an estoppel provision of Federal law as a matter of equitable relief. Patent owner has not provided any basis for believing that the district courts lack authority to act as described above.

As a final point in this section of the decision as to the Office lacking the authority to investigate:

The reexamination statute requires, *inter alia*, that a request for *inter partes* reexamination proceeding "shall ... include the identity of the real party in interest... ."[18] The *inter partes* reexamination rules require that a request for *inter partes*

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[16] 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.

[17] 65 Fed. Reg. 76756, 76759 (Dec. 7, 2000), emphasis added.

[18] 35 U.S.C. § 311(b)(1).

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."[19] Requester has clearly stated that MMC is the real party in interest, and that is an identification to a sufficient extent that "a subsequent person filing an *inter partes* reexamination request" can look into its interaction with the identified MMC to "determine whether that person is a privy" with the real party in interest that filed the present reexamination. Neither the *inter partes* reexamination statute nor the *inter partes* reexamination rules imposes a duty on the Office to investigate the accuracy of an unambiguous identification of the real party in interest in a third party requester's request for *inter partes* reexamination proceeding.

In the present *inter partes* reexamination proceeding, the real party in interest is unambiguously identified in the current record. The identification of the real party in interest does not appear to be facially inaccurate. The Office will refuse to accord a filing date to a request for *inter partes* reexamination that does not identify the real party in interest, or which provides an identification of the real party in interest that is ambiguous or facially inaccurate. If the Office accords a filing date to a request for *inter partes* reexamination, and later discovers an ambiguity or a facial inaccuracy in the identification of the real party in interest, the Office can, and will, require that a party appearing before it as third party requester in an *inter partes* reexamination proceeding clarify the ambiguity or facial inaccuracy. 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 instant reexamination proceeding, because there is no legal reason to do so, even if the Office's ability to do so could be shown (which it has not been, as discussed above).

B. The Office Has No *Present* Duty To Investigate The Identity Of The Real Party In Interest In The Instant *Inter Partes* Reexamination Proceeding.

It is also to be noted that, in the instant reexamination proceeding, patent owner is requesting relief based upon an injury that has not yet occurred, and may never occur, even according to patent owner's view of the situation. Patent owner does not allege that the named real party in interest is itself estopped from filing and participating in the instant reexamination proceeding. Rather, patent owner's concern must be that patent owner might be harassed by the filing of a subsequent request for *inter partes* reexamination of the patent or maintaining the instant reexamination by a party that should have been identified as a real party in interest in the instant reexamination proceeding, but was not so identified. Such a hypothetical party, as a real party in interest in the instant reexamination proceeding, would be subject to a statutory estoppel that could preclude (if the statutory provisions are satisfied) its filing of another *inter partes* reexamination

[19] 37 CFR 1.915(b)(8).

proceeding, or from maintaining the instant reexamination proceeding if such a party "loses" as a defendant in any litigation of the patent. While a patent owner is statutorily entitled to be protected from harassment by the filing of a subsequent request for *inter partes* reexamination of the patent by a party who is estopped from filing such a request, the record simply does not show that such a circumstance presently exists as to the instant reexamination proceeding. No additional requests for *inter partes* reexamination of the patent have been filed by any of MMC's co-defendants nor is the only identified litigation (as to the patent) final. Thus, 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 patent. Accordingly, there is no need to consider addressing the relief requested by patent owner in the present *inter partes* reexamination proceeding, since patent owner cannot have been injured by the filing of another request for *inter partes* reexamination for the patent or by maintaining a reexamination that is barred by statutory estoppel.

C. Synopsis

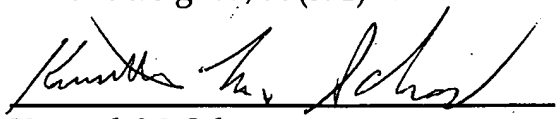
Rather than having presented clear and undisputed evidence establishing that MMC is not the only real party in interest in the instant reexamination proceeding, the petition is supported only by supposition and conjecture on patent owner's part. Accordingly, patent owner has not demonstrated a persuasive basis for the requested relief of vacatur of the filing date of the instant reexamination proceeding. Therefore, such request for relief is dismissed.

CONCLUSION

1. The November 23, 2009 patent owner renewed petition is dismissed.

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

3. Telephone inquiries related to this decision should be directed to Hiram H. Bernstein, Senior Legal Advisor, at (571) 272-7707, or, in his absence, to the undersigned, at (571) 272-7710.



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

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APPENDIX OF RELEVANT STATUTORY, REGULATORY AND PRACTICE PROVISIONS

35 U.S.C. §§ 311(a) and (b) provide:

(a)IN GENERAL.– Any third-party requester at any time may file a request for inter partes reexamination by the Office of a patent on the basis of any prior art cited under the provisions of section 301.
(b) REQUIREMENTS.– The request shall–
(1) be in writing, include the identity of the real party in interest, and be accompanied by payment of an inter partes reexamination fee established by the Director under section 41; and
(2) set forth the pertinency and manner of applying cited prior art to every claim for which reexamination is requested.

35 U.S.C. § 315(c) provides:

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

35 U.S.C. § 317 provides:

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

newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the inter partes reexamination proceedings.

37 CFR 1.105 provides:

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

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

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

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

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

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

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

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

(viii) *Technical information* known to applicant.

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

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

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

manner, for example:

(i) A requirement for factual information;

(ii) Interrogatories in the form of specific questions seeking applicant's factual knowledge; or

(iii) Stipulations as to facts with which the applicant may agree or disagree.

(4) Any reply to a requirement for information pursuant to this section that states either that the information required to be submitted is unknown to or is not readily available to the party or parties from which it was requested may be accepted as a complete reply.
(b)The requirement for information of paragraph (a)(1) of this section may be included in an Office action, or sent separately.
(c) A reply, or a failure to reply, to a requirement for information under this section will be governed
by §§ 1.135 and 1.136.

37 CFR 1.907 provides:

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

37 CFR 1.913 provides:

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

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

(b) A request for *inter partes* reexamination must include the following parts:
(7) A certification by the third party requester that the estoppel provisions of § 1.907 do not prohibit the inter partes reexamination.
(8) A statement identifying the real party in interest to the extent necessary for a subsequent person filing an *inter partes* reexamination request to determine whether that person is a privy.

...

(d) If *the inter partes* request does not include the fee for requesting *inter partes* reexamination required by paragraph (a) of this section and meet all the requirements of paragraph (b) of this section, then the person identified as requesting *inter partes* reexamination will be so notified and will generally be given an opportunity to complete the request within a specified time. Failure to comply with the notice will result in the *inter partes* reexamination request not being granted a filing date, and will result in placement of the request in the patent file as a citation if it complies with the requirements of § 1.501.

37 CFR 1.919(a) provides:

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

MPEP § 2612 provides, in part:

37 CFR 1.907 defines specific situations where a third party is prohibited from filing a request for an inter partes reexamination. 37 CFR 1.915(b)(7) requires the third party requester to certify that the estoppel provisions of 37 CFR 1.907 do not prohibit the filing of the inter partes reexamination request by the real party in interest (note that it is the real party in interest that is subject to the estoppel provisions and not the party who actually files the request). The certification identified in 37 CFR 1.915(b)(7) will constitute a prima facie showing that the party requesting the inter partes reexamination is not barred from doing so under 37 CFR 1.907. The Office does not intend to look beyond this required certification. It is only in the rare instance where a challenge to the accuracy of the certification is raised by the patent owner, that the question would then need to be addressed. A challenge to the accuracy of the certification must facially establish that the third party requesting the inter partes reexamination is barred from doing so under 37 CFR 1.907. Thus, for example, the challenger cannot rely on an argument that the third party requesting reexamination was, at one point, involved with a party barred under 37 CFR 1.907, and should thus be considered as a real party in interest (and barred from filing the request). Involvement *per se* does not facially establish that the other party is a real party in interest. The fact that a second party may benefit from an earlier reexamination request filed by a first party or a civil action conducted by the first party, or that the second party may have collaborated with the first party in a matter, does not facially evidence the second party was a real party in interest with the first party. With respect to the Office conducting an investigation to uncover whether the second party was a "real party in interest," the statute does not require, nor does it provide the tools, for the Office to investigate such matter. Further, Congress has not provided the Office with subpoena power or discovery tools and has not provided the Office with the ability to conduct hearings for eliciting testimony and cross-examination. The Office has not been authorized to impose punitive sanctions for non-compliance. Such evidentiary tools are, however, available to the courts, which

are the appropriate vehicle to make a factual investigation as to the accuracy of the identification of a "real party in interest."

MPEP § 2614 provides, in part:

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,207	08/19/2009	7072190	36856.1759	6970

24197 7590 06/21/2010

KLARQUIST SPARKMAN, LLP
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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/21/2010

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.
95/001,207	08/19/09	7072190	36856.1759

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ART UNIT	PAPER
3992	

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JUN 21 2010

CENTRAL REEXAMINATION UNIT

INTER PARTES REEXAMINATION COMMUNICATION

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

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

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CENTRAL REEXAMINATION UNIT

In re Schlecht, et al :
Reexamination Proceeding : DECISION
Control No.: 95/001,207 : DISMISSIING
Filed: August 19, 2009 : PETITION
For: U.S. Patent No.: 7,072,190 :
Title: High Efficiency Power Converter :

This is a decision on a November 23, 2009 patent owner § 1.182 "Petition to Vacate Filing Date of *Inter Partes* Reexamination Request and The Order Granting *Inter Partes* Reexamination."

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

The petition is dismissed.

FEES

The § 1.182 petition fee of $400.00 fee (as set forth in 37 CFR 1.17(f)) has been paid as indicated in Office PALM records.

BACKGROUND

1. U.S. Patent No. 7,072,190 (the '190 patent) was issued on July 4, 2006.

2. On July 14, 2009, a request for *inter partes* reexamination of the '190 patent was filed by requester Murata Manufacturing Co., Ltd. (MMC) who was also identified as the real party in interest.[1] The request was assigned reexamination control No. 95/001,207 (the '1,207 reexamination proceeding). The request

[1] At page 1, paragraph 2b. of the "Request for *Inter Partes* Reexamination Transmittal Form," MMC was identified as the "real party in interest," pursuant to 37 CFR 1.915(b)(8) and 35 U.S.C. § 311(b).

noted copending litigation of *SynQor, Inc. v. Artesyn Technologies, Inc. et al.*

3. On August 19, 2009, a revised request for *inter partes* reexamination was filed naming the same real party in interest, MMC, and the proceeding was assigned a filing date of August 19, 2009.

4. On November 13, 2009, the Office issued an Order Granting Request for *Inter Partes* Reexamination for the'1,207 reexamination proceeding.

5. On November 23, 2009, patent owner filed the instant petition under 37 CFR 1.182 to vacate the filing date of the present reexamination proceeding and the Order Granting *Inter Partes* Reexamination. An opposition to the instant petition under 37 CFR 1.182 has not been filed by the requester.

PETITION FOR VACATUR

Petitioner (Patent Owner) asserts that the real party in interest was not properly identified in the request for reexamination as required by 35 U.S.C. § 311(b). Petitioner notes that the Office will not permit the use of a "straw man" or "shill" to file an *inter partes* reexamination request so as to shield a real party in interest from the estoppel provisions, such as in 35 U.S.C. § 315(c) and 35 U.S.C. § 317(b), *e.g.*, barring a real party in interest in a first *inter partes* reexamination from filing a second request for *inter partes* reexamination (after order of the first reexamination) or maintaining an *inter partes* reexamination upon final decision in a civil action (to which the real party in interest was a party) that does not sustain the invalidity of any patent claim.[2]

Petitioner claims that all the defendants to a patent infringement suit based on the '190 patent being reexamined are real parties in interest to the instant '1,207 reexamination proceedings; yet, they have not been identified as such. The reexamination request only identifies one of the defendants in the infringement suit as the real party in interest in filing the request for reexamination, thereby shielding the rest of the defendants in the suit from the estoppel provisions of the reexamination statute. Patent owner petitioner's basis for alleging a failure to identify all the real parties in interest in filing the request for reexamination lies in (1) the art presented by the defendants in the infringement suit as an invalidity defense is also being used as a basis for the reexamination request, which most, if not all, of the defendants in the litigation collaborated in identifying,[3] (2) the existence of a joint defense group by some of the defendants in the suit, and (3) the use of joint defense counsel in the suit by some of the defendants.[4]

Petitioner highlights the following statement in the reexamination request [5] to

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[2] Petition at page 2, citing Decision Vacating Filing Date in 95/001,045, decision copy supplied as part of Exhibit A.
[3] Petition at page 9.
[4] Petition at page 3.
[5] August 19, 2009 revised request for reexamination, pages 205-6.

establish that the prior art used by the requester in the request for reexamination was not by happenstance duplicative of some of the art used by defendants in the litigation:

> It is noted that Invalidity Contentions have been filed in the above-identified litigation citing numerous prior art references. In order to simplify this Request and to avoid undue burden on the U.S. Patent Office, this Request cites only some of the prior art references submitted in the Invalidity Contentions.

It is therefore argued that, based on the combined set of invalidity contentions for the litigation having been used as the input for the request for reexamination, as admitted in the request for reexamination, all defendants in the litigation are required to be named as real parties in interest in the request for reexamination.

To permit the instant reexamination to go forward without all of the defendants in the infringement litigation being named as real parties in interest in the request for reexamiantion is asserted to thwart the goals of the statutory estoppel provisions. Any of the defendants in the litigation, other than the single defendant named as the real party in interest in the reexamination, could then initiate a subsequent *inter partes* request or argue invalidity of any confirmed claims in the litigation using the same art of record.[6]

Petitioner reminds the Office that it has identified the following actions that, if attributable to a particular party, would require that party to be identified as a real party in interest: [7]

> 1. Accept payment from another group, pay the requester to file the request for *inter partes* reexamination, and have itself named solely as the real party in interest.
>
> 2. Obtain money for foundation grants, file a "*quid pro quo*" request for an *inter partes* reexamination where the foundation wants reexamination on a specific patent that the foundation deems anti-competitive, and name itself solely as real party in interest.
>
> 3. Allow another party to direct or control the content (*e.g.*, provide the prior patents/printed publications on which the reexam is to be based) of the request whether such is termed "technical review" or some other phase.

Petitioner believes that itemized items 1 and 3 would be applicable in this instance. [8] The first item is asserted to be implicated if the joint defense group allocates fee payments, work load, etc between defendants. The third item is asserted to be implicated if the joint defense group prepares a common pool of prior art, but then provides that information to another entity (*e.g.*, another defendant or another law

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[6] Petition at page 6.
[7] *Id.*
[8] Petition at page 6.

firm). The gravamen of petitioner's contentions is that the litigation defendants (paid for) and created a combined set of invalidity contentions that was also used as the input for the reexamination request. Petitioner further speculates that: "Of course, if any of the other defendants provided a 'technical review' of the request [for reexamination] prior to filing, even silence may constitute a form of direction or control)," that would also require their identification as a real party in interest.[9]

DECISION

The MPEP [10] makes clear that the Office does not intend to look beyond the required certification in the request for reexamination, except for the rare instance where a challenge to the sufficiency of the certification facially establishes that the identified real party in interest is not accurate. The certification cannot be successfully challenged merely because, at one point, the certified real party in interest was "involved" with another (barred) party, or there was some collaboration in a matter other than the request for reexamination.

The common interest among litigation defendants seeking to invalidate a patent does not translate *ipso facto* into each defendant being a real party in interest where a request for reexamination is filed by only one of the defendants in the litigation. This is not to say that the other defendants cannot be real parties in interest in a request for reexamination, but such result cannot merely be based on the concomitant use of common defendant litigation materials in a later request for reexamination. To be required to be named as a real party in interest, a party must participate in some manner in the request for reexamination. Accordingly, a search for prior art, review of possibly useful prior art, preparation of an invalidity defense based on found and evaluated prior art to support a litigation defense, and financial support to carry out a litigation defense do not amount to participation in a request for reexamination based on such activities, where the activities are conducted with only an intent to defend the litigation suit. Evidence that the activities were conducted with an intent to file an *inter partes* reexamination request is required, in order for a petitioner to establish that other defendants are real parties in interest in a request for reexamination

The question of whether a party is a real party in interest must be determined on a case-by-case basis focusing on **the showing** of participation of a party in regard to the filing of a request for reexamination, and not ancillary matters such as being a co-defendant in a litigation. For example, if the Office were to follow petitioner's line of reasoning, a patent owner might challenge an identification of the real party in interest in a reexamination, where a third party requester not involved in the litigation (as to a patent) and even ignorant thereof, was to file a request for reexamination utilizing one or more pieces of prior art employed by unrelated defendants in the separate litigation. The third party requester could be placed in a position of having to prove a negative - that it did not participate in the litigation.

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[9] Petition bridge of pages 6 and 7.
[10] MPEP § 2612.

Similarly, here, the co-defendants need not prove a negative - that they did not participate in the reexamination. The fact that a first party participated in a joint defense, or utilized the same counsel, and a second party later filed a request for reexamination, should not doom the first party to life as a real party in interest for any request for reexamination that may be later filed by another defendant in the joint litigation defense or who utilized joint counsel. Rather, the burden is on the challenging patent owner to provide evidence of participation.

It may be that a particular defendant has decided to proceed with a request for reexamination in the face of hostile opposition by one or more other defendants (who would rather settle the matter in court, than before the Office, based on the nature of their case) who should therefore not be embraced as a real party in interest in the request for reexamination. To do so, would result in estoppel against parties who had no control over the request for reexamination, particularly as in the instant case where the requester acknowledges that not all the prior art identified in the litigation forms the basis of the instant request for reexamination.[11] None-the-less, according to petitioner's theory that the co-defendants must be deemed to be real parties in interest, the other defendants in the litigation would be barred (under 35 U.S.C. § 317(a)) from raising the other prior art that they may feel is better in a subsequent request for reexamination after the first request has been ordered.

In deciding a petition for vacatur, the Office will not engage in conjecture as to the participation in the request for reexamination of any particular alleged unnamed real party in interest. It is incumbent upon petitioner to present objective evidence that a party not identified as a real party in interest in fact participated in the request for reexamination.

A. The Identification Of The Real Party In Interest Is Not Facially Inaccurate Or Ambiguous. Therefore, The Office Lacks The Authority And The Tools To Question That Identification.

The arguments presented in the petition for reconsideration fail to establish that the Office has the authority to question the accuracy of a third party requester's facially accurate and unambiguous identification of the real party in interest in this *inter partes* reexamination proceeding, or the tools to competently conduct an investigation of the matter.

To the extent that patent owner argues that the Office has the ability to investigate the accuracy of the identification of the real party in interest in an *inter partes* reexamination proceeding, or to issue a Show Cause Order requiring the identified real party in interest to confirm that it, and it alone, is the real party in interest, patent owner does not make a persuasive case that the Office is required to do so by either the reexamination statute or the reexamination regulations, when the *inter*

[11] August 19, 2009 revised request for reexamination, pages 205-6.

partes reexamination as filed, or as subsequently corrected by the requester, contains an unambiguous identification of the identity of the real party in interest.

Patent owner's argument is not persuasive, because it does not reflect the intent of the provisions of 37 CFR 1.915(b)(7) and (b)(8). A certification statement made pursuant to 37 CFR 1.915(b)(7) is a statement by the third party requester to the effect that the third party requester is not itself estopped by the statutory estoppel provisions from filing a request for *inter partes* reexamination of a given patent. The *inter partes* rule making at 65 Fed. Reg. 76756, 76759 (Dec. 7, 2000), provides that:

> It should be noted that the Office generally will not have a need to resolve the factual issue of whether or not one party is a privy of another party. Section 1.915(b)(7) requires a third party requester to certify that the estoppel provisions of §1.907 do not prohibit the filing of the *inter partes* reexamination request, and the Office does not intend to look beyond this required certification. It is only in the rare instance where a challenge to the accuracy of the certification is raised by the patent owner, that the question would then need to be addressed.

A substantially identical statement also appears at 65 Fed. Reg. 76756, 76764. These statements establish that the Office will, in the rare instance that it is necessary to do so, "address" the accuracy of a certification that statutory estoppel does not bar the filing of a request for *inter partes* reexamination. However, the rule making does not discuss the type or depth of investigation that can and will be undertaken, and it does not state or imply that a patent owner may trigger an investigation of the accuracy of the certification merely by advancing an unsupported allegation that the third party requester is estopped from filing a request for *inter partes* reexamination.

This is not an instance where the identification of the real party in interest required by 37 CFR 1.915(b)(8) is ambiguous or facially inaccurate, in which instance the third party requester who is before the Office can be queried by the Office, because the record is not clear at that point in time (*i.e.*, the ambiguity causes an issue that is ripe for consideration). Since the present record in the instant reexamination proceeding is not ambiguous as to the identification of the real party in interest (and patent owner has provided no persuasive extrinsic evidence to establish ambiguity), there is no basis to proceed any further in this proceeding as to the matter. Likewise, this is not an instance where all co-defendants have been shown to appear to rely on the request for reexamination as a basis for a joint motion to stay the litigation, where a third party requester who is before the Office can be queried by the Office, to provide an explanation.

Aside from the above, a second reexamination proceeding that would be the subject of the above-cited paragraph of the rule making notice has not yet been filed, nor has a final decision issued in the litigation; thus the issue is not ripe for consideration (see discussion in part B. below). If the issue whether a second reexamination does become ripe for consideration via a second reexamination proceeding filed by a second requester (who is one of the co-defendants), the Office can then query an *ambiguous or facially inaccurate* 37 CFR 1.915(b)(7) certification

statement. The second third party requester making such statement would then be a party appearing before the Office. In other words, a second co-defendant, i.e., the second third party requester, would then be available to be asked by the Office to clarify or support a 37 CFR 1.915(b)(7) certification statement that is ambiguous or facially inaccurate. Presumably, that third party requester would be able to respond based on facts wholly within its knowledge and possession. The Office would be able to obtain information from the patent owner and the second third party requester, and would have no need to obtain information from a party not before the Office by reason of the filing of a first request for *inter partes* reexamination.

Aside from the inherent ability of the Office to issue an Order to Show Cause directed to a party that is before the Office, patent owner does not point to any regulation that would provide a mechanism for conducting an investigation directed to determining whether parties not before the Office are in fact real parties in interest in an *inter partes* reexamination proceeding. For example, 37 CFR 1.105 was promulgated pursuant to 35 U.S.C. §§ 131 and 132, statutes that relate to the examination of applications and (via incorporation by the reexamination statute) the conduct of reexamination proceedings as to patentability. The regulation was promulgated for the purpose of requiring submission of information material to patentability from persons having a duty under 37 CFR 1.56 to disclose information to the Office that is material to patentability.[12] The identification of the real party in interest has no relationship to the duty to disclose information that is material to patentability (which applies to an applicant for patent and to a patent owner in a reexamination proceeding). [13] With respect to obtaining information from a party who is alleged to be an undisclosed real party in interest in an *inter partes* reexamination proceeding, it is not apparent, how 37 CFR 1.105 could be applied to a party who is not before the Office in that proceeding.

Therefore, where a patent owner who is a party in an *inter partes* reexamination proceeding believes that an identification of the real party in interest is inaccurate, even though it is facially unambiguous, the courts are the appropriate venue from which the patent owner should seek relief to obtain evidence extrinsic to the record, for incorporation into the record. It is to be noted that there is precedent on the issue of "real party in interest" in the federal courts, on matters ranging from jurisdiction (*e.g.*, presence of diversity or amount of suit) [14] to actions in which the principle is applied to prevent multiple or conflicting lawsuits by persons such as assignees. [15] These examples of court proceedings resolving "real party in interest" issues demonstrate the reason why the Office cannot perform such a function here. Upon obtaining jurisdiction over the parties, courts may order discovery, taking of testimony with cross examination and use of other evidentiary tools, while enforcing compliance with its requirements via its subpoena power and power to

[12] 65 Fed. Reg. 54604, 54633, (Sept. 8, 2000.)

[13] 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.

[14] *Varlotta Construction Corporation v. Carla Development Corporation*, 886 F. Supp 315 (E.D.N.Y. 1995)

[15] *First Hartford Corporation Pension Plan & Trust v. United States*, 194 F.3d 1279 (Fed. Cir. 1999)

impose sanctions. Accordingly, the courts are the forums best equipped to determine who is, and who is not, the "real party in interest" when there is a reason to doubt the third party requester's identification of a party or parties as being the real party in interest in an *inter partes* reexamination proceeding. Further, courts may provide relief, as appropriate, by enjoining the filing of a further *inter partes* reexamination request by the other parties in a civil action. Even if an *inter partes* reexamination request was filed by one of the other parties in the civil action who is barred from requesting *inter partes* reexamination by statutory estoppel, a court could always enjoin participation by that requester in the proceeding and essentially turn the proceeding into an *ex parte* reexamination proceeding, the filing of which does not require identification of "a real party in interest" (35 U.S.C §§ 301 and 302), and is not prohibited by statute or rule, even after an *inter partes* reexamination was filed by the same real party in interest. [16]

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. The Office may consider that it is "the sole agency that administers the patent statute,"[17] and the Office certainly conducts the *inter partes* proceeding; however, it is common knowledge that the federal courts (which are not an agency in the sense used in the *inter partes* reexamination rule making) routinely adjudicate matters arising under the patent statute. Further, patent owner should appreciate the difference between conducting a reexamination proceeding, which is the province of the Office, and enforcing an estoppel provision of Federal law as a matter of equitable relief. Patent owner has not provided any basis for believing that the district courts lack authority to act as described above.

As a final point in this section of the decision as to the Office lacking the authority to investigate:

The reexamination statute requires, *inter alia*, that a request for *inter partes* reexamination proceeding "shall ... include the identity of the real party in interest... ." [18] 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

[16] 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.
[17] 65 Fed. Reg. 76756, 76759 (Dec. 7, 2000), emphasis added.
[18] 35 U.S.C. § 311(b)(1).

request to determine whether that person is a privy." [19] Requester has clearly stated that MMC is the real party in interest, and that is an identification to a sufficient extent that "a subsequent person filing an *inter partes* reexamination request" can look into its interaction with the identified MMC to "determine whether that person is a privy" with the real party in interest that filed the present reexamination. Neither the *inter partes* reexamination statute nor the *inter partes* reexamination rules imposes a duty on the Office to investigate the accuracy of an unambiguous identification of the real party in interest in a third party requester's request for *inter partes* reexamination proceeding.

In the present *inter partes* reexamination proceeding, the real party in interest is unambiguously identified in the current record. The identification of the real party in interest does not appear to be facially inaccurate. The Office will refuse to accord a filing date to a request for *inter partes* reexamination that does not identify the real party in interest, or which provides an identification of the real party in interest that is ambiguous or facially inaccurate. If the Office accords a filing date to a request for *inter partes* reexamination, and later discovers an ambiguity or a facial inaccuracy in the identification of the real party in interest, the Office can, and will, require that a party appearing before it as third party requester in an *inter partes* reexamination proceeding clarify the ambiguity or facial inaccuracy. 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 instant reexamination proceeding, because there is no legal reason to do so, even if the Office's ability to do so could be shown (which it has not been, as discussed above).

B. The Office Has No *Present* Duty To Investigate The Identity Of The Real Party In Interest In The Instant *Inter Partes* Reexamination Proceeding.

It is also to be noted that, in the instant reexamination proceeding, patent owner is requesting relief based upon an injury that has not yet occurred, and may never occur, even according to patent owner's view of the situation. Patent owner does not allege that the named real party in interest is itself estopped from filing and participating in the instant reexamination proceeding. Rather, patent owner's concern must be that patent owner might be harassed by the filing of a subsequent request for *inter partes* reexamination of the patent or maintaining the instant reexamination by a party that should have been identified as a real party in interest in the instant reexamination proceeding, but was not so identified. Such a hypothetical party, as a real party in interest in the instant reexamination proceeding, would be subject to a statutory estoppel that could preclude (if the statutory provisions are satisfied) its filing of another *inter partes* reexamination proceeding, or from maintaining the instant reexamination proceeding if such a party "loses" as a defendant in any litigation of the patent. While a patent owner is

[19] 37 CFR 1.915(b)(8).

statutorily entitled to be protected from harassment by the filing of a subsequent request for *inter partes* reexamination of the patent by a party who is estopped from filing such a request, the record simply does not show that such a circumstance presently exists as to the instant reexamination proceeding. No additional requests for *inter partes* reexamination of the patent have been filed by any of MMC's co-defendants nor is the only identified litigation (as to the patent) final. Thus, 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 patent. Accordingly, there is no need to consider addressing the relief requested by patent owner in the present *inter partes* reexamination proceeding, since patent owner cannot have been injured by the filing of another request for *inter partes* reexamination for the patent or by maintaining a reexamination that is barred by statutory estoppel.

C. Synopsis

Rather than having presented clear and undisputed evidence establishing that MMC is not the only real party in interest in the instant reexamination proceeding, the petition is supported only by supposition and conjecture on patent owner's part. Accordingly, patent owner has not demonstrated a persuasive basis for the requested relief of vacatur of the filing date of the instant reexamination proceeding. Therefore, such request for relief is dismissed.

CONCLUSION

1. The November 23, 2009 patent owner renewed petition is dismissed.

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

3. Telephone inquiries related to this decision should be directed to Hiram H. Bernstein, Senior Legal Advisor, at (571) 272-7707, or, in his absence, to the undersigned, at (571) 272-7710.

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

6-21-10
Kenpet8

APPENDIX OF RELEVANT STATUTORY, REGULATORY AND PRACTICE PROVISIONS

35 U.S.C. §§ 311(a) and (b) provide:

(a)IN GENERAL.– Any third-party requester at any time may file a request for inter partes reexamination by the Office of a patent on the basis of any prior art cited under the provisions of section 301.
(b) REQUIREMENTS.– The request shall–
(1) be in writing, include the identity of the real party in interest, and be accompanied by payment of an inter partes reexamination fee established by the Director under section 41; and
(2) set forth the pertinency and manner of applying cited prior art to every claim for which reexamination is requested.

35 U.S.C. § 315(c) provides:

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

35 U.S.C. § 317 provides:

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

newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the inter partes reexamination proceedings.

37 CFR 1.105 provides:

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

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

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

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

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

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

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

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

(viii) *Technical information* known to applicant.

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

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

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

manner, for example:

(i) A requirement for factual information;

(ii) Interrogatories in the form of specific questions seeking applicant's factual knowledge; or

(iii) Stipulations as to facts with which the applicant may agree or disagree.

(4) Any reply to a requirement for information pursuant to this section that states either that the information required to be submitted is unknown to or is not readily available to the party or parties from which it was requested may be accepted as a complete reply.
(b)The requirement for information of paragraph (a)(1) of this section may be included in an Office action, or sent separately.
(c) A reply, or a failure to reply, to a requirement for information under this section will be governed
by §§ 1.135 and 1.136.

37 CFR 1.907 provides:

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

37 CFR 1.913 provides:

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

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

(b) A request for *inter partes* reexamination must include the following parts:
(7) A certification by the third party requester that the estoppel provisions of § 1.907 do not prohibit the inter partes reexamination.
(8) A statement identifying the real party in interest to the extent necessary for a subsequent person filing an *inter partes* reexamination request to determine whether that person is a privy.

...

(d) If *the inter partes* request does not include the fee for requesting *inter partes* reexamination required by paragraph (a) of this section and meet all the requirements of paragraph (b) of this section, then the person identified as requesting *inter partes* reexamination will be so notified and will generally be given an opportunity to complete the request within a specified time. Failure to comply with the notice will result in the *inter partes* reexamination request not being granted a filing date, and will result in placement of the request in the patent file as a citation if it complies with the requirements of § 1.501.

37 CFR 1.919(a) provides:

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

MPEP § 2612 provides, in part:

37 CFR 1.907 defines specific situations where a third party is prohibited from filing a request for an inter partes reexamination. 37 CFR 1.915(b)(7) requires the third party requester to certify that the estoppel provisions of 37 CFR 1.907 do not prohibit the filing of the inter partes reexamination request by the real party in interest (note that it is the real party in interest that is subject to the estoppel provisions and not the party who actually files the request). The certification identified in 37 CFR 1.915(b)(7) will constitute a prima facie showing that the party requesting the inter partes reexamination is not barred from doing so under 37 CFR 1.907. The Office does not intend to look beyond this required certification. It is only in the rare instance where a challenge to the accuracy of the certification is raised by the patent owner, that the question would then need to be addressed. A challenge to the accuracy of the certification must facially establish that the third party requesting the inter partes reexamination is barred from doing so under 37 CFR 1.907. Thus, for example, the challenger cannot rely on an argument that the third party requesting reexamination was, at one point, involved with a party barred under 37 CFR 1.907, and should thus be considered as a real party in interest (and barred from filing the request). Involvement *per se* does not facially establish that the other party is a real party in interest. The fact that a second party may benefit from an earlier reexamination request filed by a first party or a civil action conducted by the first party, or that the second party may have collaborated with the first party in a matter, does not facially evidence the second party was a real party in interest with the first party. With respect to the Office conducting an investigation to uncover whether the second party was a "real party in interest," the statute does not require, nor does it provide the tools, for the Office to investigate such matter. Further, Congress has not provided the Office with subpoena power or discovery tools and has not provided the Office with the ability to conduct hearings for eliciting testimony and cross-examination. The Office has not been authorized to impose punitive sanctions for non-compliance. Such evidentiary tools are, however, available to the courts, which

are the appropriate vehicle to make a factual investigation as to the accuracy of the identification of a "real party in interest."

MPEP § 2614 provides, in part:

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

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,209	07/16/2009	6795327	075783.0115	9750

7590 11/04/2009

EXAMINER

DANA L. TANGREN
WORKMAN, NYDEGGER & SEELEY
1000 EAGLE GATE TOWER
60 EAST SOUTH TEMPLE
SALT LAKE CITY, UT 84111

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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CENTRAL REEXAMINATION UNIT

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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:

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001209
PATENT NO. : 6795327
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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NOV 04 2009

CENTRAL REEXAMINATION UNIT

DANA L. TANGREN
WORKMAN, NYDEGGER & SEELEY
1000 EAGLE GATE TOWER
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SALT LAKE CITY UT 84111.

(For Patent Owner)

Dr. Gregory J Gonsalves
1629 K Street NW, Suite 300
Washington, DC 20006

(For Patent Owner,
Courtesy Only)

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

(For Third Party Requester)

In re: Deng *et alia*
Inter Partes Reexamination Proceeding
Control No. 95/001,209
Deposited on: 16 July 2009
For: US Patent No. 6,795,327

DECISION
GRANTING-IN-PART
PETITION FOR EXTESNION
OF TIME
37 CFR § 1.956

This is a decision on the 23 October 2009, patent owner "Expedited Request For Extension of Time Under 37 CFR § 1.956," requesting that the time for responding to the non-final Office action mailed 10 September 2009 to be extended by one (1) month.

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

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

Discussion

The Patent Owner requests an extension of time in which to file a response to the non-final Office action was mailed 10 September 2009. The Office action provides two (2) months period for response thereto. The petition requesting a one (1) month extension of time was timely filed on 23 October 2009. The fee was provided in the petition to pay the $200 petition fee pursuant to 37 CFR §1.17 (g).

The request is granted-in-part.

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

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

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

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

37 CFR § 1.33 Correspondence respecting patent applications, reexamination proceedings, and other proceedings (in-part)

...

(c) All notices, official letters, and other communications for the patent owner or owners in a reexamination proceeding will be directed to the correspondence address. Amendments and other papers filed in a reexamination proceeding on behalf of the patent owner must be signed by the patent owner, or if there is more han one owner by all the owners, or by an attorney or agent of record in the patent file, or by a registered attorney or agent not of record who acts in a representative capacity under the provisions of § 1.34. Double correspondence with the patent owner or owners and the patent owner's attorney or agent, or with more than one attorney or agent, will not be undertaken. (emphasis added)

MPEP § 2622 Address of Patent Owner (in-part)

...

If the patent owner desires that a different attorney or agent receive correspondence, then a new power of attorney must be filed. See MPEP § 324 for establishing an assignee's right to take action when submitting a power of attorney.

...

MPEP § 405 Patent Practitioner Not of Record

Papers may be filed in patent applications and reexamination proceedings by registered attorneys or agents not of record under 37 CFR 1.34. Filing of such papers is considered to be a representation that the attorney or agent is authorized to act in a representative capacity on behalf of applicant. However, interviews with a registered attorney or agent not of record will ordinarily be conducted based only on the information and files supplied by the attorney or agent in view of 35 U.S.C. § 122. Interviews may be conducted with a registered practitioner who does not have a copy of the application file, but has proper authority from the applicant or attorney or agent of record in the form of a paper on file in the application. See also MPEP § 713.05. Such a paper may be an "Authorization to Act in a Representative Capacity." Form/PTO/SB/84, "Authorization to Act in a Representative Capacity" is available from the USPTO Internet web site at http://www.uspto.gov/web/forms/sb0084.pdf.

Decision

The patent owner's representative petitions under 37 CFR § 1.956 to extend the period for response by adding one (1) month to the period for response. The decision to extend the

period for response is evaluated based upon a showing of "sufficient cause." There is always the consideration to balance the need for the patent owner to have a fair opportunity to respond to the Office action between the need for special dispatch.

The non-final Office action was mailed 10 September 2009. The patent owner submitted a timely filed the petition on 23 October 2009 with the appropriate fee and certificate of service.

The petition dated 23 October 2009 cites the delay in receipt of the Office action as reason for extending the time for response. The record indicates that the papers were mailed to the address of record which at the time of the mailing of this decision remains the same. Further, since the patent owner was apprised of the filing of the request as indicated by the certificate of service dated 16 July 2009 the patent owner was aware of this proceeding which likewise was mailed to the address of record and had opportunity to request a change of address as needed. Further the petitioner is reminded that pursuant to 37 CFR § 1.33(c) "Double correspondence with the patent owner or owners and the patent owner's attorney or agent, or with more than one attorney or agent, will not be undertaken.." It is not clear if the petitioner, Dr. Gregory J Gonsalves, has standing in the prosecution of this proceeding since there is nothing in the record to indicate such. Pursuant to MPEP § 405, the petition submitted by Dr. Gonsalves is accepted. For the purpose of responding to the instant petition a courtesy copy will be sent to the address of Dr Gonsalves. Future correspondence will be directed to the address of record only.

Additionally the petitioned cited a Chinese holiday lasting seven (7) days as well as the complexity and length of the Office action. On balance, the petitioner has demonstrated "sufficient cause" to support a fourteen (14) day extension of time.

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

Conclusion

1. The patent owner's petition for extension of time in which to file a response to the non-final Office action dated 10 September 2009 is hereby **granted-in-part.**

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

3. The response is extended to **24 November 2009.**

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

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

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

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

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

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

/Mark Reinhart/
for

Gregory Morse,
Director,
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,209	07/16/2009	6795327	075783.0115	9750

7590 04/30/2010

DR. GREGORY J. GONSALVES
1629 K STREET N.W.
SUITE 300
WASHINGTON, DC 20006

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/30/2010

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
BAKER BOTTS L.L.P.
PATENT DEPARTMENT
98 SAN JACINTO BLVD., SUITE 1500
AUSTIN, TX 78701-4039

Date: MAILED

APR 30 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001209
PATENT NO. : 6795327
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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DR. GREGORY J. GONSALVES
1629 K STREET N.W.
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WASHINGTON DC 20006.

(For Patent Owner)

MAILED

APR 30 2010

CENTRAL REEXAMINATION UNIT

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

(For Third Party Requester)

In re: Deng *et alia*
Inter Partes Reexamination Proceeding
Control No. 95/001,209
Deposited on: 16 July 2009
For: US Patent No. 6,795,327

DECISION
GRANTING-IN-PART
PETITION FOR EXTESNION
OF TIME
37 CFR § 1.956

This is a decision on the 19 April 2010, patent owner "Expedited Request For Extension of Time Under 37 CFR § 1.956," requesting that the time for responding to the Action Closing Prosecution mailed 30 March 2010 to be extended by two (2) months.

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

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

Discussion

The Patent Owner requests an extension of time in which to file a response to the Action Closing Prosecution was mailed 30 March 2010. The Office action provides one (1) months period for response thereto. The petition requesting two (2) months extension of time was timely filed on 19 April 2010. The fee was provided in the petition to pay the $200 petition fee pursuant to 37 CFR §1.17 (g).

The request is granted-in-part.

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

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

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

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

> Requests for an extension of time in an inter partes reexamination proceeding will be considered only after the first Office action on the merits in the reexamination is

mailed. Any request for an extension of time filed prior to the first action will be denied.

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

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

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

Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. The reasons must include (A) a statement of what action the patent owner has taken to provide a response, to date as of the date the request for extension is submitted, and (B) why, in spite of the action taken thus far, the requested additional time is needed. The statement of (A) must provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.

Prosecution will be conducted by initially setting a time period of at least 30 days or one month (whichever is longer), see MPEP § 2662. First requests for extensions of these time periods will be granted for sufficient cause, and for a reasonable time specified-usually 1 month. The reasons stated in the request will be evaluated, and the

request will be favorably considered where there is a factual accounting of reasonably diligent behavior by all those responsible for preparing a response or comments within the statutory time period. Second or subsequent requests for extensions of time, or requests for more than one month, will be granted only in extraordinary situations.

...

Decision

The patent owner's representative petitions under 37 CFR § 1.956 to extend the period for response by adding two (2) months to the period for response. The decision to extend the period for response is evaluated based upon a showing of "sufficient cause." There is always the consideration to balance the need for the patent owner to have a fair opportunity to respond to the Office action between the need for special dispatch.

The petitioner notes the length and extensive number of rejections of the Office action. Further the petitioner notes a set of new rejections. While the petitioner could have expected consideration of the many newly added claims following the non-final Office action which certainly one would expect could have resulted in additional rejections. Further it is not clear that the petitioner has fully met the requirements of MPEP 2665 "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." On balance, there is "sufficient cause" to grant the petition-in-part.

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

The time will be extended by one (1) month

Conclusion

1. The patent owner's petition for extension of time in which to file a response to the Action Closing Prosecution dated 30 March 2010 is hereby **granted-in-part.**

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

3. The response is extended to **30 May 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, 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.

5. Telephone inquiries with regard to this decision should be directed to Mark Reinhart, at (571) 272-1611, in the absence of Mark Reinhart calls may be directed to Eric

Keasel, at (571) 272-4929, or Jessica Harrison, at (571) 272-4449, all are Supervisory Patent Examiners in the Central Reexamination Unit, Art Unit 3992.

/Mark Reinhart/

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,210	08/13/2009	7274926	60851-381252	1276

23370 7590 12/23/2009

JOHN S. PRATT, ESQ
KILPATRICK STOCKTON, LLP
1100 PEACHTREE STREET
SUITE 2800
ATLANTA, GA 30309

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 12/23/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
PERKINS COIE LLP
PATENT-SEA
P O BOX 1247
SEATTLE, WA 98111-1247

Date:

MAILED

DEC 23 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001210
PATENT NO. : 7274926
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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United States Patent and Trademark Office
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JOHN S. PRATT, ESQ
KILPATRICK STOCKTON, LLP
1100 PEACHTREE STREET
SUITE 2800
ATLANTA GA 30309

(For Patent Owner)

MAILED

DEC 23 2009

CENTRAL REEXAMINATION UNIT

Chun M Ng
PERKINS COIE LLP
PATENT-SEA
P.O. BOX 1247
SEATTLE, WA 98111-1247

(For Third Party Requester)

In re: Laumen et alia
Inter Partes Reexamination Proceeding
Control No. 95/001,210
Deposited on: 16 July 2009
For: US Patent No. 7,274,926

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

This is a decision on the 18 December 2009, "Petition and Request for Extension of Time Under 37 CFR § 1.956and Payment of Fee Under 37 CFR 1.17(g)" requesting the response period be extended by one-month for the non-Final Office action mailed 17 November 2009, be extended by one (1) month. The petition submitted 18 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 for the reasons set forth below.

DISCUSSION

The Patent Owner's representative requests the period for response be extended by one-month for the non-final Office action mailed 17 November 2009, which set two (2) month's time for filing a response thereto. The petition for extension of time was timely filed on 18 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.

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

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

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

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

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

> Requests for an extension of time in an inter partes reexamination proceeding will be

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

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

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

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

DECISION

The patent owner's representative petitions to extend the period for response by adding one (1) month to the response period under 37 CFR § 1.956. The decision to extend the period for response is evaluated based upon a showing of "sufficient cause." There is always the consideration to balance the need for the patent owner to have a fair opportunity to respond to the Office action between the need for special dispatch.

The non-final Office action was mailed 17 November 2009. The patent owner submitted a

timely filed the petition on 18 December 2009 with the appropriate fee and certificate of service.

The petition dated 18 December 2009 notes several reasons for extension, among them, length of the Office action and time required for a technical expert to provide analysis. On balance, the petitioner has demonstrated "sufficient cause" for the purpose of granting one (1) month extension of time.

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

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

CONCLUSION

1. The patent owner's petition for extension for one (1) month time in which to file a response to the non-final Office action dated 17 November 2009 is hereby **granted.**

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

3. The response is extended to **17 February 2010.**

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

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

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

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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

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.
95/001,211	08/12/2009	7,333,822	60851-381251	1324

23370 7590 12/29/2009

JOHN S. PRATT, ESQ
KILPATRICK STOCKTON, LLP
1100 PEACHTREE STREET
SUITE 2800
ATLANTA, GA 30309

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 12/29/2009

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

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PATENT-SEA
P.O. BOX 1247
SEATTLE, WA 98111-1247

Date:
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DEC 2 9 2009

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001211
PATENT NO. : 7333822
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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JOHN S. PRATT, ESQ
KILPATRICK STOCKTON, LLP
1100 PEACHTREE STREET
SUITE 2800
ATLANTA GA 30309

(For Patent Owner)

MAILED

DEC 29 2009

CENTRAL REEXAMINATION UNIT

Chun M Ng
PERKINS COIE LLP
PATENT-SEA
P.O. BOX 1247
SEATTLE, WA 98111-1247

(For Third Party Requester)

In re: Laumen et alia
Inter Partes Reexamination Proceeding
Control No. 95/001,211
Deposited on: 16 July 2009
For: US Patent No. 7,333,822

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

This is a decision on the 18 December 2009, "Petition and Request for Extension of Time Under 37 CFR § 1.956 and Payment of Fee Under 37 CFR 1.17(g)" requesting the response period be extended by one-month for the non-Final Office action mailed 09 November 2009, be extended by one (1) month. The petition submitted 18 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 for the reasons set forth below.

DISCUSSION

The Patent Owner's representative requests the period for response be extended by one-month for the non-final Office action mailed 09 November 2009, which set two (2) month's time for filing a response thereto. The petition for extension of time was timely filed on 18 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.

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

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

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

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

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

> Requests for an extension of time in an inter partes reexamination proceeding will be

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

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

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

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

DECISION

The patent owner's representative petitions to extend the period for response by adding one (1) month to the response period under 37 CFR § 1.956. The decision to extend the period for response is evaluated based upon a showing of "sufficient cause." There is always the consideration to balance the need for the patent owner to have a fair opportunity to respond to the Office action between the need for special dispatch.

The non-final Office action was mailed 09 November 2009. The patent owner submitted a

timely filed the petition on 18 December 2009 with the appropriate fee and certificate of service.

The petition dated 18 December 2009 notes several reasons for extension, among them, length of the Office action and time required for a technical expert to provide analysis. On balance, the petitioner has demonstrated "sufficient cause" for the purpose of granting one (1) month extension of time.

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

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

CONCLUSION

1. The patent owner's petition for extension for one (1) month time in which to file a response to the non-final Office action dated 09 November 2009 is hereby **granted.**

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

3. The response is extended to **09 February 2010.**

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

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

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

By Hand: Customer Service Window
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Alexandria, VA 22314

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

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

/Mark Reinhart/

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

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UNITED STATES 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.
95/001,219	08/11/2009	6987980	60851-381394	9497

23370 7590 12/11/2009

JOHN S. PRATT, ESQ
KILPATRICK STOCKTON, LLP
1100 PEACHTREE STREET
SUITE 2800
ATLANTA, GA 30309

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 12/11/2009

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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JOHN S. PRATT, ESQ
KILPATRICK STOCKTON, LLP
1100 PEACHTREE STREET SUITE 2800
ATLANTA GA 30309

: (For Patent Owner)

PERIKINS COIE LLP
PATENT – SEA
P O BOX 1247
SEATTLE WA 98111-1247

: (For Third Party Requester)

In re: HANS *et alia*
Inter partes Reexamination Proceeding
Control No. 95/001,219
Deposited: AUGUST 11, 2009
For: U.S. Patent No. 6,987,980

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

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 October 16, 2009 office action is ongoing and patent owner requests additional time to review, prepare , anc consult technical experts. 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 9, 2010.** Responses received on or before January 16, 2010 will be considered timely under 37 CFR 1.7(a).

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

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

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

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

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

Telephone inquiries with regard to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner in the Central Reexamination Unit, Art Unit 3992, at (571) 272-1611, alternatively where Mark Reinhart is unavailable, Eric Keasel, at (571) 272-4929 or Jessica Harrison at (571) 272-4449, Supervisory Patent Examiners, Art Unit 3992, may be contacted.

/J. Harrison/

Jessica J Harrison
SPE AU 3992
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,219	08/11/2009	6987980	60851-381394	9497

23370 7590 12/17/2009

JOHN S. PRATT, ESQ
KILPATRICK STOCKTON, LLP
1100 PEACHTREE STREET
SUITE 2800
ATLANTA, GA 30309

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 12/17/2009

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

Corrected copy.

DEC 17 2009

John S. Pratt, ESQ : (For Patent Owner)
KILPATRIK STOCKTON, LLP :
1100 PEACHTREE STREET SUITE 2900 :
ATLANTA GA 30309

PERKINS COIE LLP : (For Third Party Requester)
PATENT –SEA :
PO BOX 1247 :
SEATTLE WA 98111-1247

In re: HANS : DECISION
Inter partes Reexamination Proceeding : GRANTING PETITION
Control No. 95/001,219 : FOR EXTENSION OF TIME
Deposited: AUGUST 11, 2009 : (37 CFR § 1.956)
For: U.S. Patent No. 6,987,980 :

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 16, 2010.** As January 16, 2010 is a Saturday and Monday January 18, 2020 a Federal Holiday, responses received on or before January 19, 2010 will be considered timely.

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

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

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

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

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

Telephone inquiries with regard to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner in the Central Reexamination Unit, Art Unit 3992, at (571) 272-1611, alternatively where Mark Reinhart is unavailable, Eric Keasel, at (571) 272-4929 or Jessica Harrison at (571) 272-4449, Supervisory Patent Examiners, Art Unit 3992, may be contacted.

/J. Harrison/

Jessica J Harrison
SPE AU 3992
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,220	08/12/2009	7536046	2756-00900	9941

41230 7590 06/30/2010

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/30/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patents and Trademark Office
P.O.Box 1450
Alexandria, VA 22313-1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

PERKINS COIE LLP
POST OFFICE BOX 1208
SEATTLE, WA 98111-1208

Date:

MAILED

JUN 30 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001220
PATENT NO. : 7536046
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

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

(For Patent Owner)

MAILED

JUN 30 2010

CENTRAL REEXAMINATION UNIT

PERKINS COIE LLP
POST OFFICE BOX 1208
SEATTLE, WA 98111-1208

(For Third Party Requester)

In re Raterman et al.
Inter Partes Reexamination Proceeding
Control No.: 95/001,220
Filed: August 12, 2009
For: U.S. Patent No. 7,536,046

DECISION DISMISSING PETITION UNDER 37 CFR 1.183

This is a decision on the November 25, 2009 patent owner petition entitled "REQUEST FOR SUSPENSION OF THE RULES PURSUANT TO 37 CFR SECTION 1.183" as supplemented by the December 28, 2009 patent owner petition entitled "SUPPLEMENT TO REQUEST FOR SUSPENSION OF THE RULES PURSUANT TO 37 C.F.R. SECTION 1.183." Patent owner timely filed a response to the October 26, 2009 non-final Office action concurrently with the supplemental petition.

The petition is before the Office of Patent Legal Administration .

The petition to waive the page limit requirement is dismissed.

FEES

The $400.00 petition fees pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183 and for the supplemental petition under 37 CFR 1.183 have been charged to patent owner's Deposit Account No. 50-4181, respectively, on May 5, 2010 and December 29, 2009.

REVIEW OF FACTS

1. U.S. Patent No. 7,536,046 (the '046 patent) issued on May 19, 2009.

2. A request for reexamination of the '046 patent was filed on August 12, 2009. The request was assigned control No. 95/001,220 (the '1220 reexamination proceeding).

3. Reexamination was ordered for the '1220 proceeding on October 26, 2009.

4. Also on October 26, 2009, a first Office action rejecting claims 1-30, 35-48, and 53-124 was mailed. A shortened statutory period of two months was set for the filing of a response to the Office action. Reexamination was not requested for claims 31-34 and 49-52.

5. On November 25, 2009, the patent owner filed a petition under 37 CFR 1.183 requesting waiver of the 37 CFR 1.943(b) requirement that responses by the patent owner, in an *inter partes* reexamination proceeding, not exceed fifty (50) pages in length.

6. On December 28, 2009, the patent owner filed a supplemental petition under 37 CFR 1.183 requesting waiver of the 37 CFR 1.943(b) requirement that responses by the patent owner not exceed fifty (50) pages in length.

7. Concurrently with its December 28, 2009 supplemental petition, the patent owner timely submitted (1) a response to the October 26, 2009 non-final Office action, and (2) an information disclosure statement. The patent owner response was accompanied by six (6) declarations and eight (8) exhibits, and the information disclosure statement was accompanied by ninety-three (93) non-patent literature (NPL) documents.

8. On January 27, 2010, third party requester timely filed comments pursuant to 37 CFR 1.947 that was accompanied by twenty-five (25) exhibits.

PATENT OWNER'S PETITION UNDER 37 CFR 1.183

In its November 25, 2009 petition under 37 CFR 1.183, as supplemented by the December 28, 2009 petition under 37 CFR 1.183, patent owner requests suspension of 37 CFR 1.943(b) with respect to the 50-page limit for the patent owner response to the October 26, 2009 non-final Office action, and requests that the page limit be extended to 99 pages.[1] In support of its request for waiver of the rule, patent owner asserts that the October 26, 2009 Office action rejects 116 of the 124 claims of the patent at issue, and those rejections incorporate by reference 366 pages of the claim charts (Appendices 3-6) submitted with the request for reexamination.[2] The patent owner also asserts that the 366 pages of the claim charts "refer to declarations of Emery and Dolsen, which in turn refer to a number of additional exhibits and declarations, which is turn refer to still additional exhibits."[3] Further in support of its request for waiver of the 50-page limit of 37 CFR 1.943(b), patent owner asserts in the November 25, 2009 petition that "there exist several substantial issues

[1] Supplemental Petition at page 2.
[2] The November 25, 2009 petition at page 2
[3] Supplemental Petition at page 2.

with respect to the alleged prior art, such as 'enablement' issues regarding some of the exhibits relied upon in those rejections," and "is prepared to show that some of the exhibits are not enabling."[4]

On December 28, 2009, patent owner filed its response to the October 26, 2009 non-final Office action concurrently with the supplemental petition. Patent owner asserts in the supplemental petition at page 1 that the response is "76 pages in length, 36 pages constitute a listing of the claims, and are excluded from the page count under MPEP § 2667." The patent owner states that the response is also accompanied by six declarations and eight numbered exhibits (Exhibits 1-8).[5] Patent owner states that if the "Patent Office concludes that these declarations constitute argument or opinion under MPEP § 2667, then the Patent Owner requests 42 pages for those declarations."[6] Patent owner asserts that the "only argument or opinion included in Exhibits 1-8" is the "21 pages of Exhibit 4."[7] Therefore, patent owner requests 99 pages for "the 36 pages of the Response, the 42 pages of declarations, and the 21 pages of Exhibit 4 that contains arguments or opinions."[8]

DECISION

The petition is dismissed.

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, the petition is incomplete because it refers to exhibits and declarations that are not sufficiently identified in the petition and not sufficiently identified in the patent owner response with which they were submitted. Patent owner's response and information disclosure statement were filed on the same day. Because patent owner failed to properly label which documents submitted on December 28, 2009 were submitted as part of the response, the Office cannot distinguish between some of the non-patent literature documents filed with the information disclosure statement, and the exhibits and declarations filed with the patent owner response.

For example, the patent owner response at page 38 states that "the six declarations submitted herewith, by Messrs. Sherman, DiBlasio, Lopez, Jones, Mennie and Collins, and Exhibits 1-8 submitted herewith, will be referred to and cited," but no further identifying information about these attachments are given in the response. Moreover, patent owner filed multiple documents labeled "Exhibit 1" and multiple Mennie declarations on December 28, 2009. In particular, the following three documents submitted on December 28, 2009 are labeled as "Exhibit 1": an

[4] The November 25, 2009 petition at page 2.
[5] Supplemental petition at pages 1-2.
[6] *Id.*
[7] *Id.* at page 2.
[8] *Id.*

expert report of Stephen G. Emery updated on December 3, 2008, a transcript of a Jury Trial, and Defendant's motion for partial summary judgment of invalidity and no willing infringement. Additionally, the following are examples of Mennie declarations submitted on December 28, 2009: Mennie declaration executed on December 2, 2008, Mennie declaration executed on June 25, 2009, Mennie declaration executed on June 16, 2009, and Mennie declaration executed on December 28, 2009.

Accordingly, due to patent owner's concurrent submission of numerous non-patent literature documents cited in the information disclosure statement and patent owner's failure to properly label and sufficiently identify which of the numerous documents filed on December 28, 2009 are the six declarations and eight exhibits referred to in the response, the Office is not able to determine the effective page length of patent owner's response for purposes of evaluating patent owner's request for waiver of the page limit.

It is apparent from the record that patent owner's response is a *bona fide* attempt to respond and to advance the prosecution. Accordingly, patent owner, **may within 15 days from the date of this decision**, file a renewed petition that sufficiently identifies the declarations and Exhibits 1-8 that accompany the patent owner response (*e.g.*, by title, date, number of pages, etc.) along with a copy of the patent owner response and the accompanying declarations and Exhibits 1-8. Such resubmission of the patent owner response, accompanied by the exhibits and declarations, would be labeled with a new date in the IFW of the present inter partes reexamination proceeding. The sufficient identification regarding the declarations and exhibits accompanying the patent owner response in the renewed petition should enable the Office to determine the effective page length of the patent owner response to the October 26, 2009 non-final Office action for purposes of evaluating patent owner's request for waiver of the page limit.

THIRD PARTY REQUESTER

Unless otherwise informed by third party requester, comment papers filed by third party requester on January 27, 2010 will be ratified as a submission after a copy of patent owner's response (with the accompanying declarations and exhibits) and renewed petition are timely filed in response to this decision, and after a decision on the renewed petition.

APPENDIX

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.

CONCLUSION

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

2. **Patent owner is given a period of fifteen (15) days from the date of this decision to file the following papers: (1) a renewed petition under 37 CFR 1.183 to correct the defects as discussed above and (2) a copy of patent owner response with accompanying declarations and exhibits.**

3. Telephone inquiries with regard to this decision should be directed to Susy Tsang-Foster, Legal Advisor, Office of Patent Legal Administration, at (571) 272-7711.

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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APR 29 2010

CENTRAL REEXAMINATION UNIT

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Inter Partes Reexamination Proceeding
Control No. 95/001,221
Filed: Aug. 12, 2009
For: U.S. Patent No. 7,043,450

Inter Partes Reexamination Proceeding
Control No. 95/001,308
Filed: Feb. 2, 2010
For: U.S. Patent No. 7,043,450

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. 7,043,450 (the '450 patent) issued to Velez et al. with the assignee listed as Paid Search Engine Tools, Inc. on May 9, 2006, with 22 claims.

2. A request for *inter partes* reexamination of claims 1-22 of the '450 patent was filed on Aug. 12, 2009, by a third party requester, and was assigned control number 95/001,221 (the '1221 *inter partes* proceeding). The real party in interest is Yahoo! Inc.

3. On Nov. 5, 2009, *inter partes* reexamination was ordered for claims 1-22 of the '450 patent based on the examiner's determination that the Aug. 12, 2009 request raised a substantial new question of patentability affecting these claims.

4. An Office action was mailed Dec. 18, 2009, in the '1221 proceeding confirming claims 4 and 19 and adopting rejections for claims 1-3, 5-18, and 20-22.

5. On February 18, 2010, patent owner filed a response to the Office action, adding new dependent claims 23-26 while maintaining original patent claims 1-22. The third party requester filed comments on March 22, 2010 on the Office action and patent owner's response.

6. A second request for *inter partes* reexamination of claims 12-20 and 22 of the '450 patent was filed on Feb. 2, 2010, by a third party requester, and was assigned control number 95/001,308 (the '1308 *inter partes* proceeding). The real parties in interest are Microsoft Corp. and Google, Inc.

7. On April 19, 2010, *inter partes* reexamination was ordered for claims 12-20 and 22 of the '450 patent based on the examiner's determination that the Feb. 2, 2010 request raised a substantial new question of patentability affecting these claims. No Office action has been issued in the '1308 proceeding.

8. A concurrent litigation styled *Paid Search Engine Tools, Inc. v. Google, Inc. et al.*, U.S. District Court of Texas, Eastern District, 2:08cv00061 filed Feb. 12, 2008 and consolidated with an earlier litigation involving the '450 patent is presently open.

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. Both proceedings are still pending, and have not been terminated. Therefore, consideration of merger pursuant to 37 CFR 1.989 is ripe at this point in time.

37 CFR 1.989 provides:

> (a) If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is

ordered, the merged examination will normally result in the issuance of a single reexamination certificate under § 1.997.

In accordance with 37 CFR 1.989(a), the 95/001,221 and 95/001,308 proceedings are merged. The merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

Patent owner is required to maintain the same claims (and specification) in both files throughout the merged proceeding. Presently, the '1221 proceeding includes additional dependent claims 23-26. Thus, the claims are not currently the same in both files. An Office action requiring an amendment placing the claims in identical form is being issued concurrently with this decision. Patent owner must respond to the Office action in accordance with the procedures in 37 CFR 1.111. The third party requesters will then have an opportunity to comment on patent owner's response in accordance with the procedures in 37 CFR 1.947.

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. Pursuant to 37 CFR 1.989(a), the merged examination will normally result in the issuance and publication of a single reexamination certificate under 37 CFR 1.997.

It is noted that reexamination was ordered for claims 1-22 of the '450 patent in the '1221 proceeding and for claims 12-20 and 22 of the '450 patent in the '1308 proceeding. The examiner will conduct reexamination in the merged proceeding for claims 1-22 and for the newly added claims 23-26 of the '450 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.

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

C. Amendments:

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

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

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

D. Fees:

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

E. Citation of Patents and Printed Publications:

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

F. Appeal Procedure Reminders for *Inter Partes* Reexamination

The parties are reminded of the procedures for taking appeal in an *inter partes* reexamination as explained in MPEP 2674 and 2675. The appeal must only be taken from (1) the rejection(s) of the claims in the Right of Appeal Notice (RAN) that the *patent owner* proposes to contest, or (2) the finding(s) of patentability of claims in the RAN that the *third party requester* proposes to contest. Therefore, in the notice of appeal, the patent owner must identify each claim rejected by examiner that the patent owner intends to contest and the third party requester must identify each rejection *that was previously proposed by that third party requester* that the third party requester intends to contest. (37 CFR 41.61) The appellant's brief shall present a concise statement of each issue. Further, no new ground of rejection can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the

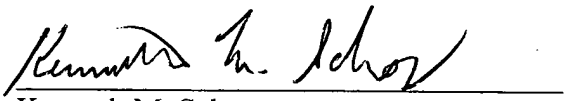
proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection. (37 CFR 41.67(c)(1)(vi))

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/001,221 and *inter partes* Reexamination Control No. 95/001,308 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.

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

April 26, 2010

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

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

(For Patent Owner)

DEC 23 2009
CENTRAL REEXAMINATION UNIT

Sterne, Kessler, Goldstein & Fox P.L.L.C.
1100 New York Avenue, N.W.
Washington, DC 20005

(For Third Party Requester)

In re: Knotts
Inter Partes Reexamination Proceeding
Control No. 95/001,222
Deposited on: 19 August 2009
For: US Patent No. 7,430,425

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

This is a decision on the 17 December 2009, "Petition for One-Month Extension (37 CFR § 1.956: MPEP § 2665)" requesting the response period be extended by one-month for the non-Final Office action mailed 23 October 2009, be extended by one (1) month. The petition submitted 17 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 for the reasons set forth below.

DISCUSSION

The Patent Owner's representative requests the period for response be extended by one-month for the non-final Office action mailed 23 October 2009, which set two (2) month's time for filing a response thereto. The petition for extension of time was timely filed on 17 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.

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

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

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

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

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

> Requests for an extension of time in an inter partes reexamination proceeding will be

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

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

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

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

DECISION

The patent owner's representative petitions to extend the period for response by adding one (1) month to the response period under 37 CFR § 1.956. The decision to extend the period for response is evaluated based upon a showing of "sufficient cause." There is always the consideration to balance the need for the patent owner to have a fair opportunity to respond to the Office action between the need for special dispatch.

The non-final Office action was mailed 23 October 2009. The patent owner submitted a

timely filed the petition on 17 December 2009 with the appropriate fee and certificate of service.

The petition dated 17 December 2009 notes several reasons for extension, among them, the untimely death of the previous patent counsel as well as the necessary papers held by said late counsel. On balance, the petitioner has demonstrated "sufficient cause" for the purpose of granting one (1) month extension of time.

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

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

CONCLUSION

1. The patent owner's petition for extension for one (1) month time in which to file a response to the non-final Office action dated 23 October 2009 is hereby **granted.**

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

3. The response is extended to **23 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

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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NOVAK DRUCE & QUIGG, LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET
FIFTY-THIRD FLOOR
HOUSTON, TX 77002

(For Patent Owner)

MAILED

FEB 22 2010

OFFICE OF PETITIONS

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

(For Requester)

In re Knotts :
Inter Partes Reexamination Proceeding :
Control No. 95/001,222 : DECISION ON PETITION
Deposited: August 19, 2009 :
For: U.S. Patent No. 7,430,425 :
Attorney Docket No. 9369-003 :

This is a decision on the "PETITION TO ACCEPT AN UNINTENTIONALLY DELAYED CLAIM UNDER 37 CFR § 1.78", filed January 25, 2010, to accept an unintentionally delayed claim under 35 U.S.C. 120 and 119(e) for the benefit of the prior-filed nonprovisional applications and provisional application set forth in the concurrently filed amendment.

The petition is **GRANTED IN PART to the extent indicated herein.**

Petitioners are seeking to claim the benefit under 35 U.S.C. 120 and 119(e) of the prior-filed nonprovisional applications and provisional application set forth in the amendment filed January 25, 2010.

As to the request to accept the unintentionally delayed claim under 35 U.S.C. 120 for the benefit of the prior-filed nonprovisional application, the Office notes that a patent owner may correct the failure to adequately claim (in the application for the patent reexamined) benefit under 35 U.S.C. 120 of an earlier filed copending U.S. patent application. For a patent to be reexamined which matured from a utility or plant application filed on or after November 29, 2000, the patent owner must file a grantable petition for an unintentionally delayed priority claim under 37 CFR 1.78(a)(3). MPEP 2258(IV)(E).

Pursuant to 37 CFR 1.78(a)(3):

> If the reference required by 35 U.S.C. 120 and paragraph (a)(2) of this section is presented after the time period provided by paragraph (a)(2)(ii) of this section, the claim under 35 U.S.C. 120, 121, or 365(c) for the benefit of a prior-filed copending nonprovisional application or international application designating the United States of America may be accepted if the reference identifying the prior-filed application by application number or international application number and international filing date was unintentionally delayed. A petition to accept an unintentionally delayed claim under 35 U.S.C. 120, 121, or 365(c) for the benefit of a prior-filed application must be accompanied by:
>
> (i) The reference required by 35 U.S.C. 120 and paragraph (a)(2) of this section to the prior-filed application, unless previously submitted;
>
> (ii) The surcharge set forth in § 1.17(t); and
>
> (iii) A statement that the entire delay between the date the claim was due under paragraph (a)(2)(ii) of this section and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

Upon review, the Office has determined that all of the requirements under 37 CFR 1.78(a)(3) have been satisfied. Accordingly, the delayed claim under 35 U.S.C. 120 for the benefit of the prior-filed nonprovisional applications is accepted as being unintentionally delayed.

As to the request to accept the unintentionally delayed claim under 35 U.S.C. 119(e) for the benefit of the prior-filed provisional application, the Office notes:

> Under no circumstances can a reexamination proceeding be employed to add or correct a benefit claim under 35 U.S.C. 119(e) for a patent matured from a utility or plant application filed on or after November 29, 2000.

Section 4503 of the American Inventor's Protection Act of 1999 (AIPA) amended 35 U.S.C. 119(e)(1) to state that:

> No application shall be entitled to the benefit of an earlier filed provisional application under this subsection unless an amendment containing the specific reference to the earlier filed provisional application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this subsection. The Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed submission of an amendment under this section during the pendency of the application.

35 U.S.C. 119(e)(1), as amended by the AIPA, clearly prohibits the addition or correction of benefit claims under 35 U.S.C. 119(e) when the application is no longer pending, e.g., an issued patent. Therefore, a reexamination is not a valid mechanism for adding or correcting a benefit claim under 35 U.S.C. 119(e) after a patent has been granted (for a patent matured from a utility or plant application filed on or after November 29, 2000).

MPEP 2258(IV)(E).

Nevertheless, the filing of a reissue application is a proper mechanism to add or correct a benefit claim under 35 U.S.C. 119(e) for a patent matured from a utility or plant application filed on or after November 29, 2000. See MPEP 1402.

In this instance, before petitioners are entitled to claim the benefit of the prior-filed provisional application, petitioners must file a reissue application to add or correct the benefit claim under 35 U.S.C. 119(e).

In summary, the petition is granted only as to the acceptance of the unintentionally delayed claim under 35 U.S.C. 120 for the benefit of the prior-filed nonprovisional applications. The petition is dismissed as to the addition or correction of the benefit claim under 35 U.S.C. 119(e) for the prior-filed provisional application.

The granting of the petition to accept the delayed benefit claim to the prior-filed nonprovisional applications under 37 CFR 1.78(a)(3) should not be construed as meaning that this application is entitled to the benefit of the prior-filed applications. In order for this application to be entitled to the benefit of the prior-filed nonprovisional applications, all other requirements under 35 U.S.C. 120 and 37 CFR 1.78(a)(1) and (a)(2) must be met. Similarly, the fact that the corrected Filing Receipt accompanying this decision on petition includes the prior-filed nonprovisional applications should not be construed as meaning that petitioners are entitled to the claim for benefit of priority to the prior-filed nonprovisional applications noted thereon.

Accordingly, the examiner will, in due course, consider this benefit claim and determine whether the nonprovisional applications are entitled to the benefit of the earlier filing date.

A corrected Filing Receipt, which includes the claim under 35 U.S.C. 120 for the benefit of the prior-filed nonprovisional applications, accompanies this decision on petition.

This application is being forwarded to Technology Center Art Unit 3992 for consideration by the examiner of petitioners' entitlement to claim benefit under 35 U.S.C. 120 to the prior-filed non-provisional application.

The $1,410.00 petition fee will be charged to the Deposit Account as authorized.

Any questions concerning this matter may be directed to Christina Tartera Donnell at (571) 272-3211.

Anthony Knight
Supervisor
Office of Petitions

Conferee: Eugenia Jones, Senior Legal Advisor

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NUMBER	FILING or 371(c) DATE	GRP ART UNIT	FIL FEE REC'D	ATTY.DOCKET.NO	TOT CLAIMS	IND CLAIMS
95/001,222	08/19/2009	3992		9369-003		

CONFIRMATION NO. 8884

CORRECTED FILING RECEIPT

37086
NOVAK DRUCE & QUIGG, LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET
FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date Mailed: 02/17/2010

Receipt is acknowledged of this non-provisional patent application. The application will be taken up for examination in due course. Applicant will be notified as to the results of the examination. Any correspondence concerning the application must include the following identification information: the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. **If an error is noted on this Filing Receipt, please submit a written request for a Filing Receipt Correction. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections**

Applicant(s)

7,430,425, Residence Not Provided;
TELECOMMUNICATION SYSTEMS, INC. (OWNER), ANNAPOLIS, MD;
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. (3RD.PTY.REQ.), WASHINGTON, DC;
SYBASE, INC. (REAL.PTY.IN.INTEREST.), Residence Not Provided;
STERNE, KESSLER,GOLDSTEIN & FOX P.L.L.C., WASHINGTON, DC

Assignment For Published Patent Application

TELECOMMUNICATION SYSTEMS, INC., ANNAPOLIS, MD

Power of Attorney: The patent practitioners associated with Customer Number 37086

Domestic Priority data as claimed by applicant

This application is a REX of 11/516,593 09/07/2006 PAT 7,430,425
which is a CON of 11/130,256 05/17/2005 ABN
which is a CON of 10/720,343 11/25/2003 PAT 6,985,748
which is a CON of 09/985,032 11/01/2001 PAT 6,658,260

Foreign Applications

Projected Publication Date: None, application is not eligible for pre-grant publication

Non-Publication Request: No

Early Publication Request: No

Title

Inter-Carrier Digital Message with User Data Payload Service Providing Phone Number Only Experience

Preliminary Class

455

PROTECTING YOUR INVENTION OUTSIDE THE UNITED STATES

Since the rights granted by a U.S. patent extend only throughout the territory of the United States and have no effect in a foreign country, an inventor who wishes patent protection in another country must apply for a patent in a specific country or in regional patent offices. Applicants may wish to consider the filing of an international application under the Patent Cooperation Treaty (PCT). An international (PCT) application generally has the same effect as a regular national patent application in each PCT-member country. The PCT process **simplifies** the filing of patent applications on the same invention in member countries, but **does not result** in a grant of "an international patent" and does not eliminate the need of applicants to file additional documents and fees in countries where patent protection is desired.

Almost every country has its own patent law, and a person desiring a patent in a particular country must make an application for patent in that country in accordance with its particular laws. Since the laws of many countries differ in various respects from the patent law of the United States, applicants are advised to seek guidance from specific foreign countries to ensure that patent rights are not lost prematurely.

Applicants also are advised that in the case of inventions made in the United States, the Director of the USPTO must issue a license before applicants can apply for a patent in a foreign country. The filing of a U.S. patent application serves as a request for a foreign filing license. The application's filing receipt contains further information and guidance as to the status of applicant's license for foreign filing.

Applicants may wish to consult the USPTO booklet, "General Information Concerning Patents" (specifically, the section entitled "Treaties and Foreign Patents") for more information on timeframes and deadlines for filing foreign patent applications. The guide is available either by contacting the USPTO Contact Center at 800-786-9199, or it can be viewed on the USPTO website at http://www.uspto.gov/web/offices/pac/doc/general/index.html.

For information on preventing theft of your intellectual property (patents, trademarks and copyrights), you may wish to consult the U.S. Government website, http://www.stopfakes.gov. Part of a Department of Commerce initiative, this website includes self-help "toolkits" giving innovators guidance on how to protect intellectual property in specific countries such as China, Korea and Mexico. For questions regarding patent enforcement issues, applicants may call the U.S. Government hotline at 1-866-999-HALT (1-866-999-4158).

LICENSE FOR FOREIGN FILING UNDER

Title 35, United States Code, Section 184

Title 37, Code of Federal Regulations, 5.11 & 5.15

GRANTED

The applicant has been granted a license under 35 U.S.C. 184, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" followed by a date appears on this form. Such licenses are issued in all applications where

the conditions for issuance of a license have been met, regardless of whether or not a license may be required as set forth in 37 CFR 5.15. The scope and limitations of this license are set forth in 37 CFR 5.15(a) unless an earlier license has been issued under 37 CFR 5.15(b). The license is subject to revocation upon written notification. The date indicated is the effective date of the license, unless an earlier license of similar scope has been granted under 37 CFR 5.13 or 5.14.

This license is to be retained by the licensee and may be used at any time on or after the effective date thereof unless it is revoked. This license is automatically transferred to any related applications(s) filed under 37 CFR 1.53(d). This license is not retroactive.

The grant of a license does not in any way lessen the responsibility of a licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations especially with respect to certain countries, of other agencies, particularly the Office of Defense Trade Controls, Department of State (with respect to Arms, Munitions and Implements of War (22 CFR 121-128)); the Bureau of Industry and Security, Department of Commerce (15 CFR parts 730-774); the Office of Foreign AssetsControl, Department of Treasury (31 CFR Parts 500+) and the Department of Energy.

NOT GRANTED

No license under 35 U.S.C. 184 has been granted at this time, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" DOES NOT appear on this form. Applicant may still petition for a license under 37 CFR 5.12, if a license is desired before the expiration of 6 months from the filing date of the application. If 6 months has lapsed from the filing date of this application and the licensee has not received any indication of a secrecy order under 35 U.S.C. 181, the licensee may foreign file the application pursuant to 37 CFR 5.15(b).

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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.
95/001,223	09/22/2009	7324833	AFF.0004B2US	1290

21906 7590 06/14/2010

TROP, PRUNER & HU, P.C.
1616 S. VOSS ROAD, SUITE 750
HOUSTON, TX 77057-2631

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/14/2010

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

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Commissioner for Patents
United States Patents and Trademark Office
P.O.Box 1450
Alexandria, VA 22313-1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
KENYON & KENYON LLP
ONE BROADWAY
NEW YORK, NY 10004

Date:

MAILED

JUN 14 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001223
PATENT NO. : 7324833
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,264	11/13/2009	7324833	AFF.0004B5US	6910

21906 7590 06/14/2010

TROP, PRUNER & HU, P.C.
1616 S. VOSS ROAD, SUITE 750
HOUSTON, TX 77057-2631

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/14/2010

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

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Commissioner for Patents
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
NOVAK DRUCE & QUIGG, LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET, FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date:
MAILED

JUN 14 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001264
PATENT NO. : 7324833
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,333	11/07/2008	7324833	AFF.0004B1US	6333

21906 7590 06/14/2010

TROP, PRUNER & HU, P.C.
1616 S. VOSS ROAD, SUITE 750
HOUSTON, TX 77057-2631

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/14/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

Date:
MAILED
JUN 14 2010
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010333
PATENT NO. : 7324833
ART UNIT : 3992

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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JUN 14 2010

CENTRAL REEXAMINATION UNIT

TROP, PRUNER & HU, P.C.
1616 S. VOSS ROAD, SUITE 750
HOUSTON TX 77057-2631

(For Patent Owner)

Kenyon & Kenyon LLP
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(For first *Inter Partes* Requester)

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(For *Ex Parte* Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,223
Filed: September 22, 2009
For: U.S. Patent No. 7,324,833

Inter Partes Reexamination Proceeding
Control No. 95/001,264
Filed: November 13, 2009
For: U.S. Patent No. 7,324,833

Ex Parte Reexamination Proceeding
Control No. 90/010,333
Filed: November 7, 2008
For: U.S. Patent No. 7,324,833

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 (consolidated) at this time.

REVIEW OF RELEVANT FACTS

1. On January 29, 2008, the Office issued U.S. Patent No. 7,324,833 (the '833 patent) issued to White *et al.*

2. On November 7, 2008, a request for *ex parte* reexamination of all the claims in the '833 patent was filed by a third party requester. The request was assigned control number 90/010,333 (the '10333 proceeding).

3. On December 19, 2008, *ex parte* reexamination was ordered on all the claims of the '833 patent in the '10333 proceeding.

4. On August 5, 2009, a non-final Office action was mailed in the '10333 proceeding, rejecting all the claims of the '833 patent.

5. On September 22, 2009, a first request for *inter partes* reexamination of all the claims in the '833 patent was filed by a third party requester and real party in interest, Volkswagen Group of Americas, Inc.. The request was assigned control number 95/001,233 (the '1233 proceeding).

6. On October 2, 2009, patent owner timely filed, in the '10333 proceeding, an amendment and response to the August 5, 2009 Office action, amending claims 1 and 17. No claims were added or canceled.

7. On November 9, 2009, *inter partes* reexamination was ordered in the '1223 proceeding.

8. On November 13, 2009, a second request for *inter partes* reexamination of all the claims in the '833 patent, was filed by a third party requester and real party in interest, Apple, Inc... The request was assigned control number 95/001,264 (the '1264 proceeding).

9. On February 5, 2010, *inter partes* reexamination was ordered in the '1223 proceeding.

10. To date, no Office action has issued in the '1223 *inter partes* proceeding, nor in the '1264 *inter partes* proceeding, and no further Office action has issued in the '10333 *ex parte* reexamination proceeding.

DECISION

I. MERGER OF PROCEEDINGS

Reexamination has been ordered in three proceedings for the same claims of the same patent Two of the proceedings are *inter partes* reexamination proceedings and one is an *ex parte* reexamination proceeding. All proceedings are still pending, and have not been terminated. Therefore, consideration of merger is ripe at this point in time.

The 95/001,080, 95/001,183 *inter partes* proceedings and the 90/010,623 *ex parte* proceedings are merged. The merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

Patent owner is required to maintain the same claims (and specification) in all files throughout the merged proceeding. Amendments to patent claims 1 and 17 have been proposed in the '10333 proceeding, while there is no amendment in either the '1223 and '1264 proceedings. Thus, the claims are not currently the same in all files. An Office action requiring an amendment placing the claims of all the proceedings in identical form is being issued concurrently with this decision. Patent owner must respond to the Office action in accordance with the procedure provided in 37 CFR 1.111. The *inter partes* third party requesters will then have an opportunity to comment on patent owner's response in accordance with the procedures in 37 CFR 1.947.

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 participation by the third party requester of the '10333 *ex parte* reexamination is governed by 37 CFR §§ 1.510 through 1.560.

B. *Inter partes* Third Party Requester Participation:

1. Comment rights:

Upon merger of proceedings both *inter partes* requesters, Apple, Inc and Volkswagen Group of Americas, Inc., can comment pursuant to 35 U.S.C. 314(b)(2).[1] First, an *inter partes* requesters' right to comment is contingent upon the patent owner responding to, or commenting on, an Office action. Second, an *inter partes* requesters' right to comment is 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. Neither *inter partes* requester has a right to comment on any issue raised outside the confines of the statute, e.g. issues raised in a previous Office action (but not raised in the most recent Office action or response) or the request and comments from another requester. Requester comments must be submitted within the statutory time period of 30 days from date of service of patent owner's response.

[1] 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.

2. Appeal Rights:

The *inter partes* reexamination procedures for taking appeal, and for participating in the patent owner's appeal, are explained in MPEP 2674 through 2675.02, 2678 through 2683. As pointed out in MPEP 2674:

> A notice of appeal by a third party requester must identify each rejection *that was previously proposed by that third party requester* which the third party requester intends to contest. It is not sufficient to merely appeal from the allowance of a claim (i.e., the examiner's finding of a claim patentable); the third party requester must identify each previously proposed rejection to be contested.

Thus, each *inter partes* reexamination requester's appeal must **only** be taken from the finding(s) of patentability of claims in the RAN that the individual third party requester proposed in the request, and any that the individual third party requester properly added during the examination stage of the merged proceeding. Also, as provided by 37 CFR 41.67(c)(1)(vi):

> No new ground of rejection can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection.

Thus, the appellant's brief shall present a concise statement of each issue. And, no new ground of rejection (i.e., a ground that the individual requester did not propose) can be proposed by a third party requester appellant, unless that ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester did not yet have an opportunity to propose it as a third party requester proposed ground of rejection.

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 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 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 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. 95/001,223 and 95/001,264 and *ex parte* Reexamination Control No. 90/010,333 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above in Part III of this decision.

2. Jurisdiction over the merged reexamination files is being forwarded to the Central Reexamination Unit (CRU).

3. 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.

4. Any questions concerning this communication should be directed to Joseph F. Weiss, Jr., Legal Advisor, at 571-272-7759.

Kenneth M. Schor

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

5-13-10

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.
95/001,224	10/22/2009	7283340	29268-0013	1988

44564 7590 04/21/2010

BOND, SCHOENECK & KING, PLLC
10 BROWN ROAD, SUITE 201
ITHACA, NY 14850-1248

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/21/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patents and Trademark Office
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Alexandria, VA 22313-1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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999 PEACHTREE STREET NE
ATLANTA, GA 30309-3996

Date:

MAILED

APR 2 1 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001224
PATENT NO. : 7283340
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
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(Patent Owner)

MAILED

APR 2 1 2010

CENTRAL REEXAMINATION UNIT

Sutherland, Asbill & Brennan, LLP
999 Peachtree Street, NE
Atlanta, GA 30309-3996

(Third Party Requester)

Patentee: Finlay, Sr. *et al.*
Inter partes Reexamination
Control No. 95/001,224
Filed: October 22, 2009
For: U.S. Patent No. 7,283,340

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

This is a decision on the January 7, 2010 patent owner paper entitled "PETITION TO SUSPEND *INTER PARTES* REEXAMINATION PROCEEDING CONTROL NO. 95/001,224 UNDER 37 C.F.R. §§ 1.182 AND 1.987." On February 6, 2010, third party requester filed an opposition to patent owner's January 7, 2010 petition entitled "THIRD PARTY REQUESTER'S RESPONSE TO PATENT OWNER'S PETITION TO SUSPEND *INTER PARTES* REEXAMINATION PROCEEDING CONTROL NO. 95/001,224," which is also addressed by this decision.

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

The patent owner petition requesting suspension of the instant reexamination proceeding is dismissed for the reasons set forth below.

FEES

The fee set forth in 37 CFR 1.17(f) for the patent owner petition is $400, and was charged to patent owner's Deposit Account No. 50-1546 on January 8, 2010 pursuant to the authorization for same in patent owner's EFS-WEB fee transmittal.

The third party requester opposition is being taken as a petition under 37 CFR 1.182. The fee set forth in 37 CFR 1.17(f) for this petition is $400 was charged to requester's deposit account No. 19-5029 on February 8, 2010, pursuant to the authorization for same in third party requester's EFS-WEB fee transmittal.

BACKGROUND

1. On August 16, 2007 Pass & Seymour, Inc. ("P&S") initiated at the U.S. International Trade Commission ("ITC") litigation styled as, *In the Matter of Certain Ground Fault Circuit Interrupters and Products Containing the Same*, Inv. No. 337-TA-615, against General Protecht Group, Inc. ("GPG") and several other ground fault circuit interrupter ("GFCI") manufacturers including Shanghai Meihao Electric, Inc. ("Meihao"), Wenzhou Trimone Company ("Trimone"), and Shanghai ELE Manufacturing Corporation ("ELE"), for patent infringement of a family of related U.S. Patents, Nos. 5,594,398, RE38,293, 7,154,718, 7,164,564, 7,212,386, and 7,256,973.

2. Concurrently on August 16, 2007, "P&S" filed a complaint for patent infringement against "GPG" in U.S. District Court for the Northern District of New York ("NDNY") styled as, *Pass & Seymour, Inc. v. General Protecht Group, Inc. et al.*, Civil Action No. 5:07-cv-00833.

3. On October 16, 2007 the Office issued U.S. Patent No. 7,283,340 (the '340 patent) to Finlay, Sr. *et al.*, which is a member of the family of U.S. patents P&S is asserting in the concurrent District Court and ITC proceedings. The '340 patent is currently assigned to P & S.

4. On October 22, 2007, the NDNY District Court issued a stay of the civil action for patent infringement pending resolution of the related ITC proceeding.

5. On December 13, 2007, P&S filed an amended complaint adding the '340 patent to the ITC proceeding. A copy of the Amended Complaint of P&S under Section 337 of the Tariff Act of 1930 is attached as Exhibit 1 of patent owner's January 7, 2010 petition.

6. On September 24, 2008, the presiding administrative law judge ("ALJ") issued an Initial Determination ("ID") in the ITC Proceeding. The ALJ found that the asserted claims of the '340 patent (claims 14, 18, and 30) were not invalid and that GPG's 2003 and 2006 GFCIs infringed claims 14 and 18 of the'340 patent. The ALJ also found that GFCIs manufactured by co-respondents Trimone, Meihao, and ELE infringed claims 14 and 18 of the '340 patent. A copy of the Public Version of the ID is attached as Exhibit 2 of patent owner's January 7, 2010 petition.

7. On March 9, 2009, the ITC Commission issued a Commission Opinion/Final Determination affirming the ALJ's ruling that all asserted claims (claims 14, 18, and 30) of the '340 patent were not invalid. A copy of the Public Version of the Commission Opinion dated March 26, 2009 is attached as Exhibit 3 of patent owner's January 7, 2010 petition.

8. In June 2009, co-respondents Trimone, GPG, and ELE each filed an appeal to the U.S. Court of Appeals for the Federal Circuit seeking review of the Commission's Final Determination. The three appeals have been consolidated. The Federal Circuit appeal is styled *General Protecht Group, Inc. and Wenzhou Trimone Science & Technology Electric Co., Ltd., and Shanghai ELE Manufacturing Corporation. v. International Trade Commission and Pass & Seymour, Inc.*, Appeal Nos. 2009-1378, -1387,-1434 (hereafter "the appeal"). The appeal challenges, *inter alia*, the Commission's claim construction of claims 14 and 18 of the '340

patent and the Commission's determination of validity of claims 14 and 18. A copy of the Statement of the Issues to be Presented for Review, filed by GPG on July 27, 2009 is attached as Exhibit 4 of patent owner's January 7, 2010 petition.

9. On October 22, 2009, GPG, as the third party requester and real party in interest, filed a request for *inter partes* reexamination of the '340 patent, on claims 14-18, 21-24 and 28-29. The request was assigned Reexamination Control No. 95/001,224 (the '1224 proceeding).

10. On October 29, 2009, GPG filed an Appellant Brief with the Court of Appeals for the Federal Circuit, which *inter alia* asserts that claims 14 and 18 are invalid as anticipated by U.S. Patent No. 6,246,558 (the '558 patent) to DiSalvo. The '558 patent was also cited in GPG's October 22, 2009 request for reexamination of the '340 patent. A copy of GPG's Appellant Brief is attached as Exhibit 6 of patent owner's January 7, 2010 petition.

11. On November 19, 2009, the Office issued an order granting reexamination in the '1224 proceeding, finding that a substantial new question of patentability was raised by the third party's request for reexamination, citing prior art submitted by the third party requester that was not submitted in the ITC proceeding. An Office action of the merits did not accompany the order, and the order stated that an Office action on the merits would issue in due course.

12. On January 7, 2010, the patent owner filed a petition entitled "PETITION TO SUSPEND *INTER PARTES* REEXAMINATION PROCEEDING CONTROL NO. 95/001,224 UNDER 37 C.F.R. §§ 1.182 AND 1.987" requesting suspension of the '1224 proceeding.

13. On February 6, 2010, the third party requester filed an opposition to patent owner's January 7, 2010 petition to suspend entitled, "THIRD PARTY REQUESTER'S RESPONSE TO PATENT OWNER'S PETITION TO SUSPEND *INTER PARTES* REEXAMINATION PROCEEDING CONTROL NO. 95/001,224".

14. As of the date of this decision no Office action on the merits has issued in the '1224 proceeding.

RELEVANT STATUTES, REGULATIONS, AND EXAMINING PROCEDURE

35 U.S.C. § 314(c) states:

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

35 U.S.C. § 317(b) states:

> FINAL DECISION.— Once a final decision has been entered against a party **in a civil action arising in whole or in part under section 1338 of title 28**, that the party has not sustained its burden of proving the invalidity of any patent claim in suit or if final decision in an inter partes reexamination proceeding instituted by a third-party requester is favorable to the patentability of any original or proposed amended or new claim of the

patent, then neither that party nor its privies may thereafter request an inter partes reexamination of any such patent claim on the basis of issues which that party or its privies raised or could have raised in such civil action or inter partes reexamination proceeding, and an inter partes reexamination requested by that party or its privies on the basis of such issues may not thereafter be maintained by the Office, notwithstanding any other provision of this chapter. This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the inter partes reexamination proceedings. [Emphasis Added]

37 CFR 1.182 states:

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

37 CFR 1.183 states:

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

37 CFR 1.907(b) states:

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

37 CFR 1.935 states:

The order for *inter partes* reexamination will usually be accompanied by the initial Office action on the merits of the reexamination.

37 CFR 1.937(a) states:

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

37 CFR 1.939 states:

> (a) If an unauthorized paper is filed by any party at any time during the *inter partes* reexamination proceeding it will not be considered and may be returned.
>
> (b) Unless otherwise authorized, no paper shall be filed prior to the initial Office action on the merits of the *inter partes* reexamination.

37 CFR 1.987 states:

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

The Manual of Patent Examining Procedure (MPEP), Section 2686.04, subsection V, states (in part):

> The statute thus authorizes the Director of the USPTO to suspend (stay) reexamination proceedings, where there is good cause to do so, pending the conclusion of litigation based on a potential for termination of a reexamination prosecution under 35 U.S.C. 317(b). Thus, a District Court decision that is pending appeal on the validity of the same claims considered in an *inter partes* reexamination proceeding may provide the requisite statutory "good cause" for suspension, due to the real possibility that the 35 U.S.C. 317(b) estoppel may attach in the near future to bar/terminate the reexamination proceeding. Any such fact situation is resolved on a case-by-case basis.
>
> In any *inter partes* reexamination where the requester (or its privies) is also a party to ongoing or concluded litigation as to the patent for which reexamination has been requested, the potential for this statutory estoppel to attach must be considered.

DECISION

I. Preliminary Matter: Waiver of 37 CFR 1.939

As noted above in paragraph 12, an *inter partes* request for reexamination of the '340 patent was filed on October 22, 2009, and was granted on November 19, 2009 without the concurrent issuance of an initial Office action. The language of 37 CFR 1.935 makes the concurrent sending of an Office action on the merits permissive. As noted above in paragraph 14, the Examiner of record has not issued an Office action on the merits. In accordance with 37 CFR 1.939(a) unauthorized papers will not be considered in *inter partes* reexamination. Furthermore, 37 CFR 1.939(b) does not permit the filing of any papers prior to the filing of the first office action on the merits. Therefore, both Patent Owner's petition dated January 7, 2010 and Requester's opposition dated February 6, 2010 are not authorized. However, based upon the unique facts and circumstances of the present proceeding, in the interests of justice and special dispatch, to the extent necessary 37 CFR 1.939 is waived.

II. DECISION DISMISSING PATENT OWNER PETITION UNDER 37 CFR 1.182

A. Patent Owner Petition Requesting Suspension of the Present Proceeding

The pending appeal to the Federal Circuit was filed by GPG along with co-respondents Trimone and ELE seeking review of the Commission's Final Determination. Pet. at page 2. The appeal challenges, *inter alia*, the ITC Commission's claim construction of claims 14 and 18 of the '340 patent and the Commission's determination of validity of claims 14 and 18 of the '340 patent.[1] Patent owner petitioner requests that the present *inter partes* reexamination proceeding be suspended in view of the concurrent litigation at the Federal Circuit. Pet. Sec. III at pages 4-5. Patent owner asserts that good cause exists for the USPTO to suspend the instant *inter partes* reexamination proceeding based on common issues involved in the more advanced Federal Circuit appeal. Pet. at page 5. Specifically, patent owner argues that the issue of construction and validity of claims 14 and 18 of the '340 patent are common to both the instant *inter partes* reexamination proceeding and the concurrent litigation at the Federal Circuit that is well under way and can be best decided at the Federal Circuit. Pet. at page 5. Patent owner further argues that overlapping validity issues exist since the claims at issue in the instant reexamination proceeding, other than claims 14 and 18, share common claim terms with claims 14 and 18, and at least one prior art reference is being relied on in both the Federal Circuit appeal and the instant reexamination proceeding. Pet. at pages 5. Patent owner believes that the Federal Circuit decision regarding the litigated claims (claims 14 and 18) will necessarily cast light on the appropriate disposition of the other claims in the instant reexamination proceeding. Pet. at page 5 f.n.4.

B. Analysis and Findings

35 U.S.C. § 314(c) authorizes the Director of the USPTO to suspend (stay) reexamination proceedings, where there is good cause to do so, pending the conclusion of litigation based on a potential for termination of a reexamination prosecution under 35 U.S.C. § 317(b). In this instance, the ITC proceeding is not an action arising under 28 U.S.C. § 1338, which gives the district courts the original jurisdiction.[2] Thus, a finding by the ITC has no bearing on the third party requester's submission of the present *inter partes* reexamination - the estoppel provisions of 35 U.S.C. § 317(b) do not attach to the present *inter partes* reexamination proceedings. The ITC's holding of validity for claims 14 and 18, even if upheld by the Federal Circuit, is not a final decision within the meaning of 35 U.S.C. § 317(b) because the litigation did not arise under 28 USC § 1338. Because there is no potential termination of the '1224 reexamination proceeding under 35 U.S.C. § 317(b), good cause does not exist to suspend the instant reexamination proceeding.

In response to patent owner's argument that overlapping validity issues exist between the instant proceeding and the appeal, the issuance of the Federal Circuit decision **upholding validity** of claims 14 and 18 will have no binding effect on prosecution in the instant reexamination

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[1] See Statement of the Issues to be Presented for Review, and Appellant Brief submitted to the CAFC by GPG, and attached as Exhibits 4 and 6 to the present patent owner petition filed on July 27, 2009 and October 29, 2009 respectively.

[2] An ITC action arises under 19 U.S.C. § 1337.

proceeding because the estoppel provisions of 35 U.S.C. § 317(b) do not attach for the reasons given above. Furthermore, the Court noted in *Ethicon v. Quigg*, 849 F.2d 1422, 1428, 7 USPQ2d 1152, 1157 (Fed. Cir. 1988) that the District Courts and the Office use different standards of proof in determining invalidity, on the same evidence, and thus could quite correctly reach different conclusions. Specifically, invalidity in a District Court must be shown by "clear and convincing" evidence (based on a presumption of validity of a patent, 35 U.S.C. § 282), whereas in the Office, only a showing of non-patentability by a "preponderance" of the evidence is needed. An ITC's determination of patent invalidity is made with the same "clear and convincing" evidence standard.[3] As the "clear and convincing" standard is harder to satisfy than the "preponderance standard," a court's holding of patent validity is not controlling. Deference will, however, ordinarily be accorded to the factual findings of the court, where the evidence before the Office and the court is the same. If sufficient reasons are present, claims held valid by the court may be rejected in reexamination.

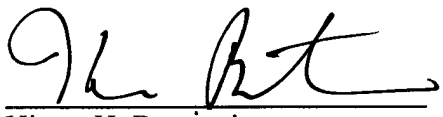
Therefore, continuing the instant *inter partes* reexamination proceeding is not barred by statute, and there is public interest in resolving the substantial new question of patentability (SNQ) raised in this reexamination proceeding with special dispatch. Accordingly, good cause does not exist to suspend the instant *inter partes* reexamination proceeding.

CONCLUSION

1. The January 7, 2010 patent owner petition requesting suspension of the instant reexamination proceeding is dismissed.

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



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

[3] See Exhibit 2 of patent owner's January 7, 2010 petition, page 35 of the ITC's September 24, 2008 Initial Determination ("ID") citing "clear and convincing" evidence as the standard of proof to overcome the presumption of validity when asserting the affirmative defense of patent invalidity.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,224	10/22/2009	7283340	29268-0013	1988

44564 7590 06/10/2010

BOND, SCHOENECK & KING, PLLC
10 BROWN ROAD, SUITE 201
ITHACA, NY 14850-1248

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/10/2010

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

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/001,224	10/22/09	7283340	29268-0013

MALVERN U. GRIFFIN III
SUTHERLAND, ASBILL & BRENNAN, LLP
999 PEACHTREE STREET, NE
ATLANTA, GA 30309

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

DATE MAILED:

06/10/10

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.
95/001,224	10/22/09	7283340	29268-0013

EXAMINER
NGUYEN, LINH

ART UNIT	PAPER
3992	

MALVERN U. GRIFFIN III
SUTHERLAND, ASBILL & BRENNAN, LLP
999 PEACHTREE STREET, NE
ATLANTA, GA 30309

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(For patent owner)

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Suite 1100
Washington, DC 20005

(For the '477 requester)

Malvern U. Griffin III
Sutherland, Asbill & Brennan, LLP
999 Peachtree Street, NE
Atlanta, Georgia 30309

(For the '1224 requester)

MAILED

JUN 10 2010

CENTRAL REEXAMINATION UNIT

In re Finlay, Sr. *et al.*
Inter Partes Reexamination
Control No. 95/000,477
Filed: June 16, 2009
For: U.S. Patent No. 7,283,340

In re Finlay, Sr. *et al.*
Inter Partes Reexamination Proceeding
Control No. 95/001,224
Filed: October 22, 2009
For: U.S. Patent No. 7,283,340

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

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

REVIEW OF FACTS

1. On October 16, 2007 the Office issued U.S. Patent No. 7,283,340 (the '340 patent) to Finlay, Sr. *et al.*

2. On June 16, 2009, a first request for *inter partes* reexamination of claims 1, 8-9, 11-16, 18, 21-24, 28-29, and 36 of the '340 patent, assigned control No. 95/000,477 ("the '477

proceeding"), was filed by a third party requester on behalf of real party in interest Shanghai Meihao Electric, Inc. ("the '477 requester").[1]

3. On July 24, 2009, *inter partes* reexamination was ordered for claims 1, 8-9, 11-16, 18, 21-24, 28-29 and 36 of the '340 patent in the '477 proceeding based upon the examiner's determination that the June 19, 2009 request raised substantial new questions of patentability. An Office action was not concurrently issued. The order indicated that an Office action would issue in due course.

4. On October 22, 2009, a second request for *inter partes* reexamination of claims 14-16, 18, 21-24, and 28-29 of the '340 patent, assigned control No. 95/001,224 ("the '1224 proceeding"), was filed by a third party requester on behalf of real party in interest General Protecht Group, Inc. ("the '1224 requester").[2]

5. On November 19, 2009, *inter partes* reexamination was ordered for claims 14-16, 18, 21-24, and 28-29 of the '340 patent in the '1224 proceeding based upon the examiner's determination that the October 22, 2009 request raised substantial new questions of patentability. An Office action was not concurrently issued. The order indicated that an Office action would issue in due course.

6. On November 20, 2009, the Office issued a non-final Office action in the '477 proceeding rejecting claims 1, 8-9, 11-16, 18, 21-24, 28-29 and 36 of the '340 patent.

7. To date, no Office action has issued in the '1224 *inter partes* proceeding.

8. On March 30, 2010, patent owner timely filed responsive comments to the November 20, 2009 Office action in the '477 proceeding.[3] The response did not include an amendment to the specification or the claims.

DECISION

I. MERGER OF PROCEEDINGS

Under 37 CFR 1.989(a):

> If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination

---

[1] Requester initially deposited a non-compliant request for reexamination on May 21, 2009, failing to secure a filing date. On June 16, 2009 requester perfected the initial request with a supplemental submission, securing the filing date of June 16, 2009.

[2] Requester initially deposited a non-compliant request for reexamination on August 21, 2009, failing to secure a filing date. On October 22, 2009 requester perfected the initial requester with a supplemental submission, securing the filing date of October 22, 2009.

[3] Patent owner comments are timely. Patent owner originally filed responsive comments to the '477 proceeding on January 20, 2010. The January 20, 2010 comments were expunged from the record by an Office decision issued on March 16, 2010 in the '477 proceeding. The March 16, 2010 Office decision gave patent owner fifteen days to refile redacted or redrafted comments responsive to the November 20, 2009 Office action.

> proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the merged examination will normally result in the issuance and publication of a single reexamination certificate under § 1.997.

As evidenced by the above review of facts, both the '477 and '1224 reexamination proceedings are currently pending. The order to reexamine has been mailed for both reexamination proceedings, and a decision under 37 CFR 1.989(a) is timely.

The general policy of the Office is that two reexamination proceedings will not be conducted separately, and at the same time, as to a particular patent. The reason for this policy is (1) to prevent inconsistent, and possibly conflicting, amendments from being introduced into the two proceedings on behalf of the patent owner, (2) to provide a comprehensive examination of the patent based on the issues raised in both of the proceedings, and (3) to expedite the prosecution of both proceedings. In the present instance, merger of the 95/000,477 and 95/001,224 reexamination proceedings would address these considerations. Thus, pursuant to 37 CFR 1.989(a), the 95/000,477 and 95/001,224 reexamination proceedings are hereby merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

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

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

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

B. Papers mailed/filed:

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

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

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

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

By U.S. Postal Service Mail:

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

By FAX to:

(571) 273-9900
Central Reexamination Unit

By hand (or delivery service):

Customer Service Window
Attn: Central Reexamination Unit
Randolph Building
401 Dulany Street
Alexandria, VA 22314

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

C. Amendments:

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

37 CFR 1.121 does not apply to amendments in a reexamination proceeding. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments

are to be presented via markings pursuant to 37 CFR 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

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

D. Fees:

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

E. Citation of Patents and Printed Publications:

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

F. Appeal Procedure Reminders for *Inter Partes* Reexamination

The parties are reminded of the procedures for taking appeal in an *inter partes* reexamination as explained in MPEP 2674 and 2675. The appeal must only be taken from (1) the rejection(s) of the claims in the Right of Appeal Notice (RAN) that the *patent owner* proposes to contest, or (2) the finding(s) of patentability of claims in the RAN that the *third party requester* proposes to contest. Therefore, in the notice of appeal, the patent owner must identify each claim rejected by examiner that the patent owner intends to contest and the third party requester must identify each rejection *that was previously proposed by that third party requester* that the third party requester intends to contest. (37 CFR 41.61) The appellant's brief shall present a concise statement of each issue. Further, no new ground of rejection can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection. (37 CFR 41.67(c)(1)(vi))

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/001,224 and *inter partes* Reexamination Control No. 95/000,477 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

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

3. Any questions concerning this communication should be directed to Joseph F. Weiss in the Office of Patent Legal Administration, at (571) 272-7759.

Pinchus M. Laufer
Legal Advisor
Office of Patent Legal Administration

June 9, 2010

United States Patent and Trademark Office

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JUL 10 2010

CENTRAL REEXAMINATION UNIT

Striker Striker & Stenby
103 East Neck Road
Huntington NY 11743 : (For Patent Owner)

Chun M. Ng
Perkins Coie LLP
P.O. Box 1247
Seattle, WA 98111-1247 : (For Third Party Requester)

John S. Pratt, Esq
Kilpatrick Stockton, LLP
1100 Peachtree Street
Suite 2800
Atlanta, GA 30309 : (Courtesy Copy)

In re Lappe et al.
Inter Partes Reexamination Proceeding
Control No. 95/001,225
Filed: August 24, 2009
For: U.S. Patent No. 6,920,124 : **DECISION DISMISSING PETITION UNDER 1.182**

This is a decision on the March 29, 2010 patent owner petition entitled "PETITION UNDER 37 C.F. R. § 1.182 TO REOPEN PROSECUTION."

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

The petition fee under 37 C.F.R. § 1.17(f) of $400 has been submitted.

The petition is **dismissed**.

BACKGROUND

- On August 24, 2009, a request for *inter partes* reexamination of U.S. Patent Number 6,920,124 ("the '124 patent") was filed by the third party requester, and the resulting reexamination proceeding was assigned control number 95/001,225 ("the '1225 proceeding").

- On November 12, 2009, reexamination was ordered for claims 1-15 of the '124 patent.

- The proceeding progressed to the point where, on January 27, 2010, the Office issued an Action Closing Prosecution (ACP) confirming the patentability of claims 1-15.

- On March 29, 2010, patent owner filed the instant petition requesting reopening of prosecution.

APPLICABLE REGULATION

37 CFR 1.182 provides:

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

DECISION

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

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

The § 1.182 petition must further the prosecution of the reexamination proceeding, rather than delay it, and must provide a submission toward that end. This is critical in the reexamination 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

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

a reexamination certificate, since this is a key factor in reducing pendency of a reexamination proceeding. It thus follows that the petition should therefore clearly discuss the manner in which the entry of the submission would act to overcome a rejection or satisfy a requirement of form such that the issues in the proceeding are better defined for appeal or issuance of a reexamination certificate. Furthermore, the requirement of special dispatch favors continued prosecution only where the need for the patent owner's proposed response could not have been anticipated earlier; thus, a petition for continuation of the reexamination prosecution is to explain why the patent owner did not become aware of the need for the new amendment or evidence earlier in the prosecution.

In this instance, patent owner seeks reopening of prosecution after the ACP to address claim interpretations in the ACP and to present new claims addressing these claim interpretations. No claim amendments have been proposed and/or included with the petition.

The instant petition fails to meet the requirements of the March, 2005 Notice. The Notice only addresses the situation in which an amendment (or evidence submission) has been submitted in the proceeding and denied entry by the examiner. In the instant proceeding, no amendment has been submitted. Therefore, by the clear terms of the Notice, the instant petition fails to meet the requirements for reopening of prosecution.

Additionally, the petition fails to comply with the statutory mandate of special dispatch. Reopening of prosecution in this proceeding is requested for an amendment that is not shown to be for the purpose of furthering the proceeding towards reducing issues for appeal or towards issuance of a reexamination certificate. Rather, patent owner's claims have already been confirmed; and granting the patent owner request for relief would prolong the reexamination proceeding to address the examiner's rationale for confirming the claims. This would not further the proceeding towards reducing patent owner's issues for appeal (of which there are none, as all claims were confirmed), or towards issuance of a reexamination certificate (reopening prosecution would merely delay such issuance). Therefore, granting this petition to reopen prosecution would not be in accord with special dispatch. Since § 1.182 operates with respect to regulatory, not statutory, provisions, a petition under § 1.182 may not be granted where the Office would thereby fail to conduct reexamination proceedings with special dispatch.

Based on the facts and circumstances of the present situation, it is found that the petition is not deemed to meet the requirements of the Notice, nor cause the reexamination to proceed a manner consistent with the requirement of 35 U.S.C. 314 to conduct reexamination proceedings "with special dispatch within the Office."

In view of the above and the facts and circumstances presented by the present record, the petition is dismissed.

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 6,920,124 patent file is that of Striker Striker & Stenby, 103 East Neck Road, Huntington NY 11743. However, the correspondence address of record in the reexamination file is that of Kilpatrick Stockton, LLP, 1100 Peachtree Street, Suite 2800, Atlanta, Georgia, 30309-4530. As a courtesy, this decision is being mailed to both addresses.

The address of Striker Striker & Stenby, 103 East Neck Road, Huntington NY 11743, will be the sole address used in future correspondence, until a change in correspondence address in the 6,920,124 patent file is made in accordance with 37 CFR 1.33(c).

CONCLUSION

- The petition is **dismissed**.
- A copy of this decision will be made of record in the reexamination file.
- Jurisdiction over the reexamination proceeding is being forwarded to the Central Reexamination Unit.
- The address of Striker Striker & Stenby, 103 East Neck Road, Huntington NY 11743, will be the sole address used in future correspondence, until a change in correspondence address in the 6,920,124 patent file is made in accordance with 37 CFR 1.33(c).
- Any inquiry concerning this decision should be directed to Michael Cygan, Legal Advisor, at (571) 272-7700.

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

July 7, 2010
C:\Kiva\Kenpet8\IP

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,227	08/25/2009	7580733	8282-83120-02	5216

7590 05/18/2010

DONALD N. HALGREN
35 CENTRAL STREET
MANCHESTER, MA 01944

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 05/18/2010

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/001,227 02	08/25/09	7580733	8282-83120-

ROBERT F. SCOTTI
KLARQUIST SPARKMAN LLP
121 SW SALMON STREET
SUITE 1600
PORTLAND, OR 97204

EXAMINER	
FOSTER, ROLAND G.	
ART UNIT	**PAPER**
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DATE MAILED:
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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/001,227 02	08/25/09	7580733	8282-83120-

ROBERT F. SCOTTI
KLARQUIST SPARKMAN LLP
121 SW SALMON STREET
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FOSTER, ROLAND G.	
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DONALD N. HALGREN
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MANCHESTER MA 01944

(For Patent Owner)

MAILED

MAY 18 2010

CENTRAL REEXAMINATION UNIT

Robert F. Scotti
KLARQUIST SPARKMAN, LLP
121 SW SALMON STREET
PORTLAND, OR 97204

(For *Inter Partes* Requester)

In re Crowley, *et al.*
Inter Partes Reexamination Proceeding
Control No. 95/001,227
Filed: August 25, 2009
For: U.S. Patent No. 7,580,733

DECISION GRANTING PETITION

This is a decision on *inter partes* third party requester's March 24, 2010 petition paper entitled "PETITION UNDER 37 C.F.R. § 1.183 TO SUSPEND THE RULES AND ENTER THIRD PARTY REQUESTER'S OPPOSITION TO THE PATENT OWNER'S PETITION TO COMPEL THE EXAMINER TO COMPLY WITH THE LIMITED SCOPE OF [*sic*-RE] EXAMINATION" (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 March 25, 2010, as authorized in the March 24, 2010 EFS-WEB fee transmittal sheet.

The petition is granted, to the extent that relief is needed for entry of the requester's opposition petition.

REVIEW OF THE RELEVANT FACTS

1. On August 25, 2009, the Office issued United States Patent Number 7,580,733 (the '733 patent) to Crowley, *et al.*

2. Concurrently with the issuance of the '733 patent, a request for *inter partes* reexamination of the '733 patent was filed by a third party requester and assigned Reexamination Control No. 95/001,227 (the '1227 proceeding).

3. On November 24, 2009, the Office issued an order granting *inter partes* reexamination in the '1227 proceeding. The order stated that an Office action on the merits would issue in due course.

4. On December 22, 2009, the Office issued a first action on the merits.

5. On February 22, 2010, patent owner filed a petition entitled "PETITION TO COMPEL THE EXAMINER TO COMPLY WITH THE LIMITED SCOPE OF EXAMINATION SET FORTH IN 37 CFR 1.906," *i.e.* a petition under 37 CFR 1.181 requester supervisor review of an action taken by the examiner in the proceeding.

6. On March 24, 2010, *inter partes* third party requester (hereinafter "requester") filed the instant petition requesting entry of a concurrently filed opposition entitled, THIRD PARTY REQUESER'S OPPOSITION TO PATENT OWNER'S PETITION TO COMPEL THE EXAMINER TO COMPLY WITH THE LIMITED SCOPE OF [*sic*-RE] EXAMINATION SET FORTH IN 37 CFR 1.906, *i.e.* an opposition under 37 CFR 1.181 regarding an action taken by the examiner.

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 February 22, 2010, patent owner filed a petition under 37 CFR 1.181, asserting that the actions taken by the examiner in the December 22, 2009 Office action was not in accordance with the relevant law regarding the conduct of reexamination. On March 24, 2010, requester, exercising their independent participation right under 37 CFR 1.181, filed an opposition to patent

owner's February 22, 2010 petition under 37 CFR 1.181. Concurrently, on March 24, 2010, requester filed the instant petition under 37 CFR 1.183 requesting entry and consideration of the petition under 37 CFR 1.181. In this instance, requester is supporting the propriety of actions taken by the examiner that patent owner has challenged in the December 22, 2009 Office action in the reexamination proceeding. This is not a situation where patent owner is asking for discretionary relief; this is simply a question of whether or not the action taken was in accordance with the relevant law regarding the conduct of reexamination. And, the requester is entitled to rebut patent owner's challenge to Office's consideration of information that that requester submitted.

Accordingly, the petition is granted to the extent that requester's opposition petition has an entry right and will be considered.

CONCLUSION

1. *Inter partes* requester's March 24, 2010 petition is granted, to the extent that relief is needed for entry of the requester's opposition petition.

2. Jurisdiction for the instant reexamination proceeding is returned to the Central Reexamination Unit (CRU), for consideration of the February 22, 2010 patent owner petition and March 24, 2010 requester opposition.

3. Telephone inquiries with regard to this decision should be directed to Joseph Weiss, Legal Advisor, Office of Patent Legal Administration, at (571) 272-7759.

Kenneth M. Schor

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

Kenpet8/IP
5-17-10

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,227	08/25/2009	7580733	8282-83120-02	5216

7590 07/13/2010

DONALD N. HALGREN
35 CENTRAL STREET
MANCHESTER, MA 01944

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 07/13/2010

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.
95/001,227 02	08/25/09	7580733	8282-83120-

ROBERT F. SCOTTI
KLARQUIST SPARKMAN LLP
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PORTLAND, OR 97204

EXAMINER	
FOSTER, ROLAND G.	
ART UNIT	**PAPER**
3992	

DATE MAILED:
MAILED
JUL 13 2010
CENTRAL REEXAMINATION UNIT

INTER PARTES REEXAMINATION COMMUNICATION

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

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

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(For Patent Owner)

MAILED

JUL 13 2010

CENTRAL REEXAMINATION UNIT

In re Crowley, et al :
Reexamination Proceeding : DECISION
Control No.: 95/001,227 : ON §1.182 and § 1.183
Filed: August 25, 2009 : PETITIONS
For: U.S. Patent No.: 7,580,733 :
Title: Personal Communicative Device :
Connectivity Arrangement :

This is a decision addressing (1) a February 22, 2010 patent owner "Petition to Vacate the *Inter Partes* Reexamination for Failure to Comply with 37 C.F.R. 1.915(b)(8)," which will be treated as a petition under § 1.182, and (2) on March 24, 2010 (a) a third party "Petition Under 37 C.F.R. § 1.183 to Suspend the Rules and Enter Third Party Requester's Opposition to the Patent Owner's Petition to Vacate," and (b) a third party requester's Opposition to the Patent Owner's Petition to Vacate *Inter Partes* Re-Examination."

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

Patent owner's § 1.182 petition to vacate the reexamination is dismissed.

Third party requester's petition under § 1.183 for entry of the Opposition is granted, and the Opposition remains entered and was considered in the decision on patent owner's § 1.182 petition.

FEES

The third party requester § 1.183 petition fee of $400.00 fee (as set forth in 37 CFR 1.17(f)) has been paid as indicated in Office PALM records. PALM records do not indicate payment by the patent owner of the § 1.182 $400 petition fee, nor does the petition authorize payment of the fee.

BACKGROUND

1. U.S. Patent No. 7,580,733 (the '733 patent) was issued on August 25, 2009.

2. On August 25, 2009, a request for *inter partes* reexamination of the '733 patent was filed by requester Robert F. Scotti.[1] The request identified as the real party in interest Aircell LLC.[2] The request was assigned reexamination control No. 95/001,227 (the '1,227 reexamination proceeding). The request noted copending litigation of *Ambit Corp. v. Delta Air Lines, Inc., et al.*, Case No. 1:09-cv-11408, (D. Mass.).[3]

3. On November 24, 2009, the Office issued an Order granting *inter partes* reexamination for the'1,227 reexamination proceeding.

4. On February 22, 2010, patent owner filed the instant petition to vacate the filing date of the present reexamination proceeding, which will be treated as a petition under § 1.182.

5. On March 24, 2010, third party requester filed an opposition to the patent owner's November 23, 2009 petition for vacatur, and a petition under § 1.183 for entry of the opposition.

Section 1.182 PETITION FOR VACATUR

Petitioner (Patent Owner) asserts that the real party in interest was not properly identified in the request for reexamination as required by § 1.915(b)(8). [4]

Petitioner points out that (1) Delta Air Lines (Delta) is a joint defendant along with the sole named real party in interest, Aircell LLC (Aircell), in the identified litigation, (2) that both Aircell and Delta have filed joint briefs in the identified litigation,[5] and (3) Aircell and Delta are working together to market Gogo™ and Delta is currently marketing on its website the Gogo™ service of Aircell.[6]

Petitioner further asserts that:

- The fact that Delta is a co defendant in a pending litigation involving the '733 patent litigation gives Delta a real interest in the *inter partes* reexamination of the patent.

- Aircell and Delta have the same legal counsel handling the litigation as

[1] Request, at page 1, paragraph 2.
[2] Request, at page 2, paragraph 12.
[3] *Id.* at page 2, paragraph 11.
[4] Petition, at page 3.
[5] The joint brief argument is made only in the summary on page 4 and not in the initial discussion on page 3 of the petition.
[6] Petition, at page 3 and Appendices A-C.

evidenced in Appendices D-F. Aircell and Delta did not identify themselves as independent defendants nor indicate they were represented by separate counsel, as evidenced in Appendix D. This provides further evidence that both are the real parties in interest in the *inter partes* reexamination.[7]

- Both Aircell and Delta are working together to market the Gogo™ service, which is the subject of the infringement asserted in the litigation of the '733 patent. Such cooperation also provides additional evidence that Aircell and Delta are both real parties in interest in the *inter partes* reexamination.

SECTION 1.183 PETITION

Petitioner third party requester seeks suspension of the rules to permit entry of an opposition to patent owner's § 1.182 petition to vacate the *inter partes* reexamination. Third party requester petitioner notes that patent owner petitioner requests extraordinary relief by asking the Commissioner of Patents to vacate the reexamination, after all the claims have been rejected. Entry of the third party opposition by granting third party's petition should allow the Commissioner to expeditiously confirm the status of Delta as not a real party in interest, which expeditious treatment is especially desirable in view of the statutory requirement for "special status"[8] in reexamination.

THIRD PARTY OPPOSITION

The third party requester opposes vacating the *inter partes* reexamination based on a its alleged failure to identify Delta as an additional real party in interest. The Opposition states that Delta[9] has:

- Not provided any financial compensation to the third party requester,
- No right to control, supervise, or review any document that has been prepared or filed in the reexamination,
- Not provided any feedback or technical review to the requester,
- Not contributed or suggested any prior art that has been submitted in the instant reexamination proceeding, and
- Not formulated any of the substantial new questions formulated by the third party requester.

It is conceded by requester that "certain invalidity arguments formulated by the Requester (and presented in the re-examination request) may have been used or adapted for use in the Litigation." However, it is argued that such "events are outside the intent of the statute, and do not transform co-defendant DAL into a real-party-in-interest in the re-examination, based on the current interpretation of the law.[10]

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[7] Petition at page 3.
[8] 35 U.S.C. § 114(c).
[9] Opposition, at page 2.
[10] *Id.*, at page 4.

The third party requester finally unequivocally states that it "has not attempted to shield any entity from being named as a real-party-in-interest."[11]

DECISION ON § 1.183 PETITION BY THIRD PARTY REQUESTER

The § 1.183 petition by third party requester, seeking entry of its opposition to the patent owner's § 1.182 petition, seeking vacatur of the reexamination, is granted.

Justice requires that the requester be given an opportunity, via the present petition, to respond to patent owner's petition to terminate requester's requested reexamination. It is noted that the straight forward statements by the third party requester regarding Delta and its lack of relation to the *inter partes* reexamination request are helpful in determining the action to be taken on patent owner's § 1.182 petition in regard to the failure to name Delta as a real party in interest in the reexamination request.

DECISION ON § 1.182 PETITION BY PATENT OWNER

The § 1.182 petition by patent owner seeking vacatur of the *inter partes* reexamination based on the failure to name Delta as a real party in interest is dismissed.

As pointed out above, PALM records do not indicate payment by the patent owner of the § 1.182 $400 petition fee, nor does the petition authorize payment of the fee. Accordingly, the petition is dismissed for failure to pay the appropriate fee.

It is also to be noted that the MPEP [12] makes clear that the Office does not look beyond the required certification in the request for reexamination, except for the rare instance where a challenge to the sufficiency of the certification facially establishes that the identified real party in interest is not accurate. The certification cannot be successfully challenged merely because, at one point, the certified real party in interest was "involved" with another party, or there was some collaboration in a matter other than the request for reexamination.

The instant reexamination was filed noting the pending litigation where Delta is a joint defendant with the sole named real party in interest. The common interest among litigation defendants seeking to invalidate a patent does not translate *ipso facto* into each defendant being a real party in interest where a request for reexamination is filed by only one of the defendants in the litigation. This is not to say that the other defendants cannot be real parties in interest in a request for reexamination, but such result cannot merely be based either on the concomitant use of available common defendant litigation materials in a later request for reexamination or use of publically available material filed in a reexamination that are later introduced into litigation. To be required to be named as a real party in

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[11] *Id.*
[12] MPEP § 2612.

interest, a party must participate in some manner in the request for reexamination. Accordingly, a search for prior art, review of possibly useful prior art, preparation of an invalidity defense based on found and evaluated prior art to support a litigation defense, and financial support to carry out a litigation defense - do not amount to participation in a request for reexamination based on such activities, where the activities are conducted with only an intent to defend the litigation suit. Evidence that the activities were conducted with an intent to file an *inter partes* reexamination request is required in order for a petitioner to establish that other defendants (co-defendants) are real parties in interest in a request for reexamination.

Similarly, joint marketing of an invention covered by the patent subject to litigation and reexamination, does not cause each of the joint marketers to be a real party in interest in the request for reexamination notwithstanding any real benefit that would result to the joint marketers from a favorable result in the reexamination.

The question of whether a party is a real party in interest must be determined on a case-by-case basis focusing on **the showing** of participation of a party in regard to the filing of a request for reexamination, and not ancillary matters, such as being a co-defendant in a litigation or a joint marketer. For example, if the Office were to follow petitioner's line of reasoning, a patent owner might challenge an identification of the real party in interest in a reexamination, where a third party requester not involved in the litigation (as to a patent) and even ignorant thereof, was to file a request for reexamination utilizing one or more pieces of prior art employed by unrelated defendants in the litigation. The third party requester could be placed in a position of having to prove a negative – that it did not participate in the litigation. Similarly, here, a co-defendant need not prove a negative - that it did not participate in the reexamination. The fact that a first party participated in a joint defense, or utilized the same counsel, and another party defendant later filed a request for reexamination, should not doom the first party to life as a real party in interest for any request for reexamination that may be later filed by another defendant in the joint litigation defense or who utilized joint counsel. Rather, the burden is on the challenging patent owner to provide evidence of participation.

It may be that a particular defendant has decided to proceed with a request for reexamination in the face of hostile opposition by one or more other defendants (who would rather settle the matter in court, than before the Office, based on the nature of their case) who should therefore not be embraced as a real party in interest in the request for reexamination. To do so, would result in estoppel against parties who had no control over the request for reexamination. None-the-less, using petitioner's theory that the co-defendants in litigation must be deemed to be real parties in interest in a request for reexamination of the patent in litigation, the other defendants in the litigation may be barred (under 35 U.S.C. § 317(a)) from raising other known prior art that they may feel is better in a subsequent request for reexamination after the first request has been ordered.

In deciding a petition for vacatur, the Office will not engage in conjecture as to the participation in the request for reexamination of any particular alleged unnamed

real party in interest. For purposes of this decision, it is not disputed that co-defendant Delta may be impacted[13] and even benefit from the filing of the instant reexamination as is alleged by patent owner petitioner. However, it is incumbent upon petitioner to present objective evidence that a party not identified as a real party in interest in fact participated in the request for reexamination, or in the reexamination proceeding after the request was filed.

A. The Identification Of The Real Party In Interest Is Not Facially Inaccurate Or Ambiguous. Therefore, The Office Lacks The Authority And The Tools To Question That Identification.

The arguments presented in the § 1.182 petition for vacatur fail to establish that the Office has the authority to question the accuracy of a third party requester's facially accurate and unambiguous identification of the real party in interest in this *inter partes* reexamination proceeding, or the tools to competently conduct an investigation of the matter.

To the extent that patent owner argues that the Office has the ability to investigate the accuracy of the identification of the real party in interest in an *inter partes* reexamination proceeding, or to issue a Show Cause Order requiring the identified real party in interest to confirm that it, and it alone, is the real party in interest, patent owner does not make a persuasive case that the Office is required to do so by either the reexamination statute or the reexamination regulations, when the *inter partes* reexamination as filed contains an unambiguous identification of the identity of the real party in interest. This unambiguous identification has been buttressed in regard to the relationship of Delta by the third party Opposition paper explicitly setting forth the lack of participation of Delta as to the present *inter partes* reexamination.

Patent owner's argument is not persuasive, because it does not reflect the intent of the provisions of 37 CFR 1.915(b)(7) and (b)(8). A certification statement made pursuant to 37 CFR 1.915(b)(7) is a statement by the third party requester to the effect that the third party requester is not itself estopped by the statutory estoppel provisions from filing a request for *inter partes* reexamination of a given patent. The *inter partes* rule making at 65 Fed. Reg. 76756, 76759 (Dec. 7, 2000), provides that:

> It should be noted that the Office generally will not have a need to resolve the factual issue of whether or not one party is a privy of another party. Section 1.915(b)(7) requires a third party requester to certify that the estoppel provisions of §1.907 do not prohibit the filing of the *inter partes* reexamination request, and the Office does not intend to look beyond this required certification. It is only in the rare instance where a challenge to the accuracy of the certification is raised by the patent owner, that the question would then need to be addressed.

[13] Section 1.182 patent owner petition to vacate, at page 4.

A substantially identical statement also appears at 65 Fed. Reg. 76756, 76764. These statements establish that the Office will, only in the rare instance that it is necessary to do so (a facial showing of inaccuracy or an ambiguity), "address" the accuracy of a certification that statutory estoppel does not bar the filing of a request for *inter partes* reexamination. Further, the rule making does not discuss the type or depth of investigation that can and will be undertaken, and it does not state or imply that a patent owner may trigger an investigation of the accuracy of the certification merely by advancing an unsupported allegation that the third party requester is estopped from filing a request for *inter partes* reexamination.

This is not an instance where the identification of the real party in interest required by 37 CFR 1.915(b)(8) is ambiguous or facially inaccurate, in which instance the third party requester who is before the Office can be queried by the Office, because the record is not clear at that point in time (*i.e.*, the ambiguity causes an issue that is ripe for consideration). Since the present record in the instant reexamination proceeding is not ambiguous as to the identification of the real party in interest (and patent owner has provided no persuasive extrinsic evidence to establish ambiguity), there is no basis to proceed any further in this proceeding as to the matter. Likewise, this is not an instance where all co-defendants have been shown to appear to rely on the request for reexamination as a basis for a joint motion to stay the litigation, where a third party requester who is before the Office can be queried by the Office, to provide an explanation.

Aside from the above, a second reexamination proceeding that would be the subject of the above-cited paragraph of the rule making notice has not yet been filed, nor has a final decision issued in the litigation; thus the issue is not ripe for consideration (see discussion in part B. below). If the issue whether a second reexamination does become ripe for consideration via a second reexamination proceeding filed by a second requester (who is one of the co-defendants), the Office can then query an *ambiguous or facially inaccurate* 37 CFR 1.915(b)(7) certification statement. In that instance, the second third party requester making such statement would become a party appearing before the Office. In other words, a second co-defendant, *i.e.*, the second third party requester, would then be available to be asked by the Office to clarify or support a 37 CFR 1.915(b)(7) certification statement that is ambiguous or facially inaccurate. Presumably, that third party requester would be able to respond based on facts wholly within its knowledge and possession. The Office would be able to obtain information from the patent owner and the second third party requester, and would have no need to obtain information from a party not before the Office by reason of the filing of a first request for *inter partes* reexamination.

Aside from the inherent ability of the Office to issue an Order to Show Cause directed to a party that is before the Office, patent owner does not point to any regulation that would provide a mechanism for conducting an investigation directed to determining whether parties not before the Office are in fact real parties in interest in an *inter partes* reexamination proceeding. For example, 37 CFR 1.105

was promulgated pursuant to 35 U.S.C. §§ 131 and 132, statutes that relate to the examination of applications and (via incorporation by the reexamination statute) the conduct of reexamination proceedings as to patentability. The regulation was promulgated for the purpose of requiring submission of information material to patentability from persons having a duty under 37 CFR 1.56 to disclose information to the Office that is material to patentability.[14] The identification of the real party in interest has no relationship to the duty to disclose information that is material to patentability (which applies to an applicant for patent and to a patent owner in a reexamination proceeding).[15] With respect to obtaining information from a party who is alleged to be an undisclosed real party in interest in an *inter partes* reexamination proceeding, it is not apparent how 37 CFR 1.105 could be applied to a party who is not before the Office in that proceeding.

Therefore, where a patent owner who is a party in an *inter partes* reexamination proceeding believes that an identification of the real party in interest is inaccurate, even though it is facially unambiguous, the courts are the appropriate venue from which the patent owner should seek relief to obtain evidence extrinsic to the record, for incorporation into the record. It is to be noted that there is precedent on the issue of "real party in interest" in the federal courts, on matters ranging from jurisdiction (*e.g.*, presence of diversity or amount of suit)[16] to actions in which the principle is applied to prevent multiple or conflicting lawsuits by persons such as assignees.[17] These examples of court proceedings resolving "real party in interest" issues demonstrate the reason why the Office cannot perform such a function here. Upon obtaining jurisdiction over the parties, courts may order discovery, taking of testimony with cross examination and use of other evidentiary tools, while enforcing compliance with its requirements via its subpoena power and power to impose sanctions. Accordingly, the courts are the forums best equipped to determine who is, and who is not, the "real party in interest" when there is a reason to doubt the third party requester's identification of a party or parties as being the real party in interest in an *inter partes* reexamination proceeding. Further, courts may provide relief, as appropriate, by enjoining the filing of a further *inter partes* reexamination request by the other parties in a civil action. Even if an *inter partes* reexamination request was filed by one of the other parties in the civil action who is barred from requesting *inter partes* reexamination by statutory estoppel, a court could always enjoin participation by that requester in the proceeding and essentially turn the proceeding into an *ex parte* reexamination proceeding, the filing of which does not require identification of "a real party in interest" (35 U.S.C §§ 301 and 302), and is not prohibited by statute or rule, even after an *inter partes* reexamination was filed by the same real party in interest.[18]

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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] *Varlotta Construction Corporation v. Carla Development Corporation*, 886 F. Supp 315 (E.D.N.Y. 1995)

[17] *First Hartford Corporation Pension Plan & Trust v. United States*, 194 F.3d 1279 (Fed. Cir. 1999)

[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.

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. The Office may consider that it is "the sole agency that administers the patent statute,"[19] and the Office certainly conducts the *inter partes* proceeding; however, it is common knowledge that the federal courts (which are not an agency in the sense used in the *inter partes* reexamination rule making) routinely adjudicate matters arising under the patent statute. Further, patent owner should appreciate the difference between conducting a reexamination proceeding, which is the province of the Office, and enforcing an estoppel provision of Federal law as a matter of equitable relief. Patent owner has not provided any basis for believing that the district courts lack authority to act as described above.

As a final point in this section of the decision as to the Office lacking the authority to investigate: The reexamination statute requires, *inter alia*, that a request for *inter partes* reexamination proceeding "shall ... include the identity of the real party in interest... ."[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] Requester has clearly stated that Aircell is the real party in interest, and that is an identification to a sufficient extent that "a subsequent person filing an *inter partes* reexamination request" can look into its interaction with the identified Aircell to "determine whether that person is a privy" with the real party in interest that filed the present reexamination. Neither the *inter partes* reexamination statute nor the *inter partes* reexamination rules imposes a duty on the Office to investigate the accuracy of an unambiguous identification of the real party in interest in a third party requester's request for *inter partes* reexamination proceeding.

In the present *inter partes* reexamination proceeding, the real party in interest is unambiguously identified in the current record. The identification of the real party in interest does not appear to be facially inaccurate. The Office will refuse to accord a filing date to a request for *inter partes* reexamination that does not identify the real party in interest, or which provides an identification of the real party in interest that is ambiguous or facially inaccurate. If the Office accords a filing date to a request for *inter partes* reexamination, and later discovers an ambiguity or a facial inaccuracy in

[19] 65 Fed. Reg. 76756, 76759 (Dec. 7, 2000), emphasis added.
[20] 35 U.S.C. § 311(b)(1).
[21] 37 CFR 1.915(b)(8).

the identification of the real party in interest, the Office can, and will, require that a party appearing before it as third party requester in an *inter partes* reexamination proceeding clarify the ambiguity or facial inaccuracy. However, it does not follow that the Office is empowered to conduct an investigation into the identity of the real party in interest when the statement identifying the real in interest in the record of an *inter partes* reexamination proceeding is neither facially inaccurate nor ambiguous. The Office will not conduct an investigation into the accuracy of the identification of the real party interest in the instant reexamination proceeding, because there is no legal reason to do so, even if the Office's ability to do so could be shown (which it has not been, as discussed above).

B. The Office Has No *Present* Duty To Investigate The Identity Of The Real Party In Interest In The Instant *Inter Partes* Reexamination Proceeding.

It is also to be noted that, in the instant reexamination proceeding, patent owner is requesting relief based upon an injury that has not yet occurred, and may never occur, even according to patent owner's view of the situation. Patent owner does not allege that the named real party in interest is itself estopped from filing and participating in the instant reexamination proceeding. Rather, patent owner's concern must be that patent owner might be harassed by the filing of a subsequent request for *inter partes* reexamination of the patent or that the instant reexamination will be inappropriately maintained by a party that should have been identified as a real party in interest in the instant reexamination proceeding, but was not so identified. Such a hypothetical party, as a real party in interest in the instant reexamination proceeding, would be subject to a statutory estoppel that could preclude (if the statutory provisions are satisfied) its filing of another *inter partes* reexamination proceeding, or from maintaining the instant reexamination proceeding if such a party "loses" as a defendant in any litigation of the patent. While a patent owner is statutorily entitled to be protected from harassment by the filing of a subsequent request for *inter partes* reexamination of the patent by a party who is estopped from filing such a request, the record simply does not show that such a circumstance presently exists as to the instant reexamination proceeding. No additional requests for *inter partes* reexamination of the patent have been filed by co-defendant Delta nor is the only identified litigation (as to the patent) final. Thus, 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 patent or inappropriately maintained the instant one. Accordingly, there is no need to consider addressing the relief requested by patent owner in the present *inter partes* reexamination proceeding, since patent owner cannot have been injured by the filing of another request for *inter partes* reexamination for the patent or by maintaining a reexamination that is barred by statutory estoppel.

C. Synopsis

The petition fee for the 37 CFR 1.182 patent owner petition has not been paid; thus the patent owner petition must be dismissed. However, in the interest of special

dispatch and given that there is a companion petition with the same issue, the merits of the petition have also been addressed to provide an alternative ground for dismissal.

Rather than having presented clear and undisputed evidence establishing that Aircell is not the only real party in interest in the instant reexamination proceeding, the petition is supported only by supposition and conjecture on patent owner's part, which has been rebutted by the third party Opposition paper. Accordingly, patent owner has not demonstrated a persuasive basis for the requested relief of vacatur of the filing date of the instant reexamination proceeding. Therefore, such request for relief is dismissed.

REMAINING PETITIONS TO BE DECIDED

Having acted on the petition for vacatur with a dismissal, the following petitions, which are still pending, will be addressed by the Office in due course:

- Two June 17, 2010 petitions related to § 1.59(b).

CONCLUSION

1. The February 22, 2010 patent owner § 1.182 petition seeking vacatur of the reexamination is dismissed.

2. The March 24, 2010 1.183 third party requester petition seeking entry of a March 24, 2010 Opposition to the § 1.182 patent owner petition is granted.

3. Jurisdiction over this proceeding will be exercised by the Office of Patent Legal Administration and the Central Reexamination Unit, as appropriate to address the pending petitions identified above.

4. Telephone inquiries related to this decision should be directed to Hiram H. Bernstein, Senior Legal Advisor, at (571) 272-7707 or, in his absence, to the undersigned, at (571) 272-7710.

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

7-13-10
Kenpet8

APPENDIX OF RELEVANT STATUTORY, REGULATORY AND PRACTICE PROVISIONS

35 U.S.C. §§ 311(a) and (b) provide:

(a)IN GENERAL.– Any third-party requester at any time may file a request for inter partes reexamination by the Office of a patent on the basis of any prior art cited under the provisions of section 301.
(b) REQUIREMENTS.– The request shall–
(1) be in writing, include the identity of the real party in interest, and be accompanied by payment of an inter partes reexamination fee established by the Director under section 41; and
(2) set forth the pertinency and manner of applying cited prior art to every claim for which reexamination is requested.

35 U.S.C. § 315(c) provides:

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

35 U.S.C. § 317 provides:

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

newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the inter partes reexamination proceedings.

37 CFR 1.105 provides:

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

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

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

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

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

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

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

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

(viii) *Technical information* known to applicant.

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

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

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

manner, for example:

(i) A requirement for factual information;

(ii) Interrogatories in the form of specific questions seeking applicant's factual knowledge; or

(iii) Stipulations as to facts with which the applicant may agree or disagree.

(4) Any reply to a requirement for information pursuant to this section that states either that the information required to be submitted is unknown to or is not readily available to the party or parties from which it was requested may be accepted as a complete reply.
(b)The requirement for information of paragraph (a)(1) of this section may be included in an Office action, or sent separately.
(c) A reply, or a failure to reply, to a requirement for information under this section will be governed
by §§ 1.135 and 1.136.

37 CFR 1.907 provides:

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

37 CFR 1.913 provides:

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

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

(b) A request for *inter partes* reexamination must include the following parts:
(7) A certification by the third party requester that the estoppel provisions of § 1.907 do not prohibit the inter partes reexamination.
(8) A statement identifying the real party in interest to the extent necessary for a subsequent person filing an *inter partes* reexamination request to determine whether that person is a privy.

...

(d) If *the inter partes* request does not include the fee for requesting *inter partes* reexamination required by paragraph (a) of this section and meet all the requirements of paragraph (b) of this section, then the person identified as requesting *inter partes* reexamination will be so notified and will generally be given an opportunity to complete the request within a specified time. Failure to comply with the notice will result in the *inter partes* reexamination request not being granted a filing date, and will result in placement of the request in the patent file as a citation if it complies with the requirements of § 1.501.

37 CFR 1.919(a) provides:

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

MPEP § 2612 provides, in part:

37 CFR 1.907 defines specific situations where a third party is prohibited from filing a request for an inter partes reexamination. 37 CFR 1.915(b)(7) requires the third party requester to certify that the estoppel provisions of 37 CFR 1.907 do not prohibit the filing of the inter partes reexamination request by the real party in interest (note that it is the real party in interest that is subject to the estoppel provisions and not the party who actually files the request). The certification identified in 37 CFR 1.915(b)(7) will constitute a prima facie showing that the party requesting the inter partes reexamination is not barred from doing so under 37 CFR 1.907. The Office does not intend to look beyond this required certification. It is only in the rare instance where a challenge to the accuracy of the certification is raised by the patent owner, that the question would then need to be addressed. A challenge to the accuracy of the certification must facially establish that the third party requesting the inter partes reexamination is barred from doing so under 37 CFR 1.907. Thus, for example, the challenger cannot rely on an argument that the third party requesting reexamination was, at one point, involved with a party barred under 37 CFR 1.907, and should thus be considered as a real party in interest (and barred from filing the request). Involvement *per se* does not facially establish that the other party is a real party in interest. The fact that a second party may benefit from an earlier reexamination request filed by a first party or a civil action conducted by the first party, or that the second party may have collaborated with the first party in a matter, does not facially evidence the second party was a real party in interest with the first party. With respect to the Office conducting an investigation to uncover whether the second party was a "real party in interest," the statute does not require, nor does it provide the tools, for the Office to investigate such matter. Further, Congress has not provided the Office with subpoena power or discovery tools and has not provided the Office with the ability to conduct hearings for eliciting testimony and cross-examination. The Office has not been authorized to impose punitive sanctions for non-compliance. Such evidentiary tools are, however, available to the courts, which

are the appropriate vehicle to make a factual investigation as to the accuracy of the identification of a "real party in interest."

MPEP § 2614 provides, in part:

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,237	09/22/2009	6875021	NINT-001/00US 144575-2016	9171

20210 7590 04/14/2010

DAVIS & BUJOLD, P.L.L.C.
112 PLEASANT STREET
CONCORD, NH 03301

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/14/2010

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,520	08/28/2009	6875021	ADC021	9714

20210 7590 04/14/2010

DAVIS & BUJOLD, P.L.L.C.
112 PLEASANT STREET
CONCORD, NH 03301

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/14/2010

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Michael Bujold
Davis & Bujold, PLLC
112 Pleasant St.
Concord, NH 03301

(For Patent Owner/*Ex Parte* Requester)

MAILED

APR 14 2010

CENTRAL REEXAMINATION UNIT

Matthew Brigham
Cooley Godward Kronish LLP
Attn: Patent Group
Suite 1100
777 – 6th Street, NW
Washington, D.C. 20001

(For *Inter Partes* Requester)

Ex parte Reexamination Proceeding
Control No. 90/009,520
Filed: August 28, 2009
For: U.S. Patent No. 6,875,021

Inter Partes Reexamination Proceeding
Control No. 95/001,237
Filed: Sept. 22, 2009
For: U.S. Patent No. 6,875,021

DECISION, *SUA SPONTE*, TO MERGE REEXAMINATION PROCEEDINGS

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

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,875,021 (the '021 patent) issued to Okamoto on April 5, 2005, with 11 claims.

2. A request for *ex parte* reexamination of claims 1, 5, 8, and 11 of the '021 patent was deposited on July 10, 2009, by patent owner, and received a filing date on August 28, 2009. The request was assigned control number 90/009,520 (the '9520 *ex parte* proceeding).

3. On Sept. 29, 2009, *ex parte* reexamination was ordered for claims 1, 5, 8, and 11 of the '021 patent based on the examiner's determination that the Aug. 28, 2009 request raised a substantial new question of patentability affecting these claims.

4. A request for *inter partes* reexamination of claims 1-11 of the '021 patent was filed on Sept. 22, 2009, by a third party requester representing Nintendo of America, Inc., Sony Computer Entertainment America Inc., and Microsoft Corporation as the real parties in interest. The request was assigned control number 95/001,237 (the '1237 *inter partes* proceeding).

5. On Dec. 18, 2009, *inter partes* reexamination was ordered for claims 1-11 of the '021 patent based on the examiner's determination that the Sept. 22, 2009 request raised a substantial new question of patentability affecting these claims.

6. A concurrent litigation styled *ADC Technology Inc. v. Microsoft Corp. et al.*, U.S. District Court of Washington Western, 2:08cv1579 filed Oct. 27, 2008 involving the '021 patent is presently open and stayed pending reexamination.

7. There has been no further Office action in either proceeding, and the time for filing a patent owner's statement pursuant to 37 CFR 1.530 in the '9520 *ex parte* proceeding expired after Nov. 29, 2009. [1]

DECISION

I. MERGER OF PROCEEDINGS

Reexamination has been ordered in two proceedings for the same claims of the same patent. One of the proceedings (the '1237 proceeding) is an *inter partes* proceeding. Both proceedings are still pending, and have not been terminated. Therefore, consideration of merger pursuant to 37 CFR 1.989 is ripe at this point in time.

37 CFR 1.989 provides:

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

[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.

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 90/009,520 and 95/001,237 proceedings are merged. The merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

II. CONDUCT OF MERGED PROCEEDING

A. Patent owner is required to maintain the same claims (and specification) in both files throughout the merged proceeding. Presently, the claims and the specification are the same in each proceeding.

B. 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, 5, 8, and 11 of the '021 patent in the '9520 proceeding and for claims 1-11 of the '021 patent in the '1237 proceeding. The examiner will conduct reexamination in the merged proceeding for claims 1-11 of the '021 patent.

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 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.

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

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 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.

F. 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.

III. . CORRESPONDENCE ADDRESSES

A. Patent Owner's Representative

The correspondence address for the patent to be reexamined is the address of the patent owner in the patent file. See MPEP 2222 and 37 CFR 1.33(c). The correspondence address of the '021 patent is not the same as the correspondence address listed in the *ex parte* request. The desired correspondence address must be corrected in the patent file to change the correspondence address to that listed in the request. Additionally, a power of attorney and a statement establishing the right of the assignee to take action under 37 CFR 3.73(b) must be filed in accordance with 37 CFR 1.510(f) in the reexamination proceeding.

B. Third Party Requesters' Representatives

The *inter partes* request was filed by three third party requesters and lists three different customer numbers for the correspondence address. Multiple correspondence addresses are not permitted. See 37 CFR 1.33(a). Therefore, correspondence will only be sent to the first listed requester with Customer Number 58249.

CONCLUSION

1. *Ex parte* Reexamination Control No. 90/009,520 and *inter partes* Reexamination Control No. 95/001,237 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.

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

April 12, 2010

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,239	10/01/2009	7068668	2001417.132-US1	2456

26181 7590 03/23/2010

FISH & RICHARDSON P.C.
PO BOX 1022
MINNEAPOLIS, MN 55440-1022

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/23/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
WILMERHALE/NEW YORK
399 PARK AVENUE
NEW YORK, NY 10022

Date:

MAILED

MAR 2 3 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001239
PATENT NO. : 7068668
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.
95/001,184	04/30/2009	7068668	027639.0021-US02	9102

26181 7590 03/23/2010

FISH & RICHARDSON P.C.
PO BOX 1022
MINNEAPOLIS, MN 55440-1022

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/23/2010

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
COVINGTON & BURLING, LLP
ATTN: PATENT DOCKETING
1201 PENNSYLVANIA AVENUE, N.W.
WASHINGTON, DC 20004-2401

Date:

MAILED

MAR 2 3 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001184
PATENT NO. : 7068668
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 23 2010

CENTRAL REEXAMINATION UNIT

FISH & RICHARDSON P.C.
PO BOX 1022
MINNEAPOLIS, MN 55440-1022 (For Patent Owner)

ANDREA G. REISTER
COVINGTON & BURLING LLP
1201 PENNSYLVANIA AVE., N.W.
WASHINGTON, D.C. 20004 (For *Inter Partes* Requester)

LAUREN A. SHERIDAN
WILMER CUTLER PICKERING HALE AND DORR LLP
399 PARK AVENUE
NEW YORK, NEW YORK 10022 (For *Inter Partes* Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,184
Filed: April 30, 2009
For: U.S. Patent No. 7,068,668

Inter Partes Reexamination Proceeding
Control No. 95/001,239
Filed: October 1, 2009
For: U.S. Patent No. 7,068,668

DECISION TO *SUA SPONTE* 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. 7,068,668 (the '668 patent) issued to Feuer on June 27, 2006.

2. A request for *inter partes* reexamination of claims 1-37 of the '668 patent was filed on April 30, 2009, by third party requester Verizon Long Distance LLC, et al., and the request was assigned control number 95/001,184 (the '1184 *inter partes* proceeding).

3. On June 22, 2009, *inter partes* reexamination was ordered for claims 1-9, 11-16 and 18-37 of the '668 patent based on the examiner's determination that the April 30, 2009 request raised a substantial new question of patentability affecting these claims.

4. On June 22, 2009, a non-final Office action was mailed in the '1184 *inter partes* proceeding, rejecting claims 1-9, 11-16, and 18-37 of the '668 patent.

5. On August 24, 2009, patent owner filed a response to the June 22, 2009 Office action requesting reconsideration of the rejections of the claims and proposing amendments to claims 1, 3, 10, 12, 17, 18, and 21 and submitting new claims 38-43.

6. On September 22, 2009, the third party requester filed comments on the June 22, 2009 Office action and patent owner's August 24, 2009 response.

7. A request for *inter partes* reexamination of claims 1-37 of the '6668 patent was filed on October 1, 2009, by third party requester Vonage Holdings Corp., and the request was assigned control number 95/001,239 (the '1239 *inter partes* proceeding).

8. On December 16, 2009, *inter partes* reexamination was ordered for claims 10, 17, 24, 26-29, and 31-32 of the '668 patent based on the examiner's determination that the October 1, 2009 request raised a substantial new question of patentability affecting these claims.

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:

> (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 95/001,184 and 95/001,239 proceedings are merged. The merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

Patent owner is required to maintain the same claims (and specification) in both files throughout the merged proceeding. Amendments to claims 1, 3, 10, 12, 17, 18, and 21 and new claims 38-43 have been proposed in the '1184 proceeding, while there is no amendment in the '1239

proceeding. Thus, the claims are not currently the same in both files. An Office action requiring an amendment placing the claims in identical form is being issued concurrently with this decision. Patent owner must respond to the Office action in accordance with the procedures in 37 CFR 1.111. The third party requesters will then have an opportunity to comment on patent owner's response in accordance with the procedures in 37 CFR 1.947.

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

The present decision merges two *inter partes* reexamination proceedings. Pursuant to 37 CFR 1.989(a), the merged examination will normally result in the issuance and publication of a single reexamination certificate under 37 CFR 1.997.

It is noted that reexamination was ordered for claims 1-9, 11-16, and 18-37 of the '668 patent in the '1184 *inter partes* proceeding, while reexamination was ordered for claims 10, 17, 24, 26-29, 31, and 32 of the '668 patent in the '1239 *inter partes* proceeding. The examiner will conduct reexamination in the merged proceeding for claims 1-37 of the '668 patent (all the claims of the 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 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.

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

C. Amendments:

The filing of any amendments to the drawings, specification or claims must comply with 37 CFR 1.943 and the guidelines of MPEP § 2666.01.

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.

F. Appeal Procedure Reminders for *Inter Partes* Reexamination

The parties are reminded of the procedures for taking appeal in an *inter partes* reexamination as explained in MPEP 2674 and 2675. The appeal must only be taken from (1) the rejection(s) of the claims in the Right of Appeal Notice (RAN) that the *patent owner* proposes to contest, or (2) the finding(s) of patentability of claims in the RAN that the *third party requester* proposes to contest. Therefore, in the notice of appeal, the patent owner must identify each claim rejected by examiner that the patent owner intends to contest and the third party requester must identify each rejection *that was previously proposed by that third party requester* that the third party requester intends to contest. (37 CFR 41.61) The appellant's brief shall present a concise statement of each issue. Further, no new ground of rejection can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection. (37 CFR 41.67(c)(1)(vi))

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/001,184 and *inter partes* Reexamination Control No. 95/001,239 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.

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

March 15, 2010

UNITED STATES PATENT AND TRADEMARK OFFICE

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FISH & RICHARDSON P.C.
PO BOX 1022
MINNEAPOLIS MN 55440-1022

MAILED

APR 3 0 2010

CENTRAL REEXAMINATION UNIT

In re Application of :
DONALD S. FEUER :
Control No. 95/001,239 (US PAT 7,068,668) : DECISION ON PETITION
Filed: October 01, 2009 : TO WITHDRAW
Attorney Docket No. 24862-0002RX3 : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed April 28, 2010.

The request is **APPROVED**.

A grantable request to withdraw as attorney/agent of record must be signed by every attorney/agent seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. The Office requires the practitioner(s) requesting withdrawal to certify that he, she, or they have: (1) given reasonable notice to the client, prior to the expiration of the response period, that the practitioner(s) intends to withdraw from employment; (2) delivered to the client or a duly authorized representative of the client all papers and property (including funds) to which the client is entitled; and (3) notified the client of any responses that may be due and the time frame within which the client must respond, pursuant 37 CFR 10.40(c).

The request was signed by Stephen R. Schaefer on behalf of all attorneys of record.

All attorneys/agents associated with Customer Number 26181 have been withdrawn.

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

The correspondence address of record has been changed and the new correspondence address is the first copied address indicated below.

Telephone inquiries concerning this decision should be directed to Patricia Volpe at 571-272-6825.

RVolpe for

Eric S. Keasel
Supervisory Patent Examiner
CRU 3992

cc: DONALD S. FEUER
CENTRE ONE
2938 CALLE FRONTERA
SAN CLEMENTE, CA 92673

cc: LAURA A. SHERIDAN (Third Party Requester)
WILMER CUTLER PICKERING HALE AND DORR LLP
399 PARK AVENUE
NEW YORK, NY 10022

Enclosure:

Copy of request for withdrawal as attorney or agent and change of correspondence address filed on April 28, 2010. There is no indication it was served on the Third Party Requester.

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.
95/001,240	10/02/2009	6891811	2187.019REX0	5316

93344 7590 05/11/2010

FLACHSBART & GREENSPOON, LLC
333 N. MICHIGAN AVE.
27TH FLOOR
CHICAGO, IL 60601

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 05/11/2010

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

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William H. Bollman
Manelli Denison & Selter, PLLC
2000 M Street, NW
Suite 700
Washington, DC 20036-3307

(For Patent Owner)

MAILED

MAY 11 2010

CENTRAL REEXAMINATION UNIT

Robert Greene Sterne, Esq.
Sterne, Kessler, Goldstein & Fox, PLLC
1100 New York Ave, NW
Washington, DC 20005

(For Third Party Requester)

Flachsbart & Greenspoon, LLC
333 N. Michigan Avenue
27th Floor
Chicago, IL 60601

(Courtesy Copy)

In re Smith et al.
Inter Partes Reexamination Proceeding
Control No.: 95/001,240
Filed: October 2, 2009
For: U.S. Patent No.: 6,891,811

DECISION GRANTING PETITION

This is a decision on the patent owner's petition entitled "Patentee's Petition under 37 CFR § 1.183 to Suspend Application Of 37 CFR § 1.945(b)(1), To Allow Submission Of A Supplemental Response Addressing Why A New Court Decision Interpreting The Patent-Under-Reexamination Supports Confirmation Of Certain Claims" filed February 15, 2010.

The petition and *inter partes* reexamination control number 95/001,240 are before the Office of Patent Legal Administration for consideration.

SUMMARY

The patent owner petition under 37 CFR 1.183 filed February 15, 2010 is granted, for the reasons set forth below.

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

RELEVANT BACKGROUND

1. U.S. Patent number 6,891,811 (the '811 patent) issued on May 10, 2005.

2. A request for *inter partes* reexamination of the '811 patent was filed on October 2, 2009. The request was assigned control No. 95/001,240 (the '1240 proceeding).

3. Reexamination was ordered for the '1240 proceeding on November 13, 2009. A first action on the merits was also mailed on November 13, 2009.

4. On January 12, 2010, the patent owner filed an amendment in response to the November 13, 2009 Office action. Patent owner also filed an information disclosure statement and a paper entitled "Reexamination – Patent Owner Power Of Attorney Or Revocation Of Power Of Attorney With A New Power of Attorney and Change of Correspondence Address."

5. On January 26, 2010, the patent owner filed a supplemental information disclosure statement.

6. On February 4, 2010, the third party requester filed a petition under 37 CFR 1.183, requesting waiver of the page limit requirement for written comments under 37 CFR 1.947 to patent owner's January 12, 2010 response, which written comments accompanied the petition. The third party requester's 37 CFR 1.183 petition is being addressed in a separate decision being mailed concurrently herewith.

7. On February 15, 2010, patent owner filed six petitions, which were entitled as follows: (1) "Petition Under 37 C.F.R. § 1.182 To Strike Requester Comments...And Conditional Petition To Strike Jeffay Declaration If Requestor's Petition To Suspend The Page Limitations Is Granted"; (2) "Petition Under 37 C.F.R. § 1.182 To Strike Requester Comments Referring To Alleged Chen Provisional Appendices"; (3) "Patentee's Petition Under 37 CFR § 1.182 To Strike Certain Pages Of The Requester's Comments Because They Contain The Requester's Argument For Claim Breadth Precluded By The Doctrine Of Judicial Estoppel"; (4) "Petition Under 37 CFR § 1.182 To Strike Requester's Petition To Suspend The Page Limitation"; (5) "Patentee's Petition Under 37 CFR § 1.183 To Suspend Application Of 37 CFR § 1.945(b)(1), To Allow Submission Of A Supplemental Response Addressing Requester's Recitation And Reliance On Wrong Claim Construction"; and (6) "Patentee's Petition Under 37 CFR § 1.183 To Suspend Application of 37 CFR § 1.945(b)(1), To Allow Submission Of A Supplemental Response Addressing Why A New Court Decision Interpreting The Patent-Under-Reexamination Supports Confirmation Of Certain Claims." Patent owner also filed a second supplemental information disclosure statement on February 15, 2010. This decision addresses petition (6). Petitions (4) and (5) are being addressed in separate decisions mailed concurrently herewith. The remaining patent owner petitions will be treated in due course by the Central Reexamination Unit (CRU).

8. On February 19, 2010, the third party requester filed oppositions under 37 CFR 1.182 to each of patent owner's February 15, 2010 petitions. The third party requester's oppositions to patent owner's petitions identified as (4)-(6) in the preceding paragraph are

being addressed in separate decisions mailed concurrently herewith. The remaining third party requester oppositions will be treated in due course by the Central Reexamination Unit.

9. On March 9, 2010, patent owner filed a third supplemental information disclosure statement.

10. On April 1, 2010, patent owner filed a fourth supplemental information disclosure statement.

RELEVANT REGULATORY PROVISIONS

37 CFR 1.111(a)(2)(i) states:

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.

37 CFR 1.183 states:

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

37 CFR 1.945(b)(1) states:

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.

DECISION ON PETITION

Patent Owner's Petition Under 37 CFR 1.183 of February 15, 2010

In the instant petition, patent owner requests suspension of 37 CFR 1.945(b)(1) to permit entry of a supplemental response that addresses "why a new court decision interpreting the patent-under-reexamination supports confirmation of certain claims."

Patent owner states that on February 5, 2010, the Eastern District of Virginia in *TeleCommunications Systems, Inc. v. Sybase, Inc.*, Case No. 09-cv-387 (E.D. Va.) revised its claim interpretation by narrowing its construction of the corresponding structure of the "translation module" of the patent claims under reexamination. The revised claim construction occurred after patent owner filed its January 12, 2010 response to the Office action. Patent owner states that "[i]n its January 12 submission, Patentee reasonably relied on the previous (broader) interpretation of corresponding structure by the same court" and "[i]n relying on this broader court claim construction, Patentee had no basis (at the time) to distinguish any applied art on the ground that the prior art lacked a disclosure of, or a reason to incorporate, the corresponding structure or equivalents thereof."

Patent owner acknowledges that the requirement of 37 CFR 1.945(b)(1), which incorporates 37 CFR 1.111(a)(2)(i), cannot be met. However, patent owner asserts that good cause exists for suspending the requirements of 37 CFR 1.954(b)(1). Patent owner states that: (1) "nothing can be more significant to examination of claims during *inter partes* reexamination than a court decision interpreting claim scope" (but acknowledges that the court decision is not binding), and (2) "this unique fact pattern will rarely occur."

The instant petition under 37 CFR 1.183 has been fully considered. Based on the above facts and the individual facts and circumstances of this proceeding, it is deemed equitable to permit the patent owner to file a supplemental response to address the recent court decision.

Accordingly, the petition under 37 CFR 1.183 is granted. Therefore, the supplemental response filed with the petition is being entered and will be considered by the examiner in due course.

The January 12, 2010 Change of Correspondence Address is Ineffective

On January 12, 2010, the patent owner filed a revocation of power of attorney with a new power of attorney and change of correspondence address in the '1240 proceeding. The official correspondence address of record for the patent owner in a reexamination proceeding, however, is the correspondence address as recorded in the patent file. See 37 CFR 1.33(c) and MPEP 2622. Office records fail to reveal that a change of correspondence address was received in the patent file, application No. 09/588,460. In the present case, the official correspondence address of record for the patent owner, as recorded in the patent file, application No. 09/588,460, is William H. Bollman, Manelli, Denison & Selter, PLLC, 2000 M Street, NW, Suite 700, Washington, DC 20036-3307.

A courtesy copy of this decision will be mailed to the correspondence address indicated on the January 12, 2010 patent owner change of correspondence address. In the absence of a proper submission of a change of correspondence address for the patent owner in the patent file, application No. 09/588,460, however, all future correspondence in this reexamination proceeding will be mailed ONLY to the official correspondence addresses of record for the patent owner and for the third party requester.

CONCLUSION

1. The patent owner petition under 37 CFR 1.183 to suspend 37 CFR 1.945(b)(1) to allow submission of a supplemental response addressing a court decision is granted.

2. The patent owner's supplemental response ("Supplemental Response Addressing Reconsidered Interpretation Of "Translation Module' Corresponding Structure") filed February 15, 2010, with the instant petition is being entered into the record and will be considered by the examiner.

3. **The third party requester has 30 days from the mailing date of this decision**, granting patent owner's petition under 37 CFR 1.183 and making patent owner's February 15, 2010 supplemental response enterable as of the mailing date of this decision, to file a comments paper pursuant to 37 CFR 1.947. In a decision mailed concurrently with this decision, the third party requester is given, with respect to its February 2010 comments, 30 days to file either a redacted or re-drafted comments paper under 37 CFR 1.947. The two sets of requester comments may be combined in one paper, and if such is done, separate sections should be used to address the patent owner's January 12, 2010 response and the patent owner's February 15, 2010 supplemental response. The section addressing patent owner's response shall not exceed 50 pages in length, and the section addressing the patent owner's supplemental response may include up to 50 pages but this section must be solely limited to addressing patent owner's supplemental response. To the extent that 37 CFR 1.943(b) requires waiver for this, it is hereby waived. If, however, the third party requester submits a separate comments paper directed to patent owner's supplemental response, that paper must be limited to addressing the patent owner's February 15, 2010 supplemental response which is being entered.

4. Jurisdiction over this proceeding is being returned to the Central Reexamination Unit for entry of the supplemental response, treatment of the petitions and opposition papers assigned to the Central Reexamination Unit, and to await the filing of any timely party papers.

5. Telephone inquiries related to this decision should be directed to Eugenia Jones, Senior Legal Advisor, at (571) 272-7727.

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

5-10-10

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,240	10/02/2009	6891811	2187.019REX0	5316

93344 7590 05/11/2010

EXAMINER

FLACHSBART & GREENSPOON, LLC
333 N. MICHIGAN AVE.
27TH FLOOR
CHICAGO, IL 60601

ART UNIT	PAPER NUMBER

DATE MAILED: 05/11/2010

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

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William H. Bollman
Manelli Denison & Selter, PLLC
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(For Patent Owner)

MAILED

MAY 11 2010

CENTRAL REEXAMINATION UNIT

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Sterne, Kessler, Goldstein & Fox, PLLC
1100 New York Ave, NW
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(For Third Party Requester)

Flachsbart & Greenspoon, LLC
333 N. Michigan Avenue
27th Floor
Chicago, IL 60601

(Courtesy Copy)

In re Smith et al.
Inter Partes Reexamination Proceeding
Control No.: 95/001,240
Filed: October 2, 2009
For: U.S. Patent No.: 6,891,811

DECISION DISMISSING PETITION AS MOOT

This is a decision on the patent owner's petition entitled "Patentee's Petition under 37 CFR § 1.183 to Suspend Application Of 37 CFR § 1.945(b)(1), To Allow Submission Of A Supplemental Response Addressing Requester's Recitation And Reliance On Wrong Claim Construction" filed February 15, 2010.

The petition and *inter partes* reexamination control number 95/001,240 are before the Office of Patent Legal Administration for consideration.

SUMMARY

The patent owner petition under 37 CFR 1.183 filed February 15, 2010 is dismissed as moot, for the reasons set forth below.

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

RELEVANT BACKGROUND

1. U.S. Patent number 6,891,811 (the '811 patent) issued on May 10, 2005.

2. A request for *inter partes* reexamination of the '811 patent was filed on October 2, 2009. The request was assigned control No. 95/001,240 (the '1240 proceeding).

3. Reexamination was ordered for the '1240 proceeding on November 13, 2009. A first action on the merits was also mailed on November 13, 2009.

4. On January 12, 2010, the patent owner filed an amendment in response to the November 13, 2009 Office action. Patent owner also filed an information disclosure statement and a paper entitled "Reexamination – Patent Owner Power Of Attorney Or Revocation Of Power Of Attorney With A New Power of Attorney and Change of Correspondence Address."

5. On January 26, 2010, the patent owner filed a supplemental information disclosure statement.

6. On February 4, 2010, the third party requester filed a petition under 37 CFR 1.183, requesting waiver of the page limit requirement for written comments under 37 CFR 1.947 to patent owner's January 12, 2010 response, which written comments accompanied the petition. The third party requester's 37 CFR 1.183 petition is being addressed in a separate decision being mailed concurrently herewith.

7. On February 15, 2010, patent owner filed six petitions, which were entitled as follows: (1) "Petition Under 37 C.F.R. § 1.182 To Strike Requester Comments...And Conditional Petition To Strike Jeffay Declaration If Requestor's Petition To Suspend The Page Limitations Is Granted"; (2) "Petition Under 37 C.F.R. § 1.182 To Strike Requester Comments Referring To Alleged Chen Provisional Appendices"; (3) "Patentee's Petition Under 37 CFR § 1.182 To Strike Certain Pages Of The Requester's Comments Because They Contain The Requester's Argument For Claim Breadth Precluded By The Doctrine Of Judicial Estoppel"; (4) "Petition Under 37 CFR § 1.182 To Strike Requester's Petition To Suspend The Page Limitation"; (5) "Patentee's Petition Under 37 CFR § 1.183 To Suspend Application Of 37 CFR § 1.945(b)(1), To Allow Submission Of A Supplemental Response Addressing Requester's Recitation And Reliance On Wrong Claim Construction"; and (6) "Patentee's Petition Under 37 CFR § 1.183 To Suspend Application of 37 CFR § 1.945(b)(1), To Allow Submission Of A Supplemental Response Addressing Why A New Court Decision Interpreting The Patent-Under-Reexamination Supports Confirmation Of Certain Claims." Patent owner also filed a second supplemental information disclosure statement on February 15, 2010. This decision addresses petition (5). Petitions (4) and (6) are being addressed in separate decisions mailed concurrently herewith. The remaining patent owner petitions will be treated in due course by the Central Reexamination Unit (CRU).

8. On February 19, 2010, the third party requester filed oppositions under 37 CFR 1.182 to each of patent owner's February 15, 2010 petitions. The third party requester's oppositions to patent owner's petitions identified as (4)-(6) in the preceding paragraph are

being addressed in separate decisions mailed concurrently herewith. The remaining third party requester oppositions will be treated in due course by the Central Reexamination Unit.

9. On March 9, 2010, patent owner filed a third supplemental information disclosure statement.

10. On April 1, 2010, patent owner filed a fourth supplemental information disclosure statement.

RELEVANT REGULATORY PROVISIONS

37 CFR 1.183 states:

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

37 CFR 1.945(b)(1) states:

> 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.

DECISION ON PETITION

Patent Owner's Petition Under 37 CFR 1.183 of February 15, 2010

In the instant petition, patent owner requests suspension of 37 CFR 1.945(b)(1) to permit entry of a supplemental response that addresses third party requester's "recitation and reliance on wrong claim construction."

The February 4, 2010 requester comments paper to which the present supplemental response is directed is being expunged in a decision mailed concurrently herewith. The third party requester's petition under 37 CFR 1.183 for page-limit waiver is being dismissed in the concurrently mailed decision; thus, the requester's February 4, 2010 written comments is not part of the record. Since the February 4, 2010 requester comments paper to which the present

supplemental response is directed is not part of the record, the instant patent owner petition is dismissed as moot.

Patent owner is advised, however, that the statute does not provide the patent owner with an opportunity to file a supplemental response to address the requester's comments. The Office stated the following when 37 CFR 1.945 was revised in 2007:

> A showing of sufficient cause will not be established by an explanation that the supplemental response is needed to address the requester's comments (on patent owner's response), and could not have been presented together with the original response because it was not known that requester would raise a particular point. The *inter partes* reexamination statute (35 U.S.C. 314) provides for the patent owner to respond to an Office action, and the requester to comment on that response. There is no intent in the statute to provide the patent owner with a chance to file a supplemental response to address the requester's comments. Indeed, 35 U.S.C. 314(b)(2) ends the iteration of addressing the Office action by stating that "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."

See Revisions and Technical Corrections Affecting Requirements for *Ex Parte* and *Inter Partes* Examination, 72 FR 18892, 18902 (Apr. 16, 2007)(final rule).

Therefore, even if the third party requester's comments had been entered, patent owner's petition to enter a supplemental response to address third party requester's comments could not be granted.

Pursuant to 37 CFR 1.939(a), "If an unauthorized paper is filed by any party at any time during the *inter partes* reexamination proceeding it will not be considered and may be returned." Since the patent owner's petition under 37 CFR 1.183 is not being granted, the supplemental response filed with the petition does not have a right of entry into the record of the present reexamination proceeding, and, as such, is not an authorized paper. Because the paper was incorporated into the electronic Image File Wrapper (IFW) for the proceeding, the original patent owner paper cannot be physically returned to the patent owner. Rather, the patent owner's supplemental response paper filed February 15, 2010 with the instant petition will be expunged from the record by marking it "non-public" and "closed" in the IFW. See MPEP 2667. A copy of this decision will be made of record in the IFW.

The January 12, 2010 Change of Correspondence Address is Ineffective

On January 12, 2010, the patent owner filed a revocation of power of attorney with a new power of attorney and change of correspondence address in the '1240 proceeding. The official correspondence address of record for the patent owner in a reexamination proceeding, however, is the correspondence address as recorded in the patent file. See 37 CFR 1.33(c) and MPEP 2622. Office records fail to reveal that a change of correspondence address was received in the patent file, application No. 09/588,460. In the present case, the official correspondence address of record for the patent owner, as recorded in the patent file, application No. 09/588,460, is

William H. Bollman, Manelli, Denison & Selter, PLLC, 2000 M Street, NW, Suite 700, Washington, DC 20036-3307.

A courtesy copy of this decision will be mailed to the correspondence address indicated on the January 12, 2010 patent owner change of correspondence address. In the absence of a proper submission of a change of correspondence address for the patent owner in the patent file, application No. 09/588,460, however, all future correspondence in this reexamination proceeding will be mailed ONLY to the official correspondence addresses of record for the patent owner and for the third party requester.

CONCLUSION

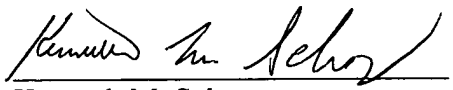
1. The patent owner petition under 37 CFR 1.183 to suspend 37 CFR 1.945(b)(1) to permit submission of a supplemental response addressing requester's comments is dismissed as moot.

2. The patent owner's supplemental response filed February 15, 2010, with the instant petition is refused entry into the record, as it is not an authorized paper. Because the patent owner's supplemental response paper was previously incorporated into the IFW for the present reexamination proceeding, the paper is being expunged from the record by marking it "non-public" and "closed" in the IFW. The patent owner's supplemental response paper filed February 15, 2010, will not constitute part of the record of the present reexamination proceeding.

3. A copy of this decision will be made of record in the IFW of the '1240 *inter partes* reexamination proceeding.

4. Jurisdiction over this proceeding is being returned to the Central Reexamination Unit for treatment of the petitions and opposition papers assigned to the Central Reexamination Unit, and to await the filing of any timely party papers.

5. Telephone inquiries related to this decision should be directed to Eugenia Jones, Senior Legal Advisor, at (571) 272-7727.



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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,240	10/02/2009	6891811	2187.019REX0	5316

93344 7590 05/11/2010

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333 N. MICHIGAN AVE.
27TH FLOOR
CHICAGO, IL 60601

EXAMINER	
ART UNIT	PAPER NUMBER

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William H. Bollman
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(For Patent Owner)

MAILED

MAY 11 2010

CENTRAL REEXAMINATION UNIT

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(Courtesy Copy)

In re Smith et al.
Inter Partes Reexamination Proceeding
Control No.: 95/001,240
Filed: October 2, 2009
For: U.S. Patent No.: 6,891,811

DECISION REFUSING ENTRY OF PAPERS

This is a decision on the third party requester petition papers entitled "Opposition Under 37 C.F.R. § 1.182 to Patentee's 'Petition Under 37 CFR § 1.183 To Suspend Application of 37 CFR § 1.945(b)(1), To Allow Submission of a Supplemental Response Addressing Requester's Recitation and Reliance On Wrong Claim Construction'" and "Opposition Under 37 C.F.R. § 1.182 to Patentee's 'Petition Under 37 CFR 1.183 To Suspend Application of 37 CFR 1.945(b)(1), To Allow Submission of a Supplemental Response Addressing Why a New Court Decision Interpreting the Patent-Under-Reexamination Supports Confirmation of Certain Claims'" both filed February 19, 2010.

The above-referenced third party requester petition papers and *inter partes* reexamination control number 95/001,240 are before the Office of Patent Legal Administration for consideration.

SUMMARY

The above-referenced third party requester petition papers filed February 19, 2010 are refused entry into the record, without consideration on the merits, for the reasons set forth below. Both papers are being expunged from the record.

The third party requester has paid the petition fee of $400.00 pursuant to 37 CFR 1.17(f) for each petition under 37 CFR 1.182.

RELEVANT BACKGROUND

1. U.S. Patent number 6,891,811 (the '811 patent) issued on May 10, 2005.

2. A request for *inter partes* reexamination of the '811 patent was filed on October 2, 2009. The request was assigned control No. 95/001,240 (the '1240 proceeding).

3. Reexamination was ordered for the '1240 proceeding on November 13, 2009. A first action on the merits was also mailed on November 13, 2009.

4. On January 12, 2010, the patent owner filed an amendment in response to the November 13, 2009 Office action. Patent owner also filed an information disclosure statement and a paper entitled "Reexamination – Patent Owner Power Of Attorney Or Revocation Of Power Of Attorney With A New Power of Attorney and Change of Correspondence Address."

5. On January 26, 2010, the patent owner filed a supplemental information disclosure statement.

6. On February 4, 2010, the third party requester filed a petition under 37 CFR 1.183, requesting waiver of the page limit requirement for written comments under 37 CFR 1.947 to patent owner's January 12, 2010 response, which written comments accompanied the petition. The third party requester petition under 37 CFR 1.183 is being addressed in a separate decision mailed concurrently herewith.

7. On February 15, 2010, patent owner filed six petitions, which were entitled as follows: (1) "Petition Under 37 C.F.R. § 1.182 To Strike Requester Comments...And Conditional Petition To Strike Jeffay Declaration If Requestor's Petition To Suspend The Page Limitations Is Granted"; (2) "Petition Under 37 C.F.R. § 1.182 To Strike Requester Comments Referring To Alleged Chen Provisional Appendices"; (3) "Patentee's Petition Under 37 CFR § 1.182 To Strike Certain Pages Of The Requester's Comments Because They Contain The Requester's Argument For Claim Breadth Precluded By The Doctrine Of Judicial Estoppel"; (4) "Petition Under 37 CFR § 1.182 To Strike Requester's Petition To Suspend The Page Limitation"; (5) "Patentee's Petition Under 37 CFR § 1.183 To Suspend Application Of 37 CFR § 1.945(b)(1), To Allow Submission Of A Supplemental Response Addressing Requester's Recitation And Reliance On Wrong Claim Construction"; and (6) "Patentee's Petition Under 37 CFR § 1.183 To Suspend Application of 37 CFR § 1.945(b)(1), To Allow Submission Of A Supplemental Response Addressing Why A New Court Decision Interpreting The Patent-Under-Reexamination Supports Confirmation Of Certain Claims." Patent owner also filed a second supplemental information disclosure statement on February 15, 2010. Petitions (4)-(6) are being addressed in separate decisions mailed concurrently herewith. The remaining patent owner petitions will be treated in due course by the Central Reexamination Unit (CRU).

8. On February 19, 2010, the third party requester filed oppositions under 37 CFR 1.182 to each of patent owner's February 15, 2010 petitions. The instant decision addresses the third party requester's oppositions to patent owner's petitions identified as (5) and (6) in the preceding paragraph. Third party requester's opposition to patent owner's petition identified as (4) in the preceding paragraph is addressed in the decision on that petition mailed concurrently herewith. The remaining third party requester oppositions will be treated in due course by the Central Reexamination Unit.

9. On March 9, 2010, patent owner filed a third supplemental information disclosure statement.

10. On April 1, 2010, patent owner filed a fourth supplemental information disclosure statement.

RELEVANT AUTHORITY

35 U.S.C. 314(b)(2) states:

> Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.

37 CFR 1.182 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 1.939(a) states:

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

37 CFR 1.947 states, in pertinent part:

> Each time the patent owner files a response to an Office action on the merits pursuant to § 1.945, a third party requester may once file written comments within a period of 30 days from the date of service of the patent owner's response.

DECISION ON PETITION

Third Party Requester Opposition Petitions of February 19, 2010

On February 19, 2010, third party requester filed the instant petitions under 37 CFR 1.182 in opposition to patent owner's two petitions under 37 CFR 1.183 each requesting suspension of 37 CFR 1.945(b)(1) to permit entry of a supplemental response.

The February 19, 2010, third party requester petitions under 37 CFR 1.182 opposing patent owner's February 15, 2010 petitions under 37 CFR 1.183 do not have an entry right in the instant proceeding, for the reasons set forth below.

Pursuant to 35 U.S.C. § 314(b)(2), the third party requester in an ordered *inter partes* reexamination proceeding has a statutory right to once file written comments to a patent owner's response to an Office action on the merits. This right is implemented by 37 CFR 1.947, which provides that a third party requester may once file written comments within 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 February 15, 2010 petitions under 37 CFR 1.183, requesting suspension of 37 CFR 1.945(b)(1) to permit entry of a supplemental response, however, are not responses to an Office action on the merits. 35 U.S.C. 314(b)(2) does not provide any right for the third party requester to file an opposition to, or otherwise comment on a patent owner's petition under 37 CFR 1.183 for suspension of the rules.

Whether a patent owner's petition under 37 CFR 1.183 for suspension of the rules is grantable is an issue that goes to procedure and a showing of equities, rather than to the merits. While enactment of the *inter partes* reexamination statute was for the purpose of expanding a third party requester's participation in the merits of the proceeding, there is no indication whatsoever in the legislative history of the *inter partes* reexamination statute that the requester was granted any right to challenge the granting of a petition under 37 CFR 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 is precursor bills), and there is no evidence to indicate that such a right was ever contemplated by Congress.

A third party requester's opposition petition in response to a patent owner's petition for suspension of 37 CFR 1.945(b)(1) to permit entry of a supplemental response 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. Third party requester's oppositions to patent owner's petitions under 37 CFR 1.183, therefore, are not enterable into the record.

Pursuant to 37 CFR 1.939(a), "If an unauthorized paper is filed by any party at any time during the *inter partes* reexamination proceeding it will not be considered and may be returned." For the reasons discussed above, the third party requester's petitions filed February 19, 2010 in opposition to patent owner's February 15, 2010 petitions under 37 CFR 1.183 do not have a right of entry into the record of the present reexamination proceeding, and, as such, the papers are not authorized papers. Because these petition papers were incorporated into the electronic Image

File Wrapper (IFW) for the proceeding, the original third party requester papers cannot be physically returned to the third party requester. Rather, these third party requester papers will be expunged from the record by marking the papers "non-public" and "closed" in the IFW. See MPEP 2667. A copy of this decision will be made of record in the IFW.

The January 12, 2010 Change of Correspondence Address is Ineffective

On January 12, 2010, the patent owner filed a revocation of power of attorney with a new power of attorney and change of correspondence address in the '1240 proceeding. The official correspondence address of record for the patent owner in a reexamination proceeding, however, is the correspondence address as recorded in the patent file. See 37 CFR 1.33(c) and MPEP 2622. Office records fail to reveal that a change of correspondence address was received in the patent file, application No. 09/588,460. In the present case, the official correspondence address of record for the patent owner, as recorded in the patent file, application No. 09/588,460, is William H. Bollman, Manelli, Denison & Selter, PLLC, 2000 M Street, NW, Suite 700, Washington, DC 20036-3307.

A courtesy copy of this decision will be mailed to the correspondence address indicated on the January 12, 2010 patent owner change of correspondence address. In the absence of a proper submission of a change of correspondence address for the patent owner in the patent file, application No. 09/588,460, however, all future correspondence in this reexamination proceeding will be mailed ONLY to the official correspondence addresses of record for the patent owner and for the third party requester.

CONCLUSION

1. The third party requester's opposition petitions under 37 CFR 1.182 filed February 19, 2010, opposing patent owner's petitions under 37 CFR 1.183, are refused entry into the record, as the papers are not authorized papers. Because these third party requester papers were previously incorporated into the IFW for the present reexamination proceeding, the papers are being expunged from the record by marking the papers "non-public" and "closed" in the IFW. These third party requester petition papers filed February 19, 2010, will not constitute part of the record of the present reexamination proceeding.

2. A copy of this decision will be made of record in the IFW of the '1240 *inter partes* reexamination proceeding.

3. Jurisdiction over this proceeding is being returned to the Central Reexamination Unit for treatment of the petitions and opposition papers assigned to the Central Reexamination Unit, and to await the filing of any timely party papers.

4. Telephone inquiries related to this decision should be directed to Eugenia Jones, Senior Legal Advisor, at (571) 272-7727.

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

5-10-10

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93344 7590 05/11/2010

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MAY 11 2010

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(Courtesy Copy)

In re Smith et al.
Inter Partes Reexamination Proceeding
Control No.: 95/001,240
Filed: October 2, 2009
For: U.S. Patent No.: 6,891,811

DECISION DISMISSING PETITION

This is a decision on the third party requester's petition entitled "Petition under 37 C.F.R. § 1.183 to Suspend the Page Limitation of 37 C.F.R. § 1.943(b)" filed February 4, 2010.

The petition and *inter partes* reexamination control number 95/001,240 are before the Office of Patent Legal Administration for consideration.

SUMMARY

The third party requester petition under 37 CFR 1.183 filed February 4, 2010 is dismissed, for the reasons set forth below.

The third party requester has paid the petition fee of $400.00 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183.

RELEVANT BACKGROUND

1. U.S. Patent number 6,891,811 (the '811 patent) issued on May 10, 2005.

2. A request for *inter partes* reexamination of the '811 patent was filed on October 2, 2009. The request was assigned control No. 95/001,240 (the '1240 proceeding).

3. Reexamination was ordered for the '1240 proceeding on November 13, 2009. A first action on the merits was also mailed on November 13, 2009.

4. On January 12, 2010, the patent owner filed an amendment in response to the November 13, 2009 Office action. Patent owner also filed an information disclosure statement and a paper entitled "Reexamination – Patent Owner Power Of Attorney Or Revocation Of Power Of Attorney With A New Power of Attorney and Change of Correspondence Address."

5. On January 26, 2010, the patent owner filed a supplemental information disclosure statement.

6. On February 4, 2010, the third party requester filed the instant petition under 37 CFR 1.183, requesting waiver of the page limit requirement for written comments under 37 CFR 1.947 to patent owner's January 12, 2010 response, which written comments accompanied the petition.

7. On February 15, 2010, patent owner filed six petitions, which were entitled as follows: (1) "Petition Under 37 C.F.R. § 1.182 To Strike Requester Comments...And Conditional Petition To Strike Jeffay Declaration If Requestor's Petition To Suspend The Page Limitations Is Granted"; (2) "Petition Under 37 C.F.R. § 1.182 To Strike Requester Comments Referring To Alleged Chen Provisional Appendices"; (3) "Patentee's Petition Under 37 CFR § 1.182 To Strike Certain Pages Of The Requester's Comments Because They Contain The Requester's Argument For Claim Breadth Precluded By The Doctrine Of Judicial Estoppel"; (4) "Petition Under 37 CFR § 1.182 To Strike Requester's Petition To Suspend The Page Limitation"; (5) "Patentee's Petition Under 37 CFR § 1.183 To Suspend Application Of 37 CFR § 1.945(b)(1), To Allow Submission Of A Supplemental Response Addressing Requester's Recitation And Reliance On Wrong Claim Construction"; and (6) "Patentee's Petition Under 37 CFR § 1.183 To Suspend Application of 37 CFR § 1.945(b)(1), To Allow Submission Of A Supplemental Response Addressing Why A New Court Decision Interpreting The Patent-Under-Reexamination Supports Confirmation Of Certain Claims." Patent owner also filed a second supplemental information disclosure statement on February 15, 2010. Petitions (4)-(6) are being addressed in separate decisions mailed concurrently herewith. The remaining patent owner petitions will be treated in due course by the Central Reexamination Unit (CRU).

8. On February 19, 2010, the third party requester filed oppositions under 37 CFR 1.182 to each of patent owner's February 15, 2010 petitions. The third party requester's oppositions to patent owner's petitions identified as (4)-(6) in the preceding paragraph are being addressed in separate decisions mailed concurrently herewith. The remaining third party requester oppositions will be treated in due course by the Central Reexamination Unit.

9. On March 9, 2010, patent owner filed a third supplemental information disclosure statement.

10. On April 1, 2010, patent owner filed a fourth supplemental information disclosure statement.

RELEVANT REGULATORY PROVISIONS

37 CFR 1.183 states:

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

37 CFR 1.943(b) states:

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

DECISION ON PETITION

Third Party Requester Petition of February 4, 2010

In the instant petition, petitioner requests waiver of the 50-page limit in 37 CFR 1.943(b) for written comments by the third party requester. While the petitioner initially states that the "Comments" do not exceed 50 pages and that the "Declaration" is limited to factual evidence, a review of the declaration under 37 CFR 1.132 reveals that it is replete with legal argument as opposed to factual evidence, as discussed below. Therefore, the 65 pages of the declaration under 37 CFR 1.132 are included in the page limit count for written comments by the third party requester, in addition to the 50 pages labeled as "Comments by Third Party Requester to Patent Owner's Response in *Inter Partes* Reexamination under 37 C.F.R. § 1.947." Accordingly, the petition under 37 CFR 1.183 will be addressed.

Petitioner requests waiver of 37 CFR 1.943(b) on the basis that the page limitation is not required by statute and suspending the rules "would be fair and just, because Requester has limited the Comments to no more than 50 pages; (2) good faith effort has been made to limit the Declaration to factual evidence; and (3) any determination by the Examiner that the Declaration contains non-factual evidence is inherently subjective and a conclusion over which reasonable minds may disagree."

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 the petitioner to set forth, with specificity, the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. General requests, unsubstantiated by specific facts to justify an increase in the number of pages available for written comments under 37 CFR 1.947, are not sufficient to demonstrate an extraordinary situation in which justice requires suspension of 37 CFR 1.943(b).

In this instance, petitioner effectively seeks waiver of 37 CFR 1.943(b) to increase the page limit by 65 pages, since the written comments under 37 CFR 1.947 include the 65-page declaration under 37 CFR 1.132. The pages of the declaration under 37 CFR 1.132 are being counted since, as pointed out above, the declaration is replete with legal argument. See MPEP 2667(I)(A)(2). For example, it is clear from paragraphs 3-5 of the declaration that the declarant, Mr. Kevin Jeffay, is offering his opinions throughout the declaration. Mr. Jeffay makes multiple references to "the opinions" and "my opinions." Furthermore, how one of ordinary skill in the art would understand the claims, how one of ordinary skill in the art would understand the applied references, and whether one of ordinary skill in the art would understand the references to anticipate or render obvious the claims under reexamination are all opinions of Mr. Jeffay. Some examples of specific statements in the declaration that are legal argument include the following: (1) "one of ordinary skill in the art in the 2000 time frame reading claims 1 and 6 in light of the specification would have understood..." (paragraph 26); (2) "A person of ordinary skill in the art in the 2000 time frame reading the claims of the '811 Patent would understand that..." (paragraph 34); (3) "one of ordinary skill in the art would not understand the inventors to have been in possession of such an invention at the time of their application for the '811 Patent" (paragraph 35); (4) "To the extent that patentee is claiming that the Nokia I reference does not teach the insertion of a short message into an HTTP protocol message...I disagree" (paragraph 52); (5) "The use of either type of message in combination with the systems disclosed in the Nokia I reference would have been obvious to a person of ordinary skill because..." (paragraph 70); (6) "one of ordinary skill in the art would be motivated to consider RFC 2068" (paragraph 90); and (7) "one of ordinary skill in the art would have been motivated to combine these references" (paragraph 133). These are legal arguments and/or conclusions.

Petitioner has not set forth with specificity any facts that would give rise to an extraordinary situation in which justice would require waiving the page limit requirement of 37 CFR 1.943(b). A mere allegation that reasonable minds may differ regarding what is non-factual evidence does not in any way satisfy petitioner's burden. It is noted that the patent owner's response to the Office action is 50 pages (excluding amendments). In addition, the issues involved in this reexamination proceeding do not appear to be of an amount and degree of complexity which would constitute an extraordinary situation. Therefore, requester has not made an adequate showing of why the third party requester should need to submit more than 50 pages of written comments.

Furthermore, a cursory review of the written comments (including the declaration under 37 CFR 1.132) filed with the instant petition also reveals that the third party requester does not appear to have made any attempt to economize the written comments such as by eliminating extraneous material and the repetition of information already of record.

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.

Pursuant to 37 CFR 1.939(a), "If an unauthorized paper is filed by any party at any time during the *inter partes* reexamination proceeding it will not be considered and may be returned." Since the third party requester's written comments paper (including the declaration under 37 CFR 1.132 with attachments) exceeds the page limit requirement set forth in 37 CFR 1.943(b), it does not have a right of entry into the record of the present reexamination proceeding, and, as such, is not an authorized paper. Because the paper was incorporated into the electronic Image File Wrapper (IFW) for the proceeding, the original third party requester paper cannot be physically returned to the third party requester. Rather, the third party requester's February 4, 2010 written comments paper will be expunged from the record by marking it "non-public" and "closed" in the IFW. See MPEP 2667. A copy of this decision will be made of record in the IFW.

The January 12, 2010 Change of Correspondence Address is Ineffective

On January 12, 2010, the patent owner filed a revocation of power of attorney with a new power of attorney and change of correspondence address in the '1240 proceeding. The official correspondence address of record for the patent owner in a reexamination proceeding, however, is the correspondence address as recorded in the patent file. See 37 CFR 1.33(c) and MPEP 2622. Office records fail to reveal that a change of correspondence address was received in the patent file, application No. 09/588,460. In the present case, the official correspondence address of record for the patent owner, as recorded in the patent file, application No. 09/588,460, is William H. Bollman, Manelli, Denison & Selter, PLLC, 2000 M Street, NW, Suite 700, Washington, DC 20036-3307.

A courtesy copy of this decision will be mailed to the correspondence address indicated on the January 12, 2010 patent owner change of correspondence address. In the absence of a proper submission of a change of correspondence address for the patent owner in the patent file, application No. 09/588,460, however, all future correspondence in this reexamination proceeding will be mailed ONLY to the official correspondence addresses of record for the patent owner and for the third party requester.

CONCLUSION

1. The third party requester petition under 37 CFR 1.183 to suspend 37 CFR 1.943(b) is dismissed.

2. The third party requester's written comments paper filed February 4, 2010, is refused entry into the record, as it is not an authorized paper. Because the third party requester's comments paper was previously incorporated into the IFW for the present reexamination proceeding, the paper is being expunged from the record by marking it "non-public" and "closed" in the IFW. The third party requester's comments paper filed February 4, 2010, will not constitute part of the record of the present reexamination proceeding.

3. A copy of this decision will be made of record in the IFW of the '1240 *inter partes* reexamination proceeding.

4. In a decision mailed concurrently with this decision, the third party requester has been given thirty days to file comments to a supplemental patent owner response. Accordingly, **the third party requester is given a period of thirty (30) days from the date of this decision** in which to file either a redacted or re-drafted comments paper under 37 CFR 1.947 that is appropriately labeled as such, and complies with 37 CFR 1.943(b). The two sets of requester comments may be combined in one paper, and if such is done, separate sections should be used to address the patent owner's January 12, 2010 response and patent owner's February 15, 2010 supplemental response. The section addressing patent owner's response shall not exceed 50 pages in length, and the section addressing the patent owner's supplemental response may include up to 50 pages but this section must be solely limited to addressing patent owner's supplemental response. To the extent that 37 CFR 1.943(b) requires waiver for this, it is hereby waived.

5. Jurisdiction over this proceeding is being returned to the Central Reexamination Unit for treatment of the petitions and opposition papers assigned to the Central Reexamination Unit, and to await the filing of any timely party papers.

6. Telephone inquiries related to this decision should be directed to Eugenia Jones, Senior Legal Advisor, at (571) 272-7727.

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

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For: U.S. Patent No.: 6,891,811

DECISION DISMISSING PETITION

This is a decision on the patent owner petition entitled "Petition Under 37 CFR § 1.182 To Strike Requester's Petition To Suspend The Page Limitation" filed February 15, 2010. This decision also addresses third party requester's opposition petition entitled "Opposition Under 37 C.F.R. § 1.182 to Patentee's 'Petition Under 37 CFR 1.182 to Strike Requester's Petition To Suspend the Page Limit'" filed February 19, 2010.

The above-referenced petitions and *inter partes* reexamination control number 95/001,240 are before the Office of Patent Legal Administration for consideration.

SUMMARY

The above-referenced patent owner petition under 37 CFR 1.182 is dismissed, for the reasons set forth below.

The patent owner has paid the petition fee of $400.00 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.182 and the third party requester has paid the petition fee of $400.00 pursuant to 37 CFR 1.17(f) for the opposition petition under 37 CFR 1.182.

RELEVANT BACKGROUND

1. U.S. Patent number 6,891,811 (the '811 patent) issued on May 10, 2005.

2. A request for *inter partes* reexamination of the '811 patent was filed on October 2, 2009. The request was assigned control No. 95/001,240 (the '1240 proceeding).

3. Reexamination was ordered for the '1240 proceeding on November 13, 2009. A first action on the merits was also mailed on November 13, 2009.

4. On January 12, 2010, the patent owner filed an amendment in response to the November 13, 2009 Office action. Patent owner also filed an information disclosure statement and a paper entitled "Reexamination – Patent Owner Power Of Attorney Or Revocation Of Power Of Attorney With A New Power of Attorney and Change of Correspondence Address."

5. On January 26, 2010, the patent owner filed a supplemental information disclosure statement.

6. On February 4, 2010, the third party requester filed a petition under 37 CFR 1.183, requesting waiver of the page limit requirement for written comments under 37 CFR 1.947 to patent owner's January 12, 2010 response, which written comments accompanied the petition. The third party requester petition under 37 CFR 1.183 is being addressed in a separate decision mailed concurrently herewith.

7. On February 15, 2010, patent owner filed six petitions, which were entitled as follows: (1) "Petition Under 37 C.F.R. § 1.182 To Strike Requester Comments...And Conditional Petition To Strike Jeffay Declaration If Requestor's Petition To Suspend The Page Limitations Is Granted"; (2) "Petition Under 37 C.F.R. § 1.182 To Strike Requester Comments Referring To Alleged Chen Provisional Appendices"; (3) "Patentee's Petition Under 37 CFR § 1.182 To Strike Certain Pages Of The Requester's Comments Because They Contain The Requester's Argument For Claim Breadth Precluded By The Doctrine Of Judicial Estoppel"; (4) "Petition Under 37 CFR § 1.182 To Strike Requester's Petition To Suspend The Page Limitation"; (5) "Patentee's Petition Under 37 CFR § 1.183 To Suspend Application Of 37 CFR § 1.945(b)(1), To Allow Submission Of A Supplemental Response Addressing Requester's Recitation And Reliance On Wrong Claim Construction"; and (6) "Patentee's Petition Under 37 CFR § 1.183 To Suspend Application of 37 CFR § 1.945(b)(1), To Allow Submission Of A Supplemental Response Addressing Why A New Court Decision Interpreting The Patent-Under-Reexamination Supports Confirmation Of Certain Claims." Patent owner also filed a second supplemental information disclosure statement on February 15, 2010. The instant decision addresses petition (4). Petitions (5) and (6) are being addressed in separate decisions mailed concurrently herewith. The remaining patent owner petitions will be treated in due course by the Central Reexamination Unit (CRU).

8. On February 19, 2010, the third party requester filed oppositions under 37 CFR 1.182 to each of patent owner's February 15, 2010 petitions. The instant decision addresses the

third party requester's opposition to patent owner's petition identified as (4) in the preceding paragraph. Third party requester's oppositions to patent owner's petitions identified as (5) and (6) in the preceding paragraph are being addressed in a separate decision being mailed concurrently herewith. The remaining third party requester oppositions will be treated in due course by the Central Reexamination Unit.

9. On March 9, 2010, patent owner filed a third supplemental information disclosure statement.

10. On April 1, 2010, patent owner filed a fourth supplemental information disclosure statement.

RELEVANT AUTHORITY

37 CFR 1.182 states:

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

37 CFR 1.183 states:

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

DECISION ON PETITION

Patent Owner's Petition Under 37 CFR 1.182 and Requester's Opposition

In the instant patent owner petition under 37 CFR 1.182 filed February 15, 2010, patent owner requests that the third party requester's petition under 37 CFR 1.183 to suspend the page limitation of 37 CFR 1.943(b) be stricken. On February 19, 2010, third party requester filed the instant petition under 37 CFR 1.182 in opposition to patent owner's petition. Since the third party requester's opposition is opposing patent owner's petition to strike the third party requester's petition and thus relates to the propriety (and consideration) of third party requester's petition, the opposition petition is being entered into the record.

The patent owner petition to strike states that patentee opposes the third party requester's petition to suspend 37 CFR 1.943(b) and that, accordingly, patentee requests the third party requester's petition, and the accompanying declaration under 37 CFR 1.132, be stricken. Patent owner has not set forth any basis for striking or expunging the third party requester's 37 CFR 1.183 petition from the record. A third party requester is permitted to file a petition under 37 CFR 1.183 to waive the page limit requirement of 37 CFR 1.943(b). Note that 37 CFR 1.183 permits an "interested party" to file a petition to suspend or waive a requirement of the regulations that is not a requirement of the statutes. Therefore, there is no basis for striking the third party requester's 37 CFR 1.183 petition itself. Whether the third party requester's petition under 37 CFR 1.183 is granted is a separate issue which is being addressed in a separate decision on that petition. Patent owner's arguments as to why the third party requester's declaration under 37 CFR 1.132 should be counted in the page limit, why 37 CFR 1.943(b) should not be suspended, and why the declaration under 37 CFR 1.132 should be stricken are not being addressed in this decision.

The third party requester's opposition petition does not set forth any arguments as to why the third party requester's petition under 37 CFR 1.183 should not be stricken and, instead, the arguments relate to why the submission of the declaration under 37 CFR 1.132 was proper, why it should not count towards the page limit, and why 37 CFR 1.943(b) should be suspended. While the arguments in the opposition petition are noted, they are not being specifically addressed in this decision.

Accordingly, patent owner's February 15, 2010 petition under 37 CFR 1.182 to strike the third party requester's petition is dismissed.

The January 12, 2010 Change of Correspondence Address is Ineffective

On January 12, 2010, the patent owner filed a revocation of power of attorney with a new power of attorney and change of correspondence address in the '1240 proceeding. The official correspondence address of record for the patent owner in a reexamination proceeding, however, is the correspondence address as recorded in the patent file. See 37 CFR 1.33(c) and MPEP 2622. Office records fail to reveal that a change of correspondence address was received in the patent file, application No. 09/588,460. In the present case, the official correspondence address of record for the patent owner, as recorded in the patent file, application No. 09/588,460, is William H. Bollman, Manelli, Denison & Selter, PLLC, 2000 M Street, NW, Suite 700, Washington, DC 20036-3307.

A courtesy copy of this decision will be mailed to the correspondence address indicated on the January 12, 2010 patent owner change of correspondence address. In the absence of a proper submission of a change of correspondence address for the patent owner in the patent file, application No. 09/588,460, however, all future correspondence in this reexamination proceeding will be mailed ONLY to the official correspondence addresses of record for the patent owner and for the third party requester.

CONCLUSION

1. The patent owner's petition under 37 CFR 1.182 to strike third party requester's petition to suspend the page limitation is dismissed.

2. Jurisdiction over this proceeding is being returned to the Central Reexamination Unit for treatment of the petitions and opposition papers assigned to the Central Reexamination Unit, and to await the filing of any timely party papers.

3. Telephone inquiries related to this decision should be directed to Eugenia Jones, Senior Legal Advisor, at (571) 272-7727.

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

5-10-10
Kenpet8/IP

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,240	10/02/2009	6891811	2187.019REX0	5316

93344 7590 05/19/2010

FLACHSBART & GREENSPOON, LLC
333 N. MICHIGAN AVE.
27TH FLOOR
CHICAGO, IL 60601

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 05/19/2010

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

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(For Patent Owner) MAILED

MAY 19 2010

CENTRAL REEXAMINATION UNIT

WILLIAM H. BOLLMAN
MANELL DENISON & SELTER PLLC
2000 M STREET, NW
SUITE 700
WASHINGTON DC 20036-3307

(For Requester)

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

(Courtesy Copy)

FLACHSBART & GREENSPOON, LLC
333 N. MICHIGAN AVE.
27TH FLOOR
CHICAGO, IL 60601

In re: Smith *et alia*
Reexamination Proceeding
Control No. 95/001,240
Request Deposited: October 2, 2009
For: U.S. Patent No. 6,891,811

DECISION

The *inter partes* reexamination is before the Central Reexamination Unit to address the following papers:

1) The Patent Owner (PO) paper filed February 15, 2010 entitled "PATENTEE'S PETITION UNDER 37 CFR §1.182 TO STRIKE CERTAIN PAGES OF THE REQUESTER'S COMMENTS BECAUSE THEY CONTAIN THE REQUESTER'S ARGUMENT FOR CLAIM BREADTH PRECLUDED BY THE DOCTRINE OF JUDICIAL ESTOPPEL".

2) The PO paper filed February 15, 2010 entitled "PETITION UNDER 37 CFR §1.182 TO STRIKE REQUESTER COMMENTS REFERRING TO ALLEGED CHEN PROVISIONAL APPENDICES".

3) The PO paper filed February 15, 2010 entitled "PETITION UNDER 37 CFR §1.182 TO STRIKE REQUESTER COMMENTS THAT RELY ON IMPROPER CITATIONS TO MATTER THAT IS NOT CITABLE IN A REEXAMINATION, AND CONDITIONAL PETITION TO STRIKE JEFFAY DECLARATION IF REQUESTOR'S PETITION TO SUSPEND THE PAGE LIMITATION IS GRANTED".

4) The Third Party Requester (3PR) paper filed February 19, 2010 entitled "Opposition Under 37 C.F.R. §1.182 to Patentee's "Petition Under 37 CFR §1.182 to Strike Certain Pages of the Requester's Comments Because They Contain the Requester's Argument for Claim Breadth Precluded by the Doctrine of Judicial Estoppel"

5) The 3PR paper filed February 19, 2010 entitled "Opposition Under 37 C.F.R. §1.182 to Patentee's "Petition Under 37 CFR 1.182 to Strike Requester Comments That Rely on Improper Citations to Matter That Is Not Citable In a Reexamination, and Conditional Petition to Strike Jeffay Declaration If Requestor's Petition to Suspend the Page Limitation Is Granted"

FINDINGS and DECISION

One of the decisions mailed May 11, 2010 refused entry of the February 4, 2010 written comments paper including the declaration under 37 CFR 1.132. The comments paper was expunged from the record and does not constitute part of the record of the present reexamination proceeding.

Accordingly, the three petitions listed above filed by Patent Owner on February 15, 2010 requesting that various portions of those comments be stricken are **dismissed as moot**.

In view of various comments in said petitions that are directed to a paper that has been expunged from the record and does not constitute part of the record of the present reexamination proceeding, the three petitions are similarly **expunged** from the record. Because the petition papers were incorporated into the electronic Image File Wrapper (IFW) for the proceeding, the papers can not be physically returned. Rather, these papers will be expunged from the file by marking the papers "non-public" and "closed" in the IFW.

The two opposition petitions listed above filed by Third-Party Requester are similarly **expunged** from the record.

PATENT OWNER'S CORRESPONDENCE ADDRESS

The January 12, 2010 Change of Correspondence Address is Ineffective

On January 12, 2010, the patent owner filed a revocation of power of attorney with a new power of attorney and change of correspondence address in the '1240 proceeding. The official correspondence address of record for the patent owner in a reexamination proceeding, however, is the correspondence address as recorded in the patent file. See 37 CFR 1.33(c) and MPEP 2622. Office records fail to reveal that a change of correspondence address was received in the patent file, application No. 09/588,460. In the present case, the official correspondence address of record for the patent owner, as recorded in the patent file, application No. 09/588,460, is

WILLIAM H. BOLLMAN
MANELL DENISON & SELTER PLLC
2000 M STREET, NW
SUITE 700
WASHINGTON DC 20036-3307.

A courtesy copy of this decision will be mailed to the correspondence address indicated on the January 12, 2010 patent owner change of correspondence address. In the absence of a proper submission of a change of correspondence address for the patent owner in the patent file, application No. 09/588,460, however, all future correspondence in this reexamination proceeding will be mailed ONLY to the official correspondence addresses of record for the patent owner and for the third party requester.

CONCLUSION

1. The three Patent Owner petitions listed above are **dismissed as moot**.

2. The two Patent Owner petitions and three Third-Party Requester papers listed above are **expunged** from the file.

3. The proceeding is awaiting the filing of Third-Party Requester comments due 30 days from the mail date of the May 11, 2010 decision granting the entry of Patent Owner's supplemental response.

4. Inquiries regarding this decision may be directed to Eric Keasel, Supervisory Patent Examiner, at (571) 272-4929.

5. This decision is not a final agency decision and is without prejudice to request reconsideration or higher-level review.

Eric Keasel
SPE, Central Reexamination Unit, Art Unit 3992

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,241	10/02/2009	7,355,990	2187.020REX0	5321

93344 7590 05/07/2010

EXAMINER

FLACHSBART & GREENSPOON, LLC
333 N. MICHIGAN AVE.
27TH FLOOR
CHICAGO, IL 60601

ART UNIT	PAPER NUMBER

DATE MAILED: 05/07/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
STERNE KESSLER GOLDSTEIN & FOX, PLLC
1100 NEW YORK AVE, N.W.
WASHINGTON, DC 20005

Date: MAILED

MAY 07 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001241
PATENT NO. : 7355990
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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MAY 07 2010

CENTRAL REEXAMINATION UNIT

Manelli Denison & Selter, PLLC (For Patent Owner)
2000 M Street, NW
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Robert Greene Sterne, Esq. (For Third Party Requester)
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333 N. Michigan Avenue
27th Floor
Chicago, IL 60601

In re Smith et al.
Inter Partes Reexamination Proceeding
Control No.: 95/001,241
Filed: October 2, 2009
For: U.S. Patent No.: 7,355,990

DECISION DISMISSING PETITION AS MOOT

This is a decision on the patent owner's petition entitled "Patentee's Petition under 37 CFR § 1.183 to Suspend Application Of 37 CFR § 1.945(b)(1), To Allow Submission Of A Supplemental Response Addressing Requester's Recitation And Reliance On Wrong Claim Construction" filed February 15, 2010.

The petition and *inter partes* reexamination control number 95/001,241 are before the Office of Patent Legal Administration for consideration.

SUMMARY

The patent owner petition under 37 CFR 1.183 filed February 15, 2010 is dismissed as moot, for the reasons set forth below.

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

RELEVANT BACKGROUND

1. U.S. Patent number 7,355,990 (the '990 patent) issued on April 8, 2008.

2. A request for *inter partes* reexamination of the '990 patent was filed on October 2, 2009. The request was assigned control No. 95/001,240 (the '1240 proceeding).

3. Reexamination was ordered for the '1240 proceeding on November 10, 2009. A first action on the merits was also mailed on November 10, 2009.

4. On January 11, 2010, the patent owner filed an amendment in response to the November 10, 2009 Office action. Patent owner also filed an information disclosure statement, a petition under 37 CFR 1.78(a)(3), and a paper entitled "Reexamination – Patent Owner Power Of Attorney Or Revocation Of Power Of Attorney With A New Power of Attorney and Change of Correspondence Address."

5. On January 26, 2010, the patent owner filed a supplemental information disclosure statement.

6. On February 4, 2010, the third party requester filed a petition under 37 CFR 1.183, requesting waiver of the page limit requirement for written comments under 37 CFR 1.947 to patent owner's January 11, 2010 response, which written comments accompanied the petition. The third party requester's 37 CFR 1.183 petition is being addressed in a separate decision being mailed concurrently herewith.

7. On February 15, 2010, patent owner filed six petitions, which were entitled as follows: (1) "Petition Under 37 C.F.R. § 1.182 To Strike Requester Comments...And Conditional Petition To Strike Jeffay Declaration If Requestor's Petition To Suspend The Page Limitations Is Granted"; (2) "Petition Under 37 C.F.R. § 1.182 To Strike Requester Comments Referring To Alleged Chen Provisional Appendices"; (3) "Patentee's Petition Under 37 CFR § 1.182 To Strike Certain Pages Of The Requester's Comments Because They Contain The Requester's Argument For Claim Breadth Precluded By The Doctrine Of Judicial Estoppel"; (4) "Petition Under 37 CFR § 1.182 To Strike 37 CFR § 1.132 Declaration And Alternative Petition To Strike Requester's Petition To Suspend The Page Limit"; (5) "Patentee's Petition Under 37 CFR § 1.183 To Suspend Application Of 37 CFR § 1.945(b)(1), To Allow Submission Of A Supplemental Response Addressing Requester's Recitation And Reliance On Wrong Claim Construction"; and (6) "Patentee's Petition Under 37 CFR § 1.183 To Suspend Application of 37 CFR § 1.945(b)(1), To Allow Submission Of A Supplemental Response Addressing Why A New Court Decision Interpreting The Patent-Under-Reexamination Supports Confirmation Of Certain Claims." Patent owner also filed a second supplemental information disclosure statement on February 15, 2010. This decision addresses petition (5). Petition (6) is being addressed in a separate decision mailed concurrently herewith. The remaining patent owner petitions will be treated in due course by the Central Reexamination Unit (CRU).

8. On February 17, 2010, the third party requester filed oppositions under 37 CFR 1.182 to each of patent owner's February 15, 2010 petitions. The third party requester's oppositions to patent owner's petitions identified as (5) and (6) in the preceding paragraph are being addressed in a separate decision mailed concurrently herewith. The remaining

third party requester oppositions will be treated in due course by the Central Reexamination Unit. The third party requester also filed a "Petition Under 37 C.F.R. § 1.183 to Suspend 37 C.F.R. § 1.947 and Allow Requester to Submit Substitute Paper" which is being addressed in a decision being mailed concurrently herewith.

9. On March 9, 2010, patent owner filed a third supplemental information disclosure statement.

10. On April 1, 2010, patent owner filed a fourth supplemental information disclosure statement.

RELEVANT REGULATORY PROVISIONS

37 CFR 1.183 states:

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

37 CFR 1.945(b)(1) states:

> 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.

DECISION ON PETITION

Patent Owner's Petition Under 37 CFR 1.183 of February 15, 2010

In the instant petition, patent owner requests suspension of 37 CFR 1.945(b)(1) to permit entry of a supplemental response that addresses third party requester's "recitation and reliance on wrong claim construction."

The February 4, 2010 requester comments paper to which the present supplemental response is directed is being expunged in a decision mailed concurrently herewith. The third party requester's petition under 37 CFR 1.183 for page-limit waiver is being dismissed in the concurrently mailed decision; thus, the requester's February 4, 2010 written comments is not part

of the record. Since the February 4, 2010 requester comments paper to which the present supplemental response is directed is not part of the record, the instant patent owner petition is dismissed as moot.

Patent owner is advised, however, that the statute does not provide the patent owner with an opportunity to file a supplemental response to address the requester's comments. The Office stated the following when 37 CFR 1.945 was revised in 2007:

> A showing of sufficient cause will not be established by an explanation that the supplemental response is needed to address the requester's comments (on patent owner's response), and could not have been presented together with the original response because it was not known that requester would raise a particular point. The *inter partes* reexamination statute (35 U.S.C. 314) provides for the patent owner to respond to an Office action, and the requester to comment on that response. There is no intent in the statute to provide the patent owner with a chance to file a supplemental response to address the requester's comments. Indeed, 35 U.S.C. 314(b)(2) ends the iteration of addressing the Office action by stating that "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."

See Revisions and Technical Corrections Affecting Requirements for *Ex Parte* and *Inter Partes* Examination, 72 FR 18892, 18902 (Apr. 16, 2007)(final rule).

Therefore, even if the third party requester's comments had been entered, patent owner's petition to enter a supplemental response to address third party requester's comments could not be granted.

Pursuant to 37 CFR 1.939(a), "If an unauthorized paper is filed by any party at any time during the *inter partes* reexamination proceeding it will not be considered and may be returned." Since the patent owner's petition under 37 CFR 1.183 is not being granted, the supplemental response filed with the petition does not have a right of entry into the record of the present reexamination proceeding, and, as such, is not an authorized paper. Because the paper was incorporated into the electronic Image File Wrapper (IFW) for the proceeding, the original patent owner paper cannot be physically returned to the patent owner. Rather, the patent owner's supplemental response paper filed February 15, 2010 with the instant petition will be expunged from the record by marking it "non-public" and "closed" in the IFW. See MPEP 2667. A copy of this decision will be made of record in the IFW.

The January 11, 2010 Change of Correspondence Address is Ineffective

On January 11, 2010, the patent owner filed a revocation of power of attorney with a new power of attorney and change of correspondence address in the '1241 proceeding. The official correspondence address of record for the patent owner in a reexamination proceeding, however, is the correspondence address as recorded in the patent file. See 37 CFR 1.33(c) and MPEP 2622. Office records fail to reveal that a change of correspondence address was received in the patent file, application No. 11/113,033. In the present case, the official correspondence address

of record for the patent owner, as recorded in the patent file, application No. 11/113,033, is Manelli, Denison & Selter, PLLC, 2000 M Street, NW, 7th Floor, Washington, DC 20036-3307.

A courtesy copy of this decision will be mailed to the correspondence address indicated on the January 11, 2010 patent owner change of correspondence address. In the absence of a proper submission of a change of correspondence address for the patent owner in the patent file, application No. 11/113,033, however, all future correspondence in this reexamination proceeding will be mailed ONLY to the official correspondence addresses of record for the patent owner and for the third party requester.

CONCLUSION

1. The patent owner petition under 37 CFR 1.183 to suspend 37 CFR 1.945(b)(1) to permit submission of a supplemental response addressing requester's comments is dismissed as moot.

2. The patent owner's supplemental response filed February 15, 2010, with the instant petition is refused entry into the record, as it is not an authorized paper. Because the patent owner's supplemental response paper was previously incorporated into the IFW for the present reexamination proceeding, the paper is being expunged from the record by marking it "non-public" and "closed" in the IFW. The patent owner's supplemental response paper filed February 15, 2010, will not constitute part of the record of the present reexamination proceeding.

3. A copy of this decision will be made of record in the IFW of the '1241 *inter partes* reexamination proceeding.

4. Jurisdiction over this proceeding is being returned to the Central Reexamination Unit for treatment of the petitions and opposition papers assigned to the Central Reexamination Unit, and to await the filing of any timely party papers.

5. Telephone inquiries related to this decision should be directed to Eugenia Jones, Senior Legal Advisor, at (571) 272-7727.

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,241	10/02/2009	7,355,990	2187.020REX0	5321

93344 7590 05/07/2010

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DATE MAILED: 05/07/2010

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STERNE KESSLER GOLDSTEIN & FOX, PLLC
1100 NEW YORK AVE, N.W.
WASHINGTON, DC 20005

Date:

MAILED

MAY 07 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001241
PATENT NO. : 7355990
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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(For Patent Owner)

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(Courtesy Copy)

In re Smith et al.
Inter Partes Reexamination Proceeding
Control No.: 95/001,241
Filed: October 2, 2009
For: U.S. Patent No.: 7,355,990

DECISION GRANTING PETITION

This is a decision on the patent owner's petition entitled "Patentee's Petition under 37 CFR § 1.183 to Suspend Application Of 37 CFR § 1.945(b)(1), To Allow Submission Of A Supplemental Response Addressing Why A New Court Decision Interpreting The Patent-Under-Reexamination Supports Confirmation Of Certain Claims" filed February 15, 2010.

The petition and *inter partes* reexamination control number 95/001,241 are before the Office of Patent Legal Administration for consideration.

SUMMARY

The patent owner petition under 37 CFR 1.183 filed February 15, 2010 is granted, for the reasons set forth below.

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

RELEVANT BACKGROUND

1. U.S. Patent number 7,355,990 (the '990 patent) issued on April 8, 2008.

2. A request for *inter partes* reexamination of the '990 patent was filed on October 2, 2009. The request was assigned control No. 95/001,241 (the '1241 proceeding).

3. Reexamination was ordered for the '1241 proceeding on November 10, 2009. A first action on the merits was also mailed on November 10, 2009.

4. On January 11, 2010, the patent owner filed an amendment in response to the November 13, 2009 Office action. Patent owner also filed an information disclosure statement, a petition under 37 CFR 1.78(a)(3), and a paper entitled "Reexamination – Patent Owner Power Of Attorney Or Revocation Of Power Of Attorney With A New Power of Attorney and Change of Correspondence Address."

5. On January 26, 2010, the patent owner filed a supplemental information disclosure statement.

6. On February 4, 2010, the third party requester filed a petition under 37 CFR 1.183, requesting waiver of the page limit requirement for written comments under 37 CFR 1.947 filed in response to patent owner's January 12, 2010 response, which written comments accompanied the petition. The third party requester's 37 CFR 1.183 petition is being addressed in a separate decision being mailed concurrently herewith.

7. On February 15, 2010, patent owner filed six petitions, which were entitled as follows: (1) "Petition Under 37 C.F.R. § 1.182 To Strike Requester Comments...And Conditional Petition To Strike Jeffay Declaration If Requestor's Petition To Suspend The Page Limitations Is Granted"; (2) "Petition Under 37 C.F.R. § 1.182 To Strike Requester Comments Referring To Alleged Chen Provisional Appendices"; (3) "Patentee's Petition Under 37 CFR § 1.182 To Strike Certain Pages Of The Requester's Comments Because They Contain The Requester's Argument For Claim Breadth Precluded By The Doctrine Of Judicial Estoppel"; (4) "Petition Under 37 CFR § 1.182 To Strike 37 CFR § 1.132 Declaration And Alternative Petition To Strike Requester's Petition To Suspend The Page Limit"; (5) "Patentee's Petition Under 37 CFR § 1.183 To Suspend Application Of 37 CFR § 1.945(b)(1), To Allow Submission Of A Supplemental Response Addressing Requester's Recitation And Reliance On Wrong Claim Construction"; and (6) "Patentee's Petition Under 37 CFR § 1.183 To Suspend Application of 37 CFR § 1.945(b)(1), To Allow Submission Of A Supplemental Response Addressing Why A New Court Decision Interpreting The Patent-Under-Reexamination Supports Confirmation Of Certain Claims." Patent owner also filed a second supplemental information disclosure statement on February 15, 2010. This decision addresses petition (6). Petition (5) is being addressed in a separate decision mailed concurrently herewith. The remaining patent owner petitions will be treated in due course by the Central Reexamination Unit (CRU).

8. On February 17, 2010, the third party requester filed oppositions under 37 CFR 1.182 to each of patent owner's February 15, 2010 petitions. The third party requester's oppositions to patent owner's petitions identified as (5) and (6) in the preceding paragraph are being addressed in a separate decision mailed concurrently herewith. The remaining

third party requester oppositions will be treated in due course by the Central Reexamination Unit. The third party requester also filed a "Petition Under 37 C.F.R. § 1.183 to Suspend 37 C.F.R. § 1.947 and Allow Requester to Submit Substitute Paper" which is being addressed in a decision being mailed concurrently herewith.

9. On March 9, 2010, patent owner filed a third supplemental information disclosure statement.

10. On April 1, 2010, patent owner filed a fourth supplemental information disclosure statement.

RELEVANT REGULATORY PROVISIONS

37 CFR 1.111(a)(2)(i) states:

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.

37 CFR 1.183 states:

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

37 CFR 1.945(b)(1) states:

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.

DECISION ON PETITION

Patent Owner's Petition Under 37 CFR 1.183 of February 15, 2010

In the instant petition, patent owner requests suspension of 37 CFR 1.945(b)(1) to permit entry of a supplemental response that addresses "why a new court decision interpreting the patent-under-reexamination supports confirmation of certain claims."

Patent owner states that on February 5, 2010, the Eastern District of Virginia in *TeleCommunications Systems, Inc. v. Sybase, Inc.*, Case No. 09-cv-387 (E.D. Va.) revised its claim interpretation by narrowing its construction of the corresponding structure of the "translation module" of the patent claims under reexamination. The revised claim construction occurred after patent owner filed its January 11, 2010 response to the Office action. Patent owner states that "[i]n its January 11 submission, Patentee reasonably relied on the previous (broader) interpretation of corresponding structure by the same court" and "[i]n relying on this broader court claim construction, Patentee had no basis (at the time) to distinguish any applied art on the ground that the prior art lacked a disclosure of, or a reason to incorporate, the corresponding structure or equivalents thereof."

Patent owner acknowledges that the requirement of 37 CFR 1.945(b)(1), which incorporates 37 CFR 1.111(a)(2)(i), cannot be met. However, patent owner asserts that good cause exists for suspending the requirements of 37 CFR 1.954(b)(1). Patent owner states that: (1) "nothing can be more significant to examination of claims during *inter partes* reexamination than a court decision interpreting claim scope" (but acknowledges that the court decision is not binding), and (2) "this unique fact pattern will rarely occur."

The instant petition under 37 CFR 1.183 has been fully considered. Based on the above facts and the individual facts and circumstances of this proceeding, it is deemed equitable to permit the patent owner to file a supplemental response to address the recent court decision.

Accordingly, the petition under 37 CFR 1.183 is granted. Therefore, the supplemental response filed with the petition is being entered and will be considered by the examiner in due course.

The January 11, 2010 Change of Correspondence Address is Ineffective

On January 11, 2010, the patent owner filed a revocation of power of attorney with a new power of attorney and change of correspondence address in the '1241 proceeding. The official correspondence address of record for the patent owner in a reexamination proceeding, however, is the correspondence address as recorded in the patent file. See 37 CFR 1.33(c) and MPEP 2622. Office records fail to reveal that a change of correspondence address was received in the patent file, application No. 11/113,033. In the present case, the official correspondence address of record for the patent owner, as recorded in the patent file, application No. 11/113,033, is Manelli, Denison & Selter, PLLC, 2000 M Street, NW, 7th Floor, Washington, DC 20036-3307.

A courtesy copy of this decision will be mailed to the correspondence address indicated on the January 11, 2010 patent owner change of correspondence address. In the absence of a proper submission of a change of correspondence address for the patent owner in the patent file, application No. 11/113,033, however, all future correspondence in this reexamination proceeding will be mailed ONLY to the official correspondence addresses of record for the patent owner and for the third party requester.

CONCLUSION

1. The patent owner petition under 37 CFR 1.183 to suspend 37 CFR 1.945(b)(1) to allow submission of a supplemental response addressing a court decision is granted.

2. The patent owner's supplemental response ("Supplemental Response Addressing Reconsidered Interpretation Of "Translation Module' Corresponding Structure") filed February 15, 2010, with the instant petition will be entered into the record and will be considered by the examiner.

3. **The third party requester has 30 days from the mailing date of this decision,** granting patent owner's petition under 37 CFR 1.183 and making patent owner's February 15, 2010 supplemental response enterable as of the mailing date of this decision, to file a comments paper pursuant to 37 CFR 1.947. In a decision mailed concurrently with this decision, the third party requester is given, with respect to its February 2010 comments, 30 days to file either a redacted or re-drafted comments paper under 37 CFR 1.947. The two sets of requester comments may be combined in one paper, and if such is done, separate sections should be used to address the patent owner's January 11, 2010 response and the patent owner's February 15, 2010 supplemental response. The section addressing patent owner's response shall not exceed 50 pages in length, and the section addressing the patent owner's response may include up to 50 pages but this section must be solely limited to addressing patent owner's supplemental response. To the extent that 37 CFR 1.943(b) requires waiver for this, it is hereby waived. If, however, the third party requester submits a separate comments paper directed to patent owner's supplemental response, that paper must be limited to addressing the patent owner's February 15, 2010 supplemental response which is being entered.

4. Jurisdiction over this proceeding is being returned to the Central Reexamination Unit for entry of the supplemental response, treatment of the petitions and opposition papers assigned to the Central Reexamination Unit, and to await the filing of any timely party papers.

5. Telephone inquiries related to this decision should be directed to Eugenia Jones, Senior Legal Advisor, at (571) 272-7727.

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

5-6-10
kenpet8/IP

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,241	10/02/2009	7,355,990	2187.020REX0	5321

93344 7590 05/07/2010

FLACHSBART & GREENSPOON, LLC
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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 05/07/2010

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
STERNE KESSLER GOLDSTEIN & FOX, PLLC
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Date:

MAILED

MAY 07 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001241
PATENT NO. : 7355990
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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27th Floor
Chicago, IL 60601

In re Smith et al. :
Inter Partes Reexamination Proceeding : **DECISION DISMISSING**
Control No.: 95/001,241 : **PETITIONS**
Filed: October 2, 2009 :
For: U.S. Patent No.: 7,355,990 :

This is a decision on the third party requester's petition entitled "Petition under 37 C.F.R. § 1.183 to Suspend the Page Limitation of 37 C.F.R. § 1.943(b)" filed February 4, 2010.

This is also a decision on the third party requester's petition entitled "Petition Under 37 C.F.R. § 1.183 to Suspend 37 C.F.R. § 1.947 and Allow Requester to Submit Substitute Paper" filed February 17, 2010.

The above-referenced petitions and *inter partes* reexamination control number 95/001,241 are before the Office of Patent Legal Administration for consideration.

SUMMARY

The third party requester petition under 37 CFR 1.183 filed February 4, 2010 is dismissed, for the reasons set forth below.

The third party requester petition under 37 CFR 1.183 filed February 17, 2010 is dismissed as moot, for the reasons set forth below.

The third party requester has paid the petition fee of $400.00 pursuant to 37 CFR 1.17(f) for each petition under 37 CFR 1.183.

RELEVANT BACKGROUND

1. U.S. Patent number 7,355,990 (the '990 patent) issued on April 8, 2008.

2. A request for *inter partes* reexamination of the '990 patent was filed on October 2, 2009. The request was assigned control No. 95/001,241 (the '1241 proceeding).

3. Reexamination was ordered for the '1241 proceeding on November 10, 2009. A first action on the merits was also mailed on November 10, 2009.

4. On January 11, 2010, the patent owner filed an amendment in response to the November 10, 2009 Office action. Patent owner also filed an information disclosure statement, a petition under 37 CFR 1.78(a)(3), and a paper entitled "Reexamination – Patent Owner Power Of Attorney Or Revocation Of Power Of Attorney With A New Power of Attorney and Change of Correspondence Address."

5. On January 26, 2010, the patent owner filed a supplemental information disclosure statement.

6. On February 4, 2010, the third party requester filed the instant petition under 37 CFR 1.183, requesting waiver of the page limit requirement for written comments under 37 CFR 1.947 to patent owner's January 11, 2010 response, which written comments accompanied the petition.

7. On February 15, 2010, patent owner filed six petitions, which were entitled as follows: (1) "Petition Under 37 C.F.R. § 1.182 To Strike Requester Comments...And Conditional Petition To Strike Jeffay Declaration If Requestor's Petition To Suspend The Page Limitations Is Granted"; (2) "Petition Under 37 C.F.R. § 1.182 To Strike Requester Comments Referring To Alleged Chen Provisional Appendices"; (3) "Patentee's Petition Under 37 CFR § 1.182 To Strike Certain Pages Of The Requester's Comments Because They Contain The Requester's Argument For Claim Breadth Precluded By The Doctrine Of Judicial Estoppel"; (4) "Petition Under 37 CFR § 1.182 To Strike 37 CFR § 1.132 Declaration And Alternative Petition To Strike Requester's Petition To Suspend The Page Limit"; (5) "Patentee's Petition Under 37 CFR § 1.183 To Suspend Application Of 37 CFR § 1.945(b)(1), To Allow Submission Of A Supplemental Response Addressing Requester's Recitation And Reliance On Wrong Claim Construction"; and (6) "Patentee's Petition Under 37 CFR § 1.183 To Suspend Application of 37 CFR § 1.945(b)(1), To Allow Submission Of A Supplemental Response Addressing Why A New Court Decision Interpreting The Patent-Under-Reexamination Supports Confirmation Of Certain Claims." Patent owner also filed a second supplemental information disclosure statement on February 15, 2010. Petitions (5) and (6) are being addressed in separate decisions mailed concurrently herewith. The remaining patent owner petitions will be treated in due course by the Central Reexamination Unit (CRU).

8. On February 17, 2010, the third party requester filed oppositions under 37 CFR 1.182 to each of patent owner's February 15, 2010 petitions. The third party requester's oppositions to patent owner's petitions identified as (5) and (6) in the preceding paragraph are being addressed in a separate decision mailed concurrently herewith. The remaining third party requester oppositions will be treated in due course by the Central Reexamination Unit. The third party requester also filed a "Petition Under 37 C.F.R. § 1.183 to Suspend 37 C.F.R. § 1.947 and Allow Requester to Submit Substitute Paper" which is being addressed in the instant decision.

9. On March 9, 2010, patent owner filed a third supplemental information disclosure statement.

10. On April 1, 2010, patent owner filed a fourth supplemental information disclosure statement.

RELEVANT REGULATORY PROVISIONS

37 CFR 1.183 states:

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

37 CFR 1.943(b) states:

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

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.

DECISION ON PETITION

Third Party Requester Petition of February 4, 2010

In the instant petition, petitioner requests waiver of the 50-page limit in 37 CFR 1.943(b) for written comments by the third party requester. While the petitioner initially states that the "Comments" do not exceed 50 pages and that the "Declaration" is limited to factual evidence, a review of the declaration under 37 CFR 1.132 reveals that it is replete with legal argument as opposed to factual evidence, as discussed below. Therefore, the 79 pages of the declaration under 37 CFR 1.132 are included in the page limit count for written comments by the third party requester, in addition to the 50 pages labeled as "Comments by Third Party Requester to Patent Owner's Response in *Inter Partes* Reexamination under 37 C.F.R. § 1.947." Accordingly, the petition under 37 CFR 1.183 will be addressed.

Petitioner requests waiver of 37 CFR 1.943(b) on the basis that the page limitation is not required by statute and suspending the rules "would be fair and just, because (1) Requester has limited the Comments to no more than 50 pages; (2) good faith effort has been made to limit the Declaration to factual evidence; and (3) any determination by the Examiner that the Declaration contains non-factual evidence is inherently subjective and a conclusion over which reasonable minds may disagree."

Third Party Requester Petition of February 17, 2010

In the petition filed February 17, 2010, third party requester requests that 37 CFR 1.947 be suspended to permit the third party requester to submit the declaration of Kevin Jeffay under 37 CFR 1.132 filed with the February 17, 2010 petition. Third party requester states that when the requester filed written comments on February 4, 2010, an unintentional clerical error occurred whereby the Jeffay declaration that pertained to the 95/001,240 reexamination proceeding was also filed in the '1241 proceeding. Petitioner seeks to replace the incorrect Jeffay declaration that was filed in the '1241 proceeding with the Jeffay declaration that was intended to be filed in the '1241 proceeding.

As discussed below, the February 4, 2010 written comments paper including the declaration under 37 CFR 1.132 is being refused entry into the record.

Accordingly, the February 17, 2010 petition under 37 CFR 1.183 to suspend 37 CFR 1.947 is dismissed as moot. The **February 17, 2010 declaration** under 37 CFR 1.132 will, however, be referred to below in the discussion of the petition under 37 CFR 1.183 to waive the page limit requirement of 37 CFR 1.943(b), since any re-submission of comments in response would presumably not include the February 4, 2010 Jeffay declaration that pertained to 95/001,240.

Analysis and Findings

The instant petition to waive the 50-page limit of 37 CFR 1.943(b) 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 the petitioner to set forth, with specificity, the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. General requests, unsubstantiated by specific facts to justify an increase in the number of pages available for written comments under 37 CFR 1.947, are not sufficient to demonstrate an extraordinary situation in which justice requires suspension of 37 CFR 1.943(b).

In this instance, petitioner effectively seeks waiver of 37 CFR 1.943(b) to increase the page limit by 79 pages, since the written comments under 37 CFR 1.947 include the 79-page declaration under 37 CFR 1.132. The pages of the declaration under 37 CFR 1.132 are being counted since, as pointed out above, the declaration is replete with legal argument. See MPEP 2667(I)(A)(2). For example, it is clear from paragraphs 3-5 of the declaration that the declarant, Mr. Kevin Jeffay, is offering his opinions throughout the declaration. Mr. Jeffay makes multiple references to "the opinions" and "my opinions." Furthermore, how one of ordinary skill in the art would understand the claims, how one of ordinary skill in the art would understand the applied references, and whether one of ordinary skill in the art would understand the references to anticipate or render obvious the claims under reexamination are all opinions of Mr. Jeffay. Some examples of specific statements in the declaration that are legal argument include the following: (1) "one of ordinary skill in the art in the 2000 time frame reading claims 1 and 6 in light of the specification would have understood..." (paragraph 26); (2) "A person of ordinary skill in the art in the 2000 time frame reading the claims of the '990 Patent would understand that..." (paragraph 34); (3) "one of ordinary skill in the art would not understand the inventors to have been in possession of such an invention at the time of their application for the '990 Patent" (paragraph 35); (4) "To the extent that patentee is claiming that the Nokia I reference does not teach the insertion of a short message into an HTTP protocol message...I disagree" (paragraph 47); (5) "The use of either type of message in combination with the systems disclosed in the Nokia I reference would have been obvious to a person of ordinary skill because..." (paragraph 64); (6) "one of ordinary skill in the art would be motivated to consider RFC 2068" (paragraph 84); and (7) "one of ordinary skill in the art would have been motivated to combine these references" (paragraph 131). These are legal arguments and/or conclusions.

Petitioner has not set forth with specificity any facts that would give rise to an extraordinary situation in which justice would require waiving the page limit requirement of 37 CFR 1.943(b). A mere allegation that reasonable minds may differ regarding what is non-factual evidence does not in any way satisfy petitioner's burden. It is noted that the patent owner's response to the Office action is 47 pages (excluding amendments). In addition, the issues involved in this reexamination proceeding do not appear to be of an amount and degree of complexity which would constitute an extraordinary situation. Therefore, requester has not made an adequate showing of why the third party requester should need to submit more than 50 pages of written comments.

Furthermore, a cursory review of the written comments (including the declaration under 37 CFR 1.132) also reveals that the third party requester does not appear to have made any attempt to economize the written comments such as by eliminating extraneous material and the repetition of information already of record.

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.

Pursuant to 37 CFR 1.939(a), "If an unauthorized paper is filed by any party at any time during the *inter partes* reexamination proceeding it will not be considered and may be returned." Since the third party requester's written comments paper (including the declaration under 37 CFR 1.132 with attachments) exceeds the page limit requirement set forth in 37 CFR 1.943(b), it does not have a right of entry into the record of the present reexamination proceeding, and, as such, is not an authorized paper. Similarly, the February 17, 2010 declaration under 37 CFR 1.132 (with attachments) 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 papers were incorporated into the electronic Image File Wrapper (IFW) for the proceeding, the original third party requester papers cannot be physically returned to the third party requester. Rather, the third party requester's February 4, 2010 written comments paper and the February 17, 2010 declaration under 37 CFR 1.132 (with attachments) will be expunged from the record by marking the papers "non-public" and "closed" in the IFW. See MPEP 2667. A copy of this decision will be made of record in the IFW.

The January 11, 2010 Change of Correspondence Address is Ineffective

On January 11, 2010, the patent owner filed a revocation of power of attorney with a new power of attorney and change of correspondence address in the '1241 proceeding. The official correspondence address of record for the patent owner in a reexamination proceeding, however, is the correspondence address as recorded in the patent file. See 37 CFR 1.33(c) and MPEP 2622. Office records fail to reveal that a change of correspondence address was received in the patent file, application No. 11/113,033. In the present case, the official correspondence address of record for the patent owner, as recorded in the patent file, application No. 11/113,033, is Manelli, Denison & Selter, PLLC, 2000 M Street, NW, 7th Floor, Washington, DC 20036-3307.

A courtesy copy of this decision will be mailed to the correspondence address indicated on the January 11, 2010 patent owner change of correspondence address. In the absence of a proper submission of a change of correspondence address for the patent owner in the patent file, application No. 11/113,033, however, all future correspondence in this reexamination proceeding will be mailed ONLY to the official correspondence addresses of record for the patent owner and for the third party requester.

CONCLUSION

1. The third party requester petition under 37 CFR 1.183 to suspend 37 CFR 1.943(b) is dismissed.

2. The third party requester's written comments paper filed February 4, 2010, is refused entry into the record, as it is not an authorized paper. Because the third party requester's

comments paper was previously incorporated into the IFW for the present reexamination proceeding, the paper is being expunged from the record by marking it "non-public" and "closed" in the IFW. The third party requester's comments paper filed February 4, 2010, will not constitute part of the record of the present reexamination proceeding.

3. The third party requester's February 17, 2010 declaration under 37 CFR 1.132 (with attachments) is refused entry into the record, as it is not an authorized paper. Because the third party requester's comments paper was previously incorporated into the IFW for the present reexamination proceeding, the paper is being expunged from the record by marking it "non-public" and "closed" in the IFW. The third party requester's February 17, 2010 declaration under 37 CFR 1.132 (with attachments) will not constitute part of the record of the present reexamination proceeding.

4. A copy of this decision will be made of record in the IFW of the '1241 *inter partes* reexamination proceeding.

5. In a decision mailed concurrently with this decision, the third party requester has been given thirty days to file comments to a supplemental patent owner response. Accordingly, **the third party requester is given a period of thirty (30) days from the date of this decision** in which to file either a redacted or re-drafted comments paper under 37 CFR 1.947 that is appropriately labeled as such, and complies with 37 CFR 1.943(b). The two sets of requester comments may be combined in one paper, and if such is done, separate sections should be used to address the patent owner's January 11, 2010 response and the patent owner's February 15, 2010 supplemental response. The section addressing patent owner's response shall not exceed 50 pages in length, and the section addressing the patent owner's supplemental response may include up to 50 pages but this section must be solely limited to addressing patent owner's supplemental response. To the extent that 37 CFR 1.943(b) requires waiver for this, it is hereby waived.

6. Jurisdiction over this proceeding is being returned to the Central Reexamination Unit for treatment of the petitions and opposition papers assigned to the Central Reexamination Unit, and to await the filing of any timely party papers.

7. Telephone inquiries related to this decision should be directed to Eugenia Jones, Senior Legal Advisor, at (571) 272-7727.

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

5-6-10
kenpet8/IP/length

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,241	10/02/2009	7,355,990	2187.020REX0	5321

93344 7590 05/19/2010

FLACHSBART & GREENSPOON, LLC
333 N. MICHIGAN AVE.
27TH FLOOR
CHICAGO, IL 60601

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 05/19/2010

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

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(For Patent Owner)

FLACHSBART & GREENSPOON, LLC
333 N. MICHIGAN AVE.
27TH FLOOR
CHICAGO, IL 60601

MAILED

MAY 19 2010

CENTRAL REEXAMINATION UNIT

(For Requester)

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

In re: Smith *et alia*
Reexamination Proceeding
Control No. 95/001,241
Request Deposited: October 2, 2009
For: U.S. Patent No. 7,355,990

DECISION

The *inter partes* reexamination is before the Central Reexamination Unit to address the following papers:

1) The Patent Owner (PO) paper filed February 15, 2010 entitled "PATENTEE'S PETITION UNDER 37 CFR §1.182 TO STRIKE CERTAIN PAGES OF THE REQUESTER'S COMMENTS BECAUSE THEY CONTAIN THE REQUESTER'S ARGUMENT FOR CLAIM BREADTH PRECLUDED BY THE DOCTRINE OF JUDICIAL ESTOPPEL".

2) The PO paper filed February 15, 2010 entitled "PETITION UNDER 37 CFR §1.182 TO STRIKE REQUESTER COMMENTS REFERRING TO ALLEGED CHEN PROVISIONAL APPENDICES".

3) The PO paper filed February 15, 2010 entitled "PETITION UNDER 37 CFR §1.182 TO STRIKE REQUESTER COMMENTS THAT RELY ON IMPROPER CITATIONS TO MATTER THAT IS NOT CITABLE IN A REEXAMINATION, AND CONDITIONAL PETITION TO STRIKE JEFFAY DECLARATION IF REQUESTOR'S PETITION TO SUSPEND THE PAGE LIMITATION IS GRANTED".

4) The PO paper filed February 15, 2010 entitled "PETITION UNDER 37 CFR §1.182 TO STRIKE 37 CFR §1.132 DECLARATION AND ALTERNATIVE PETITION TO STRIKE REQUESTER'S PETITION TO SUSPEND THE PAGE LIMIT".

5) The Third Party Requester (3PR) paper filed February 17, 2010 entitled "Opposition Under 37 C.F.R. §1.182 to Patentee's "Petition Under 37 CFR §1.182 to Strike Certain Pages of the Requester's Comments Because They Contain the Requester's Argument for Claim Breadth Precluded by the Doctrine of Judicial Estoppel"

6) The 3PR paper filed February 17, 2010 entitled "Opposition Under 37 C.F.R. §1.182 to Patentee's "Petition Under 37 CFR 1.182 to Strike Requester Comments Referring to Alleged Chen Provisional Appendices"".

7) The 3PR paper filed February 17, 2010 entitled "Opposition Under 37 C.F.R. §1.182 to Patentee's "Petition Under 37 CFR 1.182 to Strike Requester Comments That Rely on Improper Citations to Matter That Is Not Citable In a Reexamination, and Conditional Petition to Strike Jeffay Declaration If Requestor's Petition to Suspend the Page Limitation Is Granted"

8) The 3PR paper filed February 17, 2010 entitled "Opposition Under 37 C.F.R. §1.182 to Patentee's "Petition Under 37 CFR 1.182 to Strike Requester's Petition to Suspend the Page Limit"

FINDINGS and DECISION

One of the decisions mailed May 7, 2010 (the seven-page decision entitled "DECISION DISMISSING PETITIONS") refused entry of the February 4, 2010 written comments paper including the declaration under 37 CFR 1.132. The comments paper was expunged from the record and does not constitute part of the record of the present reexamination proceeding.

Accordingly, the four petitions listed above filed by Patent Owner on February 15, 2010 requesting that various portions of those comments be stricken are **dismissed as moot**.

In view of various comments in said petitions that are directed to a paper that has been expunged from the record and does not constitute part of the record of the present reexamination proceeding, the four petitions are similarly **expunged** from the record. Because the petition papers were incorporated into the electronic Image File Wrapper (IFW) for the proceeding, the papers can not be physically returned. Rather, these papers will be expunged from the file by marking the papers "non-public" and "closed" in the IFW.

The four opposition petitions listed above filed by Third-Party Requester are similarly **expunged** from the record.

CONCLUSION

1. The four Patent Owner petitions listed above are **dismissed as moot**.

2. The four Patent Owner petitions and four Third-Party Requester papers listed above are **expunged** from the file.

3. The proceeding is awaiting the filing of Third-Party Requester comments due 30 days from the mail date of the May 7, 2010 decision granting the entry of Patent Owner's supplemental response.

4. Inquiries regarding this decision may be directed to Eric Keasel, Supervisory Patent Examiner, at (571) 272-4929.

5. This decision is not a final agency decision and is without prejudice to request reconsideration or higher-level review.

Eric Keasel
SPE, Central Reexamination Unit, Art Unit 3992

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Manelli Denison & Selter, PLLC **(For Patent Owner)**
2000 M Street, NW
7th Floor
Washington, DC 20036-3307

Robert Greene Sterne, Esq. **(For Third Party Requester)**
Sterne, Kessler, Goldstein & Fox, PLLC
1100 New York Ave, NW
Washington, DC 20005

Flachsbart & Greenspoon, LLC **(Courtesy Copy)**
333 N. Michigan Avenue
27th Floor
Chicago, IL 60601

MAILED

JUN 16 2010

OFFICE OF PETITIONS

In re Smith et al.
Reexamination Proceeding
Control No. 95/001,241
Request Deposited: October 2, 2009
For: U.S. Patent No. 7,355,990

: DECISION ON PETITION
: UNDER 37 CFR 1.78(a)(3)

This is a decision on the petition, filed January 11, 2010, which is being treated as a petition under 37 CFR 1.78(a)(3), seeking to add a claim for priority under 35 U.S.C. § 120 to a patent that matured from a prior-filed nonprovisional application, as set forth in the amendment filed with the petition.

The petition is **GRANTED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

(1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;
(2) the surcharge set forth in § 1.17(t); and

(3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

All of the above requirements having been satisfied, the late claim for priority under 35 U.S.C. § 120 is accepted as being unintentionally delayed.

The granting of the petition to accept the delayed benefit claim to the prior-filed applications under 37 CFR 1.78(a)(3) should not be construed as meaning that the present patent being examined is entitled to the benefit of the prior-filed applications. In order for the patent to be entitled to the benefit of the prior-filed applications, all other requirements under 35 U.S.C. § 120 and 37 CFR 1.78(a)(1) and (a)(2) must be met. Similarly, the fact that the corrected Filing Receipt accompanying this decision on petition includes the prior-filed applications should not be construed as meaning that patent owner is entitled to the claim for benefit of priority to the prior-filed applications noted thereon. Accordingly, the examiner will, in due course, consider this benefit claim and determine whether the patent is entitled to the benefit of the earlier filing date.

The January 11, 2010 Change of Correspondence Address is Ineffective

On January 11, 2010, the patent owner filed a revocation of power of attorney with a new power of attorney and change of correspondence address in the '1241 proceeding. The official correspondence address of record for the patent owner in a reexamination proceeding, however, is the correspondence address as recorded in the patent file. See 37 CFR 1.33(c) and MPEP 2622. Office records fail to reveal that a change of correspondence address was received in the patent file, application No. 11/113,033. In the present case, the official correspondence address of record for the patent owner, as recorded in the patent file, application No. 11/113,033, is Manelli, Denison & Selter, PLLC, 2000 M Street, NW, 7th Floor, Washington, DC 20036-3307.

A courtesy copy of this decision will be mailed to the correspondence address indicated on the January 11, 2010 patent owner change of correspondence address. In the absence of a proper submission of a change of correspondence address for the patent owner in the patent file, application No. 11/113,033, however, all future correspondence in this reexamination proceeding will be mailed ONLY to the official correspondence addresses of record for the patent owner and for the third party requester.

CONCLUSION

1. As the petition for acceptance of an unintentionally delayed claim for the benefit of priority under 35 U.S.C. § 120 to the above-noted, prior-filed nonprovisional application satisfies the conditions of 37 CFR 1.78(a)(3), the petition is granted.

2. A corrected Filing Receipt, which includes the priority claim to the above-noted, prior-filed nonprovisional application, accompanies this decision on petition.

3. Any inquiries concerning this decision may be directed to Carl Friedman at (571) 272-6842.

4. This application is being forwarded to the Central Reexam Unit for consideration by the examiner as to patent owner's entitlement to claim benefit of priority under 35 U.S.C. § 120 to the prior filed application.

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

ATTACHMENT: Corrected Filing Receipt

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APPLICATION NUMBER	FILING or 371(c) DATE	GRP ART UNIT	FIL FEE REC'D	ATTY.DOCKET.NO	TOT CLAIMS	IND CLAIMS
95/001,241	10/02/2009	3992		2187.020REX0		

CONFIRMATION NO. 5321

CORRECTED FILING RECEIPT

93344
FLACHSBART & GREENSPOON, LLC
333 N. MICHIGAN AVE.
27TH FLOOR
CHICAGO, IL 60601

Date Mailed: 06/14/2010

Receipt is acknowledged of this non-provisional patent application. The application will be taken up for examination in due course. Applicant will be notified as to the results of the examination. Any correspondence concerning the application must include the following identification information: the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. **If an error is noted on this Filing Receipt, please submit a written request for a Filing Receipt Correction. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections**

Applicant(s)

7,355,990, Residence Not Provided;
TELECOMMUNICATION SYSTEMS, INC. (OWNER), ANNAPOLIS, MD;
STERNE KESSLER GOLDSTEIN & FOX, PLLC (3RD.PTY.REQ.), WASHINGTON, DC;
SYBASE, INC. (REAL.PTY.IN.INTEREST.), Residence Not Provided;
STERNE KESSLER GOLDSTEIN & FOX, PLLC, WASHINGTON, DC

Assignment For Published Patent Application

TELECOMMUNICATION SYSTEM, INC., ANNAPOLIS, MD

Power of Attorney: The patent practitioners associated with Customer Number 93344

Domestic Priority data as claimed by applicant

This application is a REX of 11/113,033 04/25/2005 PAT 7,355,990
which is a CON of 09/588,460 06/06/2000 PAT 6,891,811
which claims benefit of 60/198,108 04/18/2000

Foreign Applications

Projected Publication Date: None, application is not eligible for pre-grant publication

Non-Publication Request: No

Early Publication Request: No

Title

MOBILE-ORIGINATED TO HTTP INTERNET COMMUNICATIONS

Preliminary Class

370

PROTECTING YOUR INVENTION OUTSIDE THE UNITED STATES

Since the rights granted by a U.S. patent extend only throughout the territory of the United States and have no effect in a foreign country, an inventor who wishes patent protection in another country must apply for a patent in a specific country or in regional patent offices. Applicants may wish to consider the filing of an international application under the Patent Cooperation Treaty (PCT). An international (PCT) application generally has the same effect as a regular national patent application in each PCT-member country. The PCT process **simplifies** the filing of patent applications on the same invention in member countries, but **does not result** in a grant of "an international patent" and does not eliminate the need of applicants to file additional documents and fees in countries where patent protection is desired.

Almost every country has its own patent law, and a person desiring a patent in a particular country must make an application for patent in that country in accordance with its particular laws. Since the laws of many countries differ in various respects from the patent law of the United States, applicants are advised to seek guidance from specific foreign countries to ensure that patent rights are not lost prematurely.

Applicants also are advised that in the case of inventions made in the United States, the Director of the USPTO must issue a license before applicants can apply for a patent in a foreign country. The filing of a U.S. patent application serves as a request for a foreign filing license. The application's filing receipt contains further information and guidance as to the status of applicant's license for foreign filing.

Applicants may wish to consult the USPTO booklet, "General Information Concerning Patents" (specifically, the section entitled "Treaties and Foreign Patents") for more information on timeframes and deadlines for filing foreign patent applications. The guide is available either by contacting the USPTO Contact Center at 800-786-9199, or it can be viewed on the USPTO website at http://www.uspto.gov/web/offices/pac/doc/general/index.html.

For information on preventing theft of your intellectual property (patents, trademarks and copyrights), you may wish to consult the U.S. Government website, http://www.stopfakes.gov. Part of a Department of Commerce initiative, this website includes self-help "toolkits" giving innovators guidance on how to protect intellectual property in specific countries such as China, Korea and Mexico. For questions regarding patent enforcement issues, applicants may call the U.S. Government hotline at 1-866-999-HALT (1-866-999-4158).

LICENSE FOR FOREIGN FILING UNDER

Title 35, United States Code, Section 184

Title 37, Code of Federal Regulations, 5.11 & 5.15

GRANTED

The applicant has been granted a license under 35 U.S.C. 184, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" followed by a date appears on this form. Such licenses are issued in all applications where the conditions for issuance of a license have been met, regardless of whether or not a license may be required as

set forth in 37 CFR 5.15. The scope and limitations of this license are set forth in 37 CFR 5.15(a) unless an earlier license has been issued under 37 CFR 5.15(b). The license is subject to revocation upon written notification. The date indicated is the effective date of the license, unless an earlier license of similar scope has been granted under 37 CFR 5.13 or 5.14.

This license is to be retained by the licensee and may be used at any time on or after the effective date thereof unless it is revoked. This license is automatically transferred to any related applications(s) filed under 37 CFR 1.53(d). This license is not retroactive.

The grant of a license does not in any way lessen the responsibility of a licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations especially with respect to certain countries, of other agencies, particularly the Office of Defense Trade Controls, Department of State (with respect to Arms, Munitions and Implements of War (22 CFR 121-128)); the Bureau of Industry and Security, Department of Commerce (15 CFR parts 730-774); the Office of Foreign AssetsControl, Department of Treasury (31 CFR Parts 500+) and the Department of Energy.

NOT GRANTED

No license under 35 U.S.C. 184 has been granted at this time, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" DOES NOT appear on this form. Applicant may still petition for a license under 37 CFR 5.12, if a license is desired before the expiration of 6 months from the filing date of the application. If 6 months has lapsed from the filing date of this application and the licensee has not received any indication of a secrecy order under 35 U.S.C. 181, the licensee may foreign file the application pursuant to 37 CFR 5.15(b).

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,243	12/04/2009	7108191	055437/368524	8401

22858 7590 06/16/2010

CARSTENS & CAHOON, LLP
P O BOX 802334
DALLAS, TX 75380

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/16/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
ANDREW T. SPENCE
ALSTON & BIRD LLP, BANK OF AMERICA PLAZA
101 SOUTH TRYON STREET, SUITE 4000
CHARLOTTE, NC 28280-4000

Date:
MAILED

JUN 16 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001243
PATENT NO. : 7108191
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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Carstens & Cahoon, LLP (For Patent Owner)
P.O. Box 802334
Dallas, TX 75380

MAILED

JUN 16 2010

Andrew T. Spence (For Requester)
Alston & Bird, LLP
Bank of America Plaza
101 South Tryon Street
Suite 4000
Charlotte, NC 28280-4000

CENTRAL REEXAMINATION UNIT

In re Paul L. Andrus :
Inter Partes Reexamination Proceeding : **DECISION**
Control No. 95/001,243 : **GRANTING**
Filed: December 4, 2009 : **PETITION UNDER**
For: U.S. Patent No. 7,108,191 : **37 CFR 1.137(b)**

This is a decision on the May 5, 2010 patent owner petition under 37 CFR 1.137(b) to accept an unintentionally delayed response to Office action and revive the present terminated reexamination proceeding ("the May 5, 2010 patent owner petition to revive").[1]

The May 5, 2010 patent owner petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The May 5, 2010 patent owner petition to revive is **granted**.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

35 U.S.C. 41(a)(7) provides, in pertinent part:

> REVIVAL FEES. — On filing each petition ... for an unintentionally delayed response by the patent owner in any reexamination proceeding ...

[1] Although a Notice of Intent to Issue *Inter Partes* Reexamination Certificate (NIRC) has not been mailed to set forth the termination of the prosecution in this instance, the prosecution was "terminated" within the meaning of 37 CFR 1.957(b) for failure of the patent owner to timely file a response under 37 CFR 1.945(a) to the January 8, 2010 Office action.

35 U.S.C. 133 provides:

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

35 U.S.C. 314(a) provides, in pertinent part:

> IN GENERAL. — Except as otherwise provided in this section, reexamination shall be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title.

37 CFR 1.137 provides, in pertinent part:

> (b) *Unintentional.* If the delay in reply by ... patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive ... a reexamination prosecution terminated under §§ 1.550(d) or 1.957(b) or limited under § 1.957(c) .... A grantable petition pursuant to this paragraph must be accompanied by:
>
> > (1) The reply required to the outstanding Office action or notice, unless previously filed;
> > (2) The petition fee as set forth in § 1.17(m);
> > (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional ....
>
> *
>
> *
>
> (d) *Terminal disclaimer.*
>
> > *
> >
> > *
> >
> > (3) The provisions of paragraph (d)(1) of this section do not apply to ... reexamination proceedings.

37 CFR 1.945(a) provides, in pertinent part:

> The patent owner will be given at least thirty days to file a response to any Office action on the merits of the *inter partes* reexamination.

37 CFR 1.957(b) provides, in pertinent part:

> If no claims are found patentable, and the patent owner fails to file a timely and appropriate response in an *inter partes* reexamination proceeding, the prosecution in the reexamination proceeding will be a terminated prosecution and the Director will proceed

to issue and publish a certificate concluding the reexamination proceeding under § 1.997 in accordance with the last action of the Office.

37 CFR 1.958(b) provides, in pertinent part:

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

MPEP 2668 provides, in pertinent part:

II. PETITION BASED ON UNINTENTIONAL DELAY

The unintentional delay fee provisions of 35 U.S.C. 41(a)(7) are imported into, and are applicable to, any reexamination proceeding by Sec. 4605(a) of the American Inventors Protection Act of 1999. Accordingly, the Office will consider, in appropriate circumstances, a petition showing unintentional delay under 37 CFR 1.137(b) where untimely papers are filed by the patent owner subsequent to the order for reexamination. Any such petition must provide a verified statement that the delay was unintentional, a proposed response to continue prosecution (unless it has been previously filed), and the petition fee required by 37 CFR 1.17(m).

*

*

IV. FURTHER DISCUSSION OF THE PETITION REQUIREMENTS

See also MPEP § 711.03(c), subsection III, for a detailed discussion of the requirements of petitions filed under 37 CFR 1.137(a) and (b).

DECISION

The Petition Under 37 CFR 1.137(b) is Granted

A grantable petition under 37 CFR 1.137(b) for a reexamination proceeding must be accompanied by: (1) a response to the outstanding Office action; (2) the petition fee set forth in 37 CFR 1.17(m); and (3) a proper statement under 37 CFR 1.137(b)(3) that the entire delay in filing the required response from the due date of the response to the filing of a grantable petition was unintentional.

Regarding item (1), this reexamination proceeding prosecution was terminated under 37 CFR 1.957(b) due to patent owner's failure to timely submit a response to the January 8, 2010 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 8, 2010 Office action set a two-month period for response. A response to the January 8, 2010 Office

action was not filed until May 5, 2010, which was untimely. However, for the purpose of evaluating whether the May 5, 2010 patent owner petition to revive is a grantable petition, the submission of the May 5, 2010 Response To Reexamination Office Action satisfies item (1).[2]

A petition fee[3] and a proper statement under 37 CFR 1.137(b)(3)[4] have been submitted with the May 5, 2010 patent owner petition to revive, which satisfy items (2) and (3), respectively.

Accordingly, the May 5, 2010 patent owner petition to revive is **granted**.

CONCLUSION

1. The May 5, 2010 patent owner petition under 37 CFR 1.137(b) is **granted**.

2. Patent owner's response to the January 8, 2010 Office action is hereby entered in the record, thus triggering a comment right for third party requester under 37 CFR 1.947. It is noted that third party requester filed comments to patent owner's response as per 37 CFR 1.947 on June 2, 2010.

3. Jurisdiction over this reexamination proceeding is being returned to the Central Reexamination Unit, Art Unit 3992, for treatment of patent owner's May 5, 2010 Response To Reexamination Office Action and third party requester's June 2, 2010 Comments By Third-Party Requester Under 37 C.F.R. § 1.947.

---

[2] This decision is not directed to the persuasiveness and propriety of the arguments presented in the May 5, 2010 Response To Reexamination Office Action as to each of the rejections set forth in the January 8, 2010 Office action; such is the examiner's province.

[3] Page 2 of the May 5, 2010 Petition To Revive *Inter Partes* Reexamination Prosecution Under The Provisions Of 37 C.F.R. 1.137(b) contains an authorization to charge payment of the $810.00 fee for small entities under 37 CFR 1.17(m) to Deposit Account No. 50-0392.

[4] The statements provided at page 1 of the May 5, 2010 Petition To Revive *Inter Partes* Reexamination Prosecution Under The Provisions Of 37 C.F.R. 1.137(b) and at page 1 of the Statement Of Christopher P. O'Hagan do not specify 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, as is required by 37 CFR 1.137(b)(3). However, the statements provided therein are being so construed, thereby satisfying item (3). Patent owner must immediately notify the Office if the Office has misconstrued the provided statements.

4. Any inquiry concerning this decision should be directed to the undersigned at (571) 272-7728.

Raul Tamayo
Legal Advisor
Office of Patent Legal Administration

June 16, 2010

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,247	10/27/2009	7582058	03190.005600.36	7728

30328 7590 06/03/2010

NuVasive
c/o CPA Global
P.O. Box 52050
Minneapolis, MN 55402

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/03/2010

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/001,247	10/27/09	7582058	

FITZPATRICK, CELLA, HARPER & SCINTO
1290 AVENUE OF THE AMERICAS
NEW YORK, NY 10104-3800

EXAMINER
FLANAGAN, BEVERLY

ART UNIT	PAPER
3993	

DATE MAILED:

06/03/10

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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(For Patent Owner)

Justin J. Oliver
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(For *Inter Partes* Requester)

MAILED

JUN 03 2010

CENTRAL REEXAMINATION UNIT

Inter Partes Reexamination Proceeding
Control No. 95/001,247
Filed: October 27, 2009
For: U.S. Patent No. 7,582,058

DECISION GRANTING PETITION

This is a decision on third party requester's March 19, 2010 petition entitled "PETITION UNDER 37 C.F.R. § 1.183" requesting waiver of the page limit requirement of 37 CFR 1.943(b).

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

The petition is granted.

FEES

The petition fee of $400 for third party requester's petition under 37 CFR 1.183 pursuant to 37 CFR 1.17(f) was charged to Deposit Account No. 50-3939 on March 22, 2010.

REVIEW OF THE RELEVANT FACTS

1. On September 1, 2009, the Office issued United States Patent Number 7,582,058 (the '058 patent) to Miles *et al.*

2. On October 27, 2009, a request for *inter partes* reexamination of claims 1-2 and 4-8 of the '058 patent, assigned Reexamination Control No. 95/001,247 (the '1247 proceeding), was filed by a third party requester.

3. On December 17, 2009, the Office issued an order granting *inter partes* reexamination in the '1247 proceeding and concurrently issued an Office action on the merits.

4. On February 18, 2010, patent owner timely filed an "AMENDMENT IN REPLY TO THE ACTION OF AUGUST 17, 2009," which amended original claim 6, added new claims 10-65 (56 new claims) and retained original claims 1- 9.[1]

5. On March 19, 2010, third party requester filed a "RESPONSE TO PATENT OWNER'S AMENDMENT," which included a 33 page remarks section, a four page affidavit and 82 pages of claim charts.

6. Concurrently, on March 19, 2010, third party requester filed a petition entitled "PETITION UNDER 37 C.F.R. § 1.183" requesting waiver of the page limit requirement of 37 CFR 1.943(b).

DECISION

Relevant Statutes, Regulations and Procedures

37 CFR 1.183 provides:

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

37 CFR 1.943(b) provides:

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

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

> 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

[1] The submission was timely as the February 18, 2010 submission was a refiling of a timely submission filed on February 17, 2010. The February 18, 2010 refiling was requested by the CRU to correct formal matters with regard to the bracketing and underlining of amendments to some of the claims.

(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.

MPEP 2667(I)(B)(2) provides (in-part):

Where the length of the third party requester submission exceeds that permitted by 37 CFR 1.943, the submission is improper. Accordingly, a Notice will be issued by the examiner and mailed to the third party requester permitting the third party requester to exercise one of the following two options:

(A) Submit a re-drafted response that does not exceed the page limit set by 37 CFR 1.943; or

(B) File a copy of the supplemental response with pages redacted to satisfy the 37 CFR 1.943 page limit requirement.

The Notice will set a period of 15 days from the date of the notice to respond. If no response is received, the improper third party requester submission will not be considered.

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

Third Party Requester's Petition under 37 CFR 1.183

Third party requester's petition under 37 CFR 1.183, requests waiver of the 50-page limit of 37 CFR 1.943(b) for the concurrently filed comments, including supplemental claim charts appendices and a declaration under 37 CFR 1.132 executed by Dr. Steven Garfin ("The Garfin declaration").

Requester has concluded, the arguments section of requester's comments, the Garfin declaration and the supplemental claim chart appendices, submitted to address new claims 10-65, exceeds the 50-page limit set forth in 37 CFR 1.943(b). Only those pages of third party requester's March 19, 2010 comments and declarations upon which arguments appear will be included against the page limit count. See MPEP 2667(I)(A)(2), which is applicable to third party requester by dint of MPEP 2667(I)(B)(2). The comments portion is 33 pages in length to include, a cover sheet, a signature page and a three page summary listing of all proposed rejections that are exclusive of argument. The Garfin declaration appears to be free of legal argument that would be included in the regulatory page count. Therefore the comments and declaration combined contains a total of 29 pages of argument that are counted against the 50 page limit of 37 CFR 1.943(b). In accordance with relevant MPEP guidance, claim charts applying the art to the claims are counted against the 50 page limit of 37 CFR 1.943(b).[2] The March 19, 2010 response under 37 CFR 1.947 contains 82 pages of six different claim chart appendices, three supplemental claim charts and three new claim charts, to address newly added claims 10-65. The March 19, 2010 response's three supplemental claim chart appendices consists of a five page continuation of originally filed Claim Chart A, an eight page continuation of originally filed Claim Chart B and a six page continuation of originally filed Claim Chart D. The March 19, 2010 response's three new claim chart appendices consists of a twenty page newly filed Claim Chart J, a twenty page newly filed Claim Chart K and a twenty-three page newly filed Claim Chart L. Therefore, requester's March 19, 2010 response (comments, declaration, supplemental and new claim charts), which is included in the regulatory page count amounts to 111 pages. Requester's response therefore exceeds the regulatory 50-page limit set forth in 37 CFR 1.943(b) by 61 pages.

In this instance, third party requester 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, requester has provided an explanation as to how the submitted response economizes, excludes extraneous material, and is arranged so as not to repeat information already of record. Requester notes that efforts to be as brief as possible were taken to respond to patent owner's amendment resulting in a 29 page arguments section in the comments. Requester notes that Office guidance indicates that the best way to provide a limitation-by-limitation patentability analysis of claims is by using claim charts. Requester asserts therefore that the inclusion of 56 new claims makes it virtually impossible to both fully respond to all issues of patentability in the new claims and also comply with the 50-page limit regulatory requirement, when following Office guidance that expresses a preference for claim chart based analysis.

Accordingly, based upon the facts and circumstances of the present proceeding, specifically in light of the fact that patent owner added 56 new claims, in the interest of justice it is equitable in this case to grant third party requester's petition under 37 CFR 1.183 as to the 61 pages of supplemental claim chart appendices in excess of the 50-page regulatory limit.

---

[2] Pursuant to MPEP 2667(I)(A)(2), claim charts applying the art to the claims are not excluded from the appeal brief 30-page limit required by 37 CFR 1.943(c). *A fortiori* claim charts applying the art to the claims in a response pursuant to 37 CFR 1.947 likewise are not excluded from the even greater 50-pages authorized by 37 CFR 1.943(b).

CONCLUSION

1. Third party requester's petition under 37 CFR 1.183 is granted to the extent that the page length of third party requester's March 19, 2010 comments, including the claim charts addressing new claims 10-65, will be accepted.

2. Jurisdiction for the '1247 reexamination proceeding is returned to the Central Reexamination Unit (CRU).

3. Any questions concerning this communication should be directed to Joseph F. Weiss, Jr., Legal Advisor, at (571) 272-7759.

Kenneth M. Schor

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examining Policy

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,252	02/01/2010	J. 7,057,150	M4065.1570/P1570	1659

25891 7590 03/22/2010

BERNHARD P. MOLLDREM, JR.
224 HARRISON STREET
SUITE 200
SYRACUSE, NY 13202

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/22/2010

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Bernhard P. Molldrem, Jr. (For Patent Owner)
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Thomas J. D'Amico (For Third Party Requester)
Dickstein Shapiro LLP
1825 Eye Street, N.W.
Washington, D.C. 20006-5403

MAILED

MAR 22 2010

CENTRAL REEXAMINATION UNIT

In re Zarnowski et al. :
Inter partes Reexamination Proceeding : **DECISION**
Control No.: 95/001,252 : **DISMISSING**
Filed: February 1, 2010 : **PETITIONS**
For: U.S. Patent No. 7,057,150 :

This is a decision on the third party requester's (1) "REQUEST FOR SUSPENSION OF RULE UNDER 37 C.F.R. §§ 1.183, 1.939(b) TO CLARIFY STATEMENT UNDER 37 C.F.R. § 10.18" filed November 3, 2009, and (2) "PETITION UNDER 37 CFR § 1.182 OR 35 U.S.C. § 311(b)(2), 37 C.F.R. § 1.915(b)(2), 37 C.F.R. § 1.915 (b)(3), 37 C.F.R. § 1.915 (b)(4), 37 C.F.R. § 1.915(d), MPEP 2617, MPEP 2618, MPEP 2627, AND/OR MPEP 2631" filed on November 10, 2009.

The 95/001,252 proceeding and the petitions are before the Office of Patent Legal Administration for consideration.

The petition fee of $400.00 pursuant to 37 CFR 1.17(f) for each petition under 37 CFR 1.182 was received.

The petitions are dismissed as moot, as a corrected request has been filed and granted a filing date of February 1, 2010.

REVIEW OF FACTS

1. U.S. Patent No. 7,057,150 ("the '150 patent") issued on June 6, 2006.

2. On November 2, 2009, a third party requester deposited a request with the Office for an *inter partes* reexamination, which proceeding was assigned Control No. 95/001,252 ("the '1252 proceeding") requesting reexamination of claims 1 and 12 of the '150 patent.

3. On November 3, 2009, the third party requester filed a first petition to notify the Office that a black and white copy of the request was deposited in the Office, but a color copy of the request had been served on the patent owner on Nov.2, 2009 followed by service of a black and white copy on patent owner on Nov. 3.

4. On November 10, 2009, the third party requester filed a second petition and a copy of the prior art reference, EP 0707417 denominated "Dickinson" noting errors in the original request with respect to references to Dickinson.

5. A Notice of Incomplete Request was issued on January 21, 2010, noting several defects in the Nov. 2, 2009 request and acknowledging the Nov. 3, 2009 and Nov. 10, 2009 petitions.

6. A corrected request for *inter partes* reexamination was deposited on Feb. 1, 2010 and granted a filing date as of that date.

DECISION

The relief requested in the Nov. 3, 2009 and Nov. 10, 2009 petitions is no longer necessary as the original request for reexamination has been replaced with a corrected request for reexamination, which has now been granted a filing date of Feb. 1, 2010. Therefore, the petitions are dismissed as moot.

CONCLUSION

1. For the reasons set forth above, the petitions are dismissed.

2. Jurisdiction of the '1252 proceeding is being returned to the Central Reexamination Unit for further handling.

3. Telephone inquiries related to this decision should be directed to Caroline Dennison at (571) 272-7729.

/Kenneth M. Schor/

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

3/19/10
Kenpet8/IP

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,254		6953262	1781.020	4448

24350 7590 01/27/2010

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EXAMINER	
ART UNIT	PAPER NUMBER

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
BOYLE FREDRICKSON S.C.
840 NORTH PLANKINTON AVENUE
MILWAUKEE, WI 53203

Date:

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JAN 2 7 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001254
PATENT NO. : 6953262
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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JAN 2 7 2010

CENTRAL REEXAMINATION UNIT

BOYLE FREDRICKSON S.C.
840 NORTH PLANKINTON AVENUE
MILWAUKEE, WI 53203

(For Requester)

In re Cleaver *et alia*
Reexamination Proceeding
Control No. 95/001,254
For: U.S. Patent No. 6,953,262

: DECISION, GRANTING
: PETITION UNDER
: 37 CFR 1.181
:

This is a decision on the December 21, 2009 paper entitled "PETITION TO WITHDRAW HOLDING OF ABANDONMENT BASED ON FAILURE TO RECEIVE OFFICE ACTION". The petition was timely filed. No fee is required. The petition is before the Director of the Central Reexamination Unit for decision.

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

An original request was deposited on November 4, 2009.

A Notice of Failure to Comply with Inter Partes Reexamination Request Filing Requirements was mailed to Requester on November 12, 2009 setting a period of 30 days to submit a fully compliant response.

No corrected response was received within the 30 days.

On December 21, 2009, the present petition was filed.

The petition is considered pursuant to 37 CFR 1.181 based on non-receipt of office correspondence mailed to the address of record.

MPEP 711.03(c)IA, states, in part:

> The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner describing the system used for recording an Office action received at the correspondence address of record with the USPTO. The statement should

establish that the docketing system is sufficiently reliable. It is expected that the record would include, but not be limited to, the application number, attorney docket number, the mail date of the Office action and the due date for the response. Practitioner must state that the Office action was not received at the correspondence address of record, and that a search of the practitioner's record(s), including any file jacket or the equivalent, and the application contents, indicates that the Office action was not received. A copy of the record(s) used by the practitioner where the non-received Office action would have been entered had it been received is required.

A copy of the practitioner's record(s) required to show non-receipt of the Office action should include the master docket for the firm. That is, if a 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.

In support of the request, petitioner has provided a showing of non-receipt of the Office communication in accordance with MPEP 711.03(c)IA.

In view of the above, the proceeding does not stand terminated in preprocessing because no corrected request was timely received. The office will mail a new Notice of Failure to Comply with *Inter Partes* Reexamination Request Filing Requirements.

The period that was originally set forth in the Office communication will be restarted to run from the mail date of the newly supplied office correspondence.

SUMMARY AND CONCLUSION

1. Petitioner has provided a showing of non-receipt of the Office communication in accordance with MPEP 711.03(c)IA.

2. The petition is **GRANTED**.

3. The office will **mail** a new Notice of Failure to Comply with Inter Partes Reexamination Request Filing Requirements.

Gregory Morse, Director
Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,255	12/09/2009	7188970	1781.021	4512

24350 7590 05/05/2010

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 05/05/2010

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Milwaukee, WI 53203

Date:
MAILED

MAY 05 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001255
PATENT NO. : 7188970
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 05 2010

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(For Third Party Requester) CENTRAL REEXAMINATION UNIT

In re: Cleaver *et alia*
Inter Partes Reexamination Proceeding
Control No. 95/001,255
Deposited on: 09 December 2009
For: US Patent No. 7,188,970

CORRECTED
DECISION
DISMISSING
PETITION FOR EXTENSION
OF TIME
[37 CFR §§ 1.956 & 1.181]

This is a corrected decision on the 26 April 2010, "Petition for Request Extension of Time Pursuant to 37 CFR § 1.956" requesting that the time for responding to the non-final Office action mailed 26 March 2010, be further extended. The petition was timely filed with certificate of service.

This decision corrects an error in the due date listed in the conclusion of the decision mailed on 29 April 2010.

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

The petition is dismissed for the reasons set forth below.

DISCUSSION

The Patent Owner's representative requests the period of time be extended in which to file a response to the non-final Office action mailed 26 March 2010, which set two (2) months time for filing a response thereto. The instant petition for extension of time requests one (1) month extension of time. The petition was timely filed on 26 April 2010, together with electronic fee transmittal for the $200.00 petition fee as required by 37 CFR § 1.956 and 37 CFR § 1.17 (g). A certificate of service was provided with the petition.

The petition is dismissed for the reasons set forth below.

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

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

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

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

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

> Requests for an extension of time in an inter partes reexamination proceeding will be

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

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

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

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

Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. The reasons must include (A) a statement of what action the patent owner has taken to provide a response, to date as of the date the request for extension is submitted, and (B) why, in spite of the action taken thus far, the requested additional time is needed. The statement of (A) must provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period. Prosecution will be conducted by initially setting a time period of at least 30 days or one month (whichever is longer), see MPEP § 2662. First requests for extensions of these time periods will be granted for sufficient cause, and for a reasonable time specified-usually 1 month. The reasons stated in the request will be evaluated, and the request will be favorably considered where there is a factual accounting of reasonably diligent behavior by all those responsible for preparing a response or comments within the statutory time period. Second or subsequent requests for extensions of

time, or requests for more than one month, will be granted only in extraordinary situations.

...

DECISION

The patent owner's representative petitions under 37 CFR § 1.956 to further 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 petition notes that the rejections and references have been reviewed as well as consulted with a technical expert. The petition lacks the reasons which 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. Generalizations of reviewing references and rejections does not set forth the statement of action taken and why in spite of such action the additional time is required further the required factual accounting of the reasonably diligent behavior of all those responsible for preparing the response to the Office action. On balance, there is not "sufficient cause" to extend the period for response.

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

CONCLUSION

1. The patent owner's petition for extension for time is hereby **dismissed.**

2. The Patent Owner's response is due **26 May 2010.**

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

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

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

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

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

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/

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

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

MAILED

JUN 08 2010

CENTRAL REEXAMINATION UNIT

AFS/ANGIODYNAMICS
666 Third Avenue
Floor 10
New York, NY 10017

(For Patent Owner)

Brad D. Pedersen
PATTERSON, THUENTE, SKAAR
& CHIRSTENSEN, P.A.
80 South 8th Street, 4800 IDS Center
Minneapolis, MN 55402

(For *Inter Partes* Requester)

In re Appling *et al.*
Inter Partes Reexamination Proceeding
Control No.: 95/001,256
Filed: November 6, 2009
For: U.S. Patent No. 7,273,478

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

This is a decision on patent owner's petition filed on February 18, 2010, entitled "PETITION UNDER 37 CFR 1.183 FOR ADDITIONAL PAGES," for a concurrently filed response to an Office action.

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

The petition is dismissed.

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 No. 01-0035, as authorized on page 2 of the petition.

REVIEW OF RELEVANT FACTS

1. On September 25, 2007, the Office issued U.S. Patent No. 7,273,478 (the '478 patent) to Appling *et al.*

2. On November 6, 2009, a request for *inter partes* reexamination of the '478 patent was filed. The request was assigned Control No. 95/001,256 (the '1256 proceeding).

3. On December 18, 2009, *inter partes* reexamination was ordered for the '1256 proceeding. On the same day, a non-final Office action was mailed in the '1256 proceeding.

4. On February 18, 2010, patent owner filed a response to the December 18, 2009 Office action and concurrently filed the instant petition paper entitled, "PETITION UNDER 37 CFR 1.183 FOR ADDITIONAL PAGES".

5. On March 19, 2010, third party requested submitted responsive comments.

DECISION

37 CFR 1.183 provides:

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

37 CFR 1.943(b) provides:

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

Patent owner's February 18, 2010 response to the December 18, 2009 Office action consists of a sixty-seven (67) pages of comments and two declarations under 37 CFR 1.132, totaling fourteen (14) pages. The two declarations were reviewed and found free of improper legal argument. One of the two declarations has ten (10) documents attached as evidentiary exhibits. The exhibited documents are being used for their relevant factual content and do not contain legal argument or legal conclusions. Therefore, the exhibited documents are not subjected to the regulatory 50-page limit. Accordingly, only the sixty-seven (67) pages of comments are subject to the 50-page limit. The sixty-seven (67) pages of patent owner comments includes a cover sheet, a three page table of contents and a signature page; thus, the substantive portion of the comments consists of sixty-two (62) pages of substantive remarks, exceeding the 50–page limit established by 37 CFR 1.943(b) by a total of twelve (12) pages.

Patent owner has NOT made an adequate showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft a response in compliance with the 50-page limit, and submitting the resulting response, which is in excess of 50 pages. Patent owner has provided no explanation of how the submitted response economizes, excludes extraneous material, and is arranged so as not to repeat information already of record. The merits of the case do not contain any unique and/or inordinately complex legal issue, but instead includes only common issues of patent law that arise in patent examination proceedings, e.g. anticipation, obviousness or availability of a reference to serve as prior art, etc. Considering the

equities, having to respond to the December 18, 2009 Office Action which consisted of seventeen (17) pages of substance without any incorporation by reference to the request, permitting patent owner to have a response of sixty-two (62) pages of substance does not balance the equities between the parties in this *inter partes* proceeding. In this instance, exceeding the page limits of 37 CFR 1.943(b) by patent owner disturbs the equitable balance set by the length-limiting rule in light of the facts and circumstances of the instant case. Therefore, patent owner's requested relief will not be granted, the February 18, 2010 response will not be entered into the IFW record, and thus will not be considered. Accordingly, third party requester's March 19, 2010 responsive comments will also not be considered, as the third party submission is responding to paper that is not of record.

Patent owner asserts three separate arguments in the February 18, 2010 petition to justify exceeding the page limit by twelve (12) pages:

1) The December 18, 2009 Office Action is a detailed 23-page first Office action on the merits comprised of thirteen (13) major grounds of rejection using more than ten (10) references [eleven (11) references were used by the examiner] and involving all the currently un-disclaimed original claims [totaling 2 claims].

2) Third party requester's November 6, 2009 request for reexamination was over thirty-five pages in length and included eleven (11) cited references and ninety-three (93) pages of claim charts.

3) Several documents made of record by patent owner's response in the '1256 proceeding memorialize extensive testimony relevant to the prior art of record from patent infringement proceedings regarding the '478 patent.

Patent owner's three specific arguments are addressed below.

1) The December 18, 2009 Office Action is a detailed 23-page first Office action on the merits comprised of thirteen (13) major grounds of rejections using more that ten (10) references [eleven (11) references were used by the examiner] and involving all the currently un-disclaimed original claims [totaling 2 claims].

The Office action is not unduly lengthy and the pattern of rejections and reference usage with respect to the claims under examination is not extraordinarily excessive or complex for an *inter partes* reexamination. The Office action is twenty-seven (27) pages long, including four pages for address/mailing purposes, an Office action summary page PTOL-2064, a reexamination procedures page that also replicates the statutory language of 35 U.S.C. 103(a), one and one-half pages listing the proposed grounds of rejection, a two page discussion regarding the scope of reexamination and a conclusion/signature page; thus the substantive content consists of approximately seventeen (17) pages. The examiner of record in the December 18, 2009 Office action restated and adopted the thirteen proposed rejections as set forth by the requester in the request for reexamination, and did not incorporate by reference any

of the proposed rejections from the request. Additionally, the use of eleven different references in thirteen different rejections in an *inter partes* reexamination proceeding alone, does not represent an extraordinarily excessive or complex usage of references in an *inter partes* reexamination. Therefore, the length of the Office action and the number of references utilized do not justify to the requested relief of a waiver of the regulatory 50-page limit requirement in this circumstance. Accordingly, there is no extraordinary situation that justice compels a grant the equitable relief of waiving the 50-page limit rule and give patent owner additional pages for responsive comments.

2) Third party requester's November 6, 2009 request for reexamination was over thirty-five pages in length and included eleven (11) cited references and ninety-three (93) pages of claim charts.

The patent owner's response is to the December 18, 2009 Office action and not the November 6, 2009 request for reexamination and the Office action did not incorporate by reference portions of the November 6, 2009 request. *See* 35 U.S.C. 314(b)(2); *See also* 37 CFR 1.945. Therefore, the length of the request, the number of references utilized and the length of the claim chart appendices are not directly relevant to the requested relief of a waiver of the regulatory 50-page limit requirement in this circumstance. Furthermore, the Office encourages the use of claimed charts to facilitate satisfaction of the detailed explanation requirements of 37 CFR 1.915(b) and for subsequent use by the parties and the Office during the proceeding, *e.g.*, citation as to the factual basis for the rejections at issue. Accordingly, there is no extraordinary situation that justice compels to grant the equitable relief of waiving the 50-page limit rule and give patent owner additional pages for responsive comments.

3) Several documents made of record by patent owner's response in the '1256 proceeding memorialize extensive testimony relevant to the prior art of record from patent infringement proceedings regarding the '478 patent.

The documents submitted with patent owner's response to the December 18, 2009 Office action are evidentiary exhibits, which are not subject to the regulatory 50-page limit. One of the two declarations submitted by patent owner on February 18, 2010 was executed by Toni Olivier, a paralegal employed by patent owner's counsel (the Oliver declaration). The Oliver declaration consisted of a two page listing of ten (10) different court documents generated by and/or used in past and concurrent patent litigation proceedings regarding the '478 patent. Patent owner submitted the ten (10) different documents as evidentiary exhibits to the Oliver declaration and the ten (10) exhibits total 188 pages in length. The Oliver declaration only states that the exhibited documents are true copies. The exhibited documents contain relevant factual evidence and do not contain legal argument or conclusions. The exhibited documents are introduced and discussed at various locations in the sixty-two (62) page remarks section, for the purpose of introducing facts regarding the technology and the invention and not for the purpose of incorporating legal arguments by reference. Therefore, the exhibited documents are not subjected to the regulatory 50-

page limit. Accordingly, there is no need to grant the equitable relief of waiving the 50-page limit rule and give patent owner additional pages based upon the submission of evidentiary exhibits, as the additional pagination of the exhibits are not relevant to the issue.

Finally, in addition to the above discussion that none of the above arguments individually make out an extraordinary basis for which justice would compel the requested equitable relief; a combination of all three arguments does not implicate an extraordinary situation for which justice compels a grant of equitable relief. Waiver of the rules under 37 CFR 1.183 may be waived in an ***extraordinary situation when justice requires***. As noted above patent owner did not provide a sufficient showing that the response represented an effort to economize its content. Furthermore, patent owner did not demonstrate how the merits of the case contained any unique and/or inordinately complex legal issue to justify waiver of the regulatory page limitation. Patent owner provides no other facts to establish an extraordinary situation where justice requires waiver of the rule to exceed the 50-page regulatory limit by twelve (12) additional pages. The failure of patent owner to comply with the rules, in the form of an economized set of comments in accordance with 37 CFR 1.943(b), does not rise to an ***extraordinary situation*** under 37 CFR 1.183 to justify waiver of the rule. Therefore, justice does not require suspension of 37 CFR 1.943(b). Accordingly, the petition requesting waiver of the 50-page limit set forth in 37 CFR 1.943(b) to accept patent owner's February 18, 2010 comments with sixty-two (62) pages of substantive remarks is DISMISSED.

ADDITIONAL DISCUSSION/GUIDANCE

Patent owner's February 18, 2010 submission is improper and subject to return. See MPEP 2667, Part I.A.2. The copy of the February 18, 2010 submission however, was scanned into the electronic Image File Wrapper (IFW) of the proceeding, before discovery of the impropriety. Thus, the submission cannot be physically returned to patent owner. Therefore, the IFW copy of the submission is being expunged, by closing it in the IFW file of the present proceeding and marking it "not public." It will not constitute part of the record of the present reexamination proceeding.

For the reasons given above, the February 18, 2010 submission by patent owner exceeded the 50-page limit established by 37 CFR 1.943(b). However, from the record it is apparent that patent owner's submission was a *bona fide* attempt to respond and advance prosecution. Accordingly, patent owner may, within 15 days from the date of this notice, exercise one of the following two options:

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

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

This 15-day period for reply is not extendable.

The declarations and exhibits are also being expunged as they are part of an improper submission. Therefore upon resubmission, patent owner should include the declarations and exhibit and as long as they are not re-drafted or altered to include improper legal argument or conclusions they would not be counted against the 50-page limit.

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

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

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

Patent owner may want to consider the following when drafting comments in an *inter partes* reexamination proceeding in light of the regulatory page limitation: (1) use of lengthy block quotes and figures should be given careful consideration and instead citation to the relevant portion(s) of the document(s) of record to economize space maybe employed; (2) remarks regarding an inventor's business and/or credentials can be submitted as an exhibit to the comments and thus not be counted against the regulatory page limit; (3) restating the legal analysis and rationale of any rejection or record can be minimized by citation to the relevant rejection in the record and then include patent owner's response to efficiently identify and provide relevant arguments to the rejections of record; and (4) extensive discussion sections regarding the current state of the law maybe minimized by citations to the relevant section(s) of the Manual of Patent Examination Procedure (MPEP) along with supplemental citation to the most current on point case law, if necessary, as patent owner argues the merits of the case.

Patent owner is advised that submissions should be of sufficient size, 12 point font, double spaced and conform to the margin requirements of 37 CFR 1.52(a)(1)(ii) and have sufficient clarity and contrast to permit direct reproduction, and electronic capture by digital imaging and optical character recognition. See 37 CFR 1.52.

CONCLUSION

1. Patent owner's February 18, 2010 petition under 37 CFR 1.183 is dismissed.

2. Patent owner's February 18, 2010 response is an improper paper and will not be considered. The response is being expunged by being closed in the '1256 proceeding's Image File Wrapper (IFW) and marking "non-public." The response will not constitute part of the record of the present reexamination proceeding.

3. A copy of this decision will be made of public record.

4. Jurisdiction over this proceeding is returned to the Central Reexamination Unit (CRU). After the CRU has processed all party papers, or there are no such papers and the time for filing same has expired, the proceeding will be taken up for appropriate action.

5. Telephone inquiries with regard to this decision should be directed to Joseph F. Weiss, Jr., Office of Patent Legal Administration, at (571) 272-7759.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examining Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,257	11/16/2009	M 7559329	P-32CONT-RE/210646	8155

76147 7590 06/08/2010

AFS / ANGIODYNAMICS
666 THIRD AVENUE
FLOOR 10
NEW YORK, NY 10017

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/08/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/001,257	11/16/2009	7559329	

EXAMINER
FLANAGAN, BEVERLY

ART UNIT	PAPER
3993	

PATTERSON, THUENTE,
SKAAR & CHRISTENSEN, PA
ATTN: Brad D. Pedersen
4800 IDS CENTER, 80 SOUTH 8th STREET
MINNEAPOLIS, MN 55402-2100

DATE MAILED:

06/08/10

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.
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UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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EXAMINER
FLANAGAN, BEVERLY

ART UNIT	PAPER
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PATTERSON, THUENTE,
SKAAR & CHRISTENSEN, PA
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4800 IDS CENTER, 80 SOUTH 8th STREET
MINNEAPOLIS, MN 55402-2100

DATE MAILED:

INTER PARTES REEXAMINATION COMMUNICATION

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UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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AFS/ANGIODYNAMICS
666 Third Avenue
Floor 10
New York, NY 10017

(For Patent Owner)

Brad D. Pedersen
PATTERSON, THUENTE, SKAAR
& CHIRSTENSEN, P.A.
80 South 8th Street, 4800 IDS Center
Minneapolis, MN 55402

(For *Inter Partes* Requester)

MAILED

JUN 08 2010

CENTRAL REEXAMINATION UNIT

In re Appling *et al.*
Inter Partes Reexamination Proceeding
Control No.: 95/001,257
Filed: November 6, 2009
For: U.S. Patent No. 7,559,329

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

This is a decision on patent owner's petition filed on March 8, 2010, entitled "PETITION UNDER 37 CFR 1.183 FOR ADDITIONAL PAGES," for a concurrently filed response to an Office action.

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

The petition is dismissed.

Office records reflect the petition fee of $400 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183 was paid by check.

REVIEW OF RELEVANT FACTS

1. On July 14, 2009, the Office issued U.S. Patent No. 7,559,329 (the '329 patent) to Appling *et al.*

2. On November 6, 2009, a request for *inter partes* reexamination of the '478 patent was filed. The request was assigned Control No. 95/001,257 (the '1257 proceeding).

3. On January 8, 2010, *inter partes* reexamination was ordered for the '1257 proceeding. On the same day, a non-final Office action was mailed in the '1257 proceeding.

4. On March 8, 2010, patent owner filed a response to the January 8, 2010 Office action and concurrently filed the instant petition paper entitled, "PETITION UNDER 37 CFR 1.183 FOR ADDITIONAL PAGES".

5. On April 6, 2010, third party requested submitted responsive comments.

DECISION

37 CFR 1.183 provides:

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

37 CFR 1.943(b) provides:

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

Patent owner's March 8, 2010 response to the January 8, 2010 Office action consists of a seventy-three (73) pages of comments and three declarations under 37 CFR 1.132, totaling nineteen (19) pages. The three declarations were reviewed and found free of improper legal argument. One of the three declarations has ten (10) documents attached as evidentiary exhibits. The exhibited documents are being used for their relevant factual content and do not contain legal argument or legal conclusions. Therefore, the exhibited documents are not subjected to the regulatory 50-page limit. Accordingly, only the seventy-three (73) pages of comments are subject to the 50-page limit. The seventy-three (73) pages of patent owner comments includes a cover sheet, a four page table of contents and a signature page; thus, the substantive portion of the comments consists of sixty-seven (67) pages of substantive remarks, exceeding the 50–page limit established by 37 CFR 1.943(b) by a total of seventeen (17) pages.

Patent owner has NOT made an adequate showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft a response in compliance with the 50-page limit, and submitting the resulting response, which is in excess of 50 pages. Patent owner has provided no explanation of how the submitted response economizes, excludes extraneous material, and is arranged so as not to repeat information already of record. The merits of the case do not contain any unique and/or inordinately complex legal issue, but instead includes only common issues of patent law that arise in patent examination proceedings, e.g. anticipation, obviousness or availability of a reference to serve as prior art, etc. Considering the

equities, having to respond to the January 8, 2010 Office Action which consisted of twelve (12) pages of substance without any incorporation by reference to the request, permitting patent owner to have a response of sixty-seven (67) pages of substance does not balance the equities between the parties in this *inter partes* proceeding. In this instance, exceeding the page limits of 37 CFR 1.943(b) by patent owner disturbs the equitable balance set by the length-limiting rule in light of the facts and circumstances of the instant case. Therefore, patent owner's requested relief will not be granted, the March 8, 2010 response will not be entered into the IFW record, and thus will not be considered. Accordingly, third party requester's April 6, 2010 responsive comments will also not be considered, as the third party submission is responding to a paper that is not of record.

Patent owner asserts three separate arguments in the March 8, 2010 petition to justify exceeding the page limit by seventeen (17) pages:

1) The January 8, 2010 Office Action is a detailed 16-page first Office action on the merits comprised of eight (8) major grounds of rejection using more than ten (10) references [eleven (11) references were used by the examiner] and involving all the '329 patent's original thirty-one (31) claims.

2) Third party requester's November 6, 2009 request for reexamination was over fifty pages in length and included eleven (11) cited references and 368 pages of claim charts.

3) Several documents made of record by patent owner's response in the '1257 proceeding memorialize extensive testimony relevant to the prior art of record from patent infringement proceedings regarding the '329 patent.

Patent owner's three specific arguments are addressed below.

1) The December 18, 2009 Office Action is a detailed 16-page first Office action on the merits comprised of eight (8) major grounds of rejections using more that ten (10) references [eleven (11) references were used by the examiner] and involving all the '329 patent's original thirty-one (31) claims.

The Office action is not unduly lengthy and the pattern of rejections and reference usage with respect to the claims under examination is not extraordinarily excessive or complex for an *inter partes* reexamination. The Office action is twenty-seven (27) pages long, including two pages for address/mailing purposes, an Office action summary page PTOL-2064, a reexamination procedures page that also replicates the statutory language of 35 U.S.C. 103(a), one page listing the proposed grounds of rejection, and a conclusion/signature page; thus the substantive content consists of approximately twelve (12) pages. The examiner of record in the January 8, 2010 Office action restated and adopted the eight proposed rejections as set forth by the requester in the request for reexamination, and did not incorporate by reference any of the proposed rejections from the request. Additionally, the use of eleven different

references in eight different rejections in an *inter partes* reexamination proceeding alone, does not represent an extraordinarily excessive or complex usage of references in an *inter partes* reexamination. Therefore, the length of the Office action and the number of references utilized do not justify to the requested relief of a waiver of the regulatory 50-page limit requirement in this circumstance. Accordingly, there is no extraordinary situation that justice compels a grant the equitable relief of waiving the 50-page limit rule and give patent owner additional pages for responsive comments.

2) Third party requester's November 6, 2009 request for reexamination was over fifty pages in length and included eleven (11) cited references and 368 pages of claim charts.

The patent owner's response is to the January 8, 2010 Office action and not the November 6, 2009 request for reexamination and the Office action did not incorporate by reference any portion of the November 6, 2009 request. *See* 35 U.S.C. 314(b)(2); *See also* 37 CFR 1.945. Therefore, the length of the request, the number of references utilized and the length of the claim chart appendices are not directly relevant to the requested relief of a waiver of the regulatory 50-page limit requirement in this circumstance. Furthermore, the Office encourages the use of claimed charts to facilitate satisfaction of the detailed explanation requirements of 37 CFR 1.915(b) and for subsequent use by the parties and the Office during the proceeding, *e.g.* citation as to the factual basis for the rejections at issue. Accordingly, there is no extraordinary situation that justice compels to grant the equitable relief of waiving the 50-page limit rule and give patent owner additional pages for responsive comments.

3) Several documents made of record by patent owner's response in the '1257 proceeding memorialize extensive testimony relevant to the prior art of record from patent infringement proceedings regarding the '329 patent.

The documents submitted with patent owner's response to the January 8, 2010 Office action are evidentiary exhibits, which are not subject to the regulatory 50-page limit. One of the three declarations submitted by patent owner on March 8, 2010 was executed by Toni Olivier, a paralegal employed by patent owner's counsel (the Oliver declaration). The Oliver declaration consisted of a two page listing of court documents generated by and/or used in past and concurrent patent litigation proceedings regarding the '329 patent along with the prosecution history of the '329 patent. Patent owner submitted these documents as evidentiary exhibits to the Oliver declaration and all the exhibits total 417 pages in length. The Oliver declaration only states that the exhibited documents are true copies. The exhibited documents contain relevant factual evidence and do not contain legal argument or conclusions. The exhibited documents are introduced and discussed at various locations in the sixty-seven (67) page remarks section, for the purpose of introducing facts regarding the technology and the invention and not for the purpose of incorporating legal arguments by reference. Therefore, the exhibited documents are not subjected to the regulatory 50-page limit. Accordingly, there is no need to grant the equitable relief

of waiving the 50-page limit rule and give patent owner additional pages based upon the submission of evidentiary exhibits, as the additional pagination of the exhibits are not relevant to the issue.

Finally, in addition to the above discussion that none of the above arguments individually make out an extraordinary basis for which justice would compel the requested equitable relief; a combination of all three arguments does not implicate an extraordinary situation for which justice compels a grant of equitable relief. Waiver of the rules under 37 CFR 1.183 may be suspended in an ***extraordinary situation when justice requires***. As noted above patent owner did not provide a sufficient showing that the response represented an effort to economize its content. Furthermore, patent owner did not demonstrate how the merits of the case contained any unique and/or inordinately complex legal issue to justify waiver of the regulatory page limitation. Patent owner provides no other facts to establish an extraordinary situation where justice requires waiver of the rule to justify seventeen (17) additional pages. The failure of patent owner to comply with the rules, in the form of submitting an economized set of comments in accordance with 37 CFR 1.943(b), does not rise to an ***extraordinary situation*** under 37 CFR 1.183 to justify waiver of the rule. Therefore, justice does not require waiver of 37 CFR 1.943(b). Accordingly, the petition requesting waiver of the 50-page limit set forth in 37 CFR 1.943(b) to accept patent owner's March 8, 2010 comments with sixty-seven (67) pages of substantive remarks is DISMISSED.

ADDITIONAL DISCUSSION/GUIDANCE

Patent owner's March 8, 2010 submission is improper and subject to return. See MPEP 2667, Part I.A.2. The copy of the March 8, 2010 submission however, was scanned into the electronic Image File Wrapper (IFW) of the proceeding, before discovery of the impropriety. Thus, the submission cannot be physically returned to patent owner. Therefore, the IFW copy of the submission is being expunged, by closing it in the IFW file of the present proceeding and marking it "not public." It will not constitute part of the record of the present reexamination proceeding.

For the reasons given above, the March 8, 2010 submission by patent owner exceeded the 50-page limit established by 37 CFR 1.943(b). However, from the record it is apparent that patent owner's submission was a *bona fide* attempt to respond and advance prosecution. Accordingly, patent owner may, within 15 days from the date of this notice, exercise one of the following two options:

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

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

This 15-day period for reply is not extendable.

The declarations and exhibits are also being expunged as they are part of an improper submission. Therefore upon resubmission, patent owner should include the declarations and exhibit and as long as they are not re-drafted or altered to include improper legal argument or conclusions they would not be counted against the 50-page limit.

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

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

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

Patent owner may want to consider the following when drafting comments in an *inter partes* reexamination proceeding in light of the regulatory page limitation: (1) use of lengthy block quotes and figures should be given careful consideration and instead citation to the relevant portion(s) of the document(s) of record to economize space maybe employed; (2) remarks regarding an inventor's business and/or credentials can be submitted as an exhibit to the comments and thus not be counted against the regulatory page limit; (3) restating the legal analysis and rationale of any rejection or record can be minimized by citation to the relevant rejection in the record and then include patent owner's response to efficiently identify and provide relevant arguments to the rejections of record; and (4) extensive discussion sections regarding the current state of the law maybe minimized by citations to the relevant section(s) of the Manual of Patent Examination Procedure (MPEP) along with supplemental citation to the most current on point case law, if necessary, as patent owner argues the merits of the case.

Patent owner is advised that submissions should be of sufficient size, 12 point font, 1.5 line spaced and conform to the margin requirements of 37 CFR 1.52(a)(1)(ii) and have sufficient clarity and contrast to permit direct reproduction, and electronic capture by digital imaging and optical character recognition. See 37 CFR 1.52.

CONCLUSION

1. Patent owner's March 8, 2010 petition under 37 CFR 1.183 is dismissed.

2. Patent owner's March 8, 2010 response is an improper paper and will not be considered. The response is being expunged by being closed in the '1257 proceeding's Image File Wrapper (IFW) and marking "non-public." The response will not constitute part of the record of the present reexamination proceeding.

3. A copy of this decision will be made of public record.

4. Jurisdiction over this proceeding is returned to the Central Reexamination Unit (CRU). After the CRU has processed all party papers, or there are no such papers and the time for filing same has expired, the proceeding will be taken up for appropriate action.

5. Telephone inquiries with regard to this decision should be directed to Joseph F. Weiss, Jr., Office of Patent Legal Administration, at (571) 272-7759.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examining Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,258	12/02/2009	7501357	16428.0001USRX	9970

32885 7590 05/10/2010

STITES & HARBISON PLLC
401 COMMERCE STREET
SUITE 800
NASHVILLE, TN 37219

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

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

Date: MAILED

MAY 10 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001258
PATENT NO. : 7501357
TECHNOLOGY CENTER : 3999
ART UNIT : 3991

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Richard S. Myers, Jr.
Stites & Harbison PLLC
401 Commerce Street
Suite 800
Nashville, TN 37219

For Patent Owner

MAILED

MAY 10 2010

CENTRAL REEXAMINATION UNIT

For Requester

Merchant & Gould PC
P O Box 2903
Minneapolis MN 55402-0903

Ex Parte Reexamination Proceeding
Control No. 95/001,258
Filed: December 02, 2009
For: US Patent No. 7,501,357

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

This is a decision on the petition filed May 7, 2010 to request an extension of time pursuant to 37 CFR 1.956 for filing a response to the Office action mailed March 10, 2010.

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

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

Best Available Copy

Decision

The Patent Owner requests an extension of time in which to file a response to the Office action dated March 10, 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 Owners have been reviewing and preparing a response to the outstanding Office action; however, the preparation of the response to the Office action of March 10, 2010 will require the retrieval and review of an extensive amount of data with regards to comparative testing. The investigation is hampered by the retirement, departure or reassignment of the inventors. An extension of time is requested to provide Patent Owner with a fair opportunity to prepare a complete and substantive response in this reexamination proceeding.

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Analysis and Findings

Patent Owner has set forth a factual accounting that is deemed to establish reasonably diligent behavior by all those responsible for preparing a response within the statutory period. When balanced against the requirement of 35 USC 305 that this proceeding be handled with special dispatch, Patent Owner's showing is sufficient to justify the grant of a one-month extension of time in which to file a response to the outstanding Office action. In the interest of providing the Patent Owner with a fair opportunity to present an argument against the rejections of record and the requirement of 35 USC 305 that the proceedings be conducted with special dispatch, an extension of time for one (1) month is granted. Patent Owner should expect that future requests for extensions will not be granted absent strong and compelling reasons that establish the existence of an extraordinary situation necessitating the additional time.

Conclusion

1. The Patent Owner's petition for extension of time in which to file a response to the Office action of March 10, 2010 is **granted for one month**.

2. The Patent Owner's response is due June 10, 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/
Deborah Jones,
SPE, Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,264	11/13/2009	7324833	AFF.0004B5US	6910

21906 7590 06/14/2010

TROP, PRUNER & HU, P.C.
1616 S. VOSS ROAD, SUITE 750
HOUSTON, TX 77057-2631

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/14/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patents and Trademark Office
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
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET, FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date:

MAILED

JUN 14 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001264
PATENT NO. : 7324833
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,223	09/22/2009	7324833	AFF.0004B2US	1290

21906 7590 06/14/2010

TROP, PRUNER & HU, P.C.
1616 S. VOSS ROAD, SUITE 750
HOUSTON, TX 77057-2631

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/14/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patents and Trademark Office
P.O.Box 1450
Alexandria, VA 22313-1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
KENYON & KENYON LLP
ONE BROADWAY
NEW YORK, NY 10004

Date:

MAILED

JUN 14 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001223
PATENT NO. : 7324833
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,333	11/07/2008	7324833	AFF.0004B1US	6333

21906 7590 06/14/2010

TROP, PRUNER & HU, P.C.
1616 S. VOSS ROAD, SUITE 750
HOUSTON, TX 77057-2631

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/14/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

Date:

MAILED

JUN 14 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010333
PATENT NO. : 7324833
ART UNIT : 3992

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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TROP, PRUNER & HU, P.C.
1616 S. VOSS ROAD, SUITE 750
HOUSTON TX 77057-2631

(For Patent Owner)

MAILED

JUN 14 2010

Kenyon & Kenyon LLP
One Broadway
New York, NY 10004

(For first *Inter Partes* Requester)

CENTRAL REEXAMINATION UNIT

Novak, Druce & Quigg LLP
(NDQ Reexamination Group)
1000 Louisiana Avenue
Fifty-Third Floor
Houston, TX 77002

(For second *Inter Partes* Requester)

Knobbe, Martens Olson & Bear, LLP
5040 Main St. 14th Floor
Irvine, CA 92614

(For *Ex Parte* Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,223
Filed: September 22, 2009
For: U.S. Patent No. 7,324,833

Inter Partes Reexamination Proceeding
Control No. 95/001,264
Filed: November 13, 2009
For: U.S. Patent No. 7,324,833

Ex Parte Reexamination Proceeding
Control No. 90/010,333
Filed: November 7, 2008
For: U.S. Patent No. 7,324,833

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 (consolidated) at this time.

REVIEW OF RELEVANT FACTS

1. On January 29, 2008, the Office issued U.S. Patent No. 7,324,833 (the '833 patent) issued to White *et al.*

2. On November 7, 2008, a request for *ex parte* reexamination of all the claims in the '833 patent was filed by a third party requester. The request was assigned control number 90/010,333 (the '10333 proceeding).

3. On December 19, 2008, *ex parte* reexamination was ordered on all the claims of the '833 patent in the '10333 proceeding.

4. On August 5, 2009, a non-final Office action was mailed in the '10333 proceeding, rejecting all the claims of the '833 patent.

5. On September 22, 2009, a first request for *inter partes* reexamination of all the claims in the '833 patent was filed by a third party requester and real party in interest, Volkswagen Group of Americas, Inc.. The request was assigned control number 95/001,233 (the '1233 proceeding).

6. On October 2, 2009, patent owner timely filed, in the '10333 proceeding, an amendment and response to the August 5, 2009 Office action, amending claims 1 and 17. No claims were added or canceled.

7. On November 9, 2009, *inter partes* reexamination was ordered in the '1223 proceeding.

8. On November 13, 2009, a second request for *inter partes* reexamination of all the claims in the '833 patent, was filed by a third party requester and real party in interest, Apple, Inc... The request was assigned control number 95/001,264 (the '1264 proceeding).

9. On February 5, 2010, *inter partes* reexamination was ordered in the '1223 proceeding.

10. To date, no Office action has issued in the '1223 *inter partes* proceeding, nor in the '1264 *inter partes* proceeding, and no further Office action has issued in the '10333 *ex parte* reexamination proceeding.

DECISION

I. MERGER OF PROCEEDINGS

Reexamination has been ordered in three proceedings for the same claims of the same patent Two of the proceedings are *inter partes* reexamination proceedings and one is an *ex parte* reexamination proceeding. All proceedings are still pending, and have not been terminated. Therefore, consideration of merger is ripe at this point in time.

The 95/001,080, 95/001,183 *inter partes* proceedings and the 90/010,623 *ex parte* proceedings are merged. The merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

Patent owner is required to maintain the same claims (and specification) in all files throughout the merged proceeding. Amendments to patent claims 1 and 17 have been proposed in the '10333 proceeding, while there is no amendment in either the '1223 and '1264 proceedings. Thus, the claims are not currently the same in all files. An Office action requiring an amendment placing the claims of all the proceedings in identical form is being issued concurrently with this decision. Patent owner must respond to the Office action in accordance with the procedure provided in 37 CFR 1.111. The *inter partes* third party requesters will then have an opportunity to comment on patent owner's response in accordance with the procedures in 37 CFR 1.947.

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 participation by the third party requester of the '10333 *ex parte* reexamination is governed by 37 CFR §§ 1.510 through 1.560.

B. *Inter partes* Third Party Requester Participation:

1. Comment rights:

Upon merger of proceedings both *inter partes* requesters, Apple, Inc and Volkswagen Group of Americas, Inc., can comment pursuant to 35 U.S.C. 314(b)(2).[1] First, an *inter partes* requesters' right to comment is contingent upon the patent owner responding to, or commenting on, an Office action. Second, an *inter partes* requesters' right to comment is 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. Neither *inter partes* requester has a right to comment on any issue raised outside the confines of the statute, e.g. issues raised in a previous Office action (but not raised in the most recent Office action or response) or the request and comments from another requester. Requester comments must be submitted within the statutory time period of 30 days from date of service of patent owner's response.

[1] 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.

2. Appeal Rights:

The *inter partes* reexamination procedures for taking appeal, and for participating in the patent owner's appeal, are explained in MPEP 2674 through 2675.02, 2678 through 2683. As pointed out in MPEP 2674:

> A notice of appeal by a third party requester must identify each rejection *that was previously proposed by that third party requester* which the third party requester intends to contest. It is not sufficient to merely appeal from the allowance of a claim (i.e., the examiner's finding of a claim patentable); the third party requester must identify each previously proposed rejection to be contested.

Thus, each *inter partes* reexamination requester's appeal must **only** be taken from the finding(s) of patentability of claims in the RAN that the individual third party requester proposed in the request, and any that the individual third party requester properly added during the examination stage of the merged proceeding. Also, as provided by 37 CFR 41.67(c)(1)(vi):

> No new ground of rejection can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection.

Thus, the appellant's brief shall present a concise statement of each issue. And, no new ground of rejection (i.e., a ground that the individual requester did not propose) can be proposed by a third party requester appellant, unless that ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester did not yet have an opportunity to propose it as a third party requester proposed ground of rejection.

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 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 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 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. 95/001,223 and 95/001,264 and *ex parte* Reexamination Control No. 90/010,333 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above in Part III of this decision.

2. Jurisdiction over the merged reexamination files is being forwarded to the Central Reexamination Unit (CRU).

3. 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.

4. Any questions concerning this communication should be directed to Joseph F. Weiss, Jr., Legal Advisor, at 571-272-7759.

Kenneth M. Schor

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

5-13-10

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.
95/001,269	12/08/2009	6502135	77580-89	2038

23630 7590 02/24/2010

MCDERMOTT WILL & EMERY LLP
28 STATE STREET
BOSTON, MA 02109-1775

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 02/24/2010

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

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Toby H Kusmer
MCDERMOTT WILL & EMERY LLP
28 STATE STREET
BOSTON MA 02109-1775

(For Patent Owner)

MAILED

FEB 25 2010

CENTRAL REEXAMINATION UNIT

ROTHWELL, FIGG, ERNST &
MANBECK, PC
1425 K Street, NW
Suite 800
Washington, DC 20005

(For Third Party Requester)

In re: Munger *et alia*
Inter Partes Reexamination Proceeding
Control No. 95/001,269
Deposited on: 08 December 2009
For: US Patent No. 6,502,135

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

This is a decision on the 22 February 2010, "Petition for Extension of Time Under 37 CFR § 1.956 to Reply to Office Action in Reexamination" requesting the response period be extended by two (2) months for response to the non-final Office action mailed 15 January 2010. The petition was timely filed with certificate of service.

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

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

DISCUSSION

The Patent Owner's representative requests the period for response be extended by two (2) months for the non-final Office action mailed 15 January 2010, which set two (2) month's time for filing a response thereto. The petition for extension of time was timely filed on 22 February 2010, together with the $200.00 petition fee as required by 37 CFR § 1.956 and 37 CFR § 1.17 (g). A certificate of service was provided with the petition.

The request is granted-in-part.

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

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

> As noted above, a request for extension of time under 37 CFR § 1.956 will be granted only for sufficient cause, ...
>
> Evaluation of whether "sufficient cause" has been shown for an extension must be made by **balancing** the desire to provide the patent owner with a fair opportunity to respond, **against** the requirement of the statute, 35 U.S.C. § 314(c), that the proceedings be conducted with special dispatch. ...
>
> Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. The reasons must include (A) a statement of what action the patent owner has taken to provide a response, to date as of the date the request for extension is submitted, and (B) why, in spite of the action taken thus far, the requested additional time is needed. The statement of (A) must provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.
>
> Prosecution will be conducted by initially setting a time period of at least 30 days or one month (whichever is longer), see MPEP § 2662. First requests for extensions of these time periods will be granted for sufficient cause, and for a reasonable time specified-usually 1 month. The reasons stated in the request will be evaluated, and the request will be favorably considered where there is a factual accounting of reasonably diligent behavior

by all those responsible for preparing a response or comments within the statutory time period. Second or subsequent requests for extensions of time, or requests for more than one month, will be granted only in extraordinary situations. (emphasis added)

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

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

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

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

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

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

DECISION

The patent owner's representative petitions to extend the period for response by adding two (2) months to the response period under 37 CFR § 1.956. The decision to extend the period for response is evaluated based upon a showing of "sufficient cause." There is always the consideration to balance the need for the patent owner to have a fair opportunity to respond to the Office action between the need for special dispatch.

The non-final Office action was mailed 15 January 2010. The patent owner submitted a timely filed the petition on 22 February 2010 with the appropriate fee and certificate of service.

The petition dated 22 February 2010 articulates the delay in receipt of the Office action (one week), the need for a technical expert as yet unavailable, and various concurrent litigation and proceedings. On balance, the petitioner has demonstrated "sufficient cause" for the purpose of granting one (1) month extension of time.

The petitioner is reminded that requests for more than one (1) month, will be granted only in extraordinary situations.

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

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

CONCLUSION

1. The patent owner's petition for extension for two (2) months time in which to file a response to the non-final Office action dated 15 January 2010 is hereby **granted-in-part.**

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

3. The response is extended to **15 April 2010.**

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

By Mail to: Mail Stop *Inter Partes* Reexam

Central Reexamination Unit
Commissioner for Patents
United States Patent & Trademark Office
P. O. Box 1450
Alexandria, VA 22313-1450

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

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

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

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

/Mark Reinhart/

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,269	12/08/2009	6502135	77580-89	2038

23630 7590 04/29/2010

McDermott Will & Emery
600 13th Street, NW
Washington, DC 20005-3096

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/29/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

ROTHWELL, FIGG, ERNST & MANBECK, P.C.
1425 K STREET N.W.
SUITE 800
WASHINGTON, D.C.

Date:

MAILED

APR 29 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001269
PATENT NO. : 6502135
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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COMMISSIONER FOR PATENTS
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Toby H. Kusmer
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600 13th Street, NW
Washington DC 20005-3096

(For Patent Owner)

MAILED

APR 29 2010

CENTRAL REEXAMINATION UNIT

William N. Hughet
Rothwell, Figg, Ernst & Manbeck, P.C.
1425 K Street NW
Suite 800
Washington, D.C 20005

(For *Inter Partes* Requester)

In re Munger et al.
Inter partes Reexamination Proceeding
Control No. 95/001,269
Filed: December 8, 2009
For: U.S. Patent No. 6,502,135

DECISION DISMISSING PETITIONS

This is a decision on the March 29, 2010 patent owner Petition To Suspend *Inter Partes* Reexamination Proceedings Pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. §§ 1.181, 1.182, 1.183, and 1.987 and on the April 15, 2010 patent owner Petition Pursuant to 37 C.F.R. § 1.182 for OPLA to Take and Retain Jurisdiction Over These Inter Partes Reexamination Proceedings. The patent owner petition to suspend is taken as a petition under 37 C.F.R. § 1.182, because the rules do not provide for the filing of a petition requesting that an *inter partes* reexamination proceeding be suspended.

This is also a decision on the April 23, 2010 Third Party Requester's Petition Pursuant to 37 C.F.R. § 1.183 and/or 1.182 in Opposition to Patent Owner's Petition to Suspend *Inter Partes* Reexamination Proceedings and the April 23, 2010 Third Party Requester's Petition Pursuant to 37 C.F.R. § 1.183 and/or § 1.182 for Entry and Consideration of the Requester's Petition in Opposition to Patent Owner's Petition to Suspend *Inter Partes* Reexamination Proceedings. Both petitions are taken under 37 C.F.R. § 1.182 because the rules do not provide for the filing of a petition in opposition or a petition to request entry of another petition

The petition fee of $400.00 pursuant to 37 C.F.R. § 1.17(f) for each of patent owner's petitions under 37 C.F.R. § 1.182 was charged to patent owner's deposit account 501133, as authorized by the patent owner.

The petition fee of $400.00 pursuant to 37 C.F.R. § 1.17(f) for each of third party requester's petitions was charged to third party requester's deposit account 022135, as authorized by the third party requester.

The proceeding, patent owner petitions, and third party requester petitions are before the Office of Patent Legal Administration for consideration.

SUMMARY

1. The patent owner Petition Under 37 C.F.R. §§ 1.181, 1.182, 1.183 and 1.987 and 35 U.S.C. § 314(c) is dismissed.

2. The patent owner Petition Under 37 C.F.R. § 1.182 for OPLA to take and retain jurisdiction is granted to the extent that OPLA has taken jurisdiction to decide patent owner's petitions, and dismissed as to the request that OPLA retain jurisdiction, since such would run contrary to the mandate of 35 U.S.C. 314 (c) for special dispatch in reexamination proceedings.

3. The third party requester's petition Pursuant to 37 C.F.R. § 1.183 and/or § 1.182 in opposition to patent owner's petition is granted to the extent that the petition has been entered and considered.

4. The third party requester's petition Pursuant to 37 C.F.R. § 1.183 and/or § 1.182 for entry and consideration of the requester's petition in opposition is dismissed as moot as it is not necessary or desirable for a party to file a petition requesting entry and consideration of another petition.

REVIEW OF FACTS

1. U.S. Patent No. 6,502,135 (the '135 patent) issued to Munger et al. on December 31, 2002, with 17 claims.

2. A civil litigation involving the '135 patent commenced on February 15, 2007, captioned *Virnetx, Inc. v. Microsoft Corporation*, U.S. District Court, Texas Eastern, Case No. 6:07cv80.

3. On November 25, 2009, a request for *inter partes* reexamination of claims 1-10 and 12 of the '135 patent was deposited by a third party requester, Microsoft Corporation (a party to the concurrent civil litigation). A corrected request was filed December 8, 2009, which received a filing date and was assigned control no. 95/001,269 (the '1269 proceeding).

4. On December 31, 2009, reexamination was ordered for claims 1-10 and 12 of the '135 patent.

5. On January 15, 2010, a first Office action was issued adopting in part a proposed rejection of claims 1, 3, 4, 6, 10, and 12 as anticipated by Aventail under 35 U.S.C. § 102(a).

6. On February 22, 2010, patent owner petitioned for an extension of time, which was granted in part on February 24, 2010, extending the period for response to April 15, 2010.

7. On March 25, 2010, patent owner filed a notice of concurrent proceedings, including a March 16, 2010 jury verdict in the concurrent litigation finding claims 1, 10, and 12 willfully infringed and not invalid, and a notice that a new complaint was filed on March 17, 2010 against Microsoft based on infringement of the '135 patent in the Eastern District of Texas, Case No. 6:10cv94.

8. On March 29, 2010, patent owner filed a second petition for an extension of time, which was dismissed on April 1, 2010.

9. On March 29, 2010, patent owner also filed the subject petition requesting that the reexamination proceeding be suspended.

10. On April 15, 2010, patent owner filed a response to the January 15, 2010, non-final action.

11. On April 15, 2010, patent owner also filed the subject petition requesting that OPLA take and retain jurisdiction over the '1269 proceeding.

12. On April 23, 2010 third party requester filed two petitions, one of which is filed in opposition to patent owner's petition for suspension, and the other which requests entry of the opposition petition.

DECISION

I. RELEVANT STATUTES, REGULATIONS, AND EXAMINING PROCEDURE

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

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

35 U.S.C. 317(b) states:

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

37 C.F.R. § 1.182 states (in part):

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

37 C.F.R. § 1.907 states (in part):

> (b) Once a final decision has been entered against a party in a civil action arising in whole or in part under 28 U.S.C. 1338 that the party has not sustained its burden of proving invalidity of any patent claim-in-suit, then neither that party nor its privies may thereafter request *inter partes* reexamination of any such patent claim on the basis of issues which that party, or its privies, raised or could have raised in such civil action, and an *inter partes* reexamination requested by that party, or its privies, on the basis of such issues may not thereafter be maintained by the Office.

37 C.F.R. § 1.987 states:

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

The Manual of Patent Examining Procedure (MPEP) § 2686.04, subsection V, states (in part):

> * * * * *
>
> The statute thus authorizes the Director of the USPTO to suspend (stay) reexamination proceedings, where there is good cause to do so, pending the conclusion of litigation based on a potential for termination of a reexamination prosecution under 35 U.S.C. **317**(b). Thus, a District Court decision that is pending appeal on the validity of the same claims considered in an *inter partes* reexamination proceeding may provide the requisite statutory "good cause" for suspension, due to the real possibility that the 35 U.S.C. **317**(b) estoppel may attach in the near future to bar/terminate the reexamination proceeding. Any such fact situation is resolved on a case-by-case basis.
>
> In any *inter partes* reexamination where the requester (or its privies) is also a party to ongoing or concluded litigation as to the patent for which reexamination has been requested, the potential for this statutory estoppel to attach must be considered.
>
> * * * * *
>
> Taking the above into account, the following factors are to be considered in determining whether it is appropriate to refuse to order an *inter partes* reexamination, terminate the reexamination, or suspend action in the reexamination, based on litigation in which the reexamination requester is a party to the litigation.
>
> (A) The 35 U.S.C. **317**(b) estoppel applies only to patent claims that were litigated in the suit, i.e., litigated claims. The estoppel does not apply to non-litigated patent claims. Where there are non-litigated claims for which reexamination had been requested in the *inter partes* reexamination request, the reexamination proceeding is to go forward based on those non-litigated claims. If, however, during the reexamination proceeding, the patent owner disclaimed all the non-litigated claims, leaving only litigated claims, the proceeding is to be referred to the Office of Patent Legal Administration (OPLA).
>
> (B) The 35 U.S.C. **317**(b) estoppel applies only to issues which the requester or its privies raised or could have raised in the civil action. The estoppel does not apply where new issues are raised in the request. If the request provides new art/issues not raised in the litigation (civil action), and which could not have been so raised, then estoppel does not attach. The patent owner has the burden of showing that the art and issues applied in the request was available to the third-party requester and could have been placed in the litigation.

(C) The 35 U.S.C. 317(b) estoppel applies only in a situation where a final decision adverse to the requester has already been issued. If there remains any time for an appeal, or a request for reconsideration, from a court (e.g., District Court or Federal Circuit) decision, or such action has already been taken, then the decision is not final, and the estoppel does not attach. A stay/suspension of action may be appropriate for the reexamination proceeding if the litigation has advanced to a late enough stage and there is sufficient probability that a final decision will be adverse to the requester; however, that is a matter to be discussed with the OPLA in any such instance.

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

II. DISCUSSION

A. Patent Owner Requests Suspension of the '1269 Proceeding

Petitioner asserts that good cause exists to suspend the '1269 proceeding because a jury verdict has been issued in the district court proceeding. Petitioner argues that when the jury verdict becomes final, the third party requester will be estopped from further addressing the present rejections in the '1269 proceeding because the grounds of rejection of claims 1, 10, and 12 were raised by the third party requester in the litigation.

Petitioner asserts that the facts of this proceeding closely follow the facts of *In re Tremblay et al.*; Reexamination Control No. 95/000093, (*Sony*) [1] in which the proceeding was suspended, except that in this proceeding, the third party requester initiated proceedings three and one-half months prior to the jury verdict rather than shortly after the verdict in *Tremblay*. There are far more significant differences between this proceeding and *Tremblay* than the timing of the filing of the request for reexamination. Most importantly, the concurrent litigation in *Tremblay* was at the appellate stage and the appeal had been briefed at the Federal Circuit. In the present proceeding, briefing and post-trial motions at the district court have not even concluded. The time for seeking appeal has not begun to run. The concurrent litigation is not final, nor is it close to being final. As acknowledged by petitioner on page 6 of the petition, opening motions have begun, replies are not due until May, and the hearing has been rescheduled for May 27. After the hearing, if a final judgment is entered by the district court, Microsoft will have the opportunity to file an appeal, which will then require briefing and will be heard on a normal schedule.

As claims 1, 3, 4, 6-10, and 12 have already been subject to an Office action and a response has been filed in this reexamination proceeding, the examiner is ready to take further action now. It is likely that the reexamination proceeding will be completed well before the concurrent litigation becomes final after appeal is exhausted.

B. Patent Owner Requests for OPLA to Take and Retain Jurisdiction of the '1269 Proceeding

Patent owner petitions for OPLA to take jurisdiction of the '1269 proceeding to decide the petition to suspend, to decide and issue a decision on the petition to suspend, and to retain jurisdiction until 30 days following a decision. OPLA has taken jurisdiction and has decided the petition for suspension; however, there is no reason for OPLA to retain jurisdiction after this

---

[1] See, the related litigation titled *Sony Computer Entertainment America Inc. v. Dudas*, 2006 U.S. Dist. LEXIS 36856, (E.D.VA 2006).

decision. To the contrary, retaining jurisdiction would retard the statutorily mandated special dispatch required (see 35 U.S.C. 314(c)) in resolving the substantial new questions of patentability raised by the reexamination request.

C. Third Party Requester's Petition in Opposition to Patent Owner's Request for Suspension

Third party requester petitions to submit arguments in opposition to the patent owner's request for suspension of the proceeding. The petition is entered to the extent that the arguments have been considered. The patent owner's request for suspension is decided and explained below in section E.

D. Third Party Requester's Petition Requesting Entry and Consideration of the Petition in Opposition

It is not necessary or desirable to file a petition requesting entry and consideration of another petition. It is customary and sufficient to request waiver of the rules to permit entry and consideration in the original opposition petition. As the second petition was an unnecessary filing, the second petition is dismissed.

E. Additional Analysis and Findings

The factors to be considered in determining whether it is appropriate to terminate action in an *inter partes* proceeding based on a concluded litigation in which the third party requester is a party to the litigation are detailed in MPEP 2686.04, subsection V, reproduced above. In this case, the civil litigation and the '1269 proceeding both involve the claims 1, 10, and 12 of the '135 patent, with the '1269 proceeding additionally conducting reexamination of dependent claims 3, 4, and 6-9 and newly added claim 18. The patent owner has raised the presumption that the prior art issues in the '1269 proceeding are the same issues raised in the civil litigation. This presumption has not been rebutted by the third party requester. There is no concurrent *ex parte* proceeding for the '135 patent.

The above factors indicate that estoppel may, in the future, attach to claims 1, 10, and 12 in the *inter partes* proceeding; however, the most significant factor is whether a final decision adverse to the requester has been issued. In this case, no final decision has been issued. Even where a decision has not yet become final, a *stay or suspension* of a proceeding may be appropriate if (a) all other factors for estoppel attachment are present and (b) the litigation has advanced to a late enough stage that a final decision will be rendered in the near future and there is sufficient probability that a final decision will be adverse to the requester based solely on the prior district court decision (the Office cannot enter into the appeals court's province to try to assess the probability as to which party will win on appeal). In this situation, the district court judgment has not been made final, and the opportunity to appeal to the Federal Circuit has not commenced.

Thus, the significant facts in this proceeding are:

(1) The '1269 proceeding is in active reexamination phase, in which the claim patentability issues have been addressed in the first action, and the proceeding is awaiting examiner action on the response to the Office action[2];

(2) The '1269 proceeding also involves claims 3-9 and 18, which have not been raised in the civil litigation, and the proceeding would continue with respect to at least these claims, even if the patentability was finally resolved in the litigation for claims 1, 10 and 12; and

(3) The district court action has not been made final, and final resolution of the action is not expected in the near future. [3]

These facts, taken with the rest of the facts and circumstances of this case, do not support a finding of good cause to suspend the '1269 proceeding.

The facts in this proceeding are not squarely aligned with the facts in *Sony*. Although all remaining (reexamination proceeding) claims had been litigated and on appeal when the renewed petition to suspend was filed in the proceedings in *Sony,* that was not the only factor considered in the decision granting the renewed petition to suspend. [4] Rather, the Office considered the relative stages of the concurrent appeal and the reexamination proceedings. As noted by the district court in *Sony*, "the PTO correctly concluded that the two 'races' between the parties were at very different stages: The Federal Circuit appeal was nearing its conclusion, while the PTO's *inter partes* review was just beginning." [5] The relative stages in this situation are much closer.

In contrast to the *Sony inter partes* reexamination proceedings, which were just at their beginning stages (e.g., the Office's work had been limited only to a finding that the requests for reexamination had raised a substantial new question of patentability), the present reexamination proceeding has advanced significantly beyond the beginning stage. In this instance, the Office has issued a non-final Office action, in response to which the patent owner has filed a patent owner's response. Thus, patentability issues have been defined and argued by parties, and the Office's work in the reexamination proceeding has not been limited to merely finding that the request for reexamination raised a substantial new question of patentability (at which point a patentability determination has not yet been made). On the other hand, the district court case has not yet been made final, as was the case in *Sony*, and has appellate review has not been exhausted.

Additionally, the reexamination proceeding must proceed with special dispatch to resolve the substantial new questions of patentability raised by the reexamination request with respect to claims 2-9 and 18, regardless of the outcome of claims 1, 10 and 12 in the civil litigation. The public interest would not be served to suspend the proceeding. when there are claims under reexamination that are not subject to a concurrent civil litigation.

---

[2] This was not so in *Sony*, as will be discussed shortly.

[3] Again, this was not the situation in *Sony*, as will be discussed shortly.

[4] *See* the decision entitled "Decision Granting Petitions to Suspend," mailed on November 17, 2005, in reexamination proceeding control no. 95/000,094.

[5] *Sony*, 2006 U.S. Dist. LEXIS 36856, at *19.

Accordingly, good cause for suspension has not been shown, and the Petition under 37 C.F.R. §§ 1.181, 1.182, 1.183 and 1.987 and 35 U.S.C. § 314(c), requesting suspension of the '1269 proceeding, is **dismissed**.

As for patent owner's petition for OPLA to take and retain jurisdiction of the '1269 proceeding, OPLA has taken jurisdiction and the decision regarding patent owner's petitions has now been rendered herein. There is no reason for OPLA to retain jurisdiction for 30 days hence as the patent owner has filed a response and the examiner is prepared to take action. Retaining jurisdiction would serve no useful purpose and would be contrary to the mandate to conduct the proceeding with special dispatch under 35 USC 314(c). Therefore, the petition for OPLA to take and retain jurisdiction is **dismissed**.

CONCLUSION

1. The patent owner Petition Under 37 C.F.R. §§ 1.181, 1.182, 1.183 and 1.987 and 35 U.S.C. § 314(c) is dismissed.

2. The patent owner Petition Under 37 C.F.R. § 1.182 for OPLA to take and retain jurisdiction is granted to the extent that OPLA took jurisdiction to decide the patent owner's petitions, and dismissed as to the request that OPLA retain jurisdiction.

3. The third party requester Petition Under 37 C.F.R. § 1.182 and/or § 1.183 in opposition is granted for entry and consideration, but the Petition Under 37 C.F.R. § 1.182 and 1.183 requesting entry and consideration of the petition in opposition is dismissed as moot.

4. Jurisdiction over this proceeding is returned to the Central Reexamination Unit to continue reexamination with special dispatch.

5. The patent owner and the third party requester are respectfully reminded of their continuing duty to keep the Office apprised as to the status of the concurrent litigation pursuant to 37 C.F.R. § 1.985.

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

/Kenneth M. Schor/

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

04-28-10
Kenpet8/

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,270	12/08/2009	7188180	077580-0090	2128

23630 7590 02/25/2010

MCDERMOTT WILL & EMERY LLP
28 STATE STREET
BOSTON, MA 02109-1775

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 02/25/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

ROTHWELL, FIGG, ERNST & MANBECK, P.C.
1425 K STREET N.W.
SUITE 800
WASHINGTON, D.C. 20005

Date:

MAILED

FEB 25 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001270
PATENT NO. : 7188180
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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Toby H Kusmer
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(For Patent Owner)

MAILED

FEB 25 2010

CENTRAL REEXAMINATION UNIT

ROTHWELL, FIGG, ERNST &
MANBECK, PC
1425 K Street NW
Suite 800
Washington, DC 20005

(For Third Party Requester)

In re: Larson *et alia*
Inter Partes Reexamination Proceeding
Control No. 95/001,270
Deposited on: 08 December 2009
For: US Patent No. 7,188,180

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

This is a decision on the 22 February 2010, "Petition for Extension of Time Under 37 CFR § 1.956 to Reply to Office Action in Reexamination" requesting the response period be extended by two (2) months for response to the non-final Office action mailed 19 January 2010. The petition was timely filed with certificate of service.

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

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

DISCUSSION

The Patent Owner's representative requests the period for response be extended by two (2) months for the non-final Office action mailed 19 January 2010, which set two (2) month's time for filing a response thereto. The petition for extension of time was timely filed on 22 February 2010, together with the $200.00 petition fee as required by 37 CFR § 1.956 and 37 CFR § 1.17 (g). A certificate of service was provided with the petition.

The request is granted-in-part.

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

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

> As noted above, a request for extension of time under 37 CFR § 1.956 will be granted only for sufficient cause, ...
>
> Evaluation of whether "sufficient cause" has been shown for an extension must be made by **balancing** the desire to provide the patent owner with a fair opportunity to respond, **against** the requirement of the statute, 35 U.S.C. § 314(c), that the proceedings be conducted with special dispatch. ...
>
> Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. The reasons must include (A) a statement of what action the patent owner has taken to provide a response, to date as of the date the request for extension is submitted, and (B) why, in spite of the action taken thus far, the requested additional time is needed. The statement of (A) must provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.
>
> Prosecution will be conducted by initially setting a time period of at least 30 days or one month (whichever is longer), see MPEP § 2662. First requests for extensions of these time periods will be granted for sufficient cause, and for a reasonable time specified-usually 1 month. The reasons stated in the request will be evaluated, and the request will be favorably considered where there is a factual accounting of reasonably diligent behavior

by all those responsible for preparing a response or comments within the statutory time period. Second or subsequent requests for extensions of time, or requests for more than one month, will be granted only in extraordinary situations. (emphasis added)

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

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

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

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

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

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

DECISION

The patent owner's representative petitions to extend the period for response by adding two (2) months to the response period under 37 CFR § 1.956. The decision to extend the period for response is evaluated based upon a showing of "sufficient cause." There is always the consideration to balance the need for the patent owner to have a fair opportunity to respond to the Office action between the need for special dispatch.

The non-final Office action was mailed 19 January 2010. The patent owner submitted a timely filed the petition on 22 February 2010 with the appropriate fee and certificate of service.

The petition dated 22 February 2010 articulates the delay in receipt of the Office action (one week), the need for a technical expert as yet unavailable, and various concurrent litigation and proceedings. On balance, the petitioner has demonstrated "sufficient cause" for the purpose of granting one (1) month extension of time.

The petitioner is reminded that requests for more than one (1) month, will be granted only in extraordinary situations.

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

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

CONCLUSION

1. The patent owner's petition for extension for two (2) months time in which to file a response to the non-final Office action dated 19 January 2010 is hereby **granted-in-part.**

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

3. The response is extended to **19 April 2010.**

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

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

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

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

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

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

/Mark Reinhart/

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,270	12/08/2009	7188180	077580-0090	2128

23630 7590 05/12/2010

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EXAMINER	
ART UNIT	PAPER NUMBER

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WASHINGTON, D.C. 20005

Date:

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CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001270
PATENT NO. : 7188180
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 *Inter Partes* Requester)

MAILED

MAY 12 2010

CENTRAL REEXAMINATION UNIT

In re Larson et al.
Inter partes Reexamination Proceeding
Control No. 95/001,270
Filed: December 8, 2009
For: U.S. Patent No. 7,188,180

DECISION
DISMISSING
PETITIONS

This is a decision on the April 19, 2010 patent owner Petition To Suspend *Inter Partes* Reexamination Proceedings Pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. §§ 1.181, 1.182, 1.183, and 1.987 and on the April 19, 2010 patent owner Petition Pursuant to 37 C.F.R. § 1.182 for OPLA to Take and Retain Jurisdiction Over These Inter Partes Reexamination Proceedings. The patent owner petition to suspend is taken as a petition under 37 C.F.R. § 1.182, because the rules do not provide for the filing of a petition requesting that an *inter partes* reexamination proceeding be suspended.

This is also a decision on the May 3, 2010 Third Party Requester's Petition Pursuant to 37 C.F.R. § 1.183 and/or 1.182 in Opposition to Patent Owner's Petition to Suspend *Inter Partes* Reexamination Proceedings. The petition is taken under 37 C.F.R. § 1.182, because the rules do not provide for the filing of an opposition petition

The petition fee of $400.00 pursuant to 37 C.F.R. § 1.17(f) for each of patent owner's petitions under 37 C.F.R. § 1.182 was charged to patent owner's deposit account 501133, as authorized by the patent owner.

The petition fee of $400.00 pursuant to 37 C.F.R. § 1.17(f) for third party requester's petition was charged to third party requester's deposit account 022135, as authorized by the third party requester.

The proceeding, patent owner petitions, and third party requester petition are before the Office of Patent Legal Administration for consideration.

SUMMARY

1. The patent owner petition under 37 C.F.R. §§ 1.181, 1.182, 1.183 and 1.987 and 35 U.S.C. § 314(c) is dismissed.

2. The patent owner petition under 37 C.F.R. § 1.182 for OPLA to take and retain jurisdiction is granted to the extent that OPLA has taken jurisdiction to decide patent owner's petitions, and dismissed as to the request that OPLA retain jurisdiction, since such would run contrary to the mandate of 35 U.S.C. 314 (c) for special dispatch in reexamination proceedings.

3. The third party requester's petition pursuant to 37 C.F.R. § 1.183 and/or § 1.182 in opposition to patent owner's petition is granted to the extent that the petition has been entered and considered.

REVIEW OF FACTS

1. U.S. Patent No. 7,188,180 (the '180 patent) issued to Larson et al. on March 6, 2007, with 41 claims.

2. A civil litigation involving the '180 patent, captioned *VirnetX, Inc. v. Microsoft Corporation*, U.S. District Court, Texas Eastern, Case No. 6:07cv80, is pending.

3. On November 25, 2009, a request for *inter partes* reexamination of claims 1, 4, 10, 12-15, 17, 20, 26, 28-31, 33, and 35 of the '180 patent was deposited by a third party requester, Microsoft Corporation (a party to the concurrent civil litigation). A corrected request was filed December 8, 2009, which received a filing date and was assigned control no. 95/001,270 (the '1270 proceeding).

4. On January 19, 2010, reexamination was ordered for claims 1, 4, 10, 12-15, 17, 20, 26, 28-31, 33, and 35 of the '180 patent.

5. On January 19, 2010, a first Office action was issued rejecting claims 1, 10, 12-15, 17, 26, 28-31, and 33 and confirming claims 4, 20, and 25. The remaining claims are not subject to reexamination.

6. On February 22, 2010, patent owner petitioned for an extension of time, which was granted in part on February 25, 2010, extending the period for response to April 19, 2010.

7. On March 25, 2010, patent owner filed a notice of concurrent proceedings, including a March 16, 2010 jury verdict in the concurrent litigation finding claims 1, 4, 15, 17, 20, 31, 33, and 35 willfully infringed and not invalid, and a notice that a new complaint was filed on March 17, 2010 against Microsoft based on infringement of the '180 patent in the Eastern District of Texas, Case No. 6:10cv94.

8. On April 19, 2010, patent owner filed a response to the January 19, 2010, non-final action.

9. On April 19, 2010, patent owner also filed the subject petitions requesting that this proceeding be suspended and that OPLA take and retain jurisdiction over the '1270 proceeding.

10. On May 3, 2010 third party requester filed the subject petition in opposition to patent owner's petition for suspension.

DECISION

I. RELEVANT STATUTES, REGULATIONS, AND EXAMINING PROCEDURE

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

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

35 U.S.C. 317(b) states:

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

37 C.F.R. § 1.182 states (in part):

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

37 C.F.R. § 1.907 states (in part):

> (b) Once a final decision has been entered against a party in a civil action arising in whole or in part under 28 U.S.C. 1338 that the party has not sustained its burden of proving invalidity of any patent claim-in-suit, then neither that party nor its privies may thereafter request *inter partes* reexamination of any such patent claim on the basis of issues which that party, or its privies, raised or could have raised in such civil action, and an *inter partes* reexamination requested by that party, or its privies, on the basis of such issues may not thereafter be maintained by the Office.

37 C.F.R. § 1.987 states:

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

The Manual of Patent Examining Procedure (MPEP) § 2686.04, subsection V, states (in part):

> * * * * *
>
> The statute thus authorizes the Director of the USPTO to suspend (stay) reexamination proceedings, where there is good cause to do so, pending the conclusion of litigation based on a potential for termination of a reexamination prosecution under 35 U.S.C. 317(b). Thus, a District Court decision that is pending appeal on the validity of the same claims considered in an *inter partes* reexamination proceeding may provide the requisite statutory "good cause" for suspension, due to the real possibility that the 35 U.S.C. 317(b) estoppel may attach in the near future to bar/terminate the reexamination proceeding. Any such fact situation is resolved on a case-by-case basis.
>
> In any *inter partes* reexamination where the requester (or its privies) is also a party to ongoing or concluded litigation as to the patent for which reexamination has been requested, the potential for this statutory estoppel to attach must be considered.
>
> * * * * *
>
> Taking the above into account, the following factors are to be considered in determining whether it is appropriate to refuse to order an *inter partes* reexamination, terminate the reexamination, or suspend action in the reexamination, based on litigation in which the reexamination requester is a party to the litigation.
>
> (A) The 35 U.S.C. 317(b) estoppel applies only to patent claims that were litigated in the suit, i.e., litigated claims. The estoppel does not apply to non-litigated patent claims. Where there are non-litigated claims for which reexamination had been requested in the *inter partes* reexamination request, the reexamination proceeding is to go forward based on those non-litigated claims. If, however, during the reexamination proceeding, the patent owner disclaimed all the non-litigated claims, leaving only litigated claims, the proceeding is to be referred to the Office of Patent Legal Administration (OPLA).
>
> (B) The 35 U.S.C. 317(b) estoppel applies only to issues which the requester or its privies raised or could have raised in the civil action. The estoppel does not apply where new issues are raised in the request. If the request provides new art/issues not raised in the litigation (civil action), and which could not have been so raised, then estoppel does not attach. The patent owner has the burden of showing that the art and issues applied in the request was available to the third-party requester and could have been placed in the litigation.
>
> (C) The 35 U.S.C. 317(b) estoppel applies only in a situation where a final decision adverse to the requester has already been issued. If there remains any time for an appeal, or a request for reconsideration, from a court (e.g., District Court or Federal Circuit) decision, or such action has already been taken, then the decision is not final, and the estoppel does not attach. A stay/suspension of action may be appropriate for the reexamination proceeding if the litigation has advanced to a late enough stage and there is sufficient probability that a final decision will be adverse to the requester; however, that is a matter to be discussed with the OPLA in any such instance.
>
> (D) Is there a concurrent *ex parte* reexamination proceeding for the patent?

II. DISCUSSION

A. Patent Owner Requests Suspension of the '1270 Proceeding

Petitioner asserts that good cause exists to suspend the '1270 proceeding because a jury verdict has been issued in the district court proceeding. Petitioner argues that when the jury verdict

becomes final, the third party requester will be estopped from further addressing the present rejections in the '1270 proceeding because the grounds of rejection of claims 1, 4, 15, 17, 20, 31, 33, and 35 were raised by the third party requester in the litigation.

Petitioner asserts that the facts of this proceeding closely follow the facts of *In re Tremblay et al.*, Reexamination Control No. 95/000093, (*Sony*) [1] in which the proceeding was suspended, except that in this proceeding, the third party requester initiated proceedings three and one-half months prior to the jury verdict rather than shortly after the verdict in *Tremblay*. There are far more significant differences between this proceeding and *Tremblay* than the timing of the filing of the request for reexamination. Most importantly, the concurrent litigation in *Tremblay* was at the appellate stage and the appeal had been briefed at the U.S. Court of Appeals for the Federal Circuit (hereinafter, the "Federal Circuit"). In the present proceeding, briefing and post-trial motions at the district court have not even concluded. The time for seeking appeal has not begun to run. The concurrent litigation is not final, nor is it close to being final. As acknowledged by petitioner on page 6 of the petition, opening motions have begun, replies are not due until May, and the hearing has been rescheduled for May 27. [2] After the hearing, if a final judgment is entered by the district court, Microsoft will have the opportunity to file an appeal, which will then require briefing and will be heard on a normal schedule.

As claims 1, 4, 10, 12-15, 17, 20, 26, 28-31, 33, and 35 have already been subject to an Office action and a response has been filed in this reexamination proceeding, the examiner is ready to take further action now. It is likely that the reexamination proceeding will be completed well before the concurrent litigation becomes final after appeal is exhausted.

B. Patent Owner Requests for OPLA to Take and Retain Jurisdiction of the '1270 Proceeding

Patent owner petitions for OPLA to take jurisdiction of the '1270 proceeding to decide the petition to suspend, to decide and issue a decision on the petition to suspend, and to retain jurisdiction until 30 days following a decision. OPLA has taken jurisdiction and has decided the petition for suspension; however, there is no reason for OPLA to retain jurisdiction after this decision. To the contrary, retaining jurisdiction would retard the statutorily mandated special dispatch required (see 35 U.S.C. 314(c)) in resolving the substantial new questions of patentability raised by the reexamination request.

C. Third Party Requester's Petition in Opposition to Patent Owner's Request for Suspension

Third party requester petitions to submit arguments in opposition to the patent owner's request for suspension of the proceeding. The petition is entered to the extent that the arguments have been considered. The patent owner's request for suspension is decided and explained below in section D.

---

[1] See, the related litigation titled *Sony Computer Entertainment America Inc. v. Dudas*, 2006 U.S. Dist. LEXIS 36856, (E.D.VA 2006).

[2] According to the facts recited in third party requester's opposition petition, the hearing has been rescheduled for June 2, 2010.

D. Additional Analysis and Findings

The factors to be considered in determining whether it is appropriate to terminate action in an *inter partes* proceeding based on a concluded litigation in which the third party requester is a party to the litigation are detailed in MPEP 2686.04, subsection V, reproduced above. In this case, the civil litigation and the '1270 proceeding both involve the claims 1, 4, 15, 17, 20, 31, 33, and 35 of the '180 patent, with the '1270 proceeding additionally conducting reexamination of dependent claims 10, 12-14, 26, and 28-30. The patent owner has raised the presumption that the prior art issues in the '1270 proceeding are the same issues that are raised or could have been raised in the civil litigation. This presumption has not been rebutted by the third party requester. There is no concurrent *ex parte* proceeding for the '180 patent.

The above factors indicate that estoppel may, in the future, attach to claims 1, 4, 15, 17, 20, 31, 33, and 35 in the *inter partes* proceeding; however, the most significant factor is whether a final decision adverse to the requester has been issued. In this case, no final decision has been issued. Even where a decision has not yet become final, a *stay or suspension* of a proceeding may be appropriate if (a) all other factors for estoppel attachment are present and (b) the litigation has advanced to a late enough stage that a final decision will be rendered in the near future and there is sufficient probability that a final decision will be adverse to the requester based solely on the prior district court decision (the Office cannot enter into the appeals court's province to try to assess the probability as to which party will win on appeal). In this situation, the district court judgment has not been made final, and the opportunity to appeal to the Federal Circuit has not commenced.

Thus, the significant facts in this proceeding are:

(1) The '1270 proceeding is in the active examination phase of the proceeding, in which the claim patentability issues have been addressed in the first action, and the proceeding is awaiting examiner action on the response to the Office action[3];

(2) The '1270 proceeding also includes reexamination of claims 10, 12-14, 26 and 28-30, which claims have not been raised in the civil litigation; the proceeding would continue with respect to at least these claims, even if the patentability was finally resolved in the litigation for claims 1, 4, 15, 17, 20, 31, 33, and 35; and

(3) The district court action has not been made final, and final resolution of the action is not expected in the near future.[4]

These facts, taken with the rest of the facts and circumstances of this case, do not support a finding of good cause to suspend the '1270 proceeding.

The facts in this proceeding are <u>not</u> squarely aligned with the facts in *Sony*. Although all remaining (reexamination proceeding) claims had been litigated and on appeal when the renewed petition to suspend was filed in the proceedings in *Sony,* that was not the only factor considered

[3] This was not so in *Sony*, as will be discussed shortly.

[4] Again, this was not the situation in *Sony*, as will be discussed shortly.

in the decision granting the renewed petition to suspend. [5] Rather, the Office considered the relative stages of the concurrent appeal and the reexamination proceedings. As noted by the district court in *Sony*, "the PTO correctly concluded that the two 'races' between the parties were at very different stages: The Federal Circuit appeal was nearing its conclusion, while the PTO's *inter partes* review was just beginning." [6] The relative stages in this situation are much closer.

In contrast to the *Sony inter partes* reexamination proceedings, which were just at their beginning stages (e.g., the Office's work had been limited only to a finding that the requests for reexamination had raised a substantial new question of patentability), the present reexamination proceeding has advanced significantly beyond the beginning stage. In this instance, the Office has issued a non-final Office action, in response to which the patent owner has filed a patent owner's response. Thus, patentability issues have been defined and argued by parties, and the Office's work in the reexamination proceeding has not been limited to merely finding that the request for reexamination raised a substantial new question of patentability (at which point a patentability determination has not yet been made). On the other hand, the district court case has not yet been made final, as was the case in *Sony*, and has appellate review has not been exhausted.

Additionally, the reexamination proceeding must proceed with special dispatch to resolve the substantial new questions of patentability raised by the reexamination request with respect to claims 10, 12-14, 26 and 28-30, regardless of the outcome of claims 1, 4, 15, 17, 20, 31, 33, and 35 in the civil litigation. The public interest would not be served to suspend the proceeding. when there are claims under reexamination that are not subject to a concurrent civil litigation.

Accordingly, good cause for suspension has not been shown, and the Petition under 37 C.F.R. §§ 1.181, 1.182, 1.183 and 1.987 and 35 U.S.C. § 314(c), requesting suspension of the '1270 proceeding, is **dismissed**.

As for patent owner's petition for OPLA to take and retain jurisdiction of the '1270 proceeding, OPLA has taken jurisdiction and the decision regarding patent owner's petitions has now been rendered herein. There is no reason for OPLA to retain jurisdiction for 30 days hence as the patent owner has filed a response and the examiner is prepared to take action. Retaining jurisdiction would serve no useful purpose and would be contrary to the mandate to conduct the proceeding with special dispatch under 35 USC 314(c). Therefore, the petition for OPLA to take and retain jurisdiction is **dismissed**.

CONCLUSION

1. The patent owner petition under 37 C.F.R. §§ 1.181, 1.182, 1.183 and 1.987 and 35 U.S.C. § 314(c) is dismissed.

---

[5] *See* the decision entitled "Decision Granting Petitions to Suspend," mailed on November 17, 2005, in reexamination proceeding control no. 95/000,094.

[6] *Sony*, 2006 U.S. Dist. LEXIS 36856, at *19.

2. The patent owner petition under 37 C.F.R. § 1.182 for OPLA to take and retain jurisdiction is granted to the extent that OPLA took jurisdiction to decide the patent owner's petitions, and dismissed as to the request that OPLA retain jurisdiction.

3. The third party requester opposition petition under 37 C.F.R. § 1.182 and/or § 1.183 is granted to the extent that is has been entered and considered.

4. Jurisdiction over this proceeding is returned to the Central Reexamination Unit to continue reexamination with special dispatch.

5. The patent owner and the third party requester are respectfully reminded of their continuing duty to keep the Office apprised as to the status of the concurrent litigation pursuant to 37 C.F.R. § 1.985.

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

/Kenneth M. Schor/

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

05-11-10
Kenpet8/IP/suspend

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.
95/001,271	11/25/2009	RE41,006	2187.021REX0	2202

37086 7590 04/21/2010

EXAMINER	
ART UNIT	PAPER NUMBER

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

DATE MAILED: 04/21/2010

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

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

(For Patent Owner)

MAILED

APR 21 2010

CENTRAL REEXAMINATION UNIT

Robert Greene Sterne
STERNE, KESSLER, GOLDSTEIN
& FOX P.L.L.C.
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

(For Third Party
Requester)

In re: Chris Knotts
Inter Partes Reexamination Proceeding
Control No. 95/001,271
Deposited on: 25 November 2010
For: US Patent No. RE41,006 E

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

This is a decision on the 20 April 2010, patent owner's "Petition for Extension of Time (37 CFR § 1.956 and MPEP § 2665)," requesting that the time for responding to the non-final Office action mailed 22 February 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-in-part for the reasons set forth below.

Discussion

The Patent Owner requests an extension of time in which to file a response to the non-final Office action dated was mailed 22 February 2010. The non-final Office action provides a two (2) month period for response. The petition requesting a one (1) month extension of time was timely filed on 20 April 2010. The $200 petition fee pursuant to 37 CFR §1.17 (g) is provided.

The request is granted-in-part.

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

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

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

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 non-final Office action was mailed 22 February 2010 and new counsel obtained 01 April 2010, it is unclear what actions were undertaken by the patent owner in the time period 22 February 2010 to 01 April 2010. MPEP 2265 points out that "[a]ny 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 petition dated 20 April 2010 lacks this factual accounting.

The petitioner additionally articulates the need for declaratory evidence in the form of declarations filed under 37 CFR §§ 1.131, 1.132. On balance, the petitioner has demonstrated "sufficient cause" for granting two (2) weeks the extension of time.

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

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 22 February 2010 is hereby **granted-in-part**.

2. A **two (2) week** extension of time is hereby granted.

3. The period to respond will end on **06 May 2010**.

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

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

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

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

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

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

/Mark Reinhart/

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.
95/001,285	12/18/2009	7057083	007408.00062	2089

23455 7590 05/10/2010

EXXONMOBIL CHEMICAL COMPANY
5200 BAYWAY DRIVE
P.O. BOX 2149
BAYTOWN, TX 77522-2149

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 05/10/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
Joseph M. Skerpon
BANNER & WITCOFF, LTD.
1100 13th Street, NW, Suite 1200
Washington, DC 20005-4051

Date:
MAILED
MAY 10 2010
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001285
PATENT NO. : 7057083
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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EXXONMOBIL CHEMICAL COMPANY
5200 Bayway Drive
P.O. Box 2149
Baytown, TX 77522-2149

For Patent Owner

MAILED

MAY 10 2010

CENTRAL REEXAMINATION UNIT

Joseph M. Skerpon
Banner & Witcoff, LTD.
100 13th Street, NW, Suite 1200
Washington, DC 20005-4051

For Requester

Ex Parte Reexamination Proceeding
Control No. 95/001,285
Filed: December 18, 2009
For: US Patent No. 7,057,083

DECISION ON
PETITION UNDER
37 CFR 1.181

This is a decision on the petition filed April 28, 2010 to request remailing of the Office action and restarting the period for response.

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

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

REVIEW OF FACTS

1. Request for reexamination of USPN 7,057,083 was filed on December 18, 2009.

2. A Notice of *Inter Partes* Reexamination Request Filing Date was mailed to both parties on December 30, 2009.

3. On March 3, 2010, the Order Granting Request for Inter Partes Reexamination was mailed to both parties. It was accompanied by a non-final Office action giving Patent Owner 2 months in which to respond.

4. This petition entitled **PETITION UNDER 37 CFR 1.181 TO RESTART PERIOD FOR RESPONSE** was submitted on April 28, 2010.

DECISION

The petitioner maintains that the Third Party Requestor filed a request for reexamination of USPN 7,057,083 on December 18, 2009 and served a copy of Patent Owner. On April 26, 2010, Mr. Kevin Faulkner, counsel for Patent Owner, noticed that Patent Owner had not received any communication from the USPTO granting or denying the Request. Upon review of PAIR, Mr. Faulkner discovered the Order and the Office action dated March 3, 2010. Patent Owner provided the following documents as evidence that the Order and Office action were not received:

Declaration from Mr. Kevin M. Faulkner, attorney for Patent Owner
Declaration from Susan G. Mohnke, Clerical supervisor
Declaration from Kerri L. Harvey, patent legal assistant
Patent actions due report

Each of the declarants have stated on the record that ExxonMobil does not keep a log of incoming mail and that the present Reexamination Proceeding is the only reexamination proceeding currently being handled by their division.

The present petition is analogous to a petition under 37 CFR 1.181(a) requesting withdrawal of the holding of an abandonment of an application based on non-receipt of an Office action. As such, the present petition is decided following the Office procedures for petitions under 37 CFR 1.181(a). MPEP 711.03(c) states that:

> To minimize costs and burdens to practitioners and the Office, the Office has modified the showing required to establish nonreceipt of an Office action. The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. **A copy of the docket record where the nonreceived Office communication would have been entered had it been received**

> **and docketed must be attached to and referenced in practitioner's statement.** For example, if a three month period for reply was set in the nonreceived Office action, a copy of the 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. [Emphasis added in bold and underlining.]

As stated above, the petition is supported by three affidavits, one by the attorney of record and two by employees of ExxonMobil, which state that, to their knowledge, the order and action were not received until April 26, 2010, when Ms. Harvey checked PAIR and downloaded the order and action. Even though the petition states that the requisite evidence was included, the petition is not accompanied by all of the requisite evidence. A copy of the docket record where the non-received Office communication would have been entered had it been received and docketed is not included. In fact, the petition admits that ExxonMobil does not keep a log or docket of incoming mail. See, e.g., paragraph 3 of the Harvey Declaration. It is further noted that the mailing address on the order and action appears to be correct. In other words, all correspondence from the USPTO has been mailed to the address of record in the patent file and to date there is no indication that it has not been received, i.e. there is no returned mail from ExxonMobil. It may be that the notice was timely received by ExxonMobil, and misdirected within that office. Furthermore, the Office is under a statutory requirement to make a decision to grant or deny reexamination within three (3) months of the request. In light of this, notification of grant or denial of the Request would have been made no later than March 18, 2010. The petition does not explain why patent owner waited over 5 weeks after that statutory deadline to check PAIR for the order. In summary, the evidence offered by Patent Owner only reveals that it was not docketed. Therefore, the record fails to clearly support the conclusion stated in the Petition that the order and action were not received in ExxonMobil until April 26, 2010. Accordingly, the petition cannot be granted.

CONCLUSION

1. The Appellant's petition for remailing the Office action and restarting the period for response is **dismissed**.

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

Gregory Morse,
Director,
Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,285	12/18/2009	7057083	007408.00062	2089

23455 7590 07/22/2010

EXAMINER

EXXONMOBIL CHEMICAL COMPANY
5200 BAYWAY DRIVE
P.O. BOX 2149
BAYTOWN, TX 77522-2149

ART UNIT	PAPER NUMBER

DATE MAILED: 07/22/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Joseph M. Skerpon
BANNER & WITCOFF, LTD.
1100 13th Street, NW, Suite 1200
Washington, DC 20005-4051

Date:

MAILED

JUL 22 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001285
PATENT NO. : 7057083
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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EXXONMOBIL CHEMICAL COMPANY
5200 Bayway Drive
P.O. Box 2149
Baytown, TX 77522-2149

For Patent Owner

MAILED

JUL 22 2010

CENTRAL REEXAMINATION UNIT

Joseph M. Skerpon
Banner & Witcoff, LTD.
1100 13th Street, NW, Suite 1200
Washington, DC 20005-4051

For Requester

Ex Parte Reexamination Proceeding
Control No. 95/001,285
Filed: December 18, 2009
For: US Patent No. 7,057,083

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

This is a decision on the petition filed April 28, 2010 to request an extension of time pursuant to 37 CFR 1.956 for filing a response to the Office action mailed March 03, 2010.

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

The petition was previously dismissed in the decision of May 11, 2010. Upon reconsideration, the petition is *sua sponte* granted 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 March 03, 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

Upon further review it is found that the petition is timely and appropriately filed. The petition for extension of time states that Patent Owner was not aware of the outstanding Office action until April 26, 2010 after reviewing PAIR. Patent Owner expected an Office action to be mailed several months after the Order granting reexamination which would have allowed time to study the order and anticipate the Office action. During this same time, the inventors have been addressing 11 related Singapore Revocation actions filed contemporaneously with the request for reexamination. The Singapore Patent Office has given an extension of time to Patent Owner to respond to these Revocation actions but it is slight. In the time from notice of the Office action, Patent Owner has been discussing a draft response with the inventors and with technical advisors to prepare a proper response. Patent Owner submits the time is insufficient to prepare a detailed response to the substantive Office action and requests a two-month extension of time.

Analysis and Findings

Patent Owner has set forth a factual accounting that is deemed to establish reasonably diligent behavior by all those responsible for preparing a response within the statutory period. It is clear that the time remaining is insufficient to prepare a complete and proper response. When balanced against the requirement of 35 USC 314(c) that this proceeding be handled with special dispatch, Owner's showing is adequate to justify the grant of a two-month extension of time in which to file a response to the Office action. The response filed by Patent Owner on June 11, 2010 and June 15, 2010 and that filed by requester on July 15, 2010 are considered timely and are entered. Patent Owner should expect that future requests for extensions will not be granted absent strong and compelling reasons that establish the existence of an extraordinary situation necessitating the additional time.

Conclusion

1. The Patent Owner's petition for extension of time in which to file a response to the Office action of March 03, 2010 is **granted**.
2. With the mailing of this decision, the proceeding is returned to the examiner for further action.

3. The Patent Owner's response is due July 3, 2010.

4. 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

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

/Deborah Jones/
Deborah Jones,
SPE, 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.
95/001,286	12/21/2009	Elliot 7441196	8157.018.196	4412

22850 7590 04/02/2010

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/02/2010

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.
95/001,286	12/21/09	7441196	8157.018.196

EXAMINER
NALVEN, ANDREW

ART UNIT	PAPER
3992	

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

DATE MAILED:

04/02/10

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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Steven McMahon Zeller
OBLON, SPIVAK, MCCLELLAND
MAIER & NEUSTADT, L.L.P.
1940 DUKE STREET
ALEXANDRIA VA 22314

(For Patent Owner)

MAILED

APR 02 2010

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: Gottfurcht *et alia*
Inter Partes Reexamination Proceeding
Control No. 95/001,286
Deposited on: 21 December 2009
For: US Patent No. 7,441,196 B2

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

This is a decision on the 26 March 2010, "Renewed Petition for Extension of Time Under 37 CFR § 1.956" requesting that the time for responding to the non-final Office action mailed 02 February 2010, be extended by one (1) month. The petition was timely filed with certificate of service.

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

The petition is 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 02 February 2010, which set two (2) months time for filing a response thereto. The renewed petition for extension of time was timely filed on 26 March 2010, together with certificate of service.

The petition supports a ten (10) day extension of time.

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

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

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

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

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

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

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

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

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

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

Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. The reasons must include (A) a statement of what action the patent owner has taken to provide a response, to date as of the date the request for extension is submitted, and (B) why, in spite of the action taken thus far, the requested additional time is needed. The statement of (A) must provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period. Prosecution will be conducted by initially setting a time period of at least 30 days or one month (whichever is longer), see MPEP § 2662. First requests for extensions of these time periods will be granted for sufficient cause, and for a reasonable time specified-usually 1 month. The reasons stated in the request will be evaluated, and the

request will be favorably considered where there is a factual accounting of reasonably diligent behavior by all those responsible for preparing a response or comments within the statutory time period. Second or subsequent requests for extensions of time, or requests for more than one month, will be granted only in extraordinary situations.

...

DECISION

The patent owner's representative petitions under 37 CFR § 1.956 to extend the period for response by adding one (1) month to the period for response. The decision to extend the period for response is evaluated based upon a showing of "sufficient cause." There is always the consideration to balance the need for the patent owner to have a fair opportunity to respond to the Office action between the need for special dispatch.

The petition notes the change in counsel. Since the files are all available on-line electronically via Public PAIR, the mailing of the action should have posed to need for additional time. The storm noted 4-15 February 2010 does support an extension of ten (10) days time since this could not have been anticipated by neither the patent owner nor counsel. The discussion of the inventor traveling from California to Virginia does not provide support for "sufficient cause" since a three (3) hour flight cannot be considered extraordinary.

On balance there is "sufficient cause" to grant ten (10) days extension of time.

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

CONCLUSION

1. The patent owner's petition for extension for time is hereby **granted-in-part.**

2. The time for response is extended by ten (10) days.

2. The Patent Owner's response is due **12 April 2010.**

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

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

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

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

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

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/

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

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95/001,286	12/21/2009	Elliot 7441196	8157.018.196	4412

22850 7590 04/20/2010

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/20/2010

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EXAMINER
NALVEN, ANDREW

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

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CENTRAL REEXAMINATION UNIT

INTER PARTES REEXAMINATION COMMUNICATION

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95/001,286	12/21/09	7441196	8157.018.196

EXAMINER
NALVEN, ANDREW

JEFFER, MANGELS, BUTLER & MARMARO, LLP
1900 AVENUE OF THE STARS
7th FLOOR
LOS ANGELES, CA 90067

ART UNIT	PAPER
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EXAMINER
NALVEN, ANDREW

JEFFER, MANGELS, BUTLER & MARMARO, LLP
1900 AVENUE OF THE STARS
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EXAMINER
NALVEN, ANDREW

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

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JEFFER, MANGELS, BUTLER & MARMARO, LLP (Patent Owner)
1900 AVENUE OF THE STARS, 7TH FLOOR
LOS ANGELES CA 90067

MAILED

APR 20 2010

CENTRAL REEXAMINATION UNIT

Steven McMahon Zeller (Courtesy Copy)
OBLON, SPIVAK, MCCLELLAND
MAIER & NEUSTADT, L.L.P.
1940 DUKE STREET
ALEXANDRIA, VA 22314

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

In re Gottfurcht et al.
Inter Partes Reexamination Proceeding
Control No.: 95/001,286
Filing Date: December 21, 2009
For: US Patent No. 7,441,196 B2

DECISION
DISMISSING
PETITION

This is a decision on the April 12, 2010 patent owner petition entitled "PETITION UNDER 37 C.F.R. § 1.182 FOR TRANSFER OF JURISDICTION TO THE OFFICE OF PATENT LEGAL ADMINISTRATION."

The present petition is before the Office of Patent Legal Administration (OPLA) for consideration.

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

FEES

The petition fee of $400.00 pursuant to 37 CFR 1.17(f) for the patent owner petition under 37 CFR 1.182 was paid on April 12, 2010.

REVIEW OF THE RELEVANT FACTS

1. On October 21, 2008, the Office issued U.S. Patent No. 7,441,196 (the '196 patent) to Gottfurcht et al.

2. On December 21, 2009, a request for *inter partes* reexamination of the '196 patent was filed by a third party requester. The resulting reexamination proceeding was assigned control number 95/001,286 (the '1286 proceeding).

3. On February 2, 2010, the Office issued an order granting *inter partes* reexamination in the '1286 proceeding, with an accompanying Office action on the merits.

4. On March 2, 2010, patent owner filed a petition entitled "PETITION UNDER 37 C.F.R. §1.181(a)(3) TO VACATE THE *ULTRA VIRES* REEXAMINATION ORDER OF FEBRUARY 2, 2010."

5. On April 12, 2010, patent owner filed a timely response to the February 2, 2010 Office action.

6. On April 12, 2010, patent owner filed the present petition entitled "PETITION UNDER 37 C.F.R. § 1.182 FOR TRANSFER OF JURISDICTION TO THE OFFICE OF PATENT LEGAL ADMINISTRATION."

RELEVANT REGULATION

37 CFR 1.182 provides:

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

DECISION

The present patent owner petition under 37 CFR 1.182 requests (1) that OPLA take jurisdiction of the instant proceeding prior to the Central Reexamination Unit (CRU) issuing a responsive communication to the patent owner's April 12, 2010 response to the February 2, 2010 Office action and (2) that OPLA retain such jurisdiction until the Director issues a decision on the

petition filed on March 2, 2010 to vacate the present reexamination as *ultra vires*.[1] Patent owner asserts that "[a]bsent the requested relief, the Examiner would be forced to expend unnecessary effort in the face of imminent termination of this reexamination."[2] Patent owner further contends that "the transfer of jurisdiction is in the best interest of conserving Office resources" and will ensure that the patent owner "is not burdened by further reexamination obligations stemming from Third Party Requester mischaracterizations of the record."[3]

The instant petition has been fully considered. However, in light of the present circumstances, OPLA will not take jurisdiction of the instant proceeding and retain jurisdiction. MPEP 1002.02(c) provides a list of the petitions decided by the Technology Center Directors, and states as follows:

> 3. Petitions invoking the supervisory authority of the Director of the USPTO under 37 CFR 1.181 involving any ex parte action or requirement in a patent application by the examiner which is not subject to appeal (37 CFR 1.191) and not otherwise provided for, as for example:
> (a) prematureness of final rejection, MPEP § 706.07(c);
> (b) holding of abandonment, MPEP § 711.03(c);
> (c) requirement to cancel "new matter" from specification, MPEP § 608.04(c);
> (d) relative to formal sufficiency and propriety of affidavits under 37 CFR 1.131 (MPEP § 715.08), 1.132 (MPEP § 716) and 1.608, MPEP § 2308 - § 2308.02;
> (e) refusal to initiate an interference under 37 CFR 1.601(i), MPEP § 2306;
> (f) refusal to enter an amendment under 37 CFR 1.312, MPEP § 714.16(d);
> (g) refusal to enter an amendment, 37 CFR 1.127, MPEP § 714.19;
> (h) refusal to enter an amendment under 37 CFR 1.111 or 37 CFR 1.115, MPEP § 714.03(a);
> (i) resetting period for reply, MPEP § 710.06; and
> (j) requirement for information under 37 CFR 1.105, MPEP § 704.11.

In this instance, the Director of the CRU stands in place of the Technology Center Director as the first line of supervisory review of a CRU examiner's actions that are petitionable, since the CRU examines reexamination proceedings, and review of a CRU examiner's actions that are petitionable is carried out by the Director of the CRU. If OPLA were to take and retain jurisdiction, such would prevent the Director of the CRU from having jurisdiction to decide the March 2, 2010 petition under 37 CFR 1.181. Accordingly, the present petition is dismissed.

PATENT OWNER'S CORRESPONDENCE ADDRESS

The patent owner is called upon to coordinate the proper correspondence addresses in (1) the patent and (2) the 95/001,286 proceeding. The current correspondence address of record **in the patent file** is the proper patent owner address for reexamination mailings pursuant to 37 CFR 1.33(c), and it is that of JEFFER, MANGELS, BUTLER & MARMARO, LLP, 1900 AVENUE OF THE STARS, 7TH FLOOR, LOS ANGELES, CA 90067.

Accordingly, all future correspondence will be directed to JEFFER, MANGELS, BUTLER & MARMARO, LLP, 1900 AVENUE OF THE STARS, 7TH FLOOR, LOS ANGELES, CA

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

90067, unless patent owner changes the correspondence address of record in the patent (the same address should be explicitly made of record in the reexamination proceeding).

As a one-time courtesy, this decision is being mailed to both addresses. However, as pointed out above, the address of JEFFER, MANGELS, BUTLER & MARMARO, LLP, 1900 AVENUE OF THE STARS, 7TH FLOOR, LOS ANGELES, CA 90067, and all further correspondence in the proceeding will be mailed to this address, until it is properly changed.

CONCLUSION

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

2. Jurisdiction over this reexamination proceeding is being returned to the Central Reexamination Unit, Art Unit 3992.

3. Any inquiry concerning this decision should be directed to Susy Tsang-Foster, Legal Advisor, at (571) 272-7711.

Kenneth M. Schor

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

4-19-10 Kenpet8\IP\UV\

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Alexandria, VA 22313-1450
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JUL 08 2010

CENTRAL REEXAMINATION UNIT

(For Patent Owner)
JEFFER, MANGELS, BUTLER & MARMARO, LLP
1900 AVENUE OF THE STARS, 7TH FLOOR
LOS ANGELES, CA 90067

OBLON, SPIVAK, MCCLELLAND MAIER
& NEUSTADT, L.L.P.
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Tracy W. Druce
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(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET
FIFTY-THIRD FLOOR
HOUSTON, TX 77002

In re Gottfurcht et al.	:	DECISION DISMISSING
Control No. 95/001,286	:	PETITION PURSUANT TO
Deposited: December 21, 2009	:	37 CFR § 1.181(a)(3) and
For: US Patent No. 7,441,196	:	PETITION TO STRIKE
	:	PURSUANT TO 37 CFR 1.182

This is a decision on the March 2, 2010 petition filed by the patent owner entitled, "Petition under 37 CFR 1.181 to vacate the *ultra vires* reexamination order of February 2, 2010" [hereinafter "the vacate petition"]. The petition under 37 CFR § 1.181(a)(3) states that the order granting reexamination in the proceeding is *ultra vires* and should be vacated. The third party requester filed a paper on March 16, 2010 in opposition to the petition [hereinafter "the first opposition"]. Patent owner filed a petition under 37 CFR 1.182 to strike the March 16, 2010 opposition [hereinafter "the strike petition"] on March 23, 2010. The requester filed an opposition to the March 16, 2010 petition to strike on March 30, 2010 [hereinafter "the second opposition"]. This decision addresses both of patent owner's petitions and both of third party requester's oppositions.

The petitions and oppositions are before the Director of the Central Reexamination Unit for consideration.

The vacate petition is dismissed for the reasons set forth below.

The strike petition is dismissed for the reasons set forth below.

SUMMARY OF RELEVANT FACTS

1. U.S. Patent No. 7,441,196 [hereinafter "the '196 patent"] was granted to *Gottfurcht et al.* on October 21, 2008.

2. On December 21, 2009, a request for *inter partes* reexamination of the '196 patent was filed by a third party requester. The resulting reexamination proceeding was assigned control number 95/001,286 (the ' 1286 proceeding).

3. On February 2, 2010, the Office issued an order granting inter partes reexamination in the ' 1286 proceeding, with an accompanying Office action on the merits.

4. On March 2, 2010, the vacate petition entitled "PETITION UNDER 37 C.F.R. §1.181(a)(3) TO VACATE THE *ULTRA VIRES* REEXAMINATION ORDER OF FEBRUARY 2, 2010" was filed.

5. On March 16, 2010, the first opposition entitled "THIRD PARTY REQUESTER'S OPPOSITION TO PATENT OWNER'S PETITION..." was filed.

6. On March 23, 2010, the strike petition entitled "PETITION UNDER 37 C.F.R. §182 TO STRIKE THIRD PARTY SUPPLEMENT TO THE *INTER PARTES* REEXAMINATION REQUEST FOR 95/001,286" was filed.

7. On March 30, 2010, the second opposition entitled "THIRD PARTY REQUESTER'S OPPOSITION TO PATENT OWNER'S PETITION TO STRIKE" was filed.

8. On April 12, 2010, patent owner filed a timely response to the February 2, 2010 Office action.

9. On May 12, 2010, the third party requester timely filed comments.

DISCUSSION

The patent owner requests that the reexamination proceeding be vacated. The petitioner considers the action taken by the Office by granting the order to reexamine the patent as an *ultra vires* action by the Office. The third party requester opposes to the petition (see the first opposition). Patent owner then filed a petition under 37 CFR 1.182 to strike the first opposition. The requester filed a second opposition addressing the strike peition on March 30, 2010.

The request to vacate the order of the reexamination proceeding is dismissed.

The request to strike the first opposition is dismissed.

STATEMENT OF RELEVANT AUTHORITY

35 U.S.C. 312 Determination of issue by Director.

(a) REEXAMINATION.- Not later than 3 months after the filing of a request for inter partes reexamination under section 311, the Director shall determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request, with or without consideration of other patents or printed publications. The existence of a substantial new question of patentability is not precluded by the fact that a patent or printed publication was previously cited by or to the Office or considered by the Office.

MPEP 2642 provides in relevant part:

I. SUBSTANTIAL NEW QUESTION OF PATENTABILITY

The presence or absence of "a substantial new question of patentability" determines whether or not reexamination is ordered. The meaning and scope of the term "a substantial new question of patentability" is not defined in the statute and must be developed to some extent on a case-by-case basis, using the case law to provide guidance as will be discussed in this section.

If the prior art patents and printed publications raise a substantial question of patentability of at least one claim of the patent, then a substantial new question of patentability is present, unless the same question of patentability has already been decided by (A) a final holding of invalidity, after all appeals, or (B) by the Office in a previous examination or pending reexamination of the patent. A "previous examination" of the patent is: (A) the original examination of the application which matured into the patent; (B) the examination of the patent in a reissue application that has resulted in a reissue of the patent; or (C) the examination of the patent in an earlier pending or concluded reexamination. The answer to the question of whether a "substantial new question of patentability" exists, and therefore whether reexamination may be had, is decided by the Director of the Office, and as 35 U.S.C. 312(c) provides, that determination is final, i.e., not subject to appeal on the merits of the decision. See *In re Etter*, 756 F.2d 852, 225 USPQ 1 (Fed. Cir. 1985) which was decided for the *ex parte* reexamination statute (note that 35 U.S.C. 312(c) for the *inter partes* reexamination statute contains the same language as 35 U.S.C. 303(c) for *ex parte* reexamination). But see *Heinl v. Godici*, 143 F.Supp.2d 593, 596-98 (E.D. Va. 2001) (35 U.S.C. 303 addresses only USPTO decisions to deny a request for reexamination and does not bar review of *ultra vires* USPTO decisions to grant reexamination requests. However, a decision to grant a reexamination request is not a final agency decision and is not ordinarily subject to judicial review.).

A prior art patent or printed publication raises a substantial question of patentability where there is a substantial likelihood that a reasonable examiner would consider the prior art patent or printed publication **important** in deciding whether or not the claim is patentable. If the prior art patents and/or publications would be considered important, then the examiner should find "a substantial new question of patentability" unless the same question of patentability has already been decided as to the claim in a final holding of invalidity by the Federal court system or by the Office in a previous examination. For example, the same question of patentability may have already been decided by the Office where the examiner finds the additional (newly provided) prior art patents or printed publications to be merely cumulative to similar prior art already fully considered by the Office in a previous examination of the claim.

Accordingly, for "a substantial new question of patentability" to be present, it is only necessary that:

(A) The prior art patents and/or printed publications raise a substantial question of patentability regarding at least one claim, i.e., the teaching of the prior art patents and printed publications is such that a reasonable examiner would consider the teaching to be **important** in deciding whether or not the claim is patentable; and

(B) The same question of patentability as to the claim has not been decided by the Office in a previous examination or pending reexamination of the patent or in a final holding of invalidity by the Federal Courts in a decision on the merits involving the claim.

It is not necessary that a *"prima facie"* case of unpatentability exist as to the claim in order for "a substantial new question of patentability" to be present as to the claim. Thus, "a substantial new question of patentability" as to a patent claim could be present even if the examiner would not necessarily reject the claim as either anticipated by, or obvious in view of, the prior art patents or printed publications. The difference between "a substantial new question of patentability" and a *"prima facie"* case of unpatentability is important. See generally *In re Etter*, 756 F.2d 852, 857 n.5, 225 USPQ 1, 4 n.5 (Fed. Cir. 1985).

...

II.A. Prior Favorable Decisions by the U.S. Patent and Trademark Office on the Same or Substantially Identical Prior Art in Relation to the Same Patent.

A "substantial new question of patentability" is not raised by prior art presented in a reexamination request if the Office has previously considered (in an earlier examination of the patent) the same question of patentability as to a patent claim favorable to the patent owner based on the same prior art patents or printed publications. *In re Recreative Technologies*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996).

In deciding whether to grant a request for reexamination of a patent, the examiner should check the patent's file history to ascertain whether any of the prior art now advanced by requester was previously cited/considered in an earlier concluded Office examination of the patent (e.g., in the examination of the application for the patent). For the sake of expediency, such art is referred to as "old art" throughout, since the term "old art" was coined by the Federal Circuit in its decision of *In re Hiniker*, 150 F.3d 1362,1365-66,47 USPQ2d 1523, 1526 (Fed. Cir. 1998).

MPEP § 2646 Decision Ordering Reexamination (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.

DECISION ON PETITION TO VACATE THE ORDER

The patent owner brings before the Office a petition under 37 CFR § 1.181(a)(3) to vacate an ordered reexamination proceeding as not raising a proper substantial new question of patentability (SNQ). The procedure for such a petition is provided for in MPEP 2646. For this petition to be granted, however, the patent owner must show that the Office had no discretion to grant the request for reexamination. See MPEP 2646.

Patent owner contends that the order for reexamination of the '196 patent is *ultra vires* and must be vacated. Patent owner presents only one basis for this contention; that the order is based wholly on cumulative claim construction issues expressly rejected by the Board of Patent Appeals and Interferences (BPAI) in the prior examination of a related application. In other words, petitioner contends that the order granting reexamination of claims 1-76 improperly disregarded the claim interpretation of the BPAI in the prior examination in a related application, and therefore, improperly decided that the cited patents and printed publications raised a substantial new question of patentability. Petition at 1-2.

Requester opposes the petition on the grounds that the petition filed by the patent owner is misconstruing the standard for a substantial new question of patentability by raising it to a *prima facie* showing of unpatentability, and the patent owner has not provided the necessary showing to support the petition.

The determination of whether an SNQ exists is a fact-specific inquiry. MPEP 2642(II)(A). Determination of the scope of previous examination consideration begins "with an analysis of the record of the prior proceedings to determine if and how the examiner used the reference in making his initial decisions." *In re Swanson*, 540 F.3d 1368, 1381 (Fed. Cir. 2008). An SNQ will not be raised solely by an "argument already decided by the Office," or where the issue merely questions the prior judgment of the examiner. *Id.* (*quoting* H.R. Rep. No 96-1307 *and citing* H.R. Rep. No. 107-120). Patent owner's contentions are focused on claim interpretation but claim interpretation, alone, is not determinative as to whether the Office exceeded its statutory authority in granting the second request for reexamination. The essential inquiry is whether the order granting reexamination established a basis for granting the reexamination, as authorized by 35 U.S.C. 311 and 312 and 37 CFR 1.915 and 1.923.

The reexamination record is clear that the examiner considered the prior examination of the '196 patent in making the determination to order the reexamination. See pages 2-3 of the order dated February 2, 2010. As stated in the order, the patentability of the claims was based on the previous examiner's determination that the cited prior art fails to teach or suggest the following limitations:

> "the on-line content reformatted from a webpage in a hypertext markup language (HTML) format into an extensible markup language (XML) format to generate a sister site, the sister site including a portion or a whole of content of the web page reformatted to be displayed and navigable through a simplified navigation interface on any one of a television, web appliance, console device, handheld device, wireless device or cellular phone, the simplified navigation interface displayed in a form of a two-dimensional layer of cells from a plurality of layers and a plurality of cells, the two-dimensional layer in a form of a navigation matrix, each cell is a division of a screen and exclusive to a separate single navigation option associated with a specific unique input, the on-line content formatted to be displayed in one or more of the plurality of cells and formatted to be selected for navigation by one or more of the unique inputs, navigation options to change between layers of the simplified navigation interface from general to more specific in each deeper layer; receiving a user selection of one of the navigation options"

These limitations are, hereinafter, referred to as "the reformatting limitations." Therefore, the prior prosecution of the '196 patent established that the prior art of record failed to teach the reformatting limitations as required by the independent claims.

The order of February 2, 2010 states that the Reformulating HTML reference, the WAP references, and the UP references present new technical teachings that were not considered in the prior examination and raise a SNQ with respect to claims 1-76 because each reference has teachings relevant to the reformatting limitation, which was a limitation found to be missing in the prior examination. See pages 7-14 of the Order of February 2, 2010. Furthermore, the order also determined that the Britton patent presents new technical teachings that were not considered in the prior examination and raise a SNQ with respect to claims 1-4, 6-13, 18-30, 34-43, 45-61, 63-68, and 70-74 because the reference has teachings relevant to the limitation that a sister site provides the simplified navigation interface. See page 15 of the Order of February 2, 2010. Therefore, the record shows that the examiner made a determination, in light of the prior examination, that these cited documents provided a new technical teaching pertaining to the reformatting limitations, which would be important to a reasonable examiner, and accordingly, raised a SNQ in regards the claims. See MPEP 2644. In other words, the record does not show that the order for reexamination was based solely on an argument already decided by the Office. Accordingly, the record shows that the determination of that a SNQ was raised by the newly considered references was in accordance with 35 U.S.C. 311 and 312, its implementing regulations, 37 CFR 1.915 and 1.922, and the guidelines set forth in MPEP 2640, 2642, 2644, and 2646.

Patent owner does not show that the order failed to establish that the cited references presented a new technical teaching that would be important to a reasonable examiner in determining the patentability of claims 1-76. Patent owner, instead, concludes that the examiner ignored the claim interpretation by the BPAI in the prior examination of a related application, and focuses on whether it was proper for the examiner to set forth an allegedly different claim interpretation for the sister site. Petition at 7-11. Patent owner's arguments are seemingly requiring that a *prima facie* case of unpatentability must be established in order for the Office to have the statutory authority to grant the request for reexamination. As explicitly stated in MPEP 2642, subsection I, such is not the standard in the determination of whether a substantial new question of patentability is raised.

Upon review of the reexamination record, the record does not support petitioner's conclusion that the examiner ignored or used an inconsistent claim interpretation of a sister site than applied by the BPAI in the prior examination of a related application. Specifically, the order states how the teachings of cited references present new, non-cumulative technological teachings that are relevant to the reformatting limitations, which were found to be missing the prior examination. It is not required that the cited references unequivocally teach the reformatting limitations in order to raise a substantial new question of patentability. The requirement is that the cited references have teachings that a reasonable examiner would consider important in determining whether claims 1-76 of the '196 patent are patentable. The order of February 2, 2010 provides such a showing to meet this requirement on pages 7-15. Therefore, the determination that the cited references raise a SNQ with respect to claims 1-76 of the '196 patent was in accordance with 35 U.S.C. 311 and 312, its implementing regulations, 37 CFR 1.915 and 1.922, and the guidelines set forth in MPEP 2640, 2642, 2644, and 2646. Accordingly, Office had discretion to grant the request for reexamination.

For these reasons, patent owner has presented insufficient support for the contention that the order was an *ultra vires* action on the part of the Office. As discussed further below, the patent owner must have shown that the Office was without authority to grant a request for reexamination. In other

words, the petition must show that there was no discretion to grant the reexamination and not just disagreement with substantive determinations in the order on what the prior art teaches.

Accordingly, it is found that the order was not based wholly on the same question of patentability raised by the prior art previously presented. Therefore, the order was not an *ultra vires* action on the part of the Office. For the reasons detailed above, patent owner has failed to show that the order was an *ultra vires* action. Petitioner is referred to *Heinl v Godici*, (E.D.Va. 2001), 143 F. Supp. 2d 593. In *Heinl*, 143 F.Supp.2d at 601, the court stated:

> "Under the well established *ultra vires* doctrine, the exhaustion and final agency requirements are excused 'only if plaintiff is able to show that the PTO clearly exceeded its statutory authority'", quoting from *Philip Morris, Inc. v. Block*, 755 F.2d 368, 370 (4th Cir. 1985) (quoting *Mayor and City Council of Baltimore v. Mathews*, 562 F.2d 914, 920 (4th Cir. 1977), vacated on other grounds, 571 F.2d 1273 (4th Cir. 1978).

The court went on to state:

> "Put differently, when an agency acts in 'brazen defiance' of its statutory authorization, courts need not await the conclusions of the underlying proceedings."

After a review of the present record, and based upon the above discussion, it is found that petitioner patent owner has not shown the Office to have "clearly exceeded its statutory authority" nor acted "in brazen defiance of its statutory authorization" in the Office's determination to order reexamination.

In view of the above, the petition to vacate the reexamination proceeding is dismissed.

DECISION ON PETITION TO STRIKE THE FIRST OPPOSITION

The patent owner brings before the Office a petition to strike the first opposition, dated March 16, 2010. Patent owner contends that the first opposition improperly supplements the initial request for reexamination by revising the stated SNQs, and therefore, must be expunged from the record as an improper paper. See the strike petition, dated March 23, 2010.

Requester opposes the petition on the grounds that the petition filed by the patent owner is procedurally improper and without basis. See the second opposition, dated March 30, 2010.

Upon review, the first opposition, dated March 16, 2010, is not deemed an improper paper that is not permitted to be entered into the reexamination record. See MPEP 2667. First, MPEP 2646 explicitly allows the third party requester to file an opposition to a patent owner's petition to vacate an order granting reexamination. Second, the first opposition is not deemed an unauthorized attempt to modify the SNQs raised in the order. In allowing the third party requester to file an opposition, the procedures permit the third party requester to respond to the issues raised by the petitioner patent owner. Specifically, it is the patent owner that raised the issues as to whether the examiner's determination in the order is consistent with the BPAI's claim interpretation in the prior examination of a related application. Accordingly, it is permissible for the third party requester to respond to

those issues with regard to the cited documents. Finally, while the first opposition was considered, this decision does not rely on the positions of the third party requester in the first opposition.

In view of the above, the petition to strike the first opposition is dismissed.

PATENT OWNER'S CORRESPONDENCE ADDRESS

As stated in the April 20, 2010 decision, the power of attorney and change of correspondence address filed February 3, 2010 is ineffective. The current power of attorney and correspondence address remains to be Jeffer, Mangels, Butler & Mamaro, LLP, 1900 Avenue of the Stars, 7th Floor, Los Angeles, CA 90067. See pages 3-4 of the April 20, 2010 decision. See also the concurrently mailed decision that vacates the March 9, 2010 Notice of Acceptance.

Patent owner is called upon to file any change of power of attorney and correspondence address in the patent file (Application No. 11/373,324) in order to properly effectuate a change in this reexamination proceeding. As a courtesy, this decision is being mailed to the address listed in the February 3, 2010 communication. However, all future correspondence may only be made to the official correspondence address of record at the time the correspondence is mailed.

CONCLUSION

1. The patent owner's petition vacate the reexamination under 37 CFR §§ 1.181(a)(3) proceeding is hereby **dismissed.**

2. The patent owner's petition strike the first opposition is hereby **dismissed.** The third party requester's opposition, dated March 16, 2010, will remain in the record.

3. Jurisdiction over the present reexamination proceeding is hereby forwarded to the examiner in charge of the proceeding for further action.

4. Response should be addressed as follows:

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

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

By Hand: Customer Service Window

Randolph Building
401 Dulany Street
Alexandria, VA 22314

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 Eric Keasel, at (571) 272-4929, in the event that Eric Keasel is unavailable, to the undersigned at (571) 272-3838.

Gregory Morse
Director,
Central Reexamination Unit 3999

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,287	12/21/2009	7020845	8157.018.845	4456

22850 7590 03/24/2010

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/24/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/001,287	12/21/09	7020845	81573018.845

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

EXAMINER	
NALVEN, ANDREW L.	
ART UNIT	**PAPER**
3992	

DATE MAILED:
MAILED
MAR 24 2010
CENTRAL REEXAMINATION UNIT

INTER PARTES REEXAMINATION COMMUNICATION

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

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

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EXAMINER
NALVEN, ANDREW L.

ART UNIT	PAPER
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NOVAK DRUCE & QUIGG. LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET, FIFTY-THIRD FLOOR
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Commissioner for Patents
United States Patent and Trademark Office
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Steven McMahon Zeller
OBLON, SPIVAK, MCCLELLAND
MAIER & NEUSTADT, L.L.P.
1940 DUKE STREET
ALEXANDRIA VA 22314

(For Patent Owner)

MAILED

MAR 24 2010

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: Gottfurcht *et alia*
Inter Partes Reexamination Proceeding
Control No. 95/001,287
Deposited on: 21 December 2009
For: US Patent No. 7,020,845

DECISION
DISMISSING
PETITION FOR EXTENSION
OF TIME
[37 CFR §§ 1.956 & 1.181]

This is a decision on the 17 March 2010, "Petition for Extension of Time Under 37 CFR § 1.956" requesting that the time for responding to the non-final Office action mailed 02 February 2010, be extended by one (1) month. The petition was timely filed with certificate of service.

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

The petition is dismissed for the reasons set forth below.

DISCUSSION

The Patent Owner's representative requests the period of time be extended in which to file a response to the non-final Office action mailed 02 February 2010, which set two (2) months time for filing a response thereto. The petition for extension of time was timely filed on 17 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 petition is dismissed for the reasons set forth below.

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

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

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

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

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

> Requests for an extension of time in an inter partes reexamination proceeding will be

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

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

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

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

Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. The reasons must include (A) a statement of what action the patent owner has taken to provide a response, to date as of the date the request for extension is submitted, and (B) why, in spite of the action taken thus far, the requested additional time is needed. The statement of (A) must provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period. Prosecution will be conducted by initially setting a time period of at least 30 days or one month (whichever is longer), see MPEP § 2662. First requests for extensions of these time periods will be granted for sufficient cause, and for a reasonable time specified-usually 1 month. The reasons stated in the request will be evaluated, and the request will be favorably considered where there is a factual accounting of reasonably diligent behavior by all those responsible for preparing a response or comments within the statutory time period. Second or subsequent requests for extensions of

time, or requests for more than one month, will be granted only in extraordinary situations.

DECISION

The patent owner's representative petitions under 37 CFR § 1.956 to extend the period for response by adding one (1) month to the period for response. The decision to extend the period for response is evaluated based upon a showing of "sufficient cause." There is always the consideration to balance the need for the patent owner to have a fair opportunity to respond to the Office action between the need for special dispatch.

The petition notes the time is needed to allow the inventor to travel from California to Virginia and ongoing business. The petitioner further notes concurrently filed petition. The Patent owner should note that extensions of time in *inter partes* proceedings require that the reasons for petitioning for the extension must include (A) a statement of what action the patent owner has taken to provide a response, to date as of the date the request for extension is submitted, and (B) why, in spite of the action taken thus far, the requested additional time is needed. The statement of (A) must provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period. The statement that the inventor has ongoing business does not articulate a complete accounting of the time and why, in spite of the actions taken thus far, the additional time is needed. Regarding the concurrently filed petition, the mere filing of a petition does not stay the time for response. On balance there is insufficient cause to grant the 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 is hereby **dismissed.**

2. The Patent Owner's response is due **02 April 2010.**

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

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

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

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

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

/Mark Reinhart/

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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22850 7590 04/07/2010

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.
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NALVEN, ANDREW L.

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

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JEFFER, MANGELS, BUTLER & MARMARO, LLP (For Patent Owner)
1900 AVENUE OF THE STARS, 7TH FLOOR
LOS ANGELES CA 90067

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APR 07 2010

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OBLON, SPIVAK, MCCLELLAND (Courtesy Copy)
MAIER & NEUSTADT, L.L.P.
1940 DUKE STREET
ALEXANDRIA VA 22314

NOVAK DRUCE & QUIGG, LLP (For Third Party Requester)
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET
FIFTY-THIRD FLOOR
HOUSTON, TX 77002

In re: Gottfurcht *et alia*
Inter Partes Reexamination Proceeding
Control No. 95/001,287
Deposited on: 21 December 2009
For: US Patent No. 7,020,845

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

This is a decision on the 26 March 2010, "Renewed Petition for Extension of Time Under 37 CFR § 1.956" requesting that the time for responding to the non-final Office action mailed 02 February 2010, be extended by one (1) month. The petition was timely filed with certificate of service.

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

The petition is **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 02 February 2010, which set two (2) months time for filing a response thereto. The renewed petition for extension of time was timely filed on 26 March 2010, together with certificate of service.

The petition supports a ten (10) day extension of time.

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

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

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

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

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

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

> Requests for an extension of time in an inter partes reexamination proceeding will be considered only after the first Office action on the merits in the reexamination is mailed. Any request for an extension of time filed prior to the first action will be denied.
>
> The certificate of mailing and the certificate of transmission procedures (37 CFR § 1.8), and the "Express Mail" mailing procedure (37 CFR § 1.10), may be used to file a request for extension of time, as well as any other paper in an existing *inter partes* reexamination proceeding (see MPEP § 2666).
>
> As noted above, a request for extension of time under 37 CFR § 1.956 will be granted only for sufficient cause, and the request must be filed on or before the day on which action by the patent owner is due. In no case, will the mere filing of a request for extension of time automatically effect any extension, because the showing of cause may be insufficient or incomplete. In the prosecution of an *ex parte* reexamination, an

automatic 1-month extension of time to take further action is granted upon filing a first timely response to a final Office action (see MPEP § 2272). The automatic extension given in *ex parte* reexamination does not apply to the first response to an Action Closing Prosecution (ACP) in an inter partes reexamination. The reason is that in *inter partes* reexamination, parties do not file an appeal in response to an ACP, and a further Office action (Right of Appeal Notice) will issue even if the parties make no response at all. Thus, there is no time period to appeal running against the parties after the ACP is issued, unlike ex parte reexamination where an appeal is due after final rejection and the time is thus automatically extended one month to provide time for the patent owner to review the Office's response to the amendment before deciding whether to appeal.

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

Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. The reasons must include (A) a statement of what action the patent owner has taken to provide a response, to date as of the date the request for extension is submitted, and (B) why, in spite of the action taken thus far, the requested additional time is needed. The statement of (A) must provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period. Prosecution will be conducted by initially setting a time period of at least 30 days or one month (whichever is longer), see MPEP § 2662. First requests for extensions of these time periods will be granted for sufficient cause, and for a reasonable time specified-usually 1 month. The reasons stated in the request will be evaluated, and the request will be favorably considered where there is a factual accounting of reasonably diligent behavior by all those responsible for preparing a response or comments within the statutory time period. Second or subsequent requests for extensions of time, or requests for more than one month, will be granted only in extraordinary situations.

...

DECISION

The patent owner's representative petitions under 37 CFR § 1.956 to extend the period for response by adding one (1) month to the period for response. The decision to extend the period for response is evaluated based upon a showing of "sufficient cause." There is always the consideration to balance the need for the patent owner to have a fair opportunity to respond to the Office action between the need for special dispatch.

The petition notes the change in counsel. Since the files are all available on-line electronically via Public PAIR, the mailing of the action should have posed no need for additional time. The storm noted 4-15 February 2010 does support an extension of ten (10) days time since this could not have been anticipated by neither the patent owner nor counsel.

On balance there is "sufficient cause" to grant ten (10) days extension of time.

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

PATENT OWNER'S CORRESPONDENCE 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 '845 patent file is that of

JEFFER, MANGELS, BUTLER & MARMARO, LLP
1900 AVENUE OF THE STARS, 7TH FLOOR
LOS ANGELES CA 90067

As a courtesy, this decision is being mailed to the address of

OBLON, SPIVAK, MCCLELLAND
MAIER & NEUSTADT, L.L.P.
1940 DUKE STREET
ALEXANDRIA VA 22314

in view of the February 3, 2010 Power of Attorney and Change of Address and the February 5, 2010 Notice of Acceptance of Power of Attorney and Notice Regarding Change of Power of Attorney present in the file of the '1287 reexamination proceeding.

The address of
JEFFER, MANGELS, BUTLER & MARMARO, LLP
1900 AVENUE OF THE STARS, 7TH FLOOR
LOS ANGELES CA 90067

, will be the sole patent owner correspondence address used in future correspondence, until a change in correspondence address in the '845 patent file is made in accordance with 37 CFR 1.33(c).

IMPROPER THIRD PARTY PETITIONS

On March 22, 2010, requester filed a paper entitled, "THIRD PARTY REQUESTER'S OPPOSITION TO PATENT OWNER'S PETITION FOR EXTENSION OF TIME". On March 31, 2010, requester filed a paper entitled, "THIRD PARTY REQUESTER'S OPPOSITION TO PATENT OWNER'S RENEWED PETITION FOR EXTENSION OF TIME".

MPEP 2667 states, in part:

"Further, any petition requesting that an extension of time be denied will be returned, since a requester does not have a statutory right to challenge this discretionary procedural process in the reexamination proceeding; whether or not the time is extended clearly does not go to the merits of the reexamination proceeding."

Therefore, the improper third-party oppositions are **expunged** from the file. Since this proceeding is not a paper file, the improper petitions filed on March 22, 2010 and March 31, 2010 are being "closed" from public view

CONCLUSION

1. The patent owner's petition for extension for time is hereby **granted-in-part.**

2. The time for response is extended by ten (10) days.

3. The Patent Owner's response is due **12 April 2010.**

4. The improper third-party opposition petitions are **expunged**.

5. 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.

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

Eric Keasel,
Supervisory Patent Examiner,
AU 3992, Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,287	12/21/2009	7020845	8157.018.845	4456

22850 7590 04/20/2010

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/20/2010

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/001,287	12/21/09	7020845	81573018.845

EXAMINER
NALVEN, ANDREW L.

ART UNIT	PAPER
3992	

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

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EXAMINER	
NALVEN, ANDREW L.	
ART UNIT	**PAPER**
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JEFFER, MANGELS, BUTLER & MARMARO, LLP (Patent Owner)
1900 AVENUE OF THE STARS, 7TH FLOOR
LOS ANGELES, CA 90067

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

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APR 20 2010

CENTRAL REEXAMINATION UNIT

In re Gottfurcht et al. :
Inter Partes Reexamination Proceeding : **DECISION**
Control No.: 95/001,287 : **DISMISSING**
Filing Date: December 21, 2009 : **PETITION**
For: US Patent No. 7,020,845 :

This is a decision on the April 12, 2010 patent owner petition entitled "PETITION UNDER 37 C.F.R. § 1.182 FOR TRANSFER OF JURISDICTION TO THE OFFICE OF PATENT LEGAL ADMINISTRATION."

The present petition is before the Office of Patent Legal Administration (OPLA) for consideration.

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

FEES

The petition fee of $400.00 pursuant to 37 CFR 1.17(f) for the patent owner petition under 37 CFR 1.182 was paid on April 12, 2010.

REVIEW OF THE RELEVANT FACTS

1. On March 28, 2006, the Office issued U.S. Patent No. 7,020,845 (the '845 patent) to Gottfurcht et al.

2. On December 21, 2009, a request for *inter partes* reexamination of the '845 patent was filed by a third party requester. The resulting reexamination proceeding was assigned control number 95/001,287 (the '1287 proceeding).

3. On February 2, 2010, the Office issued an order granting *inter partes* reexamination in the '1286 proceeding, with an accompanying Office action on the merits.

4. On March 2, 2010, patent owner filed a petition entitled "PETITION UNDER 37 C.F.R. §1.181(a)(3) TO VACATE THE *ULTRA VIRES* REEXAMINATION ORDER OF FEBRUARY 2, 2010."

5. On April 12, 2010, patent owner filed a timely response to the February 2, 2010 Office action.

6. On April 12, 2010, patent owner filed the present petition entitled "PETITION UNDER 37 C.F.R. § 1.182 FOR TRANSFER OF JURISDICTION TO THE OFFICE OF PATENT LEGAL ADMINISTRATION."

RELEVANT REGULATION

37 CFR 1.182 provides:

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

DECISION

The present patent owner petition under 37 CFR 1.182 requests (1) that OPLA take jurisdiction of the instant proceeding prior to the Central Reexamination Unit (CRU) issuing a responsive communication to the patent owner's April 12, 2010 response to the February 2, 2010 Office action and (2) that OPLA retain such jurisdiction until the Director issues a decision on the petition filed on March 2, 2010 to vacate the present reexamination as *ultra vires*.[1] Patent owner asserts that "[a]bsent the requested relief, the Examiner would be forced to expend unnecessary effort in the face of imminent termination of this reexamination."[2] Patent owner further contends that "the transfer of jurisdiction is in the best interest of conserving Office resources" and will ensure that the patent owner "is not burdened by further reexamination obligations stemming from Third Party Requester mischaracterizations of the record."[3]

---

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

The instant petition has been fully considered. However, in light of the present circumstances, OPLA will not take jurisdiction of the instant proceeding and retain jurisdiction. MPEP 1002.02(c) provides a list of the petitions decided by the Technology Center Directors, and states as follows:

> 3. Petitions invoking the supervisory authority of the Director of the USPTO under 37 CFR 1.181 involving any ex parte action or requirement in a patent application by the examiner which is not subject to appeal (37 CFR 1.191) and not otherwise provided for, as for example:
> (a) prematureness of final rejection, MPEP § 706.07(c);
> (b) holding of abandonment, MPEP § 711.03(c);
> (c) requirement to cancel "new matter" from specification, MPEP § 608.04(c);
> (d) relative to formal sufficiency and propriety of affidavits under 37 CFR 1.131 (MPEP § 715.08), 1.132 (MPEP § 716) and 1.608, MPEP § 2308 - § 2308.02;
> (e) refusal to initiate an interference under 37 CFR 1.601(i), MPEP § 2306;
> (f) refusal to enter an amendment under 37 CFR 1.312, MPEP § 714.16(d);
> (g) refusal to enter an amendment, 37 CFR 1.127, MPEP § 714.19;
> (h) refusal to enter an amendment under 37 CFR 1.111 or 37 CFR 1.115, MPEP § 714.03(a);
> (i) resetting period for reply, MPEP § 710.06; and
> (j) requirement for information under 37 CFR 1.105, MPEP § 704.11.

In this instance, the Director of the CRU stands in place of the Technology Center Director as the first line of supervisory review of a CRU examiner's actions that are petitionable, since the CRU examines reexamination proceedings, and review of a CRU examiner's actions that are petitionable is carried out by the Director of the CRU. If OPLA were to take and retain jurisdiction, such would prevent the Director of the CRU from having jurisdiction to decide the March 2, 2010 petition under 37 CFR 1.181. Accordingly, the present petition is dismissed.

CONCLUSION

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

2. Jurisdiction over this reexamination proceeding is being returned to the Central Reexamination Unit, Art Unit 3992.

3. Any inquiry concerning this decision should be directed to Susy Tsang-Foster, Legal Advisor, at (571) 272-7711.

Kenneth M. Schor

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

4-19-10 Kenpet8\IP\UV

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,287	12/21/2009	7020845	8157.018.845	4456

22850 7590 07/08/2010

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EXAMINER	
ART UNIT	PAPER NUMBER

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HOUSTON, TX 77002

EXAMINER	
NALVEN, ANDREW L.	
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(For Patent Owner)
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LOS ANGELES, CA 90067

OBLON, SPIVAK, MCCLELLAND MAIER
& NEUSTADT, L.L.P.
1940 DUKE STREET
ALEXANDRIA VA 22314

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CENTRAL REEXAMINATION UNIT

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

In re Gottfurcht et al.	:	DECISION DISMISSING
Control No. 95/001,287	:	PETITION PURSUANT TO
Deposited: December 21, 2009	:	37 CFR § 1.181(a)(3) and
For: US Patent No. 7,020,845	:	PETITION TO STRIKE
	:	PURSUANT TO 37 CFR 1.182

This is a decision on the March 2, 2010 petition filed by the patent owner entitled, "Petition under 37 CFR 1.181 to vacate the *ultra vires* reexamination order of February 2, 2010" [hereinafter "the vacate petition"]. The petition under 37 CFR § 1.181(a)(3) states that the order granting reexamination in the proceeding is *ultra vires* and should be vacated. The third party requester filed a paper on March 16, 2010 in opposition to the petition [hereinafter "the first opposition"]. Patent owner filed a petition under 37 CFR 1.182 to strike the March 16, 2010 opposition [hereinafter "the strike petition"] on March 23, 2010. The requester filed an opposition to the March 16, 2010 petition to strike on March 30, 2010 [hereinafter "the second opposition"]. This decision addresses both of patent owner's petitions and both of third party requester's oppositions.

The petitions and oppositions are before the Director of the Central Reexamination Unit for consideration.

The vacate petition is dismissed for the reasons set forth below.

The strike petition is dismissed for the reasons set forth below.

SUMMARY OF RELEVANT FACTS

1. U.S. Patent No. 7,020,845 [hereinafter "the '845 patent"] was granted to *Gottfurcht et al.* on March 28, 2006.

2. On December 21, 2009, a request for *inter partes* reexamination of the '845 patent was filed by a third party requester. The resulting reexamination proceeding was assigned control number 95/001,287 (the ' 1287 proceeding).

3. On February 2, 2010, the Office issued an order granting inter partes reexamination in the ' 1286 proceeding, with an accompanying Office action on the merits.

4. On March 2, 2010, the vacate petition entitled "PETITION UNDER 37 C.F.R. §1.181(a)(3) TO VACATE THE *ULTRA VIRES* REEXAMINATION ORDER OF FEBRUARY 2, 2010" was filed.

5. On March 16, 2010, the first opposition entitled "THIRD PARTY REQUESTER'S OPPOSITION TO PATENT OWNER'S PETITION..." was filed.

6. On March 23, 2010, the strike petition entitled "PETITION UNDER 37 C.F.R. §182 TO STRIKE THIRD PARTY SUPPLEMENT TO THE *INTER PARTES* REEXAMINATION REQUEST FOR 95/001,287" was filed.

7. On March 30, 2010, the second opposition entitled "THIRD PARTY REQUESTER'S OPPOSITION TO PATENT OWNER'S PETITION TO STRIKE" was filed.

8. On April 12, 2010, patent owner filed a timely response to the February 2, 2010 Office action.

9. On May 12, 2010, the third party requester timely filed comments.

DISCUSSION

The patent owner requests that the reexamination proceeding be vacated. The petitioner considers the action taken by the Office by granting the order to reexamine the patent as an *ultra vires* action by the Office. The third party requester opposes to the petition (see the first opposition). Patent owner then filed a petition under 37 CFR 1.182 to strike the first opposition. The requester filed a second opposition addressing the strike peition on March 30, 2010.

The request to vacate the order of the reexamination proceeding is dismissed.

The request to strike the first opposition is dismissed.

STATEMENT OF RELEVANT AUTHORITY

35 U.S.C. 312 Determination of issue by Director.

(a) REEXAMINATION.- Not later than 3 months after the filing of a request for inter partes reexamination under section 311, the Director shall determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request, with or without consideration of other patents or printed publications. The existence of a substantial new question of patentability is not precluded by the fact that a patent or printed publication was previously cited by or to the Office or considered by the Office.

MPEP 2642 provides in relevant part:

I. SUBSTANTIAL NEW QUESTION OF PATENTABILITY

The presence or absence of "a substantial new question of patentability" determines whether or not reexamination is ordered. The meaning and scope of the term "a substantial new question of patentability" is not defined in the statute and must be developed to some extent on a case-by-case basis, using the case law to provide guidance as will be discussed in this section.

If the prior art patents and printed publications raise a substantial question of patentability of at least one claim of the patent, then a substantial new question of patentability is present, unless the same question of patentability has already been decided by (A) a final holding of invalidity, after all appeals, or (B) by the Office in a previous examination or pending reexamination of the patent. A "previous examination" of the patent is: (A) the original examination of the application which matured into the patent; (B) the examination of the patent in a reissue application that has resulted in a reissue of the patent; or (C) the examination of the patent in an earlier pending or concluded reexamination. The answer to the question of whether a "substantial new question of patentability" exists, and therefore whether reexamination may be had, is decided by the Director of the Office, and as 35 U.S.C. 312(c) provides, that determination is final, i.e., not subject to appeal on the merits of the decision. See *In re Etter*, 756 F.2d 852, 225 USPQ 1 (Fed. Cir. 1985) which was decided for the *ex parte* reexamination statute (note that 35 U.S.C. 312(c) for the *inter partes* reexamination statute contains the same language as 35 U.S.C. 303(c) for *ex parte* reexamination). But see *Heinl v. Godici*, 143 F.Supp.2d 593, 596-98 (E.D. Va. 2001) (35 U.S.C. 303 addresses only USPTO decisions to deny a request for reexamination and does not bar review of *ultra vires* USPTO decisions to grant reexamination requests. However, a decision to grant a reexamination request is not a final agency decision and is not ordinarily subject to judicial review.).

A prior art patent or printed publication raises a substantial question of patentability where there is a substantial likelihood that a reasonable examiner would consider the prior art patent or printed publication **important** in deciding whether or not the claim is patentable. If the prior art patents and/or publications would be considered important, then the examiner should find "a substantial new question of patentability" unless the same question of patentability has already been decided as to the claim in a final holding of invalidity by the Federal court system or by the Office in a previous examination. For example, the same question of patentability may have already been decided by the Office where the examiner finds the additional (newly provided) prior art patents or printed publications to be merely cumulative to similar prior art already fully considered by the Office in a previous examination of the claim.

Accordingly, for "a substantial new question of patentability" to be present, it is only necessary that:

(A) The prior art patents and/or printed publications raise a substantial question of patentability regarding at least one claim, i.e., the teaching of the prior art patents and printed publications is such that a reasonable examiner would consider the teaching to be **important** in deciding whether or not the claim is patentable; and

(B) The same question of patentability as to the claim has not been decided by the Office in a previous examination or pending reexamination of the patent or in a final holding of invalidity by the Federal Courts in a decision on the merits involving the claim.

It is not necessary that a *"prima facie"* case of unpatentability exist as to the claim in order for "a substantial new question of patentability" to be present as to the claim. Thus, "a substantial new question of patentability" as to a patent claim could be present even if the examiner would not necessarily reject the claim as either anticipated by, or obvious in view of, the prior art patents or printed publications. The difference between "a substantial new question of patentability" and a *"prima facie"* case of unpatentability is important. See generally *In re Etter*, 756 F.2d 852, 857 n.5, 225 USPQ 1, 4 n.5 (Fed. Cir. 1985).

...

II.A. Prior Favorable Decisions by the U.S. Patent and Trademark Office on the Same or Substantially Identical Prior Art in Relation to the Same Patent.

A "substantial new question of patentability" is not raised by prior art presented in a reexamination request if the Office has previously considered (in an earlier examination of the patent) the same question of patentability as to a patent claim favorable to the patent owner based on the same prior art patents or printed publications. *In re Recreative Technologies*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996).

In deciding whether to grant a request for reexamination of a patent, the examiner should check the patent's file history to ascertain whether any of the prior art now advanced by requester was previously cited/considered in an earlier concluded Office examination of the patent (e.g., in the examination of the application for the patent). For the sake of expediency, such art is referred to as "old art" throughout, since the term "old art" was coined by the Federal Circuit in its decision of *In re Hiniker*, 150 F.3d 1362,1365-66,47 USPQ2d 1523, 1526 (Fed. Cir. 1998).

MPEP § 2646 Decision Ordering Reexamination (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.

DECISION ON PETITION TO VACATE THE ORDER

The patent owner brings before the Office a petition under 37 CFR § 1.181(a)(3) to vacate an ordered reexamination proceeding as not raising a proper substantial new question of patentability (SNQ). The procedure for such a petition is provided for in MPEP 2646. For this petition to be granted, however, the patent owner must show that the Office had no discretion to grant the request for reexamination. See MPEP 2646.

Patent owner contends that the order for reexamination of the '845 patent is *ultra vires* and must be vacated. Patent owner presents only one basis for this contention; that the order is based wholly on cumulative claim construction issues expressly rejected by the Board of Patent Appeals and Interferences (BPAI) in the prior examination. In other words, petitioner contends that the order granting reexamination of claims 1-36 improperly disregarded the claim interpretation of the BPAI in the prior examination, and therefore, improperly decided that the cited patents and printed publications raised a substantial new question of patentability. Petition at 1-2.

Requester opposes the petition on the grounds that the petition filed by the patent owner is misconstruing the standard for a substantial new question of patentability by raising it to a *prima facie* showing of unpatentability, and the patent owner has not provided the necessary showing to support the petition.

The determination of whether an SNQ exists is a fact-specific inquiry. MPEP 2642(II)(A). Determination of the scope of previous examination consideration begins "with an analysis of the record of the prior proceedings to determine if and how the examiner used the reference in making his initial decisions." *In re Swanson*, 540 F.3d 1368, 1381 (Fed. Cir. 2008). An SNQ will not be raised solely by an "argument already decided by the Office," or where the issue merely questions the prior judgment of the examiner. *Id.* (*quoting* H.R. Rep. No 96-1307 *and citing* H.R. Rep. No. 107-120). Patent owner's contentions are focused on claim interpretation but claim interpretation, alone, is not determinative as to whether the Office exceeded its statutory authority in granting the second request for reexamination. The essential inquiry is whether the order granting reexamination established a basis for granting the reexamination, as authorized by 35 U.S.C. 311 and 312 and 37 CFR 1.915 and 1.923.

The reexamination record is clear that the examiner considered the prior examination of the '845 patent in making the determination to order the reexamination. See pages 2-3 of the order dated February 2, 2010. As stated by the examiner, the patentability of the claims were based on the BPAI decision that found that the cited prior art fails to teach or suggest the limitation that the sister site provides the simplified interface for the webpage. Therefore, the prior prosecution of the '845 patent established that the prior art of record failed to teach the limitation that the sister site provides the simplified navigation interface for the webpage as required by the independent claims.

The order of February 2, 2010 states that the Reformulating HTML reference, the WAP references, and the UP references present new technical teachings that were not considered in the prior examination and raise a SNQ with respect to claims 1-36 because each reference has teachings relevant to the limitation that a sister site provides the simplified navigation interface, which was a limitation found to be missing in the prior examination. See pages 7-12 of the Order of February 2, 2010. Furthermore, the order also determined that the Britton patent presents new technical teachings that were not considered in the prior examination and raise a SNQ with respect to claims 3-5 and 8-10 because the reference has teachings relevant to the limitation that a sister site provides the simplified navigation interface. See pages 12-13 of the Order of February 2, 2010. Therefore, the record shows that the examiner made a determination, in light of the prior examination, that these cited documents provided a new technical teaching pertaining to the simplified navigation interface of a sister site, which would be important to a reasonable examiner, and accordingly, raised a SNQ in regards the claims. See MPEP 2644. In other words, the record does not show that the order for reexamination was based solely on an argument already decided by the Office. Accordingly, the record shows that the determination of that a SNQ was raised by the newly considered references

was in accordance with 35 U.S.C. 311 and 312, its implementing regulations, 37 CFR 1.915 and 1.922, and the guidelines set forth in MPEP 2640, 2642, 2644, and 2646.

Patent owner does not show that the order failed to establish that the cited references presented a new technical teaching that would be important to a reasonable examiner in determining the patentability of claims 1-36. Patent owner, instead, concludes that the examiner ignored the claim interpretation by the BPAI in the prior examination, and focuses on whether it was proper for the examiner to set forth an allegedly different claim interpretation for the limitation pertaining to the sister site. Petition at 7-12. Patent owner's arguments are seemingly requiring that a *prima facie* case of unpatentability must be established in order for the Office to have the statutory authority to grant the request for reexamination. As explicitly stated in MPEP 2642, subsection I, such is not the standard in the determination of whether a substantial new question of patentability is raised.

Upon review of the reexamination record, the record does not support petitioner's conclusion that the examiner ignored or used an inconsistent claim interpretation than applied by the BPAI in the prior examination. Specifically, the order states how the teachings of cited references present new, non-cumulative technological teachings that are relevant to the sister site limitation, which was found to be missing the prior examination. It is not required that the cited references unequivocally teach the sister site limitation in order to raise a substantial new question of patentability. The requirement is that the cited references have teachings that a reasonable examiner would consider important in determining whether claims 1-36 of the '845 patent are patentable. The order of February 2, 2010 provides such a showing to meet this requirement on pages 7-13. Therefore, the determination that the cited references raise a SNQ with respect to claims 1-36 of the '845 patent was in accordance with 35 U.S.C. 311 and 312, its implementing regulations, 37 CFR 1.915 and 1.922, and the guidelines set forth in MPEP 2640, 2642, 2644, and 2646. Accordingly, Office had discretion to grant the request for reexamination.

For these reasons, patent owner has presented insufficient support for the contention that the order was an *ultra vires* action on the part of the Office. As discussed further below, the patent owner must have shown that the Office was without authority to grant a request for reexamination. In other words, the petition must show that there was no discretion to grant the reexamination and not just disagreement with substantive determinations in the order on what the prior art teaches.

Accordingly, it is found that the order was not based wholly on the same question of patentability raised by the prior art previously presented. Therefore, the order was not an *ultra vires* action on the part of the Office. For the reasons detailed above, patent owner has failed to show that the order was an *ultra vires* action. Petitioner is referred to *Heinl v Godici*, (E.D.Va. 2001), 143 F. Supp. 2d 593. In *Heinl*, 143 F.Supp.2d at 601, the court stated:

> "Under the well established *ultra vires* doctrine, the exhaustion and final agency requirements are excused 'only if plaintiff is able to show that the PTO clearly exceeded its statutory authority'", quoting from *Philip Morris, Inc. v. Block*, 755 F.2d 368, 370 (4th Cir. 1985) (quoting *Mayor and City Council of Baltimore v. Mathews*, 562 F.2d 914, 920 (4th Cir. 1977), vacated on other grounds, 571 F.2d 1273 (4th Cir. 1978).

The court went on to state:

> "Put differently, when an agency acts in 'brazen defiance' of its statutory authorization, courts need not await the conclusions of the underlying proceedings."

After a review of the present record, and based upon the above discussion, it is found that petitioner patent owner has not shown the Office to have "clearly exceeded its statutory authority" nor acted "in brazen defiance of its statutory authorization" in the Office's determination to order reexamination.

In view of the above, the petition to vacate the reexamination proceeding is dismissed.

DECISION ON PETITION TO STRIKE THE FIRST OPPOSITION

The patent owner brings before the Office a petition to strike the first opposition, dated March 16, 2010. Patent owner contends that the first opposition improperly supplements the initial request for reexamination by revising the stated SNQs, and therefore, must be expunged from the record as an improper paper. See the strike petition, dated March 23, 2010.

Requester opposes the petition on the grounds that the petition filed by the patent owner is procedurally improper and without basis. See the second opposition, dated March 30, 2010.

Upon review, the first opposition, dated March 16, 2010, is not deemed an improper paper that is not permitted to be entered into the reexamination record. See MPEP 2667. First, MPEP 2646 explicitly allows the third party requester to file an opposition to a patent owner's petition to vacate an order granting reexamination. Second, the first opposition is not deemed an unauthorized attempt to modify the SNQs raised in the order. In allowing the third party requester to file an opposition, the procedures permit the third party requester to respond to the issues raised by the petitioner patent owner. Specifically, it is the patent owner that raised the issues as to whether the examiner's determination in the order is consistent with the BPAI's claim interpretation in the prior examination. Accordingly, it is permissible for the third party requester to respond to those issues with regard to the cited documents. Finally, while the first opposition was considered, this decision does not rely on the positions of the third party requester in the first opposition.

In view of the above, the petition to strike the first opposition is dismissed.

PATENT OWNER'S CORRESPONDENCE ADDRESS

For the same reasons as stated in the April 20, 2010 decision in related reexamination proceeding 95/001,287, the power of attorney and change of correspondence address filed February 3, 2010 is ineffective. The current power of attorney and correspondence address remains to be Jeffer, Mangels, Butler & Mamaro, LLP, 1900 Avenue of the Stars, 7th Floor, Los Angeles, CA 90067. See pages 3-4 of the April 20, 2010 decision. See also the concurrently mailed decision regarding the patent owner's correspondence address.

Patent owner is called upon to file any change of power of attorney and correspondence address in the patent file (Application No. 09/518,015) in order to properly effectuate a change in this reexamination proceeding. As a courtesy, this decision is being mailed to the address listed in the February 3, 2010 communication. However, all future correspondence

may only be made to the official correspondence address of record at the time the correspondence is mailed.

CONCLUSION

1. The patent owner's petition vacate the reexamination under 37 CFR §§ 1.181(a)(3) proceeding is hereby **dismissed.**

2. The patent owner's petition strike the first opposition is hereby **dismissed.** The third party requester's opposition, dated March 16, 2010, will remain in the record.

3. Jurisdiction over the present reexamination proceeding is hereby forwarded to the examiner in charge of the proceeding for further action.

4. Response should be addressed as follows:

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

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

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

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 Eric Keasel, at (571) 272-4929, in the event that Eric Keasel is unavailable, to the undersigned at (571) 272-3838.

Gregory Morse
Director
Central Reexamination Unit

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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(For Patent Owner)

REINHART BOERNER VAN DEUREN S.C.
ATTN: LINDA KASULKE, DOCKET COORDINATOR
1000 NORTH WATER STREET, STE. 2100
MILWAUKEE WI 53202

MAILED

JUN 03 2010

OFFICE OF PETITIONS

(For Requester)

VINSON & ELKINS L.L.P.
FIRST CITY TOWER
1001 FANNIN ST., STE 2500
HOUSTON TX 77002-6760

In re Bridgham et al.	:	
Reexamination Proceeding	:	DECISION
Control No. 95/001,292	:	DISMISSING
Filed: 12/31/2009	:	PETITION
For: U.S. Patent 6,654,505	:	
Attorney Docket Number: INV850/4-046REUS	:	

This is a decision on the patent owner's petition under 37 CFR § 1.78(a)(3), filed on May 21, 2010, to accept an unintentionally delayed claim under 35 U.S.C. §§ 120 and 365(c) for the benefit of priority to the prior-filed nonprovisional and international applications set forth in the concurrently filed amendment.

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

The petition is **DISMISSED**

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000, and after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

(1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;
(2) the surcharge set forth in § 1.17(t); and
(3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

The petition does not comply with item (1).

At the outset, the amendment is not acceptable as drafted since it improperly incorporates by reference prior-filed Application No. 08/358,810, a reference to which was not made on filing in Application No. 09/907,795, which is the subject of the instant reexamination proceeding. An incorporation by reference statement added after an application's filing date is not effective, because no new matter can be added to an application after its filing date (*see* 35 U.S.C. § 132(a)). If an incorporation by reference statement is included in an amendment to the specification to add a benefit claim under 35 U.S.C. § 120 after the filing date of the application, the amendment would not be proper. When a benefit claim under 35 U.S.C. § 120 is submitted after the filing of an application, the reference to the prior application must not include an incorporation by reference statement of the prior application. *See* Dart Industries v. Banner, 636 F.2d 684, 207 USPQ 273 (C.A.D.C. 1980). *Note* MPEP §§ 201.06(c) and 608.04(b).[1]

Further, where an application claims a benefit under 35 U.S.C. 120 of a chain of applications, the application must make a reference to the first (earliest) application and every intermediate application. See Sampson v. Ampex Corp., 463 F.2d 1042, 1044-45, 174 USPQ 417, 418-19 (2d Cir. 1972); Sticker Indus. Supply Corp. v. Blaw-Knox Co., 405 F.2d 90, 93, 160 USPQ 177, 179 (7th Cir. 1968); Hovlid v. Asari, 305 F.2d 747, 751, 134 USPQ 162, 165 (9th Cir. 1962). See also MPEP 201.11. In addition, every intermediate application must also make a reference to the first (earliest) application and every application after the first application and before such intermediate application. MPEP 201.06(d).

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[1] The petition references an amendment to the specification filed in *Ex Parte* Reexamination Control No. 90/009,581 to correct the claims of benefit. It is noted that the amendment filed in theabove-referenced *Ex Parte* Reexamination also contains an improper incorporation by reference.

Petitioners should review the claim for priority to ensure that a reference is made to the first application and to every intermediate application.

In this regard, a review of Office records reveals that Application No. 08/862,610 does not contain a claim to prior filed Application Nos. 08/358,810 and 08/322,348.

Additionally, it is noted that U.S. Patent No. 6,280,935 states that Application No. 08/659,453, now U.S. Patent 5846719, is a continuation-in-part (CIP) of PCT/US95/12791. U.S. Patent No. 5,846,719 states that Application No. 08/358,810, now U.S. Patent No. 5,604,097, is a CIP of the above-referenced PCT application. U.S. Patent No. 5,604,097, however, does not contain a reference to the aforementioned PCT application.

Moreover, 37 CFR 1.78(a)(1) states, in pertinent part, that in order for an application to claim the benefit of a prior-filed copending nonprovisional application or international application designating the United States of America, each prior-filed application must name as an inventor at least one inventor named in the later-filed application and disclose the named inventor's invention claimed in at least one claim of the later-filed application in the manner provided by the first paragraph of 35 U.S.C. 112.

In this regard, Application No. 09/090,809, which issued as U.S. Patent No. 6,280,935, lists Stephen C. Macevicz as the sole inventor. Macevicz is not listed as an inventor in the subject ex parte reexamination proceeding, or in Application Nos. 09/907,795, 08/358,810, or 08/322,348. Accordingly, the requirement of § 1.78(a)(1) has not been met.

Before the petition under 37 CFR § 1.78(a)(3) can be granted, the above-referenced matters must be addressed.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop PETITIONS
Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

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

By fax: (571) 273-8300
ATTN: Office of Petitions

Telephone inquiries related to this decision only should be directed to Senior Petitions Attorney Douglas I. Wood at (571) 272-3231.

Inquiries regarding petition status or general petition information are handled by the Office of Petitions staff at (571) 272-9282.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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DRW Jun-10

(For Patent Owner)

REINHART BOERNER VAN DEUREN S.C.
ATTN: LINDA KASULKE, DOCKET COORDINATOR
1000 NORTH WATER STREET, STE. 2100
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FIRST CITY TOWER
1001 FANNIN ST., STE 2500
HOUSTON TX 77002-6760

MAILED

JUN 3 0 2010

OFFICE OF PETITIONS

In re Bridgham et al.	:	
Reexamination Proceeding	:	DECISION GRANTING
Control No. 95/001,292	:	PETITION UNDER
Filed: 12/31/2009	:	37 CFR 1.78(a)(3)
For: U.S. Patent 6,654,505	:	
Attorney Docket Number:	:	
INV850/4-046REUS		

This is a decision on the renewed patent owner's petition under 37 CFR § 1.78(a)(3), filed on June 17, 2010, to accept an unintentionally delayed claim under 35 U.S.C. §§ 120 and 365(c) for the benefit of priority to the prior-filed nonprovisional and international applications set forth in the concurrently filed amendment.

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

The petition is **GRANTED.**

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000, and after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

(1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) to the prior-filed application, unless previously submitted;
(2) the surcharge set forth in § 1.17(t); and
(3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

Receipt of the June 17, 2010 supplemental amendment, containing the claim of benefit under 37 CFR 1.78(a)(3), is acknowledged.

All of the above requirements having been satisfied, the late claim for priority under 35 U.S.C. § 120 and 365(c) is accepted as being unintentionally delayed.

The granting of the petition to accept the delayed benefit claim to the prior-filed applications under 37 CFR 1.78(a)(3) should not be construed as meaning that the patent being reexamined is entitled to the benefit of the prior-filed applications. In order for this patent to be entitled to the benefit of the prior-filed applications, all other requirements under 35 U.S.C. § 120 and 365(c) and 37 CFR 1.78(a)(1) and (a)(2) must be met. Similarly, the fact that the corrected Filing Receipt accompanying this decision on petition includes the prior-filed applications should not be construed as meaning that patent owner is entitled to the claim for benefit of priority to the prior-filed applications noted thereon. Accordingly, the examiner will, in due course, consider this benefit claim and determine whether the patent is entitled to the benefit of the earlier filing date.

The rule at 37 CFR § 1.78(a)(3) requires a statement that the entire delay between the date the claim was due under 37 CFR § 1.78(a)(2)(ii) and the date the claim was filed was unintentional. Since the statement appearing in the petition varies from the required language, the statement is being construed as the statement required by 37 CFR §1.78(a)(3). If this is not a correct reading of the statement appearing in the petition, petitioner should promptly notify the Office.

A corrected Filing Receipt, which includes the priority claim to the prior-filed international and nonprovisional applications, accompanies this decision on petition.

Any inquiries concerning this decision only may be directed to Senior Petitions Attorney Douglas I. Wood at (571) 272-3231.

Inquiries regarding petition status or general petition information are handled by the Office of Petitions staff at (571) 272-9282.

All other inquiries concerning either the examination procedures or status of the application should be directed to the Central Reexamination Unit.

Jurisdiction over the proceeding is being transferred to Central Reexamination Unit, Art Unit 3991, for consideration by the examiner of patent owner's entitlement to claim benefit of priority under 35 U.S.C. § 120 and 365(c) to the prior-filed applications.

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

Encl: Corrected Filing Receipt

6-29-10
Kenpet8/IP

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APPLICATION NUMBER	FILING or 371(c) DATE	GRP ART UNIT	FIL FEE REC'D	ATTY.DOCKET.NO	TOT CLAIMS	IND CLAIMS
95/001,292	12/31/2009	3991		048522-0004		

CONFIRMATION NO. 9037

CORRECTED FILING RECEIPT

22922
REINHART BOERNER VAN DEUREN S.C.
ATTN: LINDA KASULKE, DOCKET COORDINATOR
1000 NORTH WATER STREET
SUITE 2100
MILWAUKEE, WI 53202

Date Mailed: 06/30/2010

Receipt is acknowledged of this non-provisional patent application. The application will be taken up for examination in due course. Applicant will be notified as to the results of the examination. Any correspondence concerning the application must include the following identification information: the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. **If an error is noted on this Filing Receipt, please submit a written request for a Filing Receipt Correction. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections**

Applicant(s)

6,654,505 B2, Residence Not Provided;
SOLEXA ,INC. (OWNER), HAYWARD, CA;
VINSON & ELKINS, L.L.P. (3RD.PTY.REQ.), HOUSTON, TX;
LIFE TECHNOLOGIES CORPORATION (REAL.PTY.IN.INTEREST), Residence Not Provided;
VINSON & ELKINS, L.L.P., HOUSTON, TX

Assignment For Published Patent Application

SOLEXA, INC., HAYWARD, CA

Power of Attorney: The patent practitioners associated with Customer Number 22922

Domestic Priority data as claimed by applicant

This application is a REX of 09/907,795 07/17/2001 PAT 6,654,505
which is a DIV of 09/424,028 11/16/1999 PAT 6,406,848
which is a 371 of PCT/US98/11224 05/22/1998
and is a CIP of 08/946,138 10/07/1997 PAT 6,013,445
which is a CIP of 08/862,610 05/23/1997 ABN
which is a CIP of 08/689,587 08/12/1996 ABN
which is a CIP of 08/659,453 06/06/1996 PAT 5,846,719
and said 08/946,138 10/07/1997
is a CIP of 08/659,453 06/06/1996 PAT 5,846,719
which is a CIP of 08/358,810 12/19/1994 PAT 5,604,097
which is a CIP of 08/322,348 10/13/1994 ABN

Foreign Applications

UNITED STATES OF AMERICA 08/862610 05/23/1997

Projected Publication Date: None, application is not eligible for pre-grant publication

Non-Publication Request: No

Early Publication Request: No

Title

SYSTEM AND APPARATUS FOR SEQUENTIAL PROCESSING OF ANALYTES

Preliminary Class

382

PROTECTING YOUR INVENTION OUTSIDE THE UNITED STATES

Since the rights granted by a U.S. patent extend only throughout the territory of the United States and have no effect in a foreign country, an inventor who wishes patent protection in another country must apply for a patent in a specific country or in regional patent offices. Applicants may wish to consider the filing of an international application under the Patent Cooperation Treaty (PCT). An international (PCT) application generally has the same effect as a regular national patent application in each PCT-member country. The PCT process **simplifies** the filing of patent applications on the same invention in member countries, but **does not result** in a grant of "an international patent" and does not eliminate the need of applicants to file additional documents and fees in countries where patent protection is desired.

Almost every country has its own patent law, and a person desiring a patent in a particular country must make an application for patent in that country in accordance with its particular laws. Since the laws of many countries differ in various respects from the patent law of the United States, applicants are advised to seek guidance from specific foreign countries to ensure that patent rights are not lost prematurely.

Applicants also are advised that in the case of inventions made in the United States, the Director of the USPTO must issue a license before applicants can apply for a patent in a foreign country. The filing of a U.S. patent application serves as a request for a foreign filing license. The application's filing receipt contains further information and guidance as to the status of applicant's license for foreign filing.

Applicants may wish to consult the USPTO booklet, "General Information Concerning Patents" (specifically, the section entitled "Treaties and Foreign Patents") for more information on timeframes and deadlines for filing foreign patent applications. The guide is available either by contacting the USPTO Contact Center at 800-786-9199, or it can be viewed on the USPTO website at http://www.uspto.gov/web/offices/pac/doc/general/index.html.

For information on preventing theft of your intellectual property (patents, trademarks and copyrights), you may wish to consult the U.S. Government website, http://www.stopfakes.gov. Part of a Department of Commerce initiative, this website includes self-help "toolkits" giving innovators guidance on how to protect intellectual property in specific countries such as China, Korea and Mexico. For questions regarding patent enforcement issues, applicants may call the U.S. Government hotline at 1-866-999-HALT (1-866-999-4158).

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Title 35, United States Code, Section 184

Title 37, Code of Federal Regulations, 5.11 & 5.15

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,295	01/14/2010	7509178	8157.029.178	2137

23117 7590 06/09/2010

NIXON & VANDERHYE, PC
901 NORTH GLEBE ROAD, 11TH FLOOR
ARLINGTON, VA 22203

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/09/2010

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

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NOVAK DRUCE & QUIGG, LLP, WELLS FARGO PLAZA
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Houston, TX 77002

Date:
MAILED
JUN 09 2010
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001295
PATENT NO. : 7509178
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

JUN 09 2010

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HOUSTON, TX 77002

(For Third Party Requester)

In re: Logan *et alia*
Inter Partes Reexamination Proceeding
Control No. 95/001,295
Deposited on: 14 January 2010
For: US Patent No. 7,509,178 B2

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

This is a decision on the 03 June 2010, patent owner's "Petition for Extension of Time in *Inter Partes* Reexamination [37 CFR § 1.956]," requesting that the time for responding to the non-final Office action mailed 16 April 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 dated was mailed 16 April 2010. The non-final Office action provides a two (2) month period for response. The petition requesting a one (1) month extension of time was timely filed on 03 June 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 articulates the length of the Office action and applied references and brief unavailability of important personnel in prosecution of the *inter partes* proceeding as grounds for demonstrating "sufficient cause" to grant the extension of time. The change in counsel is noted. 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 16 April 2010 is hereby **granted**.

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

3. The period to respond will end on **16 July 2010**.

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

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

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

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

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

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

/Mark Reinhart/

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

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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.
95/001,299	01/21/2010	6549759	8934.009.RXUS00	1299

21967 7590 04/21/2010

HUNTON & WILLIAMS LLP
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WASHINGTON, DC 20006-1109

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/21/2010

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

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(For Patent Owner)

MAILED

APR 21 2010

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(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET
FIFTY-THIRD FLOOR
HOUSTON, TX 77002

(For Third Party Requester)

In re: Arviv *et alia*
Inter Partes Reexamination Proceeding
Control No. 95/001,299
Deposited on: 21 January 2010
For: US Patent No. 6,549,759 B2

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

This is a decision on the 07 April 2010, "Petition for Extension of Time Pursuant to 37 CFR § 1.956" requesting that the time for responding to the non-final Office action mailed 26 February 2010, be extended by one (1) month. The petition was timely filed with certificate of service.

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

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

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1000 LOUSIANA STREET
FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date: MAILED
APR 21 2010
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001299
PATENT NO. : 6549759
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.

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 26 February 2010, which set two (2) months time for filing a response thereto. The renewed petition for extension of time was timely filed on 07 April 2010, together with certificate of service.

The petition supports a twenty-one (21) day extension of time.

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

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

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

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

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

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

> Requests for an extension of time in an inter partes reexamination proceeding will be

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

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

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

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

Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. The reasons must include (A) a statement of what action the patent owner has taken to provide a response, to date as of the date the request for extension is submitted, and (B) why, in spite of the action taken thus far, the requested additional time is needed. The statement of (A) must provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period. Prosecution will be conducted by initially setting a time period of at least 30 days or one month (whichever is longer), see MPEP § 2662. First requests for extensions of these time periods will be granted for sufficient cause, and for a reasonable time specified-usually 1 month. The reasons stated in the request will be evaluated, and the request will be favorably considered where there is a factual accounting of reasonably diligent behavior by all those responsible for preparing a response or comments

within the statutory time period. Second or subsequent requests for extensions of time, or requests for more than one month, will be granted only in extraordinary situations.

...

DECISION

The patent owner's representative petitions under 37 CFR § 1.956 to extend the period for response by adding one (1) month to the period for response. The decision to extend the period for response is evaluated based upon a showing of "sufficient cause." There is always the consideration to balance the need for the patent owner to have a fair opportunity to respond to the Office action between the need for special dispatch.

The petition notes delay in the patent owner seeking counsel to represent the patent owner which is unfortunate but does not support "sufficient cause" for the purpose of extension of time in reexamination proceedings. The petitioner further notes the mailing of the Office action close to the Order granting reexamination. The petitioner should note that this practice is outlined in the MPEP for the purpose of special dispatch and does not support "sufficient cause" for the purpose of extension of time. The petitioner additionally notes a technical expert is preparing a declaration which requires three weeks additional time. On balance, there is "sufficient cause" to grant-in-part the petition for extension of time.

On balance there is "sufficient cause" to grant twenty-one (21) days extension of time.

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

CONCLUSION

1. The patent owner's petition for extension for time is hereby **granted-in-part.**

2. The time for response is extended by twenty-one (21) days.

2. The Patent Owner's response is due **17 May 2010.**

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

By Mail to: Mail Stop *Ex Parte* Reexam
Central Reexamination Unit
Commissioner for Patents
United States Patent & Trademark Office
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Alexandria, VA 22313-1450

By Fax to: (571) 273-9900
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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/

Mark Reinhart,
Supervisory Patent Examiner,
AU 3992,
Central Reexamination Unit
571-272-1611

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San Francisco, CA 94104-1715

Inter Partes Reexamination Proceeding :
Control No. 95/001,221 :
Filed: Aug. 12, 2009 : **DECISION, *SUA SPONTE,***
For: U.S. Patent No. 7,043,450 : **TO MERGE**
: **REEXAMINATION**
Inter Partes Reexamination Proceeding : **PROCEEDINGS**
Control No. 95/001,308 :
Filed: Feb. 2, 2010 :
For: U.S. Patent No. 7,043,450 :

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. 7,043,450 (the '450 patent) issued to Velez et al. with the assignee listed as Paid Search Engine Tools, Inc. on May 9, 2006, with 22 claims.

2. A request for *inter partes* reexamination of claims 1-22 of the '450 patent was filed on Aug. 12, 2009, by a third party requester, and was assigned control number 95/001,221 (the '1221 *inter partes* proceeding). The real party in interest is Yahoo! Inc.

3. On Nov. 5, 2009, *inter partes* reexamination was ordered for claims 1-22 of the '450 patent based on the examiner's determination that the Aug. 12, 2009 request raised a substantial new question of patentability affecting these claims.

4. An Office action was mailed Dec. 18, 2009, in the '1221 proceeding confirming claims 4 and 19 and adopting rejections for claims 1-3, 5-18, and 20-22.

5. On February 18, 2010, patent owner filed a response to the Office action, adding new dependent claims 23-26 while maintaining original patent claims 1-22. The third party requester filed comments on March 22, 2010 on the Office action and patent owner's response.

6. A second request for *inter partes* reexamination of claims 12-20 and 22 of the '450 patent was filed on Feb. 2, 2010, by a third party requester, and was assigned control number 95/001,308 (the '1308 *inter partes* proceeding). The real parties in interest are Microsoft Corp. and Google, Inc.

7. On April 19, 2010, *inter partes* reexamination was ordered for claims 12-20 and 22 of the '450 patent based on the examiner's determination that the Feb. 2, 2010 request raised a substantial new question of patentability affecting these claims. No Office action has been issued in the '1308 proceeding.

8. A concurrent litigation styled *Paid Search Engine Tools, Inc. v. Google, Inc. et al.*, U.S. District Court of Texas, Eastern District, 2:08cv00061 filed Feb. 12, 2008 and consolidated with an earlier litigation involving the '450 patent is presently open.

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. Both proceedings are still pending, and have not been terminated. Therefore, consideration of merger pursuant to 37 CFR 1.989 is ripe at this point in time.

37 CFR 1.989 provides:

> (a) If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is

ordered, the merged examination will normally result in the issuance of a single reexamination certificate under § 1.997.

In accordance with 37 CFR 1.989(a), the 95/001,221 and 95/001,308 proceedings are merged. The merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

Patent owner is required to maintain the same claims (and specification) in both files throughout the merged proceeding. Presently, the '1221 proceeding includes additional dependent claims 23-26. Thus, the claims are not currently the same in both files. An Office action requiring an amendment placing the claims in identical form is being issued concurrently with this decision. Patent owner must respond to the Office action in accordance with the procedures in 37 CFR 1.111. The third party requesters will then have an opportunity to comment on patent owner's response in accordance with the procedures in 37 CFR 1.947.

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. Pursuant to 37 CFR 1.989(a), the merged examination will normally result in the issuance and publication of a single reexamination certificate under 37 CFR 1.997.

It is noted that reexamination was ordered for claims 1-22 of the '450 patent in the '1221 proceeding and for claims 12-20 and 22 of the '450 patent in the '1308 proceeding. The examiner will conduct reexamination in the merged proceeding for claims 1-22 and for the newly added claims 23-26 of the '450 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.

Patent owner and requester(s) are reminded that every paper filed in the merged proceeding subsequent to this decision must be served on the other parties, and every paper filed must reflect that such paper was served on the other parties, pursuant to 37 CFR 1.903. All papers are to be addressed to the Central Reexamination Unit as provided above.

C. Amendments:

The filing of any amendments to the drawings, specification or claims must comply with 37 CFR 1.943, which incorporates the provisions of 37 CFR 1.530, and the guidelines of MPEP § 2666.01, which in turn references the guidelines of MPEP § 2250.

37 CFR 1.121 does not apply to amendments in reexamination. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via markings pursuant to paragraph 37 CFR 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

Pursuant to 37 CFR 1.530(i), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the request for reexamination. *Amendments are not to be made relative to previous amendments.* Thus, for all amendments, all words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets.

D. Fees:

Where a paper is filed that requires payment of a fee (*e.g.*, petition fee, excess claims fee, extension of time fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For example, only one fee need be paid for any patent owner's appellant brief (or that of the *inter partes* reexamination requester) which may be filed, even though the brief relates to merged multiple proceedings, and copies must be filed (as pointed out above) for each file in the merged proceeding.

E. Citation of Patents and Printed Publications:

Upon return of the present merged proceeding to the examiner, the examiner will review the files to insure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.

F. Appeal Procedure Reminders for *Inter Partes* Reexamination

The parties are reminded of the procedures for taking appeal in an *inter partes* reexamination as explained in MPEP 2674 and 2675. The appeal must only be taken from (1) the rejection(s) of the claims in the Right of Appeal Notice (RAN) that the *patent owner* proposes to contest, or (2) the finding(s) of patentability of claims in the RAN that the *third party requester* proposes to contest. Therefore, in the notice of appeal, the patent owner must identify each claim rejected by examiner that the patent owner intends to contest and the third party requester must identify each rejection *that was previously proposed by that third party requester* that the third party requester intends to contest. (37 CFR 41.61) The appellant's brief shall present a concise statement of each issue. Further, no new ground of rejection can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the

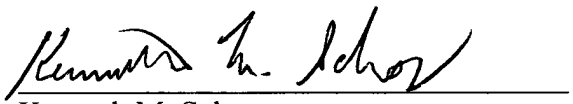
proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection. (37 CFR 41.67(c)(1)(vi))

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/001,221 and *inter partes* Reexamination Control No. 95/001,308 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.

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

April 26, 2010

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,312	03/16/2010	7,542,878	LWC-005RX2	1549

42532 7590 06/04/2010

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/04/2010

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(For Patent Owner)

MAILED

JUN 04 2010

CENTRAL REEXAMINATION UN

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(For *Ex parte* Requester)

Steven B. Maebius
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3000 K. St. N.W., Suite 600
Washington, D.C. 20007

(Courtesy Copy
For *Inter partes* Requester)

In re Reissue Application of Nanikashvili
Application No. 12/706,541
Filed: Feb. 16, 2010
For: U.S. Patent No. 7,542,878

In re Nanikashvili
Ex parte Reexamination Proceeding
Control No. 90/010,751
Filed: Nov. 30, 2009
For: U.S. Patent No. 7,542,878

In re Nanikashvili
Inter partes Reexamination Proceeding
Control No. 95/001,312
Filed: March 16, 2010
For: U.S. Patent No. 7,542,878

DECISION, *SUA SPONTE*, TO MERGE REISSUE AND *EX PARTE* REEXAMINATION PROCEEDINGS

The above-captioned reissue, *ex parte* reexamination proceeding, and *inter partes* reexamination proceeding are before the Office of Patent Legal Administration for *sua sponte* consideration of whether the proceedings should be merged under 37 CFR 1.565(d) at this time.

REVIEW OF FACTS

1. U.S. Patent No. 7,542,878 (the '878 patent) issued on June 2, 2009, with 30 claims.

2. A request for *ex parte* reexamination of claim 1 of the '878 patent was filed by a third party requester on Nov. 30, 2009, and was assigned control No. 90/010,751 (the '10751 proceeding).

3. *Ex parte* reexamination in the '10751 proceeding was ordered for claim 1 of the '878 patent on Jan. 15, 2010.

4. A patent owner's statement under 37 CFR 1.530 has not been received in the '10751 proceeding, and the time for filing same has expired.

5. A reissue application was filed on February 16, 2010 by patent owner to correct an error in inventorship and was assigned serial no. 12/706,541 (the '541 application).

6. The filing of the '541 application was announced in the *Official Gazette* on March 23, 2010.

7. A request for *inter partes* reexamination of claim 1-30 of the '878 patent was deposited on Feb. 16, 2010 by a third party requester, United Therapeutics Corp., and was assigned control no. 95/001,312 (the '1312 proceeding). The filing date requirements for the '1312 proceeding were satisfied on March 16, 2010.

8. *Inter partes* reexamination in the '1312 proceeding was ordered for claims 2-30 of the '878 patent on April 23, 2010. No substantial new question of patentability was found for claim 1 based on the request in the '1312 proceeding.

DISCUSSION REGARDING MERGER

Under 37 CFR 1.565(d):

> "If a reissue application and an *ex parte* reexamination proceeding on which an order pursuant to § 1.525 has been mailed are pending concurrently on a patent, a decision will normally be made to merge the two proceedings or to suspend one of the two proceedings."

Under 37 CFR 1.991:

> "If a reissue application and an *inter partes* reexamination proceeding on which an order pursuant to § 1.931 has been mailed are pending concurrently on a patent, a decision may be made to merge the two proceedings or to suspend one of the two proceedings."

Under 37 CFR 1.989(b):

> "An *inter partes* reexamination proceeding filed under § 1.913 which is merged with an ex parte reexamination proceeding filed under § 1.510 will result in the merged proceeding

being governed by §§ 1.902 through 1.997, except that the rights of any third party requester of the ex parte reexamination shall be governed by §§ 1.510 through 1.560."

As evidenced by the above review of facts, reissue application No. 12/706,541, *ex parte* reexamination control no. 90/010,751, and *inter partes* reexamination control no. 95/001,312 are currently pending. The order to reexamine has been mailed in both reexamination proceedings, and notice of the reissue application has been published in the *Official Gazette*. Accordingly, a decision under 37 CFR 1.565(d), 37 CFR 1.991, and 37 CFR 989(b) is timely.

The general policy of the Office is that a reissue application examination and a reexamination proceeding will not be conducted separately, and at the same time, as to a particular patent. 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. The proceedings will be merged when it is desirable to do so in the interest of expediting the prosecution of the proceedings. In making a decision on whether or not to merge the proceedings, consideration is given to the status of each proceeding. See MPEP § 2285.

The Office has complete discretion regarding merger. A decision not to merge is within the sole discretion of the Office to facilitate/carry out the statutory mandate of 35 U.S.C. 305 and 314(c) to conduct reexamination proceedings with "special dispatch."

In this situation, *ex parte* reexamination has been ordered in the '10751 proceeding for claim 1, while *inter partes* reexamination has been ordered in the '1312 proceeding for claims 2-30. The reissue application has been filed to correct the inventorship. No amendments to the claims have been made in any of the proceedings.

In order to provide efficient and prompt handling of all of the proceedings, it is appropriate that the instant reissue application and the instant *ex parte* reexamination proceeding be merged and a joint examination be conducted. However, in view of the facts and circumstances of the reexamination proceedings and in compliance with the mandate for "special dispatch," the *ex parte* reexamination proceeding and the *inter partes* reexamination proceeding will not be merged and will proceed independently. Accordingly, **only** the examination of the reissue application and the *ex parte* reexamination proceeding will be merged in accordance with the decision set forth below.

It is to be noted that the grant of merger of a reissue application and an *ex parte* reexamination proceeding under 37 CFR 1.565(d) **is discretionary**. *The present merger is not an assurance that, in a future similar situation, merger would be ordered.* In addition, **if a request for continued examination (RCE) is filed under 37 CFR 1.114, the merged proceeding will be automatically severed,** and the reissue application may then be suspended. Patent owner is put on notice that in such event, any response to the outstanding Office action (e.g., response to a final rejection) at that stage must be made based upon the fact that a request for continued

examination (RCE) is not available in reexamination. Any failure to timely respond would result in the termination of the *ex parte* reexamination proceeding as per 37 CFR 1.550(d).

DECISION MERGING THE REISSUE AND *EX PARTE* REEXAMINATION PROCEEDINGS

I. Merger of Proceedings

The above-identified reissue application and *ex parte* reexamination proceeding are hereby merged. A joint examination will be conducted in accordance with the following guidelines and requirements. The *inter partes* reexamination of claim 2-30 will proceed independently of the merged proceeding.

II. Conduct of the Merged Reissue Application Examination and *Ex Parte* Reexamination Proceeding

1. The examiner should promptly prepare an Office action for the merged proceeding.

2. In the event that the claims in any proceeding are amended, concurrent amendments must be made in both the reissue and *ex parte* reexamination proceedings, to maintain identical text. Any claim that does not contain identical text in the merged proceedings will 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.[1]

3. Because the statutory provisions for reissue application examination include, *inter alia*, provisions equivalent to 35 U.S.C. 305 relating to the conduct of *ex parte* reexamination proceedings, the merged examination will be conducted on the basis of the rules relating to the broader, reissue application examination. The examiner will apply the reissue statute, rules, and case law to the merged proceeding. **However, periods for response are to be set at TWO (2) months to comply with the statutory requirement for special dispatch in *ex parte* reexamination (35 U.S.C. 305). In addition, if a final rejection Office action should be issued in this merged proceeding, any request for extension for time must be filed under 37 CFR 1.136(b) where an extension is permitted by rule. No extension of time will be permitted under 37 CFR 1.136(a) after any final rejection.**

4. Each Office action issued by the examiner will take the form of a single action that jointly applies to the reissue application and the *ex parte* reexamination proceeding. Each action will contain identifying data for all of the cases, i.e., the reissue application and the

[1] The merged proceeding and the *inter partes* proceeding may contain different claims, since the claims being addressed do not overlap. Claim consistency for the patent will be adjusted at the point where the later of the two proceedings is issued and published as a patent/certificate.

ex parte reexamination proceeding, and each action will be entered into the file history for both files (which will be maintained as separate files).

5. Any response by the applicant/patent owner must consist of a single response, with two copies being filed for entry in the two files, with each of the two bearing a signature. Any such response must be served on the requester, who will also be sent copies of Office actions.

6. Pursuant to MPEP 2285:
"Amendments should be submitted in accordance with the reissue practice under ... 37 CFR 1.173; see MPEP § 1453."

Thus, the filing of any amendments to the drawings, specification, or claims must comply with the provisions of 37 CFR 1.173 and the guidelines of MPEP 1453. It is to be noted that 37 CFR 1.121 does not apply to amendments in a reissue application. Accordingly, clean copies of the amended claims are not required, and such clean copies are not to be submitted. Instead, pursuant to 37 CFR 1.173(b)(2), amendments are to be presented via markings pursuant to 37 CFR 1.173(d), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

Pursuant to 37 CFR 1.173(g), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the reissue application. Amendments are not to be made relative to previous amendments. Thus, for all amendments, all words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets.

7. Where a paper is filed which requires payment of a fee (e.g., petition fee, excess claim 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 appeal brief, 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.

8. Upon return of the present merged proceeding to the examiner, the examiner will review the files to ascertain 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.

9. If the reissue application ultimately matures into a reissue patent, the reexamination proceeding shall be concluded by the grant of the reissue patent, and the reissue patent will serve as the certificate under 37 CFR 1.570. See: MPEP 2285.

10. If the applicant/patent owner fails to file a timely and appropriate response to any Office action, the merged proceeding will be concluded as follows. The reissue application will be held abandoned, and the merger will be dissolved. With respect to the *ex parte* reexamination proceeding, the Director will proceed to issue a reexamination certificate under 37 CFR 1.570 in accordance with the last action of the Office, unless further action is clearly needed as a result of the difference in rules relating to reexamination and reissue proceedings. Thus, any grounds of rejection that are not applicable under *ex parte* reexamination would be withdrawn (e.g., based on public use or sale), and any new grounds of rejection that are applicable under *ex parte* reexamination (e.g., improperly broadened claims) would be made by the examiner upon dissolution of the merged proceeding. The existence of any questions/issues remaining which cannot be considered under *ex parte* reexamination following the dissolution would be noted by the examiner as not being proper under reexamination pursuant to 37 CFR 1.552(c).

11. If the applicant/patent owner files an express abandonment of the reissue application pursuant to 37 CFR 1.138, the next Office action of the examiner will accept the express abandonment, dissolve the merged proceeding, and continue examination as to the *ex parte* reexamination proceeding. Such examination would be conducted as set forth in the immediately preceding paragraph.

CONCLUSION

1. Reissue application No. 12/706,541 and *ex parte* reexamination control no. 90/010,751 **are merged** into a single proceeding. *Inter partes* reexamination control no. 95/001,312 will remain as a separate, non-merged proceeding and shall be conducted independently of the merged proceeding in accordance with the rules of *inter partes* reexamination. The patent owner shall ensure that the text of the claims of the '878 patent remains identical in the merged proceeding.

2. A copy of this decision shall be entered into all three proceeding files in the Image File Wrapper (IFW).

3. Periods for response in the merged proceeding are to be set at TWO (2) months to comply with the statutory requirement for special dispatch in reexamination. In addition, **if a final rejection Office action should be issued in this merged proceeding**, any request for extension for time must be filed under 37 CFR 1.136(b) where an extension is permitted by rule. No extension of time will be permitted under 37 CFR 1.136(a) after any final rejection.

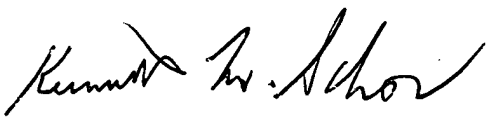
4. All further examination in the merged proceeding should be conducted in accordance with Part II of this decision.

5. **If a request for continued examination (RCE) is filed under 37 CFR 1.114, the merged proceeding will be automatically severed.** Patent owner is put on notice that in such event, any response to the outstanding Office action (e.g., response to a final rejection) at that stage must be made based upon the fact that a request for continued examination (RCE) is not available in reexamination. Any failure to timely respond would result in the termination of the proceeding as per 37 CFR 1.550(d).

6. Jurisdiction over the merged reissue and *ex parte* reexamination proceeding is being transferred to Technology Center 2800, in which the reissue proceeding is assigned. The examiner assigned the merged proceeding is not to be one who was involved in any part of the examination of the '878 patent (e.g., by preparing/signing an action). See MPEP 2236.

7. Jurisdiction over the *inter partes* reexamination proceeding is being forwarded to the Central Reexamination Unit.

8. 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

June 2, 2010
Kentpetmerger/IP-reissue

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,312	03/16/2010	7,542,878	LWC-005RX2	1549

42532 7590 07/21/2010

PROSKAUER ROSE LLP
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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 07/21/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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3000 K STREET
SUITE 500
WASHINGTON, DC 20007

Date:
MAILED
JUL 21 2010
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001312
PATENT NO. : 7542878
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

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MAILED

JUL 21 2010

CENTRAL REEXAMINATION UNIT

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(For Third Party Requester)

In re: Nanikashvili
Inter Partes Reexamination Proceeding
Control No.: 95/001,312
Deposited: March 16, 2010
For: U.S. Patent No.: 7,542,878

DECISION ON PETITION
UNDER 37 CFR § 1.181

The petition filed by the third party requester on May 24, 2010, entitled "PETITION FOR RECONSIDERATION OF PARTIAL DENIAL OF REQUEST FOR *INTER PARTES* REEXAMINATION OF U.S. PATENT NO. 7,542,878," [hereinafter "the petition"] is being treated as a petition under 37 CFR §§ 1.181 and 1.927. Petitioner, the reexamination requester, seeks review of the Order Granting Request for *Inter Partes* Reexamination mailed April 23, 2010, which granted the request as to claims 2-30, but denied the request as to claim 1.

The petition is before the Director of the Central Reexamination Unit.

The petition is denied.

REVIEW OF RELEVANT FACTS

- U.S. Patent No. 7,542,878 issued on June 2, 2009.

- A request for *ex parte* reexamination was filed November 30, 2009 and assigned control no. 90/010,751. Reexamination was requested of claim 1, and the request was granted in an Order mailed January 15, 2010.

- A reissue application was filed February 16, 2010 and assigned application no. 12/706,541.

- A request for *inter partes* reexamination was filed March 16, 2010 and assigned control no. 95/001,312. Reexamination was requested of claims 1-30.

- In an Order mailed April 23, 2010, the *inter partes* request was granted for claims 2-30, but was denied for claim 1.

- On May 24, 2010, the third party requester timely filed the instant petition requesting reconsideration of the denial of the request as to claim 1. The petition does not request reconsideration as to claims 2-30.

- In a paper mailed June 4, 2010, the Office merged the *ex parte* reexamination and reissue application, and left the *inter partes* reexamination separate.

- A Non-final rejection issued in the merged proceeding on June 11, 2010. A Non-final rejection issued in the instant *inter partes* proceeding on June 11, 2010. In the instant proceeding the examiner did not exercise her discretion to examine claim 1.

DECISION

Standard of Review

37 CFR § 1.927 provides for the filing of a petition under 37 CFR § 1.181 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 claim 1 was correct, and will not necessarily indicate agreement or disagreement with every aspect of the examiner's rationale for denying the request.

The Legal Standard for Ordering Reexamination

A review of 35 U.S.C. §§ 311 and 312 reveals that, by statute, *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. 35 U.S.C. § 311 requires that a request for *inter partes* reexamination be based upon prior art as set forth in 35 U.S.C. § 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 court holding of invalidity after all appeals, or by the Office in an earlier examination or in a reexamination of a patent. That is, the requester must "demonstrate[] that a patent or printed publication that is relied upon in a proposed rejection presents a new, non-cumulative technical teaching that was not previously considered and discussed on the record during the prosecution of the application that resulted in the patent for which reexamination is requested, and during the prosecution of any other prior proceeding involving the patent." MPEP § 2616. If a substantial new question of patentability is found to be raised, an order granting *inter partes* reexamination of the patent is issued.

Additionally, the MPEP states:

> If a second or subsequent request for reexamination is filed (by any party permitted to do so) while a first reexamination is pending, the presence of a substantial new question of patentability depends on the art (patents and printed publications) cited by the second or

> subsequent request . . . . [I]f the subsequent request includes the art which raised a substantial new question in the earlier pending reexamination, then reexamination should be ordered only if the art cited raises a substantial new question of patentability which is different from that raised in the earlier pending reexamination. If the art cited in the subsequent request raises the same substantial new question of patentability as that raised in the earlier pending reexamination, the subsequent request should be denied. Where the request raises a different substantial new question of patentability as to some patent claims, but not as to others, the request would be granted in part . . . . If the subsequent request does not include the art which raised the substantial new question of patentability in the earlier pending reexamination, reexamination may or may not be ordered, depending on whether the different art cited raises a substantial new question of patentability.

MPEP § 2640.

Furthermore:

> If the prior art patents and printed publications raise a substantial question of patentability of at least one claim of the patent, then a substantial new question of patentability is present, unless the same question of patentability has already been decided . . . (B) by the Office in a previous examination or pending reexamination of the patent. A "previous examination" of the patent is: (A) the original examination of the application which matured into the patent; (B) the examination of the patent in a reissue application that has resulted in a reissue of the patent; or (C) the examination of the patent in an earlier pending or concluded reexamination.

MPEP § 2642.I. (emphasis added).

Thus, even if the references raise a substantial question of patentability, there is no substantial new question if the same question of patentability was already decided in a pending reexamination of the patent. The requester must therefore demonstrate that the patents and printed publications relied upon present a new question of patentability not considered in the earlier pending reexamination.

Summary of the Prior Prosecution with Respect to the '878 Patent

The '878 patent contains claims 1-30, of which only claim 1 is at issue in this decision. The Director agrees with the examiner's discussion of the prosecution history in the Order Granting the Request mailed April 23, 2010 at pp. 3-4, and hereby incorporates that discussion by reference. Furthermore, a substantial new question of patentability was raised as to claim 1 in proceeding 90/010,751 based on prior art applied in two anticipation proposals and one

obviousness proposal. Claim 1 was rejected based on those proposals in a Non-final rejection mailed June 11, 2010.

Decision on the Request for Reexamination

As applicable here, the Request proposes that a substantial new question of patentability is raised as to claim 1 based on prior art applied in ten different proposed rejections, that claim 1 is anticipated or rendered obvious by a number of references. Request p. 4. Claim 1, however, has already been rejected in pending reexamination 90/010,751 as being anticipated and obvious over various prior art. The examiner has therefore already decided the question of whether claim 1 is patentable. The proposals in the instant Request are likewise asking the Office to decide that claim 1 is unpatentable. The proposals are therefore asking the Office to decide the same thing that it already decided—the question of the patentability of claim 1, in favor of claim 1 being unpatentable. This is not a new question of patentability, it is the same question that is already at issue in the pending proceeding.

Additional explanation of whether there is a substantial question of patentability is given in the MPEP: "A prior art patent or printed publication raises a substantial question of patentability where there is a substantial likelihood that a reasonable examiner would consider the prior art patent or printed publication important in deciding whether or not the claim is patentable." MPEP § 2642.I. A reasonable examiner is less likely to deem a reference important in deciding patentability of a claim when there are already other references (for example, here there are other references in the pending reexamination) that render the claim unpatentable. MPEP § 706.02.I. instructs the examiner to confine her rejections to the best available art, unless certain exceptions apply. Absent an exception, once art is found that supports a rejection, the examiner will give much less importance to additional art that may also support a rejection. As there is already art in the pending reexamination that supports a rejection, a reasonable examiner will give much less importance to other art, such as that presented in the instant proceeding, that may also support a rejection. There is no indication that the art in the pending reexamination falls under any of the exceptions of MPEP § 706.02.I. This weighs against there being a "substantial likelihood that a reasonable examiner would consider the [art] important in deciding whether the claim is patentable," further weighing against a finding that there is a substantial question of patentability.

Accordingly, the Director finds that the question of the patentability of claim 1 of the '878 patent has already been decided in a pending reexamination in favor of claim 1 being unpatentable. The proposals suggesting that claim 1 is unpatentable are therefore not a new question of patentability different than that already decided. Reexamination is therefore denied as to claim 1 of the '878 patent.

Response to the Petition

Even with the Director's *de novo* review set forth above, petitioner sets forth several arguments why reexamination should be granted as to claim 1. These will be addressed.

(1) The Office's Discretion to Order Reexamination

Petitioner argues the Office should use its discretion to order reexamination of claim 1 for the sake of efficiency. Petition pp. 4-5. The Office may, in its sole discretion, reexamine claims for which no substantial new question of patentability was found. *See* MPEP § 2640. The examiner has already determined, in her discretion, not to examine claim 1 in this proceeding, because a Non-final Rejection has issued not examining claim 1. Whether or not such a decision is ideal or most efficient (a finding the Director does not make), there is nothing in the record or the petition to indicate that the examiner has abused her discretion in choosing not to examine claim 1. Absent an abuse of discretion, the Director will not substitute his own discretion for the examiner's discretion, therefore the petitioner's arguments are not persuasive.

(2) Office Guidance Concerning What Petitioner Has Done

Petitioner argues that the Office guidance in the MPEP permits new art to raise a substantial new question of patentability relative to a prior filed but ongoing reexamination. Petition pp. 5-8. The argument is that, based on the 2005 Official Gazette Notice, which is now implemented in MPEP § 2640.II.A., there is a distinction between subsequent requests based on the same prior art as a pending proceeding, and subsequent requests based on different prior art as a pending proceeding. *Id.* Petitioner argues that in the former case the "newness" of a substantial question of patentability is measured against the issue presented in the pending reexamination, while in the latter case the "newness" of the substantial question of patentability is measured only against completed proceedings, not any pending proceeding. *Id.* p. 8. The Director disagrees that there is such a distinction.

The section of the MPEP at issue here, and relied upon by petitioner as allegedly showing that in the instant case a substantial new question of patentability must be measured against completed proceedings, states in pertinent part:

> If the subsequent request does not include the art which raised the substantial new question of patentability in the earlier pending reexamination, reexamination may or may not be ordered, depending on whether the different art cited raises a substantial new question of patentability.

MPEP § 2640.II.A.

Nothing here tells us that the presence of a substantial new question of patentability relates only to completed proceedings. All this tells us is that, like with any request, it will be granted only if there is a substantial new question of patentability.

Whether a substantial new question of patentability exists is further explained elsewhere in the MPEP. For example:

> If the prior art patents and printed publications raise a substantial question of patentability of at least one claim of the patent, then a substantial new question of patentability is present, unless the same question of patentability has already been decided . . . (B) by the Office in a previous examination or pending reexamination of the patent. A "previous examination" of the patent is: (A) the original examination of the application which matured into the patent; (B) the examination of the patent in a reissue application that has resulted in a reissue of the patent; or (C) the examination of the patent in an earlier pending or concluded reexamination.

MPEP § 2642.I. (emphasis added).

In other words, a substantial new question of patentability is always measured against the questions of patentability that have been decided in pending reexaminations. Petitioner's interpretation of section 2640, when read in light of section 2642, is simply incorrect. The determination as to whether there is a substantial new question of patentability must take into account pending reexaminations, it is not limited to completed proceedings even when the cited art is different than that found in the pending proceeding.

(3) New Technological Teaching Based on Different Species of Claim 1

Petitioner argues the references in the *inter partes* request teach different species within the genus of claim 1 than those found in the *ex parte* proceeding, thus presenting a new non-cumulative technological teaching. Petition pp. 8-12. Be that as it may, this does not compel that the request must be granted.

While it is true that for a request for reexamination to be granted it must present a new non-cumulative technical teaching, MPEP § 2616, this is not all that is required. That is, a new non-cumulative technical teaching is necessary but not sufficient for the granting of a request. This is merely a means of getting at what is required in the statute—that the prior art patents and printed publications raise a substantial new question of patentability. As has already been discussed *supra*, the references cited herein raise the same question of patentability already decided in the

prior pending reexamination, therefore there is no substantial new question of patentability. That the references may have teachings different than those presented in the pending reexamination proceeding does not require a finding of a substantial new question of patentability.

(4) The Priority Question

Petitioner argues that the determination of the priority claim compels a finding that there is a substantial new question of patentability. Petition pp. 12-15. Petitioner cites two cases as allegedly requiring this result, but those cases are distinguishable from the instant proceeding.

Petitioner argues that in *Ex Parte Basell Poliolefine Italia S.P.A.*, 2006 WL 4404080, Appeal 2007-0111 (Bd. Pat. App. & Interf. 2007), the Board found a substantial new question of patentability based on a reference solely based on a previously unconsidered question of priority. This is not entirely accurate. In *Basell*, old art to Vandenberg was found to raise a substantial new question of patentability because it was determined that during the earlier examination the examiner was mistaken as to the entitlement of an earlier priority date, and thus mistaken as to Vandenberg's prior art status. *Basell*, 2006 WL 4404080 at *22. *Basell* therefore stands for the notion that old art may raise a substantial new question of patentability based on a new determination as to the issue of priority. *Basell* does not stand for the notion that a substantial new question of patentability is raised any time a priority issue is called into question. None of the references cited in the instant request were considered previously; they are not like Vandenberg, which was considered and then dropped due to a mistaken belief by the examiner about the priority claim. The issue here is not the same as in *Basell*, and the case is therefore not controlling.

The other case cited by petitioner, *Heinl v. Godici*, 143 F. Supp. 2d 593 (E.D. Va. 2001), is similar to *Basell* in that a substantial new question of patentability was raised based on old art because of new arguments as to the prior art status of the old art. Again, the case does not stand for the notion that any challenge to a priority claim raises a substantial new question of patentability, but only for the notion that old art can properly raise a substantial new question if read in a new light based on new arguments as to its prior art status.

Petitioner's arguments are therefore not persuasive. The cited cases do not require that a substantial new question of patentability is raised any time intervening art is cited, therefore challenging the priority claim; the cases merely permit a substantial new question of patentability to be raised when prior art status or priority is called into question, even if the cited art is old art. The cases are not controlling in the manner suggested by petitioner.

(5) Argument That Any Denial of the Request is Legally Incorrect

Petitioner argues that if Office guidance is interpreted such that the request for reexamination of claim 1 is denied, then such guidance is legally incorrect. Petition pp. 15-16.

Petitioner first argues that the statute already strikes a balance between the rights of requesters to file requests and the interests of patent owners to not have requests filed, and Congress could have added further restrictions if it wished. Petition p. 15. 35 U.S.C. § 317(a), cited by petitioner, prevents an *inter partes* requester from filing subsequent *inter partes* requests while a first such proceeding is pending. But this is not related to the statutory requirement that for a request to be granted there must be a substantial new question of patentability. Just because some types of requests are barred does not lower the requirements for other types of requests, simply because Congress could have barred those also. There is nothing here that proves the Office's guidance is legally incorrect.

Petitioner next argues that when Congress passed the original reexamination statute, the intent was to "bar reconsideration of any argument already decided by the [PTO], whether during the original examination or an earlier reexamination." Petition pp. 15-16. Notably, nothing here restricts the earlier reexamination to a concluded reexamination, but petitioner states that this must be so. Petitioner points to 35 U.S.C. §§ 304 and 313 as allegedly showing that a question of patentability is not "decided" until a reexamination certificate issues. These statutes state that if there is a substantial new question of patentability, reexamination is ordered for "resolution of the question." Petitioner argues that this means the question of patentability is not decided until a reexamination is concluded, therefore whether a question of patentability is new must be measured only against concluded proceedings. This is somewhat tenuous, and does not really tell us when a "decision" is made on a question of patentability. More telling is 35 U.S.C. §§ 306 and 315, which tell us that a patent owner can appeal to the Board with respect to "any decision adverse to patentability." That is, a determination by the examiner, prior to the conclusion of the reexamination proceeding, is a "decision" on the question of patentability. Nothing in the legislative history therefore requires that a substantial new question of patentability be measured only against concluded proceedings.

Petitioner finally argues that the efficiencies of the *inter partes* reexamination statutory scheme would be lost if reexamination were not ordered for claim 1. This is no more than a policy argument, an argument that in the opinion of petitioner efficiency will suffer with this result. It in no way shows that reexamination of claim 1 is required or that the result here is legally incorrect.

Accordingly, because the proposals do not raise a substantial new question of patentability, the request for reexamination of claim 1 of the '878 patent is denied. Petitioner's additional justifications for ordering *inter partes* reexamination of claim 1 are not persuasive, and the petition filed May 24, 2010 is denied.

CONCLUSION

1. Based on a *de novo* review of the record as a whole, the petition is denied. Accordingly, the request for *inter partes* reexamination of claim 1 of the '878 patent is denied.

2. The decision is final and non-appealable. See 35 U.S.C. § 312(c) and 37 C.F.R. § 1.927. No further communication on this matter will be acknowledged or considered.

3. Claims 2-30 remain subject to reexamination in this proceeding. Claim 1 remains subject to reexamination in proceeding 90/010,751. Patent owner's time for response to the Office actions mailed June 11, 2010 remains as set forth in those actions.

4. Telephone inquiries related to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner, at (571) 272-1611 or in his absence to the undersigned at (571) 272-3838.

Gregory A. Morse
Director
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,319	03/29/2010	7133293	MOUNT-00100	1333

32361 7590 07/19/2010

GREENBERG TRAURIG, LLP
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NEW YORK, NY 10166

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 07/19/2010

Please find below and/or attached an Office communication concerning this application or proceeding.

UNITED STATES PATENT AND TRADEMARK OFFICE

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
STEVENS LAW GROUP
1754 TECHNOLOGY DRIVE
SUITE #226
SAN JOSE, CA 95110

Date: MAILED
JUL 19 2010
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001319
PATENT NO. : 7133293
TECHNOLOGY CENTER : 3999
ART UNIT : 3993

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

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(For Patent Owner)

MAILED

JUL 19 2010

CENTRAL REEXAMINATION UNIT

DAVID R. STEVENS
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1754 TECHNOLOGY DRIVE SUITE 226
SAN JOSE, CA 95110

(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,319
Filed: March 29, 2010
For: U.S. Patent No. 7,133,293

DECISION
DISMISSING
PETITION

This is a decision on patent owner's petition 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 June 3, 2010, as supplemented by the petition paper entitled "COMBINED SUPPLEMENTAL PETITION TO EXCEED THE PAGE LIMIT FOR PATENT OWNER'S RESPONSE IN AN *INTER PARTES* REEXAMINATION AND DECLARATION IN SUPPORT," filed on June 11, 2010.

The patent owner petition under 37 CFR 1.183, as supplemented, is before the Office of Patent Legal Administration.

The petition is dismissed for the reasons set forth herein.

FEES

Pursuant to 37 CFR 1.17(f), a petition fee of $400.00 is required for the petition under 37 CFR 1.183. For the June 3, 2010 petition under 37 CFR 1.183, $130.00 was charged to patent owner's Deposit Account No. 501561 on June 4, 2010, and the deficiency of $270.00 is being charged to patent owner's Deposit Account No. 501561, pursuant to the authorization on page 3 of the June 3, 2010 petition under 37 CFR 1.183.

BACKGROUND

1. On November 7, 2006, United States Patent No. 7,133,293 ("the '293 patent") issued to Fiorentino *et al.*

2. On March 2, 2009, a request for *inter partes* reexamination of the '293 patent was filed by a third party requester, which request was assigned Reexamination Control No. 95/001,319 ("the '1319 proceeding").

3. On March 29, 2010, a corrected request for *inter partes* reexamination of the '293 patent was filed by the third party requester in the '1319 proceeding, and the proceeding was assigned a filing date of March 29, 2010.

4. On May 11, 2010, the Office mailed an order granting *inter partes* reexamination of claims 1-9 in the '1319 proceeding, concurrently with a non-final Office action on the merits.

5. On June 3, 2010, patent owner filed the instant petition 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").

6. On June 11, 2010, patent owner filed the instant supplement to the original petition, entitled "COMBINED SUPPLEMENTAL PETITION TO EXCEED THE PAGE LIMIT FOR PATENT OWNER'S RESPONSE IN AN *INTER PARTES* REEXAMINATION AND DECLARATION IN SUPPORT" ("supplemental petition under 37 CFR 1.183").

7. Concurrently, on June 11, 2010, patent owner filed a response to the May 11, 2010 Office action.

8. On July 12, 2010, third party requester filed comments after patent owner's June 11, 2010 response.

DECISION

Relevant Statutes, Regulations and Procedures

37 CFR 1.183 provides:

> In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, sua sponte, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.943(b) provides:

> Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

MPEP 2667(I), provides in pertinent part:

> Any affidavit or declaration (or a clearly defined portion thereof) that contains opinion(s) of the affiant/declarant, or argument(s) that the art either does or does not anticipate or render obvious the claims, or specific claim elements, of the patent under reexamination, is considered to be part of the comments submitted by the patent owner, or by the third party requester, and is subject to the page limit requirements of 37 CFR 1.943. Affidavits or declarations that are excluded from the page limit requirements include, for example, declarations attempting to swear behind (antedate) the filing date of a reference, or to establish the date of a printed publication, or declarations that provide comparative test data and an analysis of same. However, if the patent owner's affidavit or declaration includes any argument as to how an outstanding/proposed rejection is overcome, then the page(s) of the affidavit or declaration upon which the argument appears would be included against of the page limit count.

Discussion

Patent owner's June 3, 2010 petition under 37 CFR 1.183, as supplemented by the June 11, 2010 petition under 37 CFR 1.183, has been fully considered. On June 11, 2010, patent owner filed a response to the May 11, 2010 Office action, concurrently with the supplemental petition under 37 CFR 1.183. Patent owner asserts that the June 11, 2010 response is 50 pages long, excluding a listing of claims (Appendix A) and two declarations under 37 CFR 1.131 (Appendices B-C), and that it believes the pages of Appendices A-C do not count against the 50-page limit of 37 CFR 1.943(b).[1] Thus, while patent owner states that "a petition to exceed page limit is not necessary in this instance," patent owner nonetheless requests waiver of 37 CFR 1.943 as it applies to the June 11, 2010 response "if deemed necessary."[2] Specifically, in the event the Office "deems any part of Appendices A-C to count towards the relevant 50 page limit," patent owner requests that "an extension of pages not exceeding the amount of pages deemed excessive by the United States Patent and Trademark Office with respect to the submission of Patent Owner's Response and accompanying Appendices A-C – be granted."[3]

In support of its request for waiver of the rule, patent owner asserts that "enforcing the page limit would prevent Patent Owner from making a full and complete response to the Office Action (and its 49 separate grounds for rejection) as required by the patent statute and rules."[4] In particular, patent owner asserts that "[t]he May 11, 2010 Office Action comprises 24 pages," "[t]he Office Action expressly incorporates by reference substantially all of the Request for Reexamination,

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[1] *See* supplemental petition under 37 CFR 1.183 at page 3.
[2] *Id.* at pages 3-4.
[3] *Id.*
[4] *Id.* at pages 4-5.

which runs to a length of 84 pages," and "[t]he ten references cited in the Request for Reexamination comprise approximately 250 more pages."[5] Patent owner further asserts that it "has attempted in good-faith to comply with the page limit" by:

> (a) Where possible reiterating arguments that apply to multiple claims rejected by the same teachings by reference to other portions of the Response; (b) Responding to rejections of independent claims together with rejections of their respective dependent claims; and (c) Responding to claims 'grouped together' in accordance with the categories of rejections set forth by the Order Granting Reexamination....[6]

In this instance, patent owner's June 11, 2010 response, including the claims appendix (Appendix A) and the two declarations under 37 CFR 1.131 (Appendices B-C), is page-length compliant, because a total of 48 pages count toward the page limit of 1.943(b). In particular, the remarks portion of the response includes 48 pages that count toward the page limit, and no pages of the three appendices count toward the page limit.[7] Thus, the portions of patent owner's June 11, 2010 response which count toward the page limit do not exceed 50 pages, and no waiver of 37 CFR 1.943(b) is required for entry of the June 11, 2010 response including the three appendices into the record of the '1319 proceeding. Accordingly, patent owner's request for waiver of the 50-page limit of 37 CFR 1.943(b) is dismissed as unnecessary.

CONCLUSION

1. Patent owner's June 3, 2010 petition under 37 CFR 1.183, as supplemented on June 11, 2010, is **dismissed**.

2. Jurisdiction for the instant reexamination proceeding is being 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

7-16-10
Kenpet8

[5] *Id.* at page 4.
[6] *Id.*
[7] Pursuant to MPEP 2667(I)(A)(2), only those pages of patent owner's response upon which arguments appear are included against the page limit count. Thus, the cover page and the last page of the remarks portion of the June 11, 2010 response are excluded from the page count, as no arguments appear on either page. Further, as set forth in MPEP 2667(I)(A)(2), 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. Thus, no pages of Appendices B-C, setting forth two declarations under 37 CFR 1.131, count toward the page limit. Additionally, because 37 CFR 1.943(b) expressly excludes appendices of claims from the page limit count, no pages of Appendix A count toward the page limit.

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20 JUL 2009

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JUDITH ABRAHAMS
QUARK PHARMACEUTICALS, INC.
C/O QBI ENTERPRISES LTD.
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NES ZIONA 70400 IL ISRAEL

In re Application of :
QUARK PHARMACEUTICALS, INC. :
PCT No.: PCT/IL2008/000797 : DECISION ON PETITION
Int. Filing Date: 12 June 2008 :
Priority Date: 15 June 2007 : UNDER 37 CFR 1.182
Attorney's Docket No.: 183/PCT1 :
For: COMPOSITIONS AND METHODS FOR :
INHIBITING NADOH OXIDASE EXPRESSION :

This decision is in response applicant's "Petition Under 37 CFR 1.182" filed 25 June 2009, and again on 06 May 2009 in the United States Patent and Trademark Office (USPTO) to correct the error in the transmittal letter of a filing of 25 September 2008. Applicant has provided payment of the $400.00 petition fee.

BACKGROUND

On 12 June 2008, applicant filed an international application selecting the United States as the international searching authority. The application was assigned PCT number PCT/IL2008/000797.

On 28 August 2008, applicant was mailed an "Invitation to Furnish Sequence Listing" (Form PCT/ISA/225). Applicant was afforded one month to file a response.

On 25 June 2009, the present petition was filed indicating that a response to the Form PCT/ISA/225 was filed on 25 September 2009 intended for international application PCT/IL2008/000797; however, the transmittal letter erroneously identified the international application number as PCT/IL2008/000079.

DISCUSSION

While applicant incorrectly identified the application serial number as PCT/IL2008/000079 on the transmittal letter, the identifying information provided on the papers filed by applicant on 25 September 2008, i.e., the title, applicant-inventor information, international filing date and attorney docket number all correspond to that of PCT/IL2008/000797. For these reasons, as well as the explanation provided in the present petition, it has been concluded that the response to the Form PCT/ISA/225 filed 25 September

2008 sufficiently identified international application PCT/IL2008/000797. Pursuant to petitioner's request, the response filed 25 September 2008 will be treated as having been filed in international application PCT/IL2008/000797.

CONCLUSION

The petition under 37 CFR 1.182 is **GRANTED**.

This application is being returned to the United States International Searching Authority (ISA/US) for further processing consistent with this decision. The papers filed on 25 September 2008 in international application PCT/IL2008/000079 will be moved to the above-captioned international application.

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Attorney Advisor
Office of PCT Legal Administration
Tel: (571) 272-3294
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15 JUN 2010

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In re Application of:
TUNEWIKI, INC.
PCT No.: PCT/IL2009/000804
International Filing Date: 13 August 2009
Priority Date: 14 August 2008
Attorney Docket No.: SFT-7268-PCT
For: A METHOD AND A SYSTEM FOR REAL TIME MUSIC PLAYBACK SYNCRONIZATION ....

DECISION ON PETITION

This decision is issued in response to the "Petition Under 37 CFR 1.181; Request For Reissued Invitation To Pay Additional Fees And, Where Applicable, Protest Fee (ISA/220)" filed 22 March 2010. No petition fee is required.

BACKGROUND

On 13 August 2009, applicant filed international application PCT/IL2009/000804. The application selected the United States International Searching Authority (ISA/US) as the searching authority.

On 17 December 2009, the ISA/US mailed an "Invitation To Pay Additional Fees And, Where Applicable, Protest Fee" (Form PCT/ISA/206) (hereinafter "Invitation"). The Invitation indicated that the application claimed a total of 6 inventions, and it required payment of an additional search fee for each of the additional inventions that applicant wanted to have searched. The Invitation set forth a one month response deadline.

Applicant did not file a response to the Invitation prior to the expiration of the one month response deadline.

On 02 March 2010, the ISA/US mailed a "Notification Of Transmittal Of The International Search Report And The Written Opinion Of The International Searching Authority, Or The Declaration" (Form PCT/ISA/220), an "International Search Report" (PCT/ISA/210), and the "Written Opinion Of The International Searching Authority" (Form PCT/ISA/237) (hereinafter collectively referred to as the "ISR/WO").

Based on applicant's failure to submit a response to the Invitation mailed 17 December 2009, the ISR/WO mailed 02 March 2010 only addressed the first invention contained in the application, specifically, claims 1-6.

On 22 March 2010, applicant filed the "Petition Under 37 CFR 1.181; Request For Reissued Invitation To Pay Additional Fees And, Where Applicable, Protest Fee (ISA/220)" considered herein. The petition asserts that the Invitation and the ISR/WO were mailed on the same date and that applicant was therefore not allowed time to file a proper response to the Invitation. Applicant therefore requests that that a new Invitation be issued, and a new response period be set.

DISCUSSION

Petitioner's assertion that the Invitation and the ISR/WO were mailed on the same date is based on the dates listed for such documents on the WIPO web site. However, the dates listed on the WIPO web site are specifically identified on such site as the dates such documents were first "made available on the PATENTSCOPE® Search Service," not the mail dates of the listed documents.

A review of the USPTO application file and the relevant forms themselves (specifically, the mail dates stamped thereon) confirms that the Invitation was mailed to applicant's counsel on 17 December 2009, and the ISR/WO was mailed to applicant's counsel on 02 March 2010, more than two months later. Thus, applicant was provided with the required one month period to respond to the Invitation mailed 17 December 2009, and applicant failed to file a timely response to such Invitation prior to the expiration of the available response period on 17 January 2010. Under these circumstances, applicant's present request to have a new Invitation issued and a new response period set is appropriately dismissed.

CONCLUSION

For the reasons set forth above, applicant's "Petition Under 37 CFR 1.181; Request For Reissued Invitation To Pay Additional Fees And, Where Applicable, Protest Fee (ISA/220)" is **DISMISSED** without prejudice.

Richard M. Ross
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In re Application of	:
Albany Medical College et al.	:
Application No. PCT/US03/10756	: DECISION ON PETITION
Int. Filing Date: 09 April 2003	:
Priority Date: 10 April 2002	: UNDER 37 CFR 1.78(a)(3)
Attorney Docket No. 0410.006BWO	:

This is a decision on the petition under 37 CFR 1.78(a)(3), filed 23 January 2007, to accept an unintentionally delayed claim under 35 U.S.C. § 120 and 365(c) for the benefit of priority to the prior-filed nonprovisional applications set forth in the amendment filed concurrently with the instant petition.

The petition is **GRANTED**.

The petition requests acceptance of the following claim for priority as an amendment to the international application:

> *This international application claims priority to and is a continuation of U.S. patent application Serial No. 10/120,005 filed on April 10, 2002 which issued as U.S. Patent No. 6,689,102 on February 10, 2004, which is a continuation-in-part of U.S. patent application Serial No. 09/840,699, filed April 23, 2001, which issued as U.S. Patent No. 6,695,814 on February 24, 2004, which is a continuation of U.S. patent application Serial No. 09/127,374, filed July 31, 1998, which issued as U.S. Patent No. 6,221,047 on April 24, 2001.*

The present application was filed after November 29, 2000, and the claim herein for the benefit of priority to the prior-filed nonprovisional applications is submitted after expiration of the period specified in 37 CFR 1.78(a)(2)(ii). Therefore, this is a proper petition under 37 CFR 1.78(a)(3).

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

(1) the reference required by 35 U.S.C. § 120 and 37 CFR

1.78(a)(2)(i) of the prior-filed application, unless previously submitted;

(2) the surcharge set forth in § 1.17(t); and

(3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

The petition complies with the requirements for a grantable petition under 37 CFR 1.78(a)(3) in that (1) a reference to the prior-filed nonprovisional applications has been included in the international application, as provided by 37 CFR 1.78(a)(2); (2) the surcharge fee required by 37 CFR 1.17(t) has been submitted; and (3) the petition contains a proper statement of unintentional delay. Accordingly, having found that the instant petition for acceptance of an unintentionally delayed claim for the benefit of priority under 35 U.S.C. § 120 to the prior-filed nonprovisional applications satisfies the conditions of 37 CFR 1.78(a)(3), the petition is granted.

The granting of the petition to accept the delayed benefit claim to the prior-filed applications under 37 CFR 1.78(a)(3) should not be construed as meaning that this application is entitled to the benefit of the prior-filed applications. In order for this application to be entitled to the benefit of the prior-filed applications, all other requirements under 35 U.S.C. § 120 and 37 CFR 1.78(a)(1) and (a)(2) must be met.

Any inquiries concerning this decision may be directed to George Dombroske at (571) 272-3283.

/George Dombroske/
George Dombroske
PCT Legal Examiner
Office of PCT Legal Administration

/Boris Milef/
Boris Milef
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PCT/US2003/025032 26.06.2007
IAP6 Rec'd PCT/PTO 26 JUN 2007

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20 JUN 2007

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OIPE IAP76 JUN 26 2007 PATENT & TRADEMARK OFFICE

In re Application of
McDONALD, John Terrance
U.S. Application No.: 10/536,112
PCT No.: PCT/US2003/025032
Int. Filing Date: 08 August 2003
Priority Date: 08 August 2002
Attorney Docket No.: P-4046.03(PCT)(US)
For: LIQUID POURER ASSEMBLY

DECISION UNDER 37 CFR 1.10(e)

This decision is in response to the papers filed 08 June 2007 which are treated as a petition under 37 CFR 1.10(e). No petition fee is required.

BACKGROUND

On 08 February 2005, applicants purportedly filed a national stage application of PCT/US2003/025032 pursuant to 35 U.S.C. 371 using Express Mail. However, the papers were not processed as a national stage application and could not be located.

Three status inquiries were filed on 25 April 2005, 11 July 2005 and 13 February 2006. No response was sent by the USPTO.

On 08 June 2007, applicants filed the instant petition which was accompanied by, *inter alia*, a copy of the papers purportedly filed 08 February 2005, a copy of the three status inquiries mailed, a "Statement of Laura Pope, and a copy of the Customer Copy of Express Mail No. EV426588465US.

DISCUSSION

The national stage papers filed 08 February 2005 including an executed declaration have been located in the underlying international application. As such, the petition under 37 CFR 1.10(e) is no longer required.

The $500.00 in fees paid have been transferred to the above-captioned national stage application.

CONCLUSION

Applicants' petition under 37 CFR 1.10(e) is **DISMISSED** as **MOOT**.

10/536,112

This application is being forwarded to the National Stage Processing Division of the Office of PCT Operations for continued processing.

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22 DEC 2006

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In re Application of
MICROSOFT CORPORATION
PCT Application No.: PCT/US03/26443
International Filing Date: 22 August 2003
Priority Date: 15 August 2003
Attorney Docket No.: MSFT 5066.1
For: SERVICING A COMPONENT-BASED SOFTWARE PRODUCT

DECISION ON PETITION UNDER 37 CFR 1.181

This decision is in response to applicant's communication filed by facsimile on 21 December 2006 which is being treated as a petition under 37 CFR 1.181 requesting that a copy of a Notice Of Confirmation Of Precautionary Designations (Form PCT/RO/144) filed therewith be accepted as having been originally filed on 26 October 2004.

The petition is **GRANTED**.

BACKGROUND

On 22 August 2003, applicant filed international application PCT/US03/26443 which claimed priority to an earlier United States application filed 15 August 2003.

On 21 December 2006, applicant filed the instant petition requesting that a copy of a Notice Of Confirmation Of Precautionary Designations (Form PCT/RO/144) filed therewith be accepted as having been filed on 26 October 2004. The petition included, *inter alia*, a copy of the Notice Of Confirmation Of Precautionary Designations (Form PCT/RO/144) , and a copy of a postcard receipt.

DISCUSSION

MPEP at section 503 states, in part:

> "A postcard receipt which itemizes and properly identifies the papers which are being filed serves as *prima facie* evidence of receipt in the PTO of all the items listed thereon on the date stamped thereon by the PTO."

Applicant's date stamped postcard receipt lists, *inter alia*, Notice of Confirmation of

Precautionary Designations and a check for $468.00 and includes a U.S. Patent and Trademark Office (PTO) date stamp of 26 October 2004. The petition indicates that the Notice Of Confirmation Of Precautionary Designations (Form PCT/RO/144) submitted on 21 December 2006 is a true copy of that originally submitted on 26 October 2004.

A review of USPTO records indicates the $468.00 was received for the instant international application on 28 October 2004.

The evidence submitted is sufficient to establish that a Notice Of Confirmation Of Precautionary Designations (Form PCT/RO/144) was originally filed in the USPTO on 26 October 2004.

CONCLUSION

The application is being returned to the United States Receiving Office for processing of applicant's Notice of Confirmation of Precautionary Designations and issuance of a Notice Regarding Confirmation of Precautionary Designations (Form PCT/RO/139).

Michael A. Neas
PCT Special Program Examiner
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09 MAY 2008

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In re Application of	:	
MATSUSHITA ELECTRIC INDUSTRIAL CO., LTD.	:	
PCT No.: PCT/US04/04647	:	DECISION ON PETITION
Int. Filing Date: 18 February 2004	:	
Priority Date: 21 February 2003	:	UNDER 37 CFR 1.181
Attorney's Docket No.: 44802-0116	:	
For: MOVING PICTURE CODING METHOD, MOVING PICTURE DECODING METHOD AND PROGRAM	:	

This is a decision on applicant's correspondence filed 17 July 2006 and again on 09 April 2008 in the United States Patent and Trademark Office (USPTO). The request is being treated as a petition under 37 CFR 1.181. No petition fee is due.

BACKGROUND

On 18 February 2004, applicant filed the above-captioned international application in the USPTO. The international application claimed priority to an earlier United States application filed 21 February 2003, an earlier United States application filed 26 November 2003 and most important for the situation at hand, a Japanese application filed 28 November 2003.

On 17 July 2006, applicant filed the petition considered herein; an additional copy of the papers was filed on 09 April 2008.

DISCUSSION

As detailed above, the above-captioned international application contains three priority claims. A "Notification Concerning Submission or Transmittal of Priority Document" (Form PCT/IB/304) mailed to applicant on 02 February 2006 indicated that the International Bureau (IB) had not received a certified copy of the Japanese application filed 28 November 2003. Applicant presently indicates that a copy of this application was provided to the United States Receiving Office (RO/US) on 27 April 2004.

The best evidence of what was actually received by the Office is a postcard receipt containing a specific itemization of all the items being submitted. See MPEP 503. Here, applicant has provided a copy of the date-stamped return postcard. The postcard identifies the

application by application serial number, title and attorney docket number. The postcard is stamped "DT07 Rec'd PCT/PTO 27 APR 2004." The item listed on the postcard is "transmittal of Priority Document #JP2003-398981" The postcard has not been annotated in any way to indicate that this paper was not received at the time of filing. Applicant has presently included a copy of the paper and certified that it is a true and complete copy of the original filed 27 April 2004. Thus, it is proper to accept the paper filed 17 July 2006 as originally filed 27 April 2004.

It is noted that 27 April 2004 is within the 16 month period from the priority date. As such, the certified copy of the priority document is considered timely pursuant to PCT Rule 17. (It is noted that the RO/US is scheduled to mail the IB a "Notification of Date of Receipt of Priority Document or of Priority Application Number" (Form PCT/RO/135) on 14 May 2008 giving notice of the receipt of the subject priority document on 27 April 2004.)

CONCLUSION

Applicant's petition under 37 CFR 1.181 is **GRANTED**.

This application is being returned to the United States Receiving Office (RO/US) for continued processing of the international application.

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07 JAN 2008

Docket Administrator
Lowenstein Sandler, PC
65 Livingston Avenue
Roseland, NJ 07068

In re Application of :
SARNOFF CORPORATION :
PCT No.: PCT/US04/11927 : COMMUNICATION
Int. Filing Date: 15 April 2004 :
Priority Date: 15 April 2003 :
Attorney Docket No.: 18703/1520 :
For: HIGH EFFICIENCY ALKALINE EARTH METAL: THIOGALLATE BASED PHOSPHORS AND METHOD OF MAKING :

This communication is in response to applicant's "Request to Reconsider Priority Date and to Notify WIPO of Same" filed in the United States Patent and Trademark Office (USPTO) on 21 November 2007.

BACKGROUND

On 15 April 2004, applicant filed the above-captioned international application in the United State Receiving Office (RO/US). The international application claimed priority to an earlier United States provisional application. The filed PCT request form (Form PCT/RO/101) listed identified the filing date of the priority item as 21 April 2003.

On 02 September 2004, applicant filed a "Correction in International Application" accompanied by a replacement sheet of the Form PCT/RO/101 identifying the filing date of the priority document as 15 April 2003.

On 02 February 2005, the International Bureau (IB) mailed applicant a "Notification Relating to Priority Claim" (Form PCT/IB/318) notifying applicant that the priority claim had been corrected as requested.

On 24 March 2005, the IB published the above-captioned international application listing a priority date of 15 April 2003.

On 21 December 2007, applicant filed the request discussed herein.

DISCUSSION

Applicant requests that the RO/US change the priority date of the international application, that the IB republish the international application with a priority date of 21 April

2003 and that any discrepancies as to the priority date of the provisional application be amended.

As detailed above, the correction of the filing date of the priority document was requested by the applicant and subsequently approved as evidenced by the mailing of the form PCT/IB/318 by the international bureau on 02 February 2005. A review of the present application shows that the thirty month time period for international processing expired in October, 2005. As such, the RO/US can not alter the requested priority date either under PCT Rule 26 nor PCT Rule 91.

All requests for re-publication must be sent directly to the IB.

As to any discrepancies in the filing date of the provisional application, if applicant feels that the provisional application was accorded an incorrect filing date, applicant should petition the USPTO through the Office of Petitions.

The application is being returned to the RO/US file repository for storage.

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16 AUG 2007

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In re Application of :
COLEY PHARMACEUTICAL GmbH et al. : DECISION ON
PCT No.: PCT/US04/19714 :
Int. Filing Date: 18 June 2004 : PETITION
Priority Date: 20 June 2003 :
Attorney's Docket No.: C1041.70036W : UNDER 37 CFR 1.181
For: Small Molecule Toll-Like Receptor (TLR) Antagonists :

This decision is in response to applicant's "Request for Additional Search and Re-Issuance of Search Report," filed on 30 April 2007 and treated as a petition under 37 CFR 1.181. No petition fee is required.

BACKGROUND

On 18 June 2004, applicants filed PCT/US04/19714 claiming an earliest priority date of 20 June 2003. Applicants designated the United States Patent and Trademark Office as the International Searching Authority (ISA/US) in Box VII of the Request Form (Form PCT/RO/101).

On 13 September 2004, the United States Receiving Office (RO/US) mailed a "Notification Of The International Application Number And Of The International Filing Date" (Form/PCT/RO/105) according an international filing date of 18 June 2004 to the above-identified application.

On 11 February 2005, the ISA/US mailed an "Invitation To Pay Additional Fees" (Form PCT/ISA/206).

On 24 February 2005, applicants allegedly filed a response to the "Invitation To Pay Additional Fees" (Form PCT/ISA/206). Specifically, applicants allegedly filed a check for $2,000 and requested that Groups 15 (claims 31-44), 23 (claims 113-124) and 24 (claims 125-142) be searched.

On 06 April 2005, the ISA/US mailed the "Notification of Transmittal of the International Search Report and the Written Opinion" (Form PCT/ISA/220), the Search Report (ISR) (Form PCT/ISA/210) and the Written Opinion of the International Searching Authority (Form PCT/ISA/237). Specifically, the International Search Report and the Written Opinion were issued based only on the invention of Group 15 (claims 31-44).

On 30 April 2007, applicants submitted the instant petition requesting that the two additional inventions of Groups 23 (claims 113-124) and 24 (claims 125-142), for which the additional fees of $2,000 were paid on 01 March 2005, be searched and that the International Search Report and the Written Opinion be reissued. The petition was accompanied by, *inter alia*, a copy of a postcard receipt date-stamped 24 February 2005 by the USPTO, a copy of the United States Postal Service customer receipt showing a "Date-In" of "2/24/05" and, a copy of the check for $2,000.

DISCUSSION

The evidence of record is sufficient to establish with reasonable certainty that on 24 February 2005 applicants submitted the additional fees of $2,000 required to search the two additional inventions of Groups 23 (claims 113-124) and 24 (claims 125-142). The proof is in the form of the copy of the postcard receipt for the above-identified application which bears a United States Patent and Trademark Office date stamp of 24 February and which itemizes, check number "0022718" and the "Resp to Invit to Pay Addl Search Fees". This postcard receipt also identified the above-mentioned attorney docket number and applicant. Also, the copy of the United States Postal Service customer receipt showing a "Date-In" of "2/24/05" reinforces applicants' position that on 24 February 2005 applicants filed a response to the "Invitation To Pay Additional Fees" (Form PCT/ISA/206). Furthermore, U.S. Patent and Trademark Office records appear to show that on 01 March 2005, the Office received a payment of $2,000 in the form of a check.

Therefore, it is appropriate, on the present record, to accept that on 24 February 2005 applicants filed a timely response to the "Invitation To Pay Additional Fees" (Form PCT/ISA/206) and paid the additional fees of $2,000 for searching two additional inventions, Groups 23 (claims 113-124) and 24 (claims 125-142).

Accordingly, a new International Search Report and Written Opinion are warranted.

CONCLUSION

For the reasons set forth above, applicants' petition under 37 CFR 1.181 is **GRANTED.**

The International Search Report (Form PCT/ISA/210 and the Written Opinion of the International Searching Authority (Form PCT/ISA/237), mailed 06 April 2005, are **VACATED**.

This application is being forwarded to the ISA/US for further processing in accordance with this decision, including providing a new International Search Report and Written Opinion.

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0 1 OCT 2007

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In re Application of	:	
MATTEL, INC. et al.	:	DECISION ON
PCT No.: PCT/US04/21936	:	
Int. Filing Date: 07 July 2004	:	PETITION
Priority Date: 07 July 2003	:	
Attorney's Docket No.: MAT 3J7PCT	:	UNDER 37 CFR 1.181
For: Diffusion-Enabled Ingestion Inhibitor	:	

This communication is issued in response to applicants' "Response To Invitation To Pay Prescribed Fees And Late Payment Fee," filed 06 July 2007, which has been treated as a petition under 37 CFR 1.181.

BACKGROUND

On 07 July 2004, applicants filed international application PCT/US04/21936, claiming a priority date of 07 July 2003.

On 30 August 2004, the United States Receiving Office (US/RO) mailed the following: Notification Concerning Payment of Fees (Form PCT/RO/102); Notification of the International Application Number and International Filing Date (Form PCT/RO/105) and, Invitation To Correct Priority Claim (Form PCT/RO/110). Specifically, the Notification Concerning Payment of Fees (Form PCT/RO/102) indicated that an additional $700 was due for payment of the international search fee.

On 24 September 2004, applicants filed a "Response To Notification Concerning Payment of Fees," stating that a U.S. corresponding application was named upon filing of the instant international application and was identified by title, filing date and application docket number. As such, the reduced search fee of $300 is appropriate and no additional fees are required.

On 08 November 2004, the United States Receiving Office (US/RO) mailed a "Communication In Cases For Which No Other Form Is Applicable" (PCT/RO/132), indicating that when identifying a U.S. corresponding application, in order to receive the reduced search fee of $300, applicants are required to include the filing date, title and name of applicant (and preferably docket number). The Communication concluded that because applicants did not indicate the name of applicant, the full search fee of $1,000 is due.

On 20 June 2007, the United States Receiving Office (US/RO) mailed an "Invitation To Pay Prescribed Fees Together With Late Payment Fees" (PCT/RO/133), indicating that applicants owed fees totaling $1,050 ($700 for unpaid fees and $350 for late payment fees). A response date of "ONE MONTH" was set from the mailing date of 20 June 2007.

On 06 July 2007, applicants filed a "Response To Invitation To Pay Prescribed Fees And Late Payment Fee," reiterating that a U.S. corresponding application was named upon filing of the instant international application and was identified by title, filing date and application docket number, as required under 37 CFR 1.434(d)(2). Further, applicants stated that the reduced search fee of $300 was provided upon filing of the instant international application, and as such, no additional fees were required. Furthermore, applicants provided authorization to charge the deficient fees of $1,050 to Deposit Account No. 11-1450.

On 01 August 2007, the United States Receiving Office (US/RO) mailed a "Notification That International Application Considered To Be Withdrawn" (PCT/RO/117), stating that due to applicants' failure to pay the prescribed fees, the instant application is considered to have been withdrawn.

DISCUSSION

37 CFR 1.445 (a)(2)(ii) states that the search fee is $300 if:

> a corresponding prior United States national application under 35 U.S.C 111(a) has been filed before December 8, 2004, the basic filing fee under § 1.16 has been paid therein, and the corresponding prior United States national application is identified by application number, if known, or if the application number is not known by the filing date, title, and name of applicant (and preferably the application docket number), in the international application or accompanying papers at the time of filing the international application. (Underlining added).

In this case, the prior US national application (10/883,395) was filed on 30 June 2004 and was identified on the Request (Form PCT/RO/101) by the filing date, title and application docket number. However, the name of the applicant was not included. Therefore, the conditions of 37 CFR 1.445 have not been satisfied. As such, applicants were not entitled to the reduced search fee of $300 and were required to pay the full search fee of $1,000. 37 CFR §1.445 (a)(2)(iii). As shown in the Notification Concerning Payment of Fees (Form PCT/RO/102), mailed 30 August 2004, because applicants included a search fee of $300 with the filing of the instant international application, a remaining balance of $700 was due.

PCT Rule 16.*bis*.2 states that:

> (a) The payment of fees in response to an invitation under Rule 16bis.1(a) may be subjected by the receiving Office to the payment to it, for its own benefit, of a late payment fee. The amount of that fee shall be:
>
> > (i) 50% of the amount of unpaid fees which is specified in the invitation, or,
> > (ii) if the amount calculated under item (i) is less than the transmittal fee, an amount equal to the transmittal fee.

In this case, the Notification Concerning Payment of Fees (Form PCT/RO/102), mailed 30 August 2004, indicated a remaining balance of $700. In view of PCT Rule 16.*bis*.2(a), the late payment fee is $350 (50% of $700). Hence, as indicated in the "Invitation To Pay Prescribed Fees Together With Late Payment Fees," mailed 20 June 2007, applicants owed fees totaling $1,050 ($700 for unpaid fees and $350 for late payment fees).

Although in the "Response To Invitation To Pay Prescribed Fees And Late Payment Fee," filed 06 July 2007, applicants maintained the position that additional fees were not due, as shown above, in view of 37 CFR 1.445(a)(2)(ii) and PCT Rule 16.*bis*.2(a), applicants owed fees totaling $1,050 ($700 for unpaid fees and $350 for late payment fees). However, applicants' response was timely and provided authorization to charge the deficient fees of $1,050 to Deposit Account No. 11-1457. Therefore, the "Notification That International Application Considered To Be Withdrawn" (PCT/RO/117), mailed 01 August 2007, was issued prematurely.

In view of applicants' timely response on 06 July 2007, the "Notification That International Application Considered To Be Withdrawn" (PCT/RO/117), mailed 01 August 2007, will be withdrawn.

In view of applicants' authorization, the deficient fees of $1,050 will be charged to Deposit Account No. 11-1457 (as noted in the Request (Form PCT/RO/101(Annex)).

CONCLUSION

For the reasons stated above, the petition under 37 C.F.R. 1.181 is **GRANTED**.

The "Notification That International Application Considered To Be Withdrawn" (Form/PCT/RO/117), mailed 01 August 2007, is **VACATED**.

The application is transmitted to the International Stage Processing Division of the PCT Operations for continued processing according to this decision.

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Stefan Staicovici
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13 FEB 2008

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In re Application of	:	CORRECTED
Mattel, Inc et al	:	DECISION
PCT Application No.: PCT/US04/21936	:	
Int. Filing Date: 07 July 2004	:	ON PETITION
Attorney's Docket No.: MAT 3J7PCT	:	
For: Diffusion-Enabled Ingestion Inhibitor	:	UNDER 37 CFR 1.181

This communication corrects the decision mailed 01 October 2007 which was issued in response to applicants' "Response To Invitation To Pay Prescribed Fees And Late Payment Fee," filed 06 July 2007, which has been treated as a petition under 37 CFR 1.181. That decision incorrectly granted applicant's petition. The petition is DISMISSED.

BACKGROUND

On 07 July 2004, applicants filed international application PCT/US04/21936, claiming a priority date of 07 July 2003.

On 30 August 2004, the United States Receiving Office (US/RO) mailed a Notification Concerning Payment of Fees (Form PCT/RO/102) which indicated that an additional $700 was due for payment of the international search fee.

On 24 September 2004, applicants filed a "Response To Notification Concerning Payment of Fees," stating that a U.S. corresponding application was named upon filing of the instant international application and was identified by title, filing date and application docket number. As such, the reduced search fee of $300 is appropriate and no additional fees are required.

On 08 November 2004, the United States Receiving Office (US/RO) mailed a "Communication In Cases For Which No Other Form Is Applicable" (PCT/RO/132), indicating that when identifying a U.S. corresponding application, in order to receive the reduced search fee of $300, applicants are required to include the filing date, title and name of applicant (and preferably docket number). The Communication concluded that because applicants did not indicate the name of applicant, the full search fee of $1,000 is due.

On 20 June 2007, the United States Receiving Office (US/RO) mailed an "Invitation To Pay

Prescribed Fees Together With Late Payment Fees" (PCT/RO/133), indicating that applicants owed fees totaling $1,050 ($700 for unpaid fees and $350 for late payment fees). A response date of "ONE MONTH" was set from the mailing date of 20 June 2007.

On 06 July 2007, applicants filed a "Response To Invitation To Pay Prescribed Fees And Late Payment Fee," reiterating that a U.S. corresponding application was named upon filing of the instant international application and was identified by title, filing date and application docket number, as required under 37 CFR 1.434(d)(2). Further, applicants stated that the reduced search fee of $300 was provided upon filing of the, instant international application, and as such, no additional fees were required. Furthermore, applicants provided authorization to charge the deficient fees of $1,050 to Deposit Account No. 11-1450.

On 01 August 2007, the United States Receiving Office (US/RO) mailed a "Notification That International Application Considered To Be Withdrawn" (PCT/RO/117), stating that due to applicants' failure to pay the prescribed fees, the instant application is considered to have been withdrawn.

On 01 October 2007, a decision was mailed vacating the "Notification That International Application Considered To Be Withdrawn" (PCT/RO/117)

DISCUSSION

The decision mailed on 01 October 2007 found that applicant was required to pay the search fee of $1,000 pursuant to 37 CFR §1.445(a)(2)(iii) as well as the late payment fee prescribed by PCT Rule 16*bis*2(a), in the amount of $350. Hence, as indicated in the "Invitation To Pay Prescribed Fees Together With Late Payment Fees," mailed 20 June 2007, applicants owed fees totaling $1,050 ($700 for unpaid fees and $350 for late payment fees). The decision then stated " applicants' response was timely and provided authorization to charge the deficient fees of $1,050 to Deposit Account No. 11-1457. Therefore, the 'Notification That International Application Considered To Be Withdrawn' (PCT/RO/117), mailed 01 August 2007, was issued prematurely." Furthermore, the decision stated that "the 'Notification That International Application Considered To Be Withdrawn' (PCT/RO/ll7), mailed 01 August 2007, will be withdrawn." Finally the decision stated that "the deficient fees of $1,050 will be charged to Deposit Account No. 11-1457 (as noted in the Request (Form PCT/RO/101 (Annex))."

The response of 06 July 2007 contain authorization to charge the fees to Deposit Account 11-1450 which is not a valid deposit account for the signor Phaedra Paul. The decision incorrectly stated that Deposit Account 11-1457 was on the Request. The deposit account on the Request is 11-1547 and is not a valid account for the signor Charles DeVoe. Accordingly, the prior decision incorrectly stated that the fee would be charged to deposit account 11-1457. Because neither deposit account is valid, the fees have not been paid and the application was properly withdrawn.

CONCLUSION

For the reasons stated above, the petition under 37 CFR 1.181 is **DISMISSED.**

The "Notification That International Application Considered to be Withdrawn" (Form/PCT/RO/117), mailed 01 August 2007 is reinstated.

The application is transmitted to the International Stage Processing Division of the PCT Operations for continued processing according to this decision.

Leonard E. Smith
PCT Legal Examiner
PCT Legal Affairs
Office of Patent Cooperation Treaty
Legal Administration

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27 JAN 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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Fabio E. MARINO
BINGHAM MCCUTCHEN LLP
Three Embarcadero Center, Suite 1800
San Francisco, California 94111-4067

In re Application of:	:	
SR TELECOM, INC.	:	
PCT No.: PCT/US04/22802	:	DECISION ON PETITION
International Filing Date: 16 July 2004	:	
Priority Date: 15 July 2003	:	
Attorney's Docket No.: 703976-6001	:	
For: METHOD OF SUPPORTING VOICE-BAND MODEM-TO-MODEM CALLS IN A WIRELESS COMMUNICATION SYSTEM	:	

This decision is issued in response to the "Petition To Correct International Filing Date Under 37 CFR 1.182" filed by facsimile 13 January 2005, treated herein as a petition under 37 CFR 1.10(d) to correct the international filing date. No petition fee is required.

BACKGROUND

Applicant initiated this international application by filing a Request (Form PCT/RO/101) and accompanying materials. A Certificate Of Express Mailing included with the application papers identifies the "Express Mail" label number used for the submission as EV148293734US and identified the date of submission as 15 July 2004.

On 31 August 2004, the RO/US mailed a "Notification Of The International Application Number And Of The International Filing Date" (Form PCT/RO/105) identifying 16 July 2004 as the international filing date and an "Invitation To Correct Priority Claim" (Form PCT/RO/110) informing applicant that the priority claim was defective because it was more than twelve months prior to the international filing date.

On 13 January 2005, applicant filed the petition considered herein (the petition includes a cover letter stating that the petition was originally submitted on 09 August 2004, but no evidence of this earlier filing date has been submitted; i.e., a return postcard). The petition seeks correction of the international filing date to 15 July 2004, the date on which applicant claims the application was originally presented to the USPS.

DISCUSSION

The present international application was accorded an international filing date of 16 July 2004. This is the "date in" entered by the USPS on the "Express Mail" envelope in which the application was submitted. It is also the "Acceptance" date indicated for this "Express Mail"

envelope in the USPS tracking data base. Applicant asserts that the proper international filing date should be 15 July 2004, the date on which the "Express Mail" envelope containing the application materials was purportedly first delivered to the USPS.

Specifically, the petition asserts that: (1) applicant used a courier to deliver the "Express Mail" package to the USPS on 15 July 2004; (2) the USPS refused to accept the envelope based on an erroneous failure by the USPS to accept applicant's corporate account number; (3) the courier returned to the envelope to applicant on 16 July 2004; and (4) that the envelope was returned to the USPS by the courier on 16 July 2004 and was accepted by the USPS at such time. In effect, applicant is arguing that the 16 July 2004 "date in" entered by the USPS was incorrect, in that the USPS should have accepted the envelope when originally delivered on 15 July 2004. Under these circumstances, where the applicant is seeking to have the USPTO apply a filing date which is different from the "date in" entered by the USPS, 37 CFR 1.10(d) is the applicable regulation. 37 CFR 1.10(d) provides:

> (d) Any person filing correspondence under this section that was received by the Office and delivered by the "Express Mail Post Office to Addressee" service of the USPS, who can show that the "date-in" on the "Express Mail" mailing label or other official notation entered by the USPS was incorrectly entered or omitted by the USPS, may petition the Commissioner to accord the correspondence a filing date as of the date the correspondence is shown to have been deposited with the USPS, provided that:
>
> (1) The petition is filed promptly after the person becomes aware that the Office has accorded, or will accord, a filing date based upon an incorrect entry by the USPS;
>
> (2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail"; and
>
> (3) The petition includes a showing which establishes, to the satisfaction of the Commissioner, that the requested filing date was the date the correspondence was deposited in "Express Mail Post Office to Addressee" service prior to the last scheduled pickup for that day. Any showing pursuant to this paragraph must be corroborated by evidence from the USPS or that came into being within one business day after deposit of the correspondence in the "Express Mail Post Office to Addressee" service of the USPS.

Here, applicant has not made the showing required under 37 CFR 1.10(d)(3). Such a showing must be in the form required by the applicable rules (see MPEP section 513(VI))). The present petition includes no evidence from the USPS to corroborate the claims made in the petition, nor has applicant provided a firsthand statement from the courier who delivered the purportedly rejected envelope to the USPS on 15 July 2004, or any contemporaneous records of

the filing (i.e., mail logs confirming the 15 July 2004 submission). Under the circumstances described by applicant, a letter from the USPS explaining their policy and the handling of the package in question must be part of any renewed petition. Absent such materials, the present record does not include an adequate showing that the "Express Mail" envelope containing the present international application was presented to the USPS for deposit prior to the last scheduled pickup on 15 July 2004. Accordingly, the requirement of 37 CFR 1.10(d)(3) is not satisfied, and applicant has not satisfied all the requirements for a grantable petition.

CONCLUSION

Applicant's petition under 37 CFR 1.10(d), requesting that the international application be accorded an international filing date of 15 July 2004, is **DISMISSED** without prejudice. The international filing date remains 16 July 2004.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.10(d)."

Please direct further correspondence with respect to this matter to the Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

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UNITED STATES PATENT AND TRADEMARK OFFICE

12 DEC 2005

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In re Application of:
SR TELECOM, INC.
PCT No.: PCT/US04/22802
International Filing Date: 16 July 2004
Priority Date: 15 July 2003
Attorney's Docket No.: 703976-6001
For: METHOD OF SUPPORTING VOICE-BAND MODEM-TO-MODEM CALLS IN A WIRELESS COMMUNICATION SYSTEM

DECISION ON PETITION
UNDER 37 CFR 1.183

This decision is issued in response to applicant's "Petition To Suspend Rule 37 CFR 1.10 Under 37 CFR 1.183" filed 31 May 2005. Pursuant to the supplemental authorization filed 01 July 2005, Deposit Account No. 50-2518 will be charged the required petition fee.

BACKGROUND

The procedural background for this application was set forth in the decisions mailed by this Office on 27 January 2005 and 31 March 2005. These decisions dismissed without prejudice applicant's petition under 37 CFR 1.10(d) to correct the international filing date from 16 July 2004 to 15 July 2004. Specifically, the previous decisions found that applicant had not provided an adequate showing that the "Express Mail" envelope containing the present application was deposited with the USPS as "Express Mail Post Office to Addressee" prior to the last scheduled pickup on the requested filing date (i.e. 15 July 2004), as required for a grantable petition under 37 CFR 1.10(d).

On 31 May 2005, applicant filed the petition considered herein. The petition requests that the requirements of 37 CFR 1.10 be waived so as to permit the international filing date to be changed from 16 July 2004 to 15 July 2004.

DISCUSSION

37 CFR 1.183 states that:

> In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the

PCT/US04/22802 - 15/12/2005

> Commissioner or the Commissioner's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed.

Here, as discussed in the previous decisions, applicant has failed to demonstrate that the application was deposited with the USPS as "Express Mail" on 15 July 2004. Rather, the evidence shows the following: (1) the application was sent by counsel, via a courier, to the U.S. Post Office on 15 July 2004; (2) the "Express Mail" envelope did not include the required corporate account number (i.e. the postage fee); (3) consistent with its stated policy, the USPS refused to accept the "Express Mail" envelope absent the required corporate account number; (4) the courier returned the "Express Mail" envelope containing the application to counsel; (5) the required corporate account number was added to the envelope; and (6) on the following day, 16 July 2005, the properly filled out "Express Mail" envelope was returned to the U.S. Post Office and deposited as "Express Mail."

In the present petition, applicant argues that the errors that prevented the envelope from being accepted on 15 July 2004 were unavoidable and beyond the control of applicant or its attorneys. These errors are identified as follows: (1) the failure to include the corporate account number on the envelope; (2) the failure of the courier to pay the required postage when the USPS refused the envelope on 15 July 2004, and (3) the USPS clerk's failure to recognize that counsel has a corporate account with the UPS.

When defining the term "unavoidable," MPEP δ 711.03(c) states that the "reasonably prudent person standard" is applied. Although this MPEP section is in the context of unavoidable abandonments, the discussion as to what constitutes "unavoidable" applies equally to applicant's assertion here that the errors were "unavoidable." Specifically, the MPEP states the following:

> 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.

A particularly relevant example cited in MPEP δ 711.03(c) states the following:

> As a "reasonably prudent person" would file papers or fees in compliance with 37 CFR 1.8 or 1.10 to ensure their timely filing in the USPTO, as well as preserve adequate evidence of such filing, a delay caused by an applicant's failure to file papers or fees in

> compliance with 37 CFR 1.8 and 1.10 does not constitute "unavoidable" delay. See *Krahn*, 15 USPQ2d at 1825.

Similarly, MPEP δ 513(III) states the following:

> Since the filing of correspondence under 37 CFR 1.10 without the number of the "Express Mail" mailing label thereon is an oversight that can be avoided by the exercise of reasonable care, requests for waiver of this requirement will not be granted on petition. A party's inadvertent failure to comply with the requirements of a rule is not deemed to be an extraordinary situation that would warrant waiver of a rule under 37 CFR 1.183, 2.146(a)(5) or 2.148, nor is such an inadvertent omission considered "unavoidable," within the meaning of 15 U.S.C. 1062(b), 35 U.S.C. 133, 37 CFR 1.137(a) or 37 CFR 2.66(a).

One of the cases cited in MPEP δ 513(III) is *Nitto Chemical Industry. Co., Ltd. v. Comer*, 39 USPQ2d 1778, 1782 (D.D.C. 1994). In that case, a number of "Express Mail" envelopes containing patent applications were mistakenly deposited as first class mail by a courier used by applicant's law firm. The original applications were not received in the USPTO, requiring applicant to re-file the applications. The applications were accorded filing dates based on the re-filed applications, and these later filing dates precluded the applicant from claiming the benefit of its prior foreign patent applications. The applicant requested waiver of the filing requirements of 37 CFR 1.10 pursuant to 37 CFR 1.183, so as to obtain the earlier filing date that would have been accorded had the courier properly deposited the application as "Express Mail." The Commissioner refused to waive the rules, finding that the courier's actions amounted to "an oversight that could have been prevented by the exercise of ordinary care or diligence" (*Nitto*, 39 USPQ2d at 1780), and the U.S. District Court upheld the Commissioner's refusal.

As in *Nitto*, the actions of the courier here amounted to "an oversight that could have been prevented by the exercise of ordinary care or diligence." For example, the courier could have been clearly instructed as to what action to take should the USPS refuse an "Express Mail" deposit, or a more senior employee with such training could have been entrusted with the deposit. Similarly, the failure of counsel's staff to properly include the corporate account number on the "Express Mail" envelope is an error that could have been avoided with the exercise of ordinary care, and such action would have eliminated any need for applicant to rely on the USPS making an exception to its stated policy regarding the acceptance of "Express Mail" packages. Finally, the application could have been forwarded for deposit with the USPS before the deadline date, in which case the one-day delay would not have affected the priority claim.

Based on the above, the failure of the "Express Mail" envelope containing the present international application to be successfully deposited with the USPS on 15 July 2004 was not an "unavoidable" occurrence that justifies waiver of the applicable rules.

Applicant also argues that justice requires waiver of the rules here, stating that the "consequences of the rejected petition are extremely severe and unjustifiable." Specifically, applicant states that, as a result of the refusal of the USPTO to waive the requirements of 37 CFR 1.10: "the Applicant may lose some, if not all, of their foreign rights in absolute novelty jurisdictions. In addition, the Applicant's U.S. application upon publication or issuance may become an invalidating prior art reference to the Applicant's pending foreign applications." However, beyond these references to potential injury that applicant "may" suffer, the petition contains no evidence that any specific injury has been, or will be, suffered by applicant should the present petition be denied.

The *Nitto* case referred to above contained a similar argument. There, the applicant asserted that the failure to waive the requirements of 37 CFR 1.10 would result in the loss of the applicant's benefit claim to its earlier foreign applications, and that the applicant's applications would therefore be prejudiced. The Court rejected this argument, stating the following:

> [Applicant] did not submit evidence showing that the inventions claimed in the two applications have been, or will be, denied patentability over applications filed [between the lost earlier priority date and the accorded filing date]. Thus, the Commissioner had no basis on which to determine whether "justice require[d] him to award [applicant] the earlier filing date.

Here, while the loss of the earlier priority date could adversely affect the patentability of the present application, the present record does not include any evidence to support a conclusion that any specific damage has or will occur. Applicant therefore has not demonstrated injury that would support a waiver of the applicable rules in the present case.

CONCLUSION

Based on the above, the present record does not demonstrate that the situation here is an "extraordinary situation" where "justice requires" suspension of the rules. Accordingly, applicants' petition under 37 CFR 1.183 is **DISMISSED** without prejudice.

The international filing date for the present application remains 16 July 2004.

If applicant desires reconsideration on the merits of this petition, a request for such reconsideration must be submitted within **TWO (2) MONTHS** of the mail date of this decision. Any reconsideration request should be entitled "Renewed Petition Under 37 CFR 1.183." No additional petition fee is required.

PCT/US04/22802 - 13-12-2005

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Mail Stop PCT, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Richard Cole
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RMR/RC

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06 OCT 2005

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In re Application of:
BOARD OR REGENTS OF THE UNIVERSITY AND COMMUNITY COLLEGE SYSTEM OF NEVADA
PCT No.: PCT/US04/34354
International Filing Date: 18 October 2004
Priority Date: 17 October 2004
Attorney's Docket No.: 40292PCT
For: SELF-SENSING ARRAY OF MICROCANTILEVERS FOR CHEMICAL DETECTION

DECISION

This decision is issued in response to the "Response To Invitation To Correct Priority Claim" filed by applicant on 11 August 2005, treated herein as a petition under PCT Rule 26bis. No petition fee is required.

BACKGROUND

On 17 October 2004, applicant filed international application PCT/US04/34354. Box No. VI of the Request (Form PCT/RO/101) identified one U.S. provisional application for priority purposes, U.S. application number 60/512,504. The filing date of the priority application was listed as 17 October 2004.

On 06 December 2004, the International Bureau (IB) mailed an "Invitation To Correct Priority Claim" indicating that the priority claim was defective in that the filing date for the priority application listed on the Request (17 October 2004) was not consistent with the filing date listed on the priority document itself (17 October 2003).

On 11 August 2005, applicant filed the "Response To Invitation To Correct Priority Claim" considered as a petition herein. In the petition, applicant states that it has "no record of receiving the originally mailed" Invitation To Correct Priority Claim. The petition seeks correction of the filing date for the priority application to 17 October 2003.

DISCUSSION

PCT Rule 26bis.1(a) states the following:

> The applicant may correct or add a priority claim by a notice submitted to the receiving Office or the International Bureau within a time limit of 16 months from the priority date or, where the correction or addition would cause a change in the priority date, 16 months from the priority date as so changed, provided that such notice may be submitted until the expiration of four months from the international filing date.

Applicant's present request for correction of the defective priority claim was filed 11 August 2005, after the expiration of the PCT Rule 26bis deadline on 17 February 2005 (i.e., 16 months from 17 October 2003). Accordingly, under PCT Rule 26bis, the correction of the defective priority claims was not timely filed and cannot be entered in the present application. The USPTO does not have the authority to extend the deadline set forth in PCT Rule 26bis. Accordingly, applicant's assertion that the Invitation To Correct Priority Claim was not timely received, even if accepted, would not alter the result.[1]

Applicant should note that, pursuant to PCT Rule 26bis.2(b):

> A priority claim shall not be considered not to have been made only because the indication of the number of the earlier application referred to in Rule 4.10(a)(ii) is missing or because an indication in the priority claim is not the same as the corresponding indication appearing in the priority document.

Pursuant to this provision, although correction will be required at the national stage, the defective priority claim will not be considered not to have been made.

CONCLUSION

For the reasons set forth above, applicant's petition is **DISMISSED** without prejudice.

The 11 August 2005 response to the Invitation To Correct Priority Claim is rejected as untimely under PCT Rule 26bis. The priority information of record remains as set forth in the originally filed Request.

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450,

[1] Applicant states that the Search Report/Written Opinion mailed herein identified the priority date as 17 October 2003. However, it is noted that the Search Report/Written Opinion was mailed 28 March 2005, after the 16 month deadline had already expired.

Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

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WOODLAND HILLS CA CALIFORNIA 91364

In re Application of:
GOTHARD, David
PCT No.: PCT/US2004/037464
International Filing Date: 10 November 2004
Claimed Priority Date: 10 November 2003
Atty Docket No.: None
For: HIGH RESOLUTION COMPUTER CONTROL DISPLAY SYSTEM

DECISION

This decision is issued in response to the "Petition To Revive An Abandoned Patent Application" filed on 12 February 2007.

BACKGROUND

On 10 November 2004, applicant initiated the present international application. The application includes one priority claim, directed to a U.S. non-provisional application filed 10 November 2003.

On 12 February 2007, applicant filed the petition considered herein seeking revival of the international application. The petition was accompanied by payment of a $750 petition fee.

DISCUSSION

It is now more than thirty months from the earliest priority date with respect to the present application. Accordingly, for purposes of national stage proceedings in the United States, the present application is abandoned.

Applicant's present petition does not include a request for entry into the national stage in the United States, nor does it imply that applicant intends to enter the national stage in the United States. Rather, applicant requests revival of the application by "the PCT office" as an apparent precursor to pursuing national stage proceedings in other countries.

There is no procedure for revival of an international application in the present context. Whether or not the international application may be revived and pursued in the national stage at this point is subject to the laws and procedures of the various national offices, and must be pursued by applicant with such offices at the time that any desired national stage proceedings are initiated.

With respect to the United States, any petition for revival of the international application under 37 CFR 1.137(b) is only appropriate if entry into the national stage in the United States is desired, and, if so, the petition should accompany the materials filed to initiate the national stage application (i.e., payment of the basic national fee, etc.) and will be considered at that time.

CONCLUSION

The "Petition To Revive An Abandoned Patent Application" filed herein on 12 February 2007 is **DISMISSED AS MOOT**. The application remains abandoned with respect to the United States.

The $750 petition fee will be refunded to applicant.

Because the present application is abandoned with respect to the United States, a grantable petition for revival must accompany any subsequent submission by applicant requesting entry into the national stage in the United States.

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UNITED STATES PATENT AND TRADEMARK OFFICE

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11 JUL 2007

Jonathan Alan Quine
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Alameda, CA 94501

In re Application of	:	
THE SCRIPPS RESEARCH INSTITUTE	:	
PCT No.: PCT/US04/39064	:	DECISION ON PETITION
Int. Filing Date: 19 November 2004	:	
Priority Date: 19 November 2003	:	UNDER 37 CFR 1.181
Attorney's Docket No.: 91-000110PC	:	
For: COMPOSITIONS AND METHODS TO REDUCE MUTAGENESIS	:	

This is a decision on applicant's correspondence filed 08 November 2006 in the United States Patent and Trademark Office (USPTO). The request is being treated as a petition under 37 CFR 1.181. No petition fee is due.

BACKGROUND

On 19 November 2004, applicant filed the above-captioned international application in the USPTO. The international application claimed priority to an earlier United States application filed 19 November 2003.

On 09 November 2005, applicant was mailed an "Invitation to Pay Additional Fees" (Form PCT/ISA/206) indicating that in order to perform a search on all of the identified inventions applicant was required to pay additional search fees.

On 21 June 2006, applicant was mailed an International Search Report (Form PCT/ISA/210) indicating that "No required search fees were timely paid by the applicant."

On 08 November 2006, applicant filed the present petition arguing that a timely response authorizing that charging of $2000.00 in additional search fees to deposit account no. 50-0893 was filed on 07 December 2005.

DISCUSSION

A review of the application file finds applicant's 07 December 2005 response contained therein. As such, it is proper to **GRANT** applicant's petition at this time to have an additional International Search Report performed which includes a search of two additional inventions.

CONCLUSION

Applicant's petition under 37 CFR 1.181 is **GRANTED**.

This application is being returned to Group Art Unit 1654 for an additional International Search Report.

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01 MAR 2007

Glenn Patent Group
3475 Edison Way, Suite L
Menlo Park, CA 94025

In re Application of
AMERICA ONLINE INC.
PCT No.: PCT/US04/39272
Int. Filing Date: 19 November 2004
Priority Date: 23 November 2003
Attorney Docket No.: AOL0126P
For: ELECTRONIC MESSAGE FORWARDING

DECISION ON PETITION

This decision is in response to applicant's "Renewed Petition for Designated State Correction" filed via facsimile transmission on 11 January 2007, which has been treated as a petition under 37 CFR 1.181.

BACKGROUND

On 20 December 2004, the United States Receiving Office (RO/US) mailed a NOTIFICATION OF THE INTERNATIONAL APPLICATION NUMBER AND OF THE INTERNATIONAL FILING DATE (Form PCT/RO/105) according the application and international filing date of 19 November 2004 and a priority date of 23 November 2003.

On 24 May 2006, applicant filed via facsimile transmission a "Request for Correction" which requested that a replacement page 3 of the Request with the boxes in Box No. V unchecked be substituted for the original page 3 of the Request which had these boxes checked.

On 28 June 2006, applicant filed a "Petition for Designated State Correction" via facsimile transmission.

On 02 August 2006, a NOTIFICATION OF DECISION CONCERNING REQUEST FOR RECTIFICATION (Form PCT/RO/109) was mailed indicating that the "Request for Correction" filed 24 May 2006 was untimely as the time limit under PCT Rule 91.1(g)(i) had expired.

On 02 August 2006, a decision was mailed dismissing applicant's request under PCT Rule 91.1.

On 11 January 2007, applicant filed the instant "Renewed Petition for Designated State Correction," which was accompanied by, inter alia, a letter dated 20 November 2006 from Jae H. Kim, Senior Legal Officer, PCT Legal Affairs Section, WIPO. The submission has been treated as a petition under 37 CFR 1.181.

DISCUSSION

The petition requests that the United States Receiving Office (RO/US) issue a form indicating that Republic of Korea (KR) is a designated state. As noted above, in Box No. V on page 3 of the Request filed 19 November 2004, the boxes were checked. The Request indicates that the checking of the Boxes signifies that the countries listed next to each box, Germany, the Republic of Korea, and the Russian Federation, are not designated for any kind of national protection.

Since the instant application did not contain a priority claim to an earlier application in any of the States listed in Box No. V of the Request filed 19 November 2004 (including KR), applicant should not have been able to indicate any of the States as not designated. Accordingly, the indication that the States listed in Box No. V are not designated is hereby CANCELLED EX OFFICIO BY THE RO/US. A form PCT/RO/146 and a corrected sheet No. 3 of the Request are attached. See PCT Receiving Office Guidelines (March 7, 2006), paragraph 102.

The letter dated 20 November 2006 has been considered. As noted above, the Request has been corrected to indicate that Germany (DE), Republic of Korea (KR) and Russian Federation (RU) are designated States.

CONCLUSION

For the reasons set forth above, the petition under 37 CFR 1.181 is **GRANTED**.

Germany (DE), Republic of Korea (KR) and Russian Federation (RU) are designated States.

The application is being forwarded to PCT Central Files for storage.

Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Telephone: (571) 272-3298
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Enc.: Form PCT/RO/146 and corrected sheet No. 3 of the Request

CC: International Bureau of WIPO

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Warren L. Franz
Texas Instruments Incorporated
Deputy General Patent Counsel
P.O. Box 655474, M/S 3999
Dallas, TX 75265-5474

In re Application of	:	
TEXAS INSTRUMENTS INCORPORATED	:	
PCT No.: PCT/US04/40033	:	DECISION ON PETITION
Int. Filing Date: 29 November 2004	:	
Priority Date: 28 November 2003	:	UNDER 37 CFR 1.181
Attorney's Docket No.: TI-37260WO	:	
For: CALIBRATING CAPACITOR MISMATCH IN A PIPE-LINE ADC	:	

This decision is in response to applicant's petition under 37 CFR 1.181filed in the United States Patent and Trademark Office (USPTO) on 16 March 2007 seeking reinstatement of the international application and mailing of the international search report.

BACKGROUND

On 29 November 2004, applicant filed the above-captioned international application in the USPTO. The international application claimed priority to an earlier United States application filed 28 November 2003.

On 06 April 2005, applicant filed a "Notice of Withdrawal" (Form PCT/IB/372) with the International Bureau (IB) requesting the withdrawal of the designation of the United States pursuant to PCT Rule 90*bis*.2.

On 08 April 2005, applicant was mailed a "Notification of Withdrawal of International Application or Designations" (Form PCT/IB/307) indicating that the United States had been withdrawn as a designated state.

On 16 March 2007, applicant filed the present petition seeking reinstatement of the present international application and mailing of the international search report.

DISCUSSION

A review of USPTO records finds that the status of the present international application was inadvertently changed to "withdrawn" following the receipt of the Form PCT/IB/307 from the IB. The status of the application has been corrected. This application is being forwarded to

Group Art Unit 2819 for the preparation and mailing of the international search report.

CONCLUSION

Applicant's petition under 37 CFR1.181 is **GRANTED**.

This application is being forwarded to Group Art Unit 2819 for the preparation and mailing of the international search report.

Derek A. Putonen
Attorney Advisor
Office of PCT Legal Administration
Tel: (571) 272-3294
Fax: (571) 273-0459

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

Michael A. Glenn
Glenn Patent Group
3475 Edison Way, Suite L
Menlo Park, CA 94025

In re Application of :
VENTURI WIRELESS INC. :
PCT No.: PCT/US04/43085 :
Int. Filing Date: 22 December 2004 : **DECISION**
Priority Date: 29 December 2003 :
Attorney's Docket No.: FOUR0004P :
For: REUSABLE COMPRESSED OBJECTS :

This decision is in response to applicant's "Renewed Petition for Designated State Correction" filed via facsimile with the United States Receiving Office (RO/US) on 11 January 2007, which has been treated as a petition under 37 CFR 1.181.

BACKGROUND

On 22 December 2004, applicant filed certain papers for an international application including a Request. On Box No. V on sheet 3 of the Request, applicant checked all three boxes indicating that Germany, the Republic of Korea and the Russian Federation were not designated for any kind of national protection.

On 28 June 2006, applicant filed a "Petition for Designated State Correction" via facsimile requesting that the Request form be changed as an obvious error pursuant to PCT Rule 91.1.

On 13 July 2006, a decision dismissing applicants's petition as untimely was mailed as the time limit under PCT Rule 91.1(g)(i) had expired.

On 28 July 2006, applicant filed a "Renewed Petition for Designated State Correction" via facsimile.

On 25 August 2006, a decision dismissing applicant's renewed petition was mailed.

On 14 December 2006, applicant filed the instant "Renewed Petition for Designated State Correction," which was accompanied by, *inter alia*, a letter dated 20 November 2006 from Jae H. Kim, Senior Legal Officer, PCT Legal Affairs Section, WIPO.

DISCUSSION

The petition requests that the RO/US issue a form indicating that Republic of Korea (KR) is a designated state. As noted above, in Box No. V on sheet 3 of the Request filed 22 December 2004, the boxes were checked. The Request indicates that the checking of the Boxes signifies that the countries listed next to each box, Germany, the Republic of Korea, and the Russian Federation, are not designated for any kind of national protection.

Since the instant application did not contain a priority claim to an earlier application in any of the States listed in Box No. V of the Request filed 22 December 2004 (including KR), applicant should not have been able to indicate any of the States as not designated. Accordingly, the indication that the States listed in Box No. V are not designated is hereby **CANCELLED EX OFFICIO BY THE RO/US**. A form PCT/RO/146 and a corrected sheet No. 3 of the Request are attached. *See* PCT Receiving Office Guidelines (March 7, 2006), paragraph 102.

The letter dated 20 November 2006 has been considered. As noted above, the Request has been corrected to indicate that Germany (DE), Republic of Korea (KR) and Russian Federation (RU) are designated States.

CONCLUSION

For the reasons set forth above, the petition under 37 CFR 1.181 is **GRANTED**.

Germany (DE), Republic of Korea (KR) and Russian Federation (RU) are designated States.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

The application is being forwarded to PCT Central Files for storage.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302

Enc.: Form PCT/RO/146 and corrected sheet No. 3 of the Request

cc: The International Bureau of WIPO
34, chemin des Colombettes
1211 Geneva 20
Switzerland

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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MICHAEL A. GLENN
GLENN PATENT GROUP
3475 EDISON WAY, STE. L.
MENLO PARK, CA 94025

In re Application of	:	DECISION ON
AMERICA ONLINE, INCORPORATED	:	
PCT No.: PCT/US05/04359	:	PETITION
Int. Filing Date: 08 February 2005	:	
Priority Date: 11 February 2004	:	
Attorney's Docket No.: TEGI0020P	:	
For: HANDWRITING AND VOICE INPUT WITH AUTOMATIC CORRECTION	:	

This decision is in response to applicant's "Renewed Petition for Designated State Correction" filed via facsimile transmission on 11 January 2007, which has properly been treated as a petition under 37 CFR 1.181.

BACKGROUND

On 31 March 2005, the United States Receiving Office (RO/US) mailed a NOTIFICATION OF THE INTERNATIONAL APPLICATION NUMBER AND OF THE INTERNATIONAL FILING DATE (Form PCT/RO/105) according the application and international filing date of 08 February 2005 and a priority date of 11 February 2004.

On 02 August 2006, applicants submitted a "Petition for Designated State Correction" via facsimile transmission which includes a request under PCT Rule 91.1.

On 20 September 2006, a decision was mailed dismissing applicant's request under PCT Rule 91.1 without prejudice.

On 11 January 2007, applicants filed the instant "Renewed Petition for Designated State Correction" which was accompanied by, *inter alia*, a letter dated 20 November 2006 from Jae H. Kim, Senior Legal Officer, PCT Legal Affairs Section, WIPO. The submission has properly been treated as a petition under 37 CFR 1.181.

DISCUSSION

The petition requests that the United States Receiving Office (RO/US) issue a form indicating that Republic of Korea (KR) is a designated state. As noted above, in Box No. V on page 3 of the Request filed 08 February 2005, the boxes were checked. The Request indicates that the checking of the Boxes signifies that the countries listed next to each box, Germany, the

Republic of Korea, and the Russian Federation, are not designated for any kind of national protection.

Since the instant application did not contain a priority claim to an earlier application in any of the States listed in Box No. V of the Request filed 08 February 2005 (including KR), applicant should not have been able to indicate any of the States as not designated. Accordingly, the indication that the States listed in Box No. V are not designated is hereby CANCELLED EX OFFICIO BY THE RO/US. A form PCT/RO/146 and a corrected sheet No. 3 of the Request are attached. See PCT Receiving Office Guidelines (March 7, 2006), paragraph 102.

The letter dated 20 November 2006 has been considered. As noted above, the Request has been corrected to indicate that Germany (DE), Republic of Korea (KR) and Russian Federation (RU) are designated States.

CONCLUSION

For the reasons set forth above, the petition under 37 CFR 1.181 is **GRANTED**.

Germany (DE), Republic of Korea (KR) and Russian Federation (RU) are designated States.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

The application is being forwarded to PCT Central Files for storage.

Daniel Stemmer
Legal Examiner
PCT Legal Affairs
Office of Patent Cooperation Treaty
Legal Administration
Telephone: (571) 272-3301
Facsimile: (571) 273-0459

Enc.: Form PCT/RO/146 and corrected sheet No. 3 of the Request

CC: International Burea of WIPO

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

10 OCT 2007

Sabra-Anne Truesdale
FENWICK & WEST, LLP
801 California Street
Mountain View, CA 94041

In re Application of
GOOGLE, INC.
PCT No.: PCT/US05/10681
Int. Filing Date: 30 March 2005
Priority Date: 29 March 2005
Agent's File Reference: 10232 PCT
For: INTEGRATION OF MULTIPLE QUERY REVISION MODELS

DECISION UNDER
37 CFR 1.10(c)

This is in response to applicants' 17 June 2005 communication, which is being treated as a petition under 37 CFR 1.10(c) requesting that the filing date of International Application No. PCT/US05/10681 be corrected from 31 March 2005 to 30 March 2005. No petition fee is due. The petition is **GRANTED** as follows:

BACKGROUND

As indicated in the "NOTIFICATION OF THE INTERNATIONAL APPLICATION NUMBER AND OF THE INTERNATIONAL FILING DATE" (Form PCT/RO/105 mailed 26 April 2005), International Application No. PCT/US05/10681 was accorded a filing date of 31 March 2005 by the United States Receiving Office (RO/US).

On 17 June 2005, the present petition was filed requesting that International Application No. PCT/US07/10681 be accorded a filing date of 30 March 2005 pursuant to the "Express Mail" provisions under 37 CFR 1.10.

DISCUSSION

37 CFR 1.10(c) provides that:

Any person filing correspondence under this section that was received by the Office and delivered by the "Express Mail Post Office to Addressee" service of the USPS, who can show that there is a discrepancy between the the filing date accorded by the Office to the correspondence and the date of deposit as shown by the "date-in" on the "Express Mail" mailing label or other official USPS notation, may petition the Commissioner to accord the correspondence a filing date as of the "date-in" on the "Express Mail" mailing label or other official USPS notation, provided that:

(1) The petition is filed promptly after the person becomes aware that the Office has accorded, or will accord, a filing date other than the USPS deposit date;

(2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail"; and

(3) The petition includes a true copy of the "Express Mail" mailing label showing the "date-in", and of any other official notation by the USPS relied upon to show the date of deposit.

The present petition has been filed promptly. 37 CFR 1.10(c)(1). "Express Mail" Label No. EV441504635US was indicated on the transmittal letter which accompanied the original application papers. 37 CFR 1.10(c)(2). The copy of "Express Mail" Label No. EV441504635US of record in the application file indicates that the "Date In" is 30 March 2005. 37 CFR 1.10(c)(3). Accordingly, correction of the international filing date to 30 March 2005 is appropriate.

CONCLUSION

For the above reasons, the request to correct the filing date is **GRANTED**. The Form PCT/RO/105 mailed 26 April 2005 is hereby **VACATED.**

A copy of this decision along with a corrected Form PCT/RO/105 and first page of the PCT Request indicating a 30 March 2005 international filing date are being sent to the International Bureau.

Bryan Lin for
Leonard Smith
Supervisory PCT Legal Examiner
Office of PCT Legal Administration

JSF/LS:jf

Jeremy Fleming
Paralegal Specialist
Office of PCT Legal Administration

(571)272-3284

Copy to:
THE INTERNATIONAL BUREAU OF WIPO
34, Chemin des Colombettes
1211 Geneve 20
SUISSE

Enclosures: a copy of corrected Form PCT/RO/105 and a copy of the corrected copy of first page of the PCT Request.

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Commissioner for Patents
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Alexandria, VA 22313-1450
www.uspto.gov

Michael E. Godar
SENNIGER POWERS LEAVITT & ROEDEL
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In re Application of	:	
DR. BROOKS INNOVATIONS, LLC	:	
PCT No.: PCT/US05/15955	:	DECISION ON
Int. Filing Date: 06 May 2005	:	REQUEST FOR REFUND
Priority Date: 06 May 2004	:	UNDER 37 CFR 1.446
Agent's File Reference: BSS 6446.2	:	
For: A SYSTEM FOR HOLDING IMPLEMENTS	:	

This decision is in response to applicants' communication filed 28 February 2006. Applicant's communication has been treated as a petition under 37 CFR 1.446 for a refund in the amount of $4,000. The petition is **GRANTED.**

BACKGROUND

On 06 May 2005, applicants filed international application no. PCT/US05/15955, which claimed priority to a U.S. application filed 06 May 2004. Applicants paid, inter alia, $1,000 to cover an international search by the United States International Searching Authority (ISA/US).

On 19 January 2006, the ISA/US mailed an "INVITATION TO PAY ADDITIONAL FEES AND, WHERE APPLICABLE, PROTEST FEE" (Form PCT/ISA/206) inviting applicants to pay fees in the amount of $5,000 to search 5 additional inventions.

On 17 February 2006, applicants filed a "Response to Invitation to Pay Additional Fees" which authorized payment in the amount of $1,000 for the search of 1 additional invention from Deposit Account No. 19-1345.

Notwithstanding the above, on 22 February 2006, the USPTO charged $4,000 to counsel's Deposit Account No. 19-1345 for additional searches.

On 28 February 2006, applicants filed the present petition requesting a refund in the amount of $4,000 as payment for only 1 additional search was authorized.

DISCUSSION

37 CFR 1.446(a) provides that:

(a) Money paid for international application fees, where paid by actual mistake or in excess, such as payment not required by law or Treaty and its Regulations, will be refunded.

A review of the application file reveals that the USPTO charged counsel's deposit account in excess of the amount authorized. Therefore, a refund in the amount of the $4,000 is appropriate.

CONCLUSION

For the above reasons, the request for refund is **GRANTED.**

This application is being forwarded to the RO/US Section of the Office of PCT Operations to refund the $4,000 overpayment to counsel's Deposit Account No. 19-1345.

Boris Milef
PCT Legal Examiner
Office of PCT Legal Administration

Jeremy Fleming
Paralegal Specialist
Office of PCT Legal Administration

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JSF/BM:jf

United States Patent and Trademark Office

UNITED STATES DEPARTMENT OF COMMERCE

Commissioner for Patents
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14 AUG 2006

DANIEL L. DAWES
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IRVINE, CALIFORNIA 92612

In re Application of
California Institute of Technology
PCT No.: PCT/US05/16116
Int. Filing Date: 06 May 2005
Claimed Priority Date: 05 May 2004
Attorney's Docket No.: CIT1.PAU.54 PCT
For: Four-Dimensional Imaging Of Periodically Moving Objects Via Post-Acquisition Synchronization Of Nongated Slice-Sequences

DECISION ON PETITION

This is in response to applicants' "Response To Invitation To Correct Defects In The International Application" filed on 14 September 2005, which is being treated under 37 CFR 1.10(d).

BACKGROUND

Applicants filed this international application with the United States receiving Office via "Express Mail."

On 14 June 2005, a Notification Of The International Application Number And Of The International Filing Date (Form PCT/RO/105) indicating an international filing date of 06 May 2005 was mailed to applicants.

DISCUSSION

Petitioner requests that this international application be accorded an international filing date of 05 May 2005, rather than 06 May 2006 as indicated on Form PCT/RO/105.

37 CFR 1.10(d) provides that

> Any person filing correspondence under this section that was received by the Office and delivered by the "Express Mail Post Office to Addressee" service of the USPS, who can show that the "date-in" on the "Express Mail" mailing label or other official notation entered by the USPS was incorrectly entered or omitted by the USPS, may petition the Director to accord the correspondence a filing date as of the date the correspondence is shown to have been deposited with the USPS, provided that:
>
> (1) The petition is filed promptly after the person becomes aware that the Office has accorded, or will accord, a filing date based upon an incorrect entry by the USPS;
>
> (2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original

PCT/US05/16116 11 JUL 2006

mailing by "Express Mail", and

(3) The petition includes a showing which establishes, to the satisfaction of the Director, that the requested filing date was the date the correspondence was deposited in the "Express Mail Post Office to Addressee" service prior to the last scheduled pickup for that day. Any showing pursuant to this paragraph must be corroborated by evidence from the USPS or that came into being after deposit and within one business day of the deposit of the correspondence in the "Express Mail Post Office to Addressee" service of the USPS.

The instant petition complies with 37 CFR 1.10(d)(1).

The petition complies with 37 CFR 1.10(d)(2) because an Express Mail mailing label number, EV553224953US, was recorded on the Transmittal Letter which accompanied and itemized the filing of this international application (the original copy of which is present in the application file).

Regarding 37 CFR 1.10(d)(3), counsel urges that the "date-in" of "5 6 05" appearing on the Express Mail mailing label was recorded "clearly by error." Counsel questions the "date-in" recorded by the USPS as inconsistent with the date stamped on the included return postcard receipt, "Rec'd PCT/PTO 06 MAY 2005." Petitioner includes no further evidence pertaining to the date of deposit of the correspondence with the USPS. However, the "Track & Confirm" page from the USPS Web site corresponding to Express Mail parcel EV553224953US indicates that this parcel was accepted by the USPS as Express Mail on "May 6, 2005," and that it was subsequently "Delivered, May 09, 2005, 5:51 am, ALEXANDRIA, VA 22313." It appears that the associated return postcard receipt was then stamped with the Express Mail "date-in" of 06 May 2005, rather than the 09 May 2005 date of physical receipt, in accordance with normal USPTO procedure. Therefore, the "date-in" on the Express Mail mailing label and the date stamped on the return postcard receipt are not in conflict. In the absence of acceptable further evidence demonstrating that the "date-in" was recorded erroneously, it would not be appropriate to consider 37 CFR 1.10(d)(3) to have been satisfied at this time.

DECISION

Applicants' petition is **DISMISSED**, without prejudice.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Mail Stop PCT, P.O. Box 1450, Alexandria, VA 22313-1450, with the contents of the letter marked to the attention of the PCT Legal Office.

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PCT Legal Examiner
Office of PCT Legal Administration

George M. Dombroske
PCT Legal Examiner
Office of PCT Legal Administration
Tel: (571) 272-3283
Fax: (571) 273-0459

enc: Copy of "Track & Confirm" page for EV553224953US

PCT/US05/16315 - 3 AUG 2006

UNITED STATES POSTAL SERVICE

Track & Confirm

Search Results

Label/Receipt Number: **EV55 3224 953U S**
Detailed Results:

- **Delivered, May 09, 2005, 5:51 am, ALEXANDRIA, VA 22313**
- **Arrival at Pick-Up-Point, May 07, 2005, 9:00 am, ALEXANDRIA, VA 22313**
- **Arrival at Unit, May 07, 2005, 8:46 am, DULLES, VA 20102**
- **Enroute, May 06, 2005, 4:53 pm, SANTA ANA, CA 92799**
- **Acceptance, May 06, 2005, 4:20 pm, NEWPORT BEACH, CA 92658**

< Back

Return to USPS.com Home >

Track & Confirm

Enter Label/Receipt Number.

Notification Options

Proof of Delivery

Verify who signed for your item by email, fax, or mail. Go >

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20 SEP 2007

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DANIEL L. DAWES
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19900 MACARTHUR BOULEVARD, SUITE 1150
IRVINE, CALIFORNIA 92612

In re Application of	
CALIFORNIA INSTITUTE OF TECHNOLOGY et al.	DECISION
PCT No.: PCT/US05/16116	
Int. Filing Date: 06 May 2005	ON PETITION
Priority Date: 05 May 2004	
Attorney's Docket No.: CIT1.PAU.54 PCT	UNDER 37 CFR 1.10(d)
For: Four-Dimensional Imaging Of Periodically Moving Objects Via Post-Acquisition Synchronization Of Nongated Slice-Sequences	

This decision is in response to applicant's "Petition For Reconsideration Of Dismissal Of Petition In Response To Invitation To Correct Defects In The International Application," filed on 01 September 2006, which has been treated as a petition under 37 CFR 1.10(d), requesting correction of the international filing date to accord a date of 05 May 2006 to the above-identified application.

BACKGROUND

The United States Receiving Office (RO/US) accorded an international filing date of 06 May 2005 to the above-identified application.

On 14 June 2005, the United States Receiving Office (RO/US) mailed, *inter alia*, a "Notification Of The International Application Number And Of The International Filing Date" (Form PCT/RO/105) indicating an international filing date of 06 May 2007.

On 14 September 2005, applicant filed a first petition requesting correction of the international filing date to accord a date of 05 May 2005 to the above-identified application. The petition included a copy the Customer receipt of the USPS "Express Mail" label showing Express Mail label number "EV 553224953 US and a "Date-In" of "5-6-05" (06 May 2005) and, a copy of the postcard receipt showing a USPTO date stamp of "06 MAY 2005."

On 14 August 2006, the Office mailed a "Decision on Petition" dismissing the petition because applicants did not provide sufficient evidence that the "Date-In" was recorded erroneously.

On 01 September 2006, applicants filed the instant "Petition For Reconsideration Of Dismissal Of Petition In Response To Invitation To Correct Defects In The International Application." The petition included a declaration by Ms. Jo Ann Breen (person who has first-hand knowledge of preparing and placing the instant application in the DDS courier box), a declaration by Ms. Sheri Malang (office manager of DDS attorney copy and messenger service) and a copy of the work order generated by DDS on 05 May 2005.

DISCUSSION

37 CFR 1.10(d) provides that

> Any person filing correspondence under this section that was received by the Office and delivered by the "Express Mail Post Office to Addressee" service of the USPS, who can show that the "date-in" on the "Express Mail" mailing label or other official notation entered by the USPS was incorrectly entered or omitted by the USPS, may petition the Director to accord the correspondence a filing date as of the date the correspondence is shown to have been deposited with the USPS, provided that:
>
> (1) The petition is filed promptly after the person becomes aware that the Office has accorded, or will accord, a filing date based upon an incorrect entry by the USPS;
>
> (2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail"; and
>
> (3) The petition includes a showing which establishes, to the satisfaction of the Director, that the requested filing date was the date the correspondence was deposited in the "Express Mail Post Office to Addressee" service prior to the last scheduled pickup for that day. Any showing pursuant to this paragraph must be corroborated by evidence from the USPS or that came into being after deposit and within one business day of the deposit of the correspondence in the "Express Mail Post Office to Addressee" service of the USPS.

As presented in the "Decision on Petition," mailed 14 August 2006, applicants have satisfied 37 CFR 1.10(d)(1) and 37 CFR 1.10(d)(2).

With regard to 37 CFR 1.10(d)(3), petitioner reiterates that the USPS made an error when recording a "Date-In" of 06 May 2007 on the Customer receipt of the USPS "Express Mail" label. According to petitioner, the correct "Date-In" is 05 May 2007. As evidence, petitioner provides the declarations of Ms. Jo Ann Breen, a person having first-hand knowledge of preparing and placing the instant application in the DDS courier box on 05 May 2007, and Ms. Sheri Malang, office manager of DDS (attorney copy and messenger service), who's employee, Mr. Peter Phan, purportedly collected the instant application and deposited it into an Express Mail Drop Box in front of the US Post Office on 05 May 2007. As further evidence, petitioner provides a copy of the work order created by DDS on 05 May 2005.

As presented in the "Decision on Petition," mailed 14 August 2006, because both the Customer receipt of the USPS "Express Mail" label and the copy of the postcard receipt show the same date of 06 May 2005, a conflict as to the deposit date does not exist. Further, the indication of the "Express Mail" label number ("EV 55322495 US ") appearing on the Transmittal Letter ties the Customer receipt of the USPS "Express Mail" label and the Transmittal Letter together, such that it appears that the international application was deposited on 06 May 2005.

MPEP §513 (II) states that,

> Parties who do use drop boxes can protect themselves from uncertainty due to illegible mailing labels by routinely maintaining a log of "Express Mail" deposits in which notations are entered by the person who deposited the correspondence as "Express Mail" within one business day after deposit with the USPS. ...Evidence that came into being after deposit and within one day after the deposit of the correspondence as "Express Mail" may be in the form of a log book which contains information such as the "Express Mail" number; the application number, attorney docket number or other such file identification number; the place, date and time of deposit; the time of the last scheduled pick-up for that date and place of deposit; the depositor's initials or signature; and the date and time of entry in the log.

In this case, petitioner has not provided any evidence that resembles a log book containing the information mentioned in MPEP §513 (II). The declaration of Ms. Jo Ann Breen, a person having first-hand knowledge of preparing and placing the instant application in the DDS courier box on 05 May 2007, does not provide new evidence that the instant application was deposited with the USPS on 05 May 2005. At most, the declaration merely shows that the instant application was deposited with the DDS courier service on 05 May 2007. Similarly, the declaration of Sheri Malang, office manager of DDS attorney copy and messenger service, does not provide new evidence that the instant application was deposited with the USPS on 05 May 2005. The declaration merely states that DDS employee Mr. Peter Phan, collected the instant application and allegedly deposited it into an Express Mail Drop Box in front of the US Post Office on 05 May 2007. No evidence is provided when he actually deposited the instant application with the USPS. With regard to the copy of the work order created by DDS on 05 May 2005, although it shows that such an order was placed on 05 May 2005, it does not add any additional information as to when the application papers were actually deposited with the USPS.

Based on the totality of the evidence currently of record, it would not be appropriate to consider the requirements of 37 C.F.R. 1.10(d) to have been satisfied.

CONCLUSION

Applicant's petition requesting that the application papers be accorded an international filing date of **05 May 2006** is **DISMISSED**, without prejudice, for the reasons described *supra*.

The International Filing Date of the instant international application remains **06 May 2007**.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 1.10(d)."

Any further correspondence with respect to this matter deposited with United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

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MICHAEL A. GLENN
GLENN PATENT GROUP
3475 EDISON WAY, STE. L.
MENLO PARK, CA 94025

In re Application of	:	DECISION ON
NANONEXUS, INC.	:	
PCT No.: PCT/US05/17881	:	PETITION
Int. Filing Date: 20 May 2005	:	
Priority Date: 20 May 2004	:	
Attorney's Docket No.: NNEX01CIP3-P	:	
For: HIGH DENSITY INTERCONNECT SYSTEM HAVING RAPID FABRICATION CYCLE	:	

This decision is in response to both applicant's "Petition For Designated State Correction" filed via facsimile transmission on 10 November 2006 and applicant's "Renewed Petition for Designated State Correction" filed via facsimile transmission on 11 January 2007, which have properly been treated as a single petition under 37 CFR 1.181.

BACKGROUND

On 05 July 2005, the United States Receiving Office (RO/US) mailed a NOTIFICATION OF THE INTERNATIONAL APPLICATION NUMBER AND OF THE INTERNATIONAL FILING DATE (Form PCT/RO/105) according the application and international filing date of 20 May 2005 and a priority date of 20 May 2004.

On 10 November 2006, applicants submitted a "Petition for Designated State Correction" via facsimile transmission.

On 11 January 2007, applicants filed a "Renewed Petition for Designated State Correction" which was accompanied by, *inter alia*, a letter dated 20 November 2006 from Jae H. Kim, Senior Legal Officer, PCT Legal Affairs Section, WIPO. The submissions filed 10 November 2006 and 11 January 2007 have properly been treated as a single petition under 37 CFR 1.181.

DISCUSSION

The petition requests that the United States Receiving Office (RO/US) issue a form indicating that Republic of Korea (KR) is a designated state. As noted above, in Box No. V on page 4 of the Request filed 20 May 2005, the boxes were checked. The Request indicates that the checking of the Boxes signifies that the countries listed next to each box, Germany, the Republic of Korea, and the Russian Federation, are not designated for any kind of national

protection.

Since the instant application did not contain a priority claim to an earlier application in any of the States listed in Box No. V of the Request filed 20 May 2005 (including KR), applicant should not have been able to indicate any of the States as not designated. Accordingly, the indication that the States listed in Box No. V are not designated is hereby CANCELLED EX OFFICIO BY THE RO/US. A form PCT/RO/146 and a corrected sheet No. 4 of the Request are attached. See PCT Receiving Office Guidelines (March 7, 2006), paragraph 102.

The letter dated 20 November 2006 has been considered. As noted above, the Request has been corrected to indicate that Germany (DE), Republic of Korea (KR) and Russian Federation (RU) are designated States.

CONCLUSION

For the reasons set forth above, the petition under 37 CFR 1.181 is **GRANTED**.

Germany (DE), Republic of Korea (KR) and Russian Federation (RU) are designated States.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

The application is being forwarded to PCT Central Files for storage.

Daniel Stemmer
Legal Examiner
PCT Legal Affairs
Office of Patent Cooperation Treaty
Legal Administration
Telephone: (571) 272-3301
Facsimile: (571) 273-0459

Enc.: Form PCT/RO/146 and corrected sheet No. 4 of the Request

CC: International Burea of WIPO

16 JUN 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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Alexandria, VA 22313-1450
www.uspto.gov

GARTH JANKE
BIRDWELL & JANKE, LLP
1100 SW SIXTH AVENUE, SUITE 1400
PORTLAND OR OREGON 97204

In re Application of	:	
HYDRACOOL Inc.	:	DECISION ON
PCT No.: PCT/US05/18300	:	
Int. Filing Date: 18 July 2005	:	PETITION
Priority Date: 28 May 2004	:	
Docket No.: P1112.15005	:	UNDER 37 CFR 1.181
For: HYDRAULIC POWER UNIT FOR A REFRIGERATION SYSTEM	:	

This is a decision on applicant's "Petition Under 37 CFR 1.181," filed in the United States Patent and Trademark Office on 28 November 2005.

BACKGROUND

On 24 May 2005, applicant filed a request, fee calculation sheet and drawings, accompanied by, *inter alia*, a check for $1838.

On 06 July 2005, the Office mailed Invitation to Correct the Purported International Application (Form PCT/RO/103) indicating that the application did not have a part which on the face of it appears to be a description or a part which on the face of it appears to be a claim or claims. It indicated that the international filing date would be the date on which the corrections were received, provided the corrections were received within one month of the mailing.

On 18 July 2005, applicant filed a petition claiming that the description, claims and abstract were present at filing and requesting that the application be accorded an international filing date of 24 May 2005.

On 03 October 2005, the Office mailed Decision On Petition Under 37 CFR 1.181, dismissing applicant's petition without prejudice.

On 28 November 2005, applicant submitted a renewed petition under 37 CFR 1.181.

DISCUSSION

A petition under 37 CFR 1.181 to accord a receipt date to paperwork that applicant claims was lost by the Office must be accompanied by (1) a true copy of what applicant claims was originally submitted and (2) proof that the paperwork was submitted on a particular date.

Item (1) was previously satisfied.

Item (2) has not been met. Applicant has not provided sufficient proof that the papers were included with the 24 May 2005 submission, to overcome the record of the Office. Actions of the Patent and Trademark Office are based exclusively on the written record in the Office. 37 CFR 1.2. Applicant is attempting to overcome the record and contends that the record is missing documents that the applicant submitted. Applicant submitted a postcard receipt with the original submission, but it was annotated by the Office to indicate that items listed on it were not received. As such, the postcard cannot function as *prima facie* evidence of receipt of those items by the Office. MPEP 503. In the absence of a postcard receipt showing receipt, applicant must still prove that the papers alleged to have been submitted were in the package at filing. Applicant's recollection and a recitation of applicant's standard business practice are not sufficient to overcome the Office's record.

CONCLUSION

For the above reasons, applicant's petition under 37 CFR 1.181 is **DISMISSED** without prejudice.

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

The application is being returned to RO/US for continued processing.

Erin P. Thomson

Erin P. Thomson
Attorney Advisor
PCT Legal Administration

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UNITED STATES PATENT AND TRADEMARK OFFICE

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06 SEP 2007

GARTH JANKE
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PORTLAND OR OREGON 97204

In re Application of	
HYDRACOOL Inc.	
PCT No.: PCT/US05/18300	DECISION ON
Int. Filing Date: 18 July 2005	PETITION
Priority Date: 28 May 2004	
Docket No.: P1112.15005	UNDER 37 CFR 1.181
For: HYDRAULIC POWER UNIT FOR A REFRIGERATION SYSTEM	

This is a decision on applicant's "Petition Under 37 CFR 1.181," filed in the United States Patent and Trademark Office on 28 November 2005.

BACKGROUND

On 16 June 2006, the Office mailed Decision On Petition Under 37 CFR 1.181, dismissing applicant's petition without prejudice.

On 20 October 2006, applicant filed this renewed petition under 37 CFR 1.181.

DISCUSSION

A petition under 37 CFR 1.181 to accord a receipt date to paperwork that applicant claims was lost by the Office must be accompanied by (1) a true copy of what applicant claims was originally submitted and (2) proof that the paperwork was submitted on a particular date.

Item (1) was previously satisfied.

Item (2) has not been met. Applicant's self-serving recitations of regular business practice are not sufficient to overcome the official record of the Office. Applicant argues that Ms. Thomas could not possibly have failed to notice that 27 of 37 pages were missing, but does not substantiate this claim. The package sent to the Office via USPS had a weight of 5 ounces. The mailer is located in the file. According to a mail scale available to the undersigned, the 27 pages that applicant claims were included with the originally filed package weigh approximately 4.5 ounces. The mailer alone, without the original contents, weighs more than one ounce. Ms. Thomas' assertions and recollection are not supported by either Office records or evidence from USPS.

In view of the above, it appears highly unlikely that the 27 pages were included with the original submission. Applicant's version requires that USPS incorrectly weighed applicant's package, that the Office then lost 27 pages of applicant's incorrectly weighed

submission and that the Office then annotated the post card after the pages were lost to indicate that they were missing. The more likely option, supported by the application file and evidence from USPS is that applicant is mistaken as to the contents of the package sent to the Office on 24 May 2005.

CONCLUSION

For the above reasons, applicant's petition under 37 CFR 1.181 is **DISMISSED** without prejudice.

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

The application is being returned to RO/US for continued processing.

Erin P. Thomson
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In re Application of	:	
HYDRACOOL Inc.	:	
PCT No.: PCT/US05/18300	:	DECISION ON
Int. Filing Date: 18 July 2005	:	PETITION
Priority Date: 28 May 2004	:	
Docket No.: P1112.15005	:	UNDER 37 CFR 1.181
For: HYDRAULIC POWER UNIT FOR A REFRIGERATION SYSTEM	:	

This is a decision on applicant's "Petition Under 37 CFR 1.181," filed in the United States Patent and Trademark Office on 28 November 2005.

BACKGROUND

On 24 May 2005, applicant filed a request, fee calculation sheet and drawings, accompanied by, *inter alia*, a check for $1838.

On 06 July 2005, the Office mailed Invitation to Correct the Purported International Application (Form PCT/RO/103) indicating that the application did not have a part which on the face of it appears to be a description or a part which on the face of it appears to be a claim or claims. It indicated that the international filing date would be the date on which the corrections were received, provided the corrections were received within one month of the mailing.

On 18 July 2005, applicant filed a petition claiming that the description, claims and abstract were present at filing and requesting that the application be accorded an international filing date of 24 May 2005.

On 03 October 2005, the Office mailed Decision On Petition Under 37 CFR 1.181, dismissing applicant's petition without prejudice.

On 28 November 2005, applicant submitted a renewed petition under 37 CFR 1.181.

DISCUSSION

A petition under 37 CFR 1.181 to accord a receipt date to paperwork that applicant claims was lost by the Office must be accompanied by (1) a true copy of what applicant claims was originally submitted and (2) proof that the paperwork was submitted on a particular date.

Item (1) was previously satisfied.

Item (2) has not been met. Applicant has not provided sufficient proof that the papers were included with the 24 May 2005 submission, to overcome the record of the Office. Actions of the Patent and Trademark Office are based exclusively on the written record in the Office. 37 CFR 1.2. Applicant is attempting to overcome the record and contends that the record is missing documents that the applicant submitted. Applicant submitted a postcard receipt with the original submission, but it was annotated by the Office to indicate that items listed on it were not received. As such, the postcard cannot function as *prima facie* evidence of receipt of those items by the Office. MPEP 503. In the absence of a postcard receipt showing receipt, applicant must still prove that the papers alleged to have been submitted were in the package at filing. Applicant's recollection and a recitation of applicant's standard business practice are not sufficient to overcome the Office's record.

CONCLUSION

For the above reasons, applicant's petition under 37 CFR 1.181 is **DISMISSED** without prejudice.

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

The application is being returned to RO/US for continued processing.

Erin P. Thomson

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PCT/US2005/018300 19.09.2006

03 OCT 2005

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GARTH JANKE
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In re Application of HYDRACOOL Inc. PCT No.: PCT/US05/18300 Int. Filing Date: 18 July 2005 Priority Date: 28 May 2004 Docket No.: P1112.15005 For: HYDRAULIC POWER UNIT FOR A REFRIGERATION SYSTEM	DECISION ON PETITION UNDER 37 CFR 1.181

This is a decision on applicant's "Response to Correct International Application," filed in the United States Patent and Trademark Office on 18 July 2005. It has been treated as a petition under 37 CFR 1.181.

BACKGROUND

On 24 May 2005, applicant filed a request, fee calculation sheet and drawings, accompanied by, *inter alia*, a check for $1838.

On 06 July 2005, the Office mailed Invitation to Correct the Purported International Application (Form PCT/RO/103) indicating that the application did not have a part which on the face of it appears to be a description or a part which on the face of it appears to be a claim or claims. It indicated that the international filing date would be the date on which the corrections were received, provided the corrections were received within one month of the mailing.

On 18 July 2005, applicant filed the instant petition claiming that the description, claims and abstract were present at filing and requesting that the application be accorded an international filing date of 24 May 2005.

DISCUSSION

A petition under 37 CFR 1.181 to accord a receipt date to paperwork that applicant claims was lost by the Office must be accompanied by (1) a true copy of what applicant claims was originally submitted and (2) proof that the paperwork was submitted on a particular date.

Item (1) has been met. Applicant has submitted claims, description and an abstract that applicant claims were earlier submitted.

Item (2) has not been met. Applicant has provided no proof that the papers were included with the 24 May 2005 submission. The annotated postcard receipt is still with the

file. It will be mailed with this decision. The postcard receipt is initialed and annotated indicating that the claims, description and abstract were not with the application when file. The annotated postcard does not serve as *prima facie* evidence of receipt by the Office of the item that was annotated. MPEP 503. In the absence of a postcard receipt showing receipt, applicant must still prove that the papers were in the package at filing. Applicant has not done so.

CONCLUSION

For the above reasons, applicant's petition under 37 CFR 1.181 is **DISMISSED** without prejudice.

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

The application is being returned to RO/US for continued processing, including mailing of a Notification of the International Application Number and of the International Filing Date indicating that the international filing date is 18 July 2005.

Erin P. Thomson

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Attorney Advisor
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22 DEC 2006

GEORGE DACAI LIU
1029 BRASSINGTON DRIVE
COLLEGEVILLE, PA 19426

In re Application of:
LIU, George, Dacai
PCT No.: PCT/US2005/019939
Receipt Date: 07 June 2005
Priority Date Claimed: 17 June 2004
Attorney's Docket No.: 1000-P01PCT
For: SYSTEM AND METHOD FOR ANTIGEN STRUCTURE-INDEPENDENT DETECTION OF ANTIGENS CAPTURED ON ANTIBODY ARRAYS

COMMUNICATION

This communication is issued in response to applicant's "Response To Invitation To Correct The Purported International Application" filed 13 November 2006. No petition fee is required.

BACKGROUND

On 07 June 2005, applicant filed materials intended to initiate the present international application. These materials were assigned application number PCT/US2005/009939. The materials filed 07 June 2005 are the following: (1) Request (Form PCT/RO/101); (2) Fee Calculation Sheet (Form PCT/RO/101 Annex); and (3) Transmittal Letter (Form PTO-1382). The Request form includes a priority claim to U.S. application number 10/870,766, filed 17 June 2004.

On 09 November 2006, the United States Receiving Office (RO/US) mailed an "Invitation To Correct The Purported International Application" (Form PCT/RO/103) which stated that the application materials filed 07 June 2005 had not been accorded an international filing date because the filed materials did not contain a part which on its face appears to be a description or a part which on its face appears to be a claim or claims." The Form PCT/RO/103 indicated that the date on which a correction of this defect was received would be the international filing date for the present application, if such a response was received within one month of mail date of the Form PCT/RO/103.

On 13 November 2006, applicant filed the response considered herein. The submission includes thirteen pages of description, 3 pages of claims (listing 20 claims), and a one page abstract.

DISCUSSION

As noted above, the application as filed in June 2005 did not include a description or claims, both of which are required in order for an application to be accorded an international filing date (see PCT Article 11). The description and claims were first filed in the present application on 13 November 2006, as part of the "Response To Invitation To Correct The Purported International Application" considered herein. Because these materials were submitted within one month of the mail date of the "Invitation To Correct The Purported International Application," these materials will be made of record in the present application, with the international filing date being 13 November 2006 (see PCT Rule 20.2).

Because the international filing date for the present application, 13 November 2006, is more than twelve months after the claimed priority date of 17 June 2004, such priority claim is defective (see PCT Rule 4.10(a)(i)).

In order for the priority claim to be acceptable here, applicant would need to file a grantable petition to correct the international filing date to 07 June 2005, a date within twelve months of the priority date and the date on which the Request and fees were filed herein. Such a petition would need to include a showing that the specification and claims were included with the original application materials filed 07 June 2005 (i.e., a return postcard that itemizes the specification and claims and bears a USPTO receipt stamp dated 07 June 2005). Absent such a grantable petition, the present application will be processed with an international filing date of 13 November 2006, and no valid priority claim.

Publication of the application would occur approximately 18 months from the international filing date.

Finally, in response to applicant's inquiry in the present correspondence, the PCT does not include a mechanism for making substantive amendments to the specification and claims of an international application prior to publication and the international search.[1]

CONCLUSION

The specification and claims filed 13 November 2006 will be entered into the present application.

The international filing date is 13 November 2006.

The priority claim is defective for failure to fall within twelve months of the international filing date.

The application is being referred to the United States Receiving Office for further processing in accordance with this decision, including the mailing of a "Notification Of The

[1] See PCT Article 19 regarding amendment of claims after the international search, and PCT Article 34 regarding amendment of the specification and/or claims during Chapter II of the PCT.

International Application Number And Of The International Filing Date" (Form PCT/RO/105) confirming the international filing date as 13 November 2006.

Any further submission with respect to the international filing date should be submitted to Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Richard M. Ross
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17 MAY 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

GEORGE DACAI LIU
1029 BRASSINGTON DRIVE
COLLEGEVILLE PA 19426

In re Application of	:	DECISION ON
LIU, George, Dacai	:	
PCT No.: PCT/US2005/019939	:	PETITION
Receipt Date: 07 June 2005	:	
Priority Date Claimed: 17 June 2004	:	
Attorney's Docket No.: 1000-P01PCT	:	
For: SYSTEM AND METHOD FOR ANTIGEN STRUCTURE-INDEPENDENT DETECTION OF ANTIGENS CAPTURED ON ANTIBODY ARRAYS	:	

This decision is in response to applicant's filed via facsmile transmission on 16 January 2007, which has properly been treated as a petition under 37 CFR 1.181.

BACKGROUND

On 07 June 2005, applicant filed international application papers. These papers were assigned application number PCT/US2005/019939. The papers filed were the following: (1) Request (Form PCT/RO/101); (2) Fee Calculation Sheet (Form PCT/RO/101 Annex); and (3) Transmittal Letter (Form PTO-1382). The Request form includes a priority claim to U.S. application number 10/870,766, filed 17 June 2004.

On 09 November 2006, the United States Receiving Office (RO/US) mailed an INVITATION TO CORRECT THE PURPORTED INTERNATIONAL APPLICATION (Form PCT/RO/103) which stated that the application papers filed 07 June 2005 had not been accorded an international filing date because the papers did not contain "a part which on its face appears to be a description" and did not contain "a part which on its face appears to be a claim or claims."

On 13 November 2006, applicant filed a submission which was accompanied by 13 pages of description, 3 pages of claims (listing 20 claims), and a one page abstract.

On 22 December 2006, a Communication was mailed indicating that an international filing date of 13 November 2006 had been accorded the instant application pursuant to PCT Rule 20.2. The Communication also noted that applicant's priority claim was defective for failure to fall within twelve months of the international filing date. The decision indicated that, in order for the priority claim to be acceptable, applicant would need to file a grantable petition to correct the

international filing date to 07 June 2005. The Communication indicated that an itemized postcard receipt for the description and claims date-stamped 07 June 2005 by the USPTO would be sufficient.

On 16 January 2007, applicant filed the instant submission requesting that the international filing date be changed to 07 June 2005. The submission has properly been treated as a petition under 37 CFR 1.181.

DISCUSSION

The best evidence of what was actually received by the Office is a postcard receipt containing a specific itemization of all the items being submitted. A review of the application file reveals that the originally filed application papers did not include a specification or claims. As noted in MPEP § 503, "all parts of the application being submitted should be separately listed on the postcard, e.g., the number of pages of specification (including written description, claims and abstract), number of claims, number of sheets of drawings, number of pages of oath/declaration, number of pages of cover sheet (provisional application)" and the postcard receipt will not serve as *prima facie* evidence of receipt if any item is not properly itemized, including "missing portions (e.g., pages, sheets of drawings) of an application if one of the components or portion of a component is found to be missing by the USPTO." As noted in MPEP § 513:

> [w]here the records of the Office (e.g., the file of the application) contain any document(s) or fee(s) corresponding to the contents of the correspondence at issue, the Office will rely upon its official record of the contents of such correspondence in absence of convincing evidence (e.g., a postcard receipt under MPEP § 503 containing specific itemization of the document(s) or fee(s) purported to have been filed with the correspondence at issue) that the Office received and misplaced any document(s) or fee(s) that is not among the official records of the Office.

No such postcard receipt has been provided. Indeed, it is not even urged that the description and claims were present on filing.

What is urged is that the delay in the time from when the application papers were first filed until the INVITATION TO CORRECT THE PURPORTED INTERNATIONAL APPLICATION was mailed is responsible for applicant's priority claim being defective and that this delay was in violation of PCT Rule 20.4(a). The application papers were filed 07 June 2005. Unfortunately, no paper was mailed by the RO/US until the INVITATION TO CORRECT THE PURPORTED INTERNATIONAL APPLICATION was mailed on 09 November 2006. The delay is regretted. However, PCT Article 11 requires that the international application contain "a part which on the face of it appears to be a description" and "a part which on the face of it appears to be a claim or claims" in order for the receiving Office to accord the application papers an international filing date. Thus, the RO/US cannot accord the instant international application an international filing date any earlier than 13 November 2006.

CONCLUSION

For the reasons set forth above, the renewed petition under 37 CFR 1.181 to change the international filing date to 07 June 2005 is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper reply must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.181."

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

The application is being referred to the RO/US for further processing in accordance with this decision, including the mailing of a NOTIFICATION OF THE INTERNATIONAL APPLICATION NUMBER AND OF THE INTERNATIONAL FILING DATE (Form PCT/RO/105) confirming the international filing date as 13 November 2006.

Daniel Stemmer
Legal Examiner
PCT Legal Affairs
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Legal Administration
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Facsimile: (571) 273-0459

0 1 OCT 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

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GEORGE DACAI LIU
1029 BRASSINGTON DRIVE
COLLEGEVILLE PA 19426

In re Application of	:	DECISION ON
LIU, George, Dacai	:	
PCT No.: PCT/US2005/019939	:	PETITION
Receipt Date: 07 June 2005	:	
Priority Date Claimed: 17 June 2004	:	
Attorney's Docket No.: 1000-P01PCT	:	
For: SYSTEM AND METHOD FOR ANTIGEN STRUCTURE-INDEPENDENT DETECTION OF ANTIGENS CAPTURED ON ANTIBODY ARRAYS	:	

This decision is in response to applicant's renewed petition under 37 CFR 1.181 filed via facsmile transmission on 16 July 2007.

BACKGROUND

On 07 June 2005, applicant filed international application papers. These papers were assigned application number PCT/US2005/019939. The papers filed were the following: (1) Request (Form PCT/RO/101); (2) Fee Calculation Sheet (Form PCT/RO/101 Annex); and (3) Transmittal Letter (Form PTO-1382). The Request form includes a priority claim to U.S. application number 10/870,766, filed 17 June 2004.

On 09 November 2006, the United States Receiving Office (RO/US) mailed an INVITATION TO CORRECT THE PURPORTED INTERNATIONAL APPLICATION (Form PCT/RO/103) which stated that the application papers filed 07 June 2005 had not been accorded an international filing date because the papers did not contain "a part which on its face appears to be a description" and did not contain "a part which on its face appears to be a claim or claims."

On 13 November 2006, applicant filed a submission which was accompanied by 13 pages of description, 3 pages of claims (listing 20 claims), and a one page abstract.

On 22 December 2006, a Communication was mailed indicating that an international filing date of 13 November 2006 had been accorded the instant application pursuant to PCT Rule 20.2. The Communication also noted that applicant's priority claim was defective for failure to fall within twelve months of the international filing date. The decision indicated that, in order for the priority claim to be acceptable, applicant would need to file a grantable petition to correct the

international filing date to 07 June 2005. The Communication indicated that an itemized postcard receipt for the description and claims date-stamped 07 June 2005 by the USPTO would be sufficient.

On 16 January 2007, applicant filed a submission requesting that the international filing date be changed to 07 June 2005. The submission was properly treated as a petition under 37 CFR 1.181.

On 17 May 2007, a decision was mailed dismissing applicant's petition under 37 CFR 1.181 without prejudice. Specifically, it was noted that sufficient proof that a description and claims had been provided on 07 June 2005, such as an itemized postcard receipt, had not been provided and that pursuant to PCT Article 11 the RO/US could not accord the instant international application an international filing date any earlier than 13 November 2006.

On 16 July 2007, applicant submitted via facsimile transmission the instant renewed petition under 37 CFR 1.181.

DISCUSSION

The best evidence of what was actually received by the Office is a postcard receipt containing a specific itemization of all the items being submitted. A review of the application file reveals that the originally filed application papers did not include a specification or claims. As noted in MPEP § 503, "all parts of the application being submitted should be separately listed on the postcard, e.g., the number of pages of specification (including written description, claims and abstract), number of claims, number of sheets of drawings, number of pages of oath/declaration, number of pages of cover sheet (provisional application)" and the postcard receipt will not serve as *prima facie* evidence of receipt if any item is not properly itemized, including "missing portions (e.g., pages, sheets of drawings) of an application if one of the components or portion of a component is found to be missing by the USPTO." As noted in MPEP § 513:

> [w]here the records of the Office (e.g., the file of the application) contain any document(s) or fee(s) corresponding to the contents of the correspondence at issue, the Office will rely upon its official record of the contents of such correspondence in absence of convincing evidence (e.g., a postcard receipt under MPEP § 503 containing specific itemization of the document(s) or fee(s) purported to have been filed with the correspondence at issue) that the Office received and misplaced any document(s) or fee(s) that is not among the official records of the Office.

No such postcard receipt has been provided. The decision mailed 17 May 2007 noted that it was not even urged that the description and claims were present on filing. In the submission filed 16 July 2007, applicant states that he did not mention the postcard because he was under the impression that he should not do so since the postcard had been lost. Applicant also states that he did not mention the description and claims because without the substantiation of a postcard, applicant did not want to create an impression that applicant was accusing the USPTO of intentionally deleting the specification. However, as noted in the decision mailed 17

May 2007, without sufficient proof that the description and claims were filed on 07 June 2005, the RO/US cannot accord the instant international application an international filing date any earlier than 13 November 2006. Thus far, no proof has been provided.

Applicant urges that the RO/US misled the applicant by accepting the filing fee, assigning an international application number, and when calling the PCT Help Desk, applicant was told that the application was in process. However, the filing fee is accepted and an international application number assigned even if, as here, the application papers are not enough to accord the application an international filing date. The response by the PCT Help Desk is hearsay. Nevertheless, even assuming for the sake of arguement that what applicant purports he was told by the PCT Help Desk is true, an indication that the application was "in process" is not an indication that the application was in compliance with PCT Article 11.

Applicant also urges that the absence of a postcard receipt and the absence of a statement regarding the missing description and claims upon the original filing are "trivial now because . . . the loss of the priority claim for the present PCT application is TOTALLY caused by the USPTO's gross negligence." (Emphasis in original.) However, it is not clear that the loss of the priority claim is totally caused by the USPTO. First, it is not clear that applicant filed a description and claims on the day of filing. Second, to ensure receipt of the items submitted, applicant is encouraged to use an itemized postcard receipt. See MPEP § 503. It is asserted that applicant did so, but no proof has been provided. Third, applicant is encouraged upon return of a postcard receipt from the USPTO to promptly review it "to ensure that every item specifically denoted on the postcard was received by the USPTO." Assuming a postcard receipt was sent to applicant and later lost, it is not clear that applicant reviewed the postcard upon receipt. If the postcard itemized a description and claims and it was not annotated to indicate that the description and claims were missing, then it would serve as prima facie evidence of receipt of these items. MPEP § 503. If the postcard were annotated to indicate that these items were missing, this would have been notice to applicant that these items were still required. Thus, applicant's failure to retain the postcard receipt and/or verify that every item specifically denoted on the postcard receipt was received by the USPTO are also responsible for the loss of priority claim.

Finally, as noted in the previous decision, regardless of the delay in the time from when the application papers were first filed until the INVITATION TO CORRECT THE PURPORTED INTERNATIONAL APPLICATION was mailed, pursuant to PCT Article 11, the RO/US simply cannot accord the instant international application an international filing date any earlier than 13 November 2006. PCT Article 11 requires, among other things, that the international application contain "a part which on the face of it appears to be a description" and "a part which on the face of it appears to be a claim or claims" in order for the receiving Office to accord the application papers an international filing date. Since the earliest it has been established that these two missing items were received is 13 November 2006, that is the earliest international filing date that can be accorded.

CONCLUSION

For the reasons set forth above, the renewed petition under 37 CFR 1.181 to change the international filing date to 07 June 2005 is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper reply must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.181."

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

The application is being referred to the RO/US for further processing in accordance with this decision, including the mailing of a NOTIFICATION OF THE INTERNATIONAL APPLICATION NUMBER AND OF THE INTERNATIONAL FILING DATE (Form PCT/RO/105) confirming the international filing date as 13 November 2006.

Daniel Stemmer
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02 AUG 2007

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In re Application of	:	
GRANITEEDGE NETWORKS	:	DECISION ON
PCT Application No.: PCT/US05/23730	:	
International Filing Date: 28 June 2005	:	PETITION
Priority Date: 28 June 2004	:	
Attorney Docket No.: 112003-143533	:	UNDER 37 CFR 1.181
For: DETERMINING EVENT CASUALTY	:	

This decision is in response to applicant's "Petition Under 37 CFR 1.182," filed 06 February 2007. It has been treated as a petition under 37 CFR 1.181.

BACKGROUND

On 28 June 2005, applicant filed papers including three pages of Request, powers of attorney, description, claims and drawings, claiming a priority date of 28 June 2004, that were assigned international application number PCT/US05/23730.

On 26 August 2005, the Office mailed, *inter alia*, Invitation to Correct the Purported International Application (Form PCT/RO/103) indicating that the application does not contain the name of the applicant, as prescribed. It further indicated that the international filing date would be the date on which the missing information was received.

On 21 September 2005, applicant submitted the "first sheet" of the Request, with the listing of two applicants, including one applicant and inventor.

On 01 February 2006, the Office mailed Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) indicating that the international filing date was 21 September 2005.

On 06 February 2007, applicant filed this petition claiming that the application papers filed on 28 June 2005, though missing the first sheet of the Request, still contained indications of the applicants as required by Article 11 and that the papers should be accorded an international filing date of 28 June 2005.

DISCUSSION

A review of the application papers filed on 28 June 2005 reveals that they indicated two applicants. The Fee Calculation Sheet and the powers of attorney both list applicants. However, the papers did not indicate that at least one applicant was a resident or national of the United States. See 37 CFR 1.421(a). As such, applicant does not have the right to file an

international application in the RO/US. Therefore, the processing of the application by the RO/US, including the mailing of the both the Form PCT/RO/103 and the Form PCT/RO/105, was in error.

In accordance with PCT Rule 19.4, the present international application will be forwarded to the International Bureau for processing in its capacity as the receiving office. Also, in accordance with PCT Rule 19.4, RO/US will retain a fee in the amount equal to the transmittal fee, $300.

CONCLUSION

For the above reasons, applicant's petition under 37 CFR 1.181 arguing that Article 11 was satisfied on 28 June 2005 is **GRANTED**.

The Invitation to Correct the Purported International Application (Form PCT/RO/103) mailed 26 August 2005 is hereby **VACATED**.

Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) mailed 01 February 2006 is hereby **VACATED**.

Any further correspondence with respect to this matter should be addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

The above-identified application number PCT/US05/23730 is for USPTO tracking purposes only. The International Bureau will contact applicant regarding the issuance of a new International Application Number and regarding the payment of fees. This application is being forwarded to the United States Receiving Office for further processing consistent with this decision including refund of the fees other than the transmittal fee and for forwarding under PCT Rule 19.4.

Erin P. Thomson

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0 2 AUG 2007

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PORTLAND, OR 97204

In re Application of	:	
GRANITEEDGE NETWORKS	:	DECISION ON
PCT Application No.: PCT/US05/23730	:	
International Filing Date: 28 June 2005	:	PETITION
Priority Date: 28 June 2004	:	
Attorney Docket No.: 112003-143533	:	UNDER 37 CFR 1.181
For: DETERMINING EVENT CASUALTY	:	

This decision is in response to applicant's "Petition Under 37 CFR 1.182," filed 06 February 2007. It has been treated as a petition under 37 CFR 1.181.

BACKGROUND

On 28 June 2005, applicant filed papers including three pages of Request, powers of attorney, description, claims and drawings, claiming a priority date of 28 June 2004, that were assigned international application number PCT/US05/23730.

On 26 August 2005, the Office mailed, *inter alia*, Invitation to Correct the Purported International Application (Form PCT/RO/103) indicating that the application does not contain the name of the applicant, as prescribed. It further indicated that the international filing date would be the date on which the missing information was received.

On 21 September 2005, applicant submitted the "first sheet" of the Request, with the listing of two applicants, including one applicant and inventor.

On 01 February 2006, the Office mailed Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) indicating that the international filing date was 21 September 2005.

On 06 February 2007, applicant filed this petition claiming that the application papers filed on 28 June 2005, though missing the first sheet of the Request, still contained indications of the applicants as required by Article 11 and that the papers should be accorded an international filing date of 28 June 2005.

DISCUSSION

A review of the application papers filed on 28 June 2005 reveals that they indicated two applicants. The Fee Calculation Sheet and the powers of attorney both list applicants. However, the papers did not indicate that at least one applicant was a resident or national of the United States. See 37 CFR 1.421(a). As such, applicant does not have the right to file an

international application in the RO/US. Therefore, the processing of the application by the RO/US, including the mailing of the both the Form PCT/RO/103 and the Form PCT/RO/105, was in error.

In accordance with PCT Rule 19.4, the present international application will be forwarded to the International Bureau for processing in its capacity as the receiving office. Also, in accordance with PCT Rule 19.4, RO/US will retain a fee in the amount equal to the transmittal fee, $300.

CONCLUSION

For the above reasons, applicant's petition under 37 CFR 1.181 arguing that Article 11 was satisfied on 28 June 2005 is **GRANTED**.

The Invitation to Correct the Purported International Application (Form PCT/RO/103) mailed 26 August 2005 is hereby **VACATED**.

Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) mailed 01 February 2006 is hereby **VACATED**.

Any further correspondence with respect to this matter should be addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

The above-identified application number PCT/US05/23730 is for USPTO tracking purposes only. The International Bureau will contact applicant regarding the issuance of a new International Application Number and regarding the payment of fees. This application is being forwarded to the United States Receiving Office for further processing consistent with this decision including refund of the fees other than the transmittal fee and for forwarding under PCT Rule 19.4.

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15 FEB 2007

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In re Application of :
UNIVERSITY OF MARYLAND :
PCT No.: PCT/US05/24121 : DECISION UNDER
Int. Filing Date: 06 July 2005 : 37 CFR 1.181
Priority Date: 28 October 2004 :
Agent's File Reference: MR2833-54/PCT :
For: NAVIGATION SYSTEM AND METHODS :
USING MODULATED CELESTIAL :
RADIATION SOURCES

Applicants' 29 January 2007 communication is being treated as a petition under 37 CFR 1.181 requesting that the copy of the "Notification to Correct Priority Claim" accompanying the present petition be accepted in lieu of the original filed on 20 September 2005. No petition fee is required. The petition is **GRANTED** as follows:

BACKGROUND

On 06 July 2005, applicants filed international application PCT/US05/24121, which did not include a priority claim.

On 29 January 2007, applicants filed the present petition forwarding a copy of the "Notification to Correct Priority Claim" and a return receipt postcard indicating receipt thereof on 20 September 2005.

DISCUSSION

MPEP at section 503 provides that:

> *"A postcard receipt which itemizes and properly identifies the items which are being filed serves as prima facie evidence of receipt in the PTO of all the items listed thereon on the date stamped thereon by the PTO".*

A review of the papers filed with the present petition reveals that applicants have provided sufficient evidence that the "Notification to Correct Priority Claim" included with the present petition was filed on 20 September 2005. The petition indicates that the copy of the "Notification to Correct Priority Claim" attached thereto is a true copy of the original filed on

20 September 2005. The copy of the return receipt postcard itemizes "NOTIFICATION TO CORRECT PRIORITY CLAIM & CERTIFIED COPY". Accordingly, the copy of the "Notification to Correct Priority Claim" filed with the present petition may properly be **ACCEPTED** as having been filed on **20 September 2005.**

CONCLUSION

Applicants' petition under 37 CFR 1.181 is **GRANTED.**

The present application is being forwarded to the RO/US for the treating of the "Notification to Correct Priority Claim" as having been filed on 20 September 2005. Additionally, a "NOTIFICATION RELATING TO PRIORITY CLAIM" (Form PCT/RO/111) adding U.S. application 60/622,766 filed 28 October 2004 as a priority claim accompanies this decision.

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In re Application of :
CISCO TECHNOLOGY, INC. :
PCT No.: PCT/US05/27322 :
Int. Filing: 02 August 2005 :
Priority Date: 03 August 2004 : DECISION ON PETITION
Attorney Docket No.:72255/00115 :
For: RADAR PROTECTION DEVICE FOR WIRELESS NETWORKS :

This decision is issued in response to applicant's facsimile communication filed 16 March 2007, which is being treated as a petition under 37 CFR 1.181. No petition fee is due.

BACKGROUND

On 02 August 2005, applicant filed international application PCT/US05/27322, which claimed priority of an earlier US application filed 03 August 2004. The international application consisted of five sheets of Request, fifteen sheets of description, four sheets of claims, one sheet of abstract, eight sheets of drawings, fee calculation sheet, transmittal letter, and a PCT EASY diskette.

On 07 December 2005, the United States Receiving Office mailed the following: the Notification of Concerning Prescribed Fees (Form PCT/RO/102); Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105); and Invitation to Correct Defects in the International Application (Form PCT/RO/106).

On 09 March 2006, the World Intellectual Property Organization (WIPO) published the above-identified international application. Figure 5 (sheet 5/8 of the drawings) was not included in the publication as part of the international application.

On 16 March 2007, applicant filed present petition indicating that 8 drawing sheets were submitted with the above-identified application on 02 August 2005.

DISCUSSION

Applicant states in the present petition, ". . .the published application for the above-identified application is missing one of its drawings, specifically Figure 5. Figure 5 was submitted to the United States Patent and Trademark Office as is evidence by the stamped postcard indicating a total of eight (8) drawings. . ." Based on applicant's statements in the present petition and the itemized return postcard bearing the 02 August 2005 USPTO receipt stamp, it is concluded that the original application materials filed by applicant on 02 August 2005 included all eight sheets of drawings accompanying the present petition (including Figures 1-8). Accordingly, the fifth sheet of drawings, which contains Figure 5 and was not included in the published international application, is properly included in the present application and accorded a filing date of 02 August 2005.

CONCLUSION

Applicant's petition under 37 CFR 1.181 is **GRANTED**.

As evidenced by the application file, Figure 5 (sheet 5/8 of the drawings) was included with the original application papers filed 02 August 2005.

This application is being forwarded to the RO/US for further processing, including: (1) forwarding a copy of this decision to the International Bureau; (2) forwarding a copy of Figure 5 (sheet 5/8 of the drawings) to the International Bureau (IB) for inclusion in the published international application as filed; and (3) requesting WIPO to republish the above-identified application.

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UNITED STATES PATENT AND TRADEMARK OFFICE
PCT/US05/27929 - 29 SEP 2006

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29 SEP 2006

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In re Application of	
CAPITOL VIAL, Inc.	
PCT Application No.: PCT/US05/27929	DECISION ON
International Filing Date: 02 August 2005	
Priority Date: 28 July 2004	PETITION
Attorney Docket No.: 64762.011502	
For: CONTAINER FOR COLLECTING AND STORING BREAST MILK	UNDER 37 CFR 1.183

This decision is in response to applicant's "Petition Under 37 C.F.R. §1.183 to Accord A July 27, 2005 Filing Date to International Application No. PCT/US2005/27929," filed with the United States Patent and Trademark Office on 05 June 2006.

BACKGROUND

On 27 July 2005, applicant submitted a package to USPS. Applicant claims that it included a request, specification and fee calculation sheet for the above captioned application.

USPS returned the package to applicant for insufficient postage, calling for an additional $10.98.

On 02 August 2005, applicant filed a request, a fee calculation sheet, specification, and a petition under 37 CFR 1.10(e).

On 16 September 2005, the Office mailed Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) indicating that the application had been assigned an international filing date of 02 August 2005 and an Invitation to Correct Priority Claim (Form PCT/RO/110), indicating that the priority date did not fall within the 12 months prior to the international filing date.

On 03 October 2005, the Office mailed Decision On Petition Under 37 CFR 1.10(e), dismissing applicant's petition without prejudice and setting a two (2) month period for reply.

On 21 October 2005, applicant filed a "Request For Withdrawal of International Application Pursuant to Rule 90 *bis* and Request For Refund Pursuant to PCT Rule 15.6.

On 05 June 2006, applicant filed the instant petition under 37 CFR 1.183 to waive the provision of 37 CFR 1.10(e) requiring that a package be deposited with Express Mail with sufficient postage.

DISCUSSION

The 21 October 2005 Request to Withdraw the International Application Under Rule 90 *bis* is ineffective as the request was not signed by all of the applicants and was not accompanied by a power of attorney from all applicants appointing the person who signed the withdrawal request. As the application was not withdrawn, applicants are not entitled to a refund of the fees.

The instant petition is filed by David H. Brinkman, who claims to have filed a "Notification of Change of Agent" on 14 February 2006. No change to either the agent of record or the correspondence address is present in this application. Until such time, correspondence will be maintained with the current correspondence address.

Petition Under 37 CFR 1.183

Preliminarily, this petition is untimely. The 03 October 2005 decision set a two (2) month period for requesting reconsideration on the merits. Applicant filed the 21 October 2005 request to withdraw the international application, but did not request reconsideration on the merits of the 03 October 2005 decision until 05 June 2006. This is well past the two (2) month period for reconsideration. Applicant argues that they were unaware of the petition decision, however applicant acknowledges that applicant received it and it was mailed to the address of record. Further it would seem likely that the request to withdraw the international application was in response to the decision dismissing applicant's petition under 37 CFR 1.10(e). Though this petition is untimely, the Office will address the substance of the arguments as though they had been part of a timely petition for reconsideration.

Section 1.10(e) sets forth a petition procedure for use when an applicant mails correspondence via "Express Mail Post Office to Addressee" that is properly addressed under 37 CFR 1.1(a) to the Office with sufficient postage, but is not received by the Office. In such a circumstance, the Director may consider the correspondence filed in the Office on the USPS deposit date, provided listed circumstances are satisfied. Applicant acknowledges that applicant did not affix sufficient postage to the correspondence addressed to the Office, deposited with USPS on 27 July 2005 and that the package was returned by USPS marked "Returned For Add'l Postage $10.98."

Applicant argues that "the logic of Rule 1.10(e) is self-evident – if an applicant can clearly prove that correspondence was submitted to the USPS on a particular date, and that proof is not subject to question of doubt, then equity requires that the correspondence to be accorded that date as the filing date." This is not correct. Section (e) is intended to protect an applicant who, while exercising due care by properly addressing correspondence and affixing sufficient postage to it, relies on the ordinarily reliable and trustworthy agency of the mail. Should applicant follow the procedures set forth in 37 CFR 1.10, but through circumstances beyond applicant's control, the correspondence not be received by the Office, applicant will not be penalized for the reliance. Sufficient postage and proper address are only required for packages not received by the Office. Packages received, whether improperly addressed or lacking sufficient postage are not denied a filing date simply for lack of postage or improper address.

Applicant attempts to distinguish *Honigsbaum v. Lehman,* 903 F. Supp. 8 (D.D.C. 1995) and *Nitto Chemical Industry, Co. v. Comer*, 39 USPQ2d 1778 (D.D.C. 1994)(hereinafter "*Nitto*"), while relying on *In re Bachler,* 229 USPQ 553, a decision of the Commisioner of Patents, from March 13, 1986.

Applicant argues that *Honigsbaum* concerns the failure of that applicant to prove that their package was deposited with USPS. Applicant confuses the factual circumstance of *Honigsbaum*, with the rule of law from it. *Honigsbaum* concerned the application of 37 CFR 1.10(c), under which applicant is required to furnish the Express Mail label demonstrating that the correspondence was deposited with USPS on the date claimed. This case concerns 37 CFR 1.10(e), which requires applicant to establish, *inter alia*, that the correspondence was deposited with sufficient postage. Applicant has failed to prove and in fact, does not allege, that the correspondence was deposited with sufficient postage.

In *Honigsbaum*, the Commissioner denied the plaintiff's petition on the grounds that had plaintiff followed Express Mail procedures, plaintiff would have had the required evidence. In this case, had applicant followed Express Mail procedures, the element would have been satisfied. In *Honigsbaum*, the Court found that Commissioner's determination that the circumstances did not warrant a waiver was not arbitrary, capricious or contrary to law. In this case, the Office does not find that the failure to affix proper postage to a package is an extraordinary circumstance, but rather, one that could be avoided by the exercise of due care. See MPEP 513. To quote *Nitto*, "the logic implicit in the Commissioner's decision to distinguish *Sturzinger, Bacheloer* and the instant case is that the circumstances are not extraordinary and do not require waiver of the rules, when the party attempting to file an application makes an avoidable mistake when depositing papers." *Nitto* at 1782.

Tangentially, applicant argues that the contents of the package mailed on 27 July 2005 are undisputed. That is not correct. The Office has no knowledge of the contents of the 27 July 2005 package, nor does Mr. Brinkman, who signed this petition, as he acknowledges in footnote 1. Petition, 05 June 2006, at 2. The 27 July 2005 package was returned to Greenberg Traurig and while the 02 August 2005 petition alleges that the sealed package was resent to the Office, that cannot be confirmed.

Finally, applicant argues that USPS was required by their procedures to contact the mailer of the correspondence to correct any deficiency in postage. Any dispute applicant has over USPS compliance with USPS procedures should be properly lodged with USPS, not with USPTO. Section 1.10(e) requires applicant to affix sufficient postage to correspondence mailed to the Office. Applicant used their office's postage meter and affixed incorrect postage to the correspondence. See postage label reading "Pitney Bowes".

CONCLUSION

For the reasons set forth above, the petition under 37 CFR 1.10(e) is **DISMISSED** without prejudice.

Any reconsideration on the merits of this petition must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.10(e)."

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

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03 OCT 2005

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NEW YORK NY NEW YORK 10166

In re Application of	:	
CAPITOL VIAL, Inc.	:	
PCT Application No.: PCT/US05/27929	:	DECISION ON
International Filing Date: 02 August 2005	:	
Priority Date: 28 July 2004	:	PETITION
Attorney Docket No.: 64762.011502	:	
For: CONTAINER FOR COLLECTING AND STORING BREAST MILK	:	UNDER 37 CFR 1.10(e)

This decision is in response to applicant's "Petition to Accord a July 27, 2005 Filing Date," filed with the United States Patent and Trademark Office on 02 August 2005, which is being treated as a petition under 37 CFR 1.10(e).

BACKGROUND

On 27 July 2005, applicant submitted a package to USPS. Applicant claims that in included a request, specification and fee calculation sheet for the instant application.

USPS returned the package to applicant for insufficient postage, calling for an additional $10.98.

On 02 August 2005, applicant filed a request, a fee calculation sheet, specification, and the instant petition.

On 16 September 2005, the Office mailed Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) indicating that the application had been assigned an international filing date of 02 August 2005 and an Invitation to Correct Priority Claim (Form PCT/RO/110), indicating that the priority date did not fall within the 12 months prior to the international filing date.

DISCUSSION

When one claims to have submitted a filing by Express Mail, but it is not received by the Office, it falls under 37 CFR 1.10(e), which states, in part:

> (e) Any person mailing correspondence addressed as set out in §1.1(a) to the Office with **sufficient postage** utilizing the "Express Mail Post Office to Addressee" service of the

> USPS but not received by the Office, may petition the Director to consider such correspondence filed in the Office on the USPS deposit date, provided that ... [Emphasis added]

Applicants cannot avail themselves of 37 CFR 1.10(e). "A party's inadvertent failure to comply with the requirements of a rule is not deemed to be an extraordinary situation that would warrant waiver of a rule under 37 CFR 1.183..." MPEP 513.

CONCLUSION

For the reasons set forth above, the petition under 37 CFR 1.10(e) is **DISMISSED** without prejudice.

Any reconsideration on the merits of this petition must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.10(e)."

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

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US05/27929 .16112006

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16 NOV 2006

Wood, Herron & Evans LLP
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In re Application of	:	
CAPITOL VIAL, Inc.	:	
PCT Application No.: PCT/US05/27929	:	DECISION ON
International Filing Date: 02 August 2005	:	
Priority Date: 28 July 2004	:	PETITION
Attorney Docket No.: 64762.011502	:	
For: CONTAINER FOR COLLECTING AND	:	UNDER 37 CFR 1.183
STORING BREAST MILK	:	

This decision is in response to applicant's "Renewed Petition Under 37 CFR 1.10(e)," filed with the United States Patent and Trademark Office on 31 October 2006. As it is clear that applicant is still seeking waiver of provisions of 37 CFR 1.10(e), this petition is being treated as a renewed petition under 37 CFR 1.183.

BACKGROUND

On 27 July 2005, applicant submitted a package to USPS. Applicant claims that it included a request, specification and fee calculation sheet for the above captioned application.

USPS returned the package to applicant for insufficient postage, calling for an additional $10.98.

On 02 August 2005, applicant filed a request, a fee calculation sheet, specification, and a petition under 37 CFR 1.10(e).

On 16 September 2005, the Office mailed Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) indicating that the application had been assigned an international filing date of 02 August 2005 and an Invitation to Correct Priority Claim (Form PCT/RO/110), indicating that the priority date did not fall within the 12 months prior to the international filing date.

On 03 October 2005, the Office mailed Decision On Petition Under 37 CFR 1.10(e), dismissing applicant's petition without prejudice and setting a two (2) month period for reply.

On 21 October 2005, applicant filed a "Request For Withdrawal of International Application Pursuant to Rule 90 *bis* and Request For Refund Pursuant to PCT Rule 15.6.

On 05 June 2006, applicant filed the instant petition under 37 CFR 1.183 to waive the provision of 37 CFR 1.10(e) requiring that a package be deposited with Express Mail with sufficient postage.

On 29 September 2006, the Office mailed Decision On Petition Under 37 CFR 1.183, dismissing applicant's petition without prejudice.

On 31 October 2006, applicant filed this renewed petition again seeking accordation of a 27 July 2005 international filing date.

DISCUSSION

As earlier indicated, this petition under 37 CFR 1.183 is untimely. The 03 October 2005 decision set a two month period for requesting reconsideration on the merits. Applicant filed the 21 October 2005 request to withdraw the international application, but did not request reconsideration on the merits of the 03 October 2005 decision until 05 June 2006. Counsel argues that he was unaware of the earlier decision until the application was transferred. Counsel's awareness is not the issue. The duly appointed counsel at the time was Barry Schindler to whom the decision was sent. Applicant is bound by the actions of their duly appointed counsel.

Section 1.10(e) sets forth a petition procedure for use when an applicant mails correspondence via "Express Mail Post Office to Addressee" that is properly addressed under 37 CFR 1.1(a) to the Office with sufficient postage, but is not received by the Office. In such a circumstance, the Director may consider the correspondence filed in the Office on the USPS deposit date, provided listed circumstances are satisfied. Applicant acknowledges that applicant did not affix sufficient postage to the correspondence addressed to the Office, deposited with USPS on 27 July 2005 and that the package was returned by USPS marked "Returned For Add'l Postage $10.98."

Applicant argues that the contents of the package mailed on 27 July 2005 remained unchanged from its original submission to USPS until it was delivered to USPTO and that the Office has no evidence to the contrary. The Office was not in receipt of the package and the package was returned by USPS to the control of applicant. As the Office was not in control of the package, the Office has no knowledge of the contents of the package. Applicant alleges that Greenberg Traurig resent the original sealed package, but there is no way to confirm this.

Finally, applicant argues that USPS was required by their procedures to contact the mailer of the correspondence to correct any deficiency in postage. The Office has requested that applicant dispute USPS compliance with USPS procedures with USPS, not with USPTO.

Applicant argues that requesting that applicant discuss their dispute over USPS's alleged failure to follow its procedures with USPS is illogical as 37 CFR 1.183 allows the Director to waive any requirement of the rules. Applicant misunderstands the suggestion. As is clear from a review of the various sections of 37 CFR 1.10, the Office favorably views evidence from USPS. In this particular case, the Office wishes to know what "date-in" USPS should have accorded the package. Enclosed is a copy of the Express Mail envelope with the returned for additional postage marking.

CONCLUSION

For the reasons set forth above, the petition under 37 CFR 1.183 is **DISMISSED** without prejudice.

Any reconsideration on the merits of this petition must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.183."

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Leonard E. Smith
Supervisory PCT Legal Examiner
PCT Legal Administration

Erin P. Thomson
Attorney Advisor
PCT Legal Administration

Telephone: 571-272-3292
Facsimile: 571-273-0459

Enclosure: Copy of Express Mail mailing label EV569744205US

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Flat Rate ☒ or Weight lbs 10 ozs.	Military ☐ 2nd Day ☐ 3rd Day	Total Postage & Fees $ 13.65
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☐ WAIVER OF SIGNATURE (Domestic Mail Only) Additional merchandise insurance is void if waiver of signature is requested. I wish delivery to be made without obtaining signature of addressee or addressee's agent (if delivery employee judges that article can be left in secure location) and I authorize that delivery employee's signature constitutes valid proof of delivery.

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Barry J. Schindler, Esq.
GREENBERG TRAURIG
200 PARK AVE # 14FL
NEW YORK NY 10166-0005

64762.011502

TO: (PLEASE PRINT) PHONE 703 305-3257
MAIL STOP PCT
commissioner for Patents
P.O. Box 1450
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UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Joseph W. Schmidt
Carter, Deluca, Farrell & Schmidt, LLP
445 Broad Hollow Road
Melville, New York 11747

In re Application of
TYCO HEALTHCARE GROUP LP
PCT No.: PCT/US05/28162
International Filing Date: 08 August 2005
Priority Date: 09 August 2004
Attorney's Docket No.: 1502-51PCT
For: MEDICAL SKIN APPARATUS APPLICATION

DECISION ON PETITION

This decision is in response to applicant's "Transmittal Letter" filed 02 February 2007, which is being treated as a Petition under 37 CFR 1.181 to accept applicant's previously filed request to add a priority claim under PCT Rule 26bis. No petition fee is required.

BACKGROUND

On 08 August 2005, applicant filed international application PCT/US05/28162.

On 27 September 2005, the United States Receiving Office mailed the following: the Notification of Concerning Prescribed Fees (Form PCT/RO/102); Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105); and Notification Regarding Certain Corrections Made Ex Officio (Form PCT/RO/146). All documents indicated that no priority date was claimed.

On 02 February 2007, applicant filed the present petition requesting that the above identified PCT application no. PCT/US05/28162, filed on 08 August 2005, be accorded the priority dates of 09 August 2005, 30 September 2004, and 22 December 2004. Attached to the present petition, applicant included a copy of the request under PCT Rule 26bis.1 originally filed 10 August 2005.

On 15 February 2007, the World Intellectual Property Organization (WIPO) published the above-identified application indicating that no priority date was claimed.

DISCUSSION

Applicant states in their present petition that a request to add a priority claim under PCT Rule 26bis was received at the United States Patent and Trademark Office on 10 August 2005. A review of the present application reveals that the request to add a

priority claim under PCT 26bis is not located therein. Section 503 of the Manual of Patent Examining Procedure under the heading "RETURN POSTCARD" states, in part:

> "A postcard receipt which itemizes and properly identifies the papers which are being filed serves as prima facie evidence of receipt in the PTO of all the items listed thereon on the date stamped thereon by the PTO."

Here, applicant has provided a copy of their date-stamped filing receipt. The receipt identifies the application by applicant, title of invention, and attorney docket number. The receipt itemizes a Transmittal Letter under Rule 26bis.1(A), a check in the amount of $60, and a certificate of Express Mail. The receipt is stamped "Rec'd PCT/PTO 10 AUG 2005" across its face is sufficient to indicate that the above items were in fact received in the Office on 10 August 2005.

Additionally, applicant states PCT/US05/28162 application should also be entitled to a priority date of 09 August 2004, 30 September 2004, and 22 December 2004. The submission will be treated as a Request To Add Priority Claim under PCT Rule 26bis. PCT Rule 26bis states:

> The applicant may correct or add a priority claim by a notice submitted to the receiving Office or the International Bureau within a time limit of 16 months from the priority date or, where the correction or addition would cause a change in the priority date, 16 months from the priority date as so changed, whichever 16-month period expires first, provided that such a notice may be submitted until the expiration of four months from the international filing date. The correction of a priority claim may include the addition of any indication referred to in Rule 4.10.

It is noted that the 10 August 2005 submission is within 16 months the earliest priority date (09 August 2004), and that the Request To Correct Priority Claim is timely filed under PCT Rule 26bis. Therefore, the applicant's request to add a priority claim (09 August 2004, 30 September 2004, and 22 December 2004) is accepted.

CONCLUSION

For the reasons above, the petition under 37 CFR 1.181 to accept the previously filed request to add a priority claim under PCT Rule 26bis is **GRANTED**.

Applicant's request to add an additional priority claims under PCT Rule 26bis is **GRANTED**.

Pursuant to applicant's request, a certified copy of U.S. provisional application no. 60/599,927 (filed 09 August 2004); 60/614,503 (filed 30 September 2004); and 60/639,182 (filed 22 December 2004) will be transmitted to the International Bureau.

The application is being returned to the United States Receiving Office for processing in accordance with this decision, that is, for: (1) entering U.S. provisional application nos. 60/599,927 (filed 09 August 2004), 60/614,503 (filed 30 September 2004), and 60/639,182 (filed 22 December 2004) as the priority claims to international application no. PCT/US05/28162; (2) preparing a Notification Relating to Priority Claim (Form PCT/RO/111); (3) transmitting a certified copy of U.S. provisional application no. 60/599,927 (filed 09 August 2004), 60/614,503 (filed 30 September 2004), and 60/639,182 (filed 22 December 2004) to the International Bureau; and (4) forwarding a copy of this decision to the International Bureau.

Anthony Smith
Attorney Advisor
Office of PCT Legal Administration
Tel: (571) 272-3298
Fax: (571) 273-0459

445 Broad Hollow Road
Suite 225
Melville, N.Y. 11747
Tel.: (631) 501-5700
Fax: (631) 501-3526

Carter, DeLuca, Farrell & Schmidt LLP

Fax

To:	U.S. Patent and Trademark Office	**From:**	Joseph W. Schmidt
Fax:	571-273-0459	**Date:**	February 7, 2007
Phone:		**Pages:**	20 (incl. Cover)
Re:	1502-51 PCT	**CC:**	

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Please see attached

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

INTERNATIONAL APPLICATION NO.: PCT/US05/28162

INTERNATIONAL FILING DATE: 08 August 2005

PRIORITY DATE CLAIMED: 09 August 2004

TITLE OF INVENTION: **MEDICAL SKIN APPARATUS APPLICATION**

APPLICANT: Tyco Healthcare Group LP

DOCKET: 1502-51 PCT DATE: February 7, 2007

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Mail Stop PCT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
Attn: RO/US

TRANSMITTAL LETTER

Sir:

Applicants filed a Transmittal Letter under Rule 26*BIS*.1A on August 10, 2005 in connection with the above application claiming priority to three U.S. provisional patent applications. (A copy of the Transmittal Letter, cleared check No. 0551 and stamped postcard acknowledging receipt of the Letter by the PCT/PTO is attached hereto.) On October 25, 2005, a communication was mailed by the Office of Public Records (copy enclosed) in which it was indicated that a "Power to Inspect" was needed

CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that this paper is being transmitted by facsimile to the U.S. Patent and Trademark Office on the date shown below. Fax No.: (571)273-0459. Total Number of Pages Sent: 19.

Date: February 7, 2007

Joseph W. Schmidt

to forward copies of the priority applications. Applicants prepared the appropriate Revocation of Power of Attorney with New Power of Attorney ("Power of Attorney") for each of the priority applications. Applicants filed the Power(s) of Attorney along with a second Transmittal Letter Under Rule 26*BIS*.1.A. (A copy of the second Transmittal Letter, Power(s) of Attorney and stamped postcard acknowledging receipt by the PCT/PTO is attached hereto). However, it appears that the priority claim and the certified copies of the provisional applications were not transmitted to the International Bureau.

No other communication is believed to be received by the Applicants subsequent to the filing of the second Transmittal Letter except for a Notice of Acceptance of Power of Attorneys and a Written Opinion of the Searching Authority.

Accordingly, in view of the foregoing, Applicants hereby request entry of the claim to priority as identified in the Transmittal Letters, and forwarding of the priority claim with the copies of the priority documents to the International Bureau.

Applicants hereby affirm that each of the documents attached hereto are exact copies as filed, and that the statements made on information and belief are believed to be true.

No fee is believed to be due with respect to this paper; however, if a fee is due or becomes due in connection with this application, please charge Deposit Account No. **50-2140**.

Please contact applicant's undersigned representative should there be any questions.

Respectfully submitted,
Carter, DeLuca, Farrell & Schmidt, LLP

By: Joseph W. Schmidt
Joseph W. Schmidt
Registration No. 36,920

Carter, DeLuca, Farrell & Schmidt, LLP
445 Broad Hollow Road
Suite 225
Melville, New York 11747
Tel.: (631) 501-5700
Fax: (631) 501-3526

JWS/td

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PATENT OFFICE DATE STAMP WILL ACKNOWLEDGE RECEIPT OF:

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1. Transmittal Letter Under Rule 26BIS.1(A)
2. Check in the amount of $60.00
3. Certificate of Express Mail No. EV 464571488 US

Applicant: Tyco Healthcare Group LP
Filed: Concurrently Herewith
For: MEDICAL SKIN APPLICATOR APPARATUS
Docket: 1502-51
Dated: August 10, 2005

JWS/ld

JC04 Rec'd PCT/PTO 10 AUG 2005

EV464571488US

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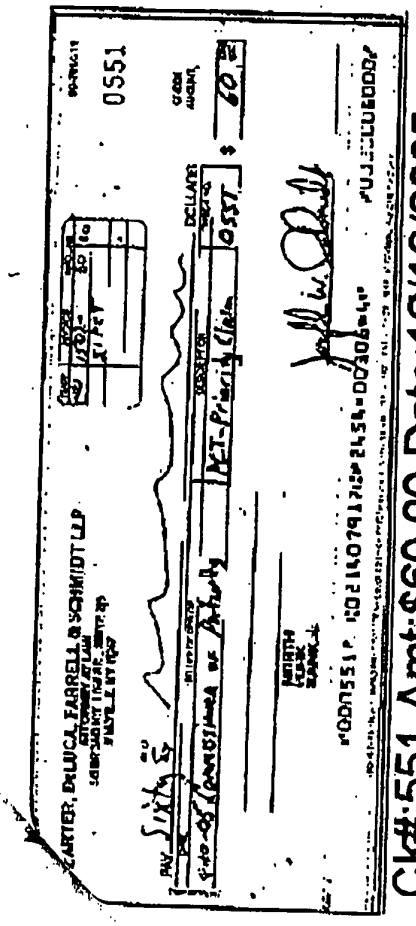

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

INTERNATIONAL APPLICATION NO.: To Be Assigned

INTERNATIONAL FILING DATE: 08 August 2005

PRIORITY DATE CLAIMED: 09 August 2004

TITLE OF INVENTION: **MEDICAL SKIN APPARATUS APPLICATION**

APPLICANT: Tyco Healthcare Group LP

DOCKET: 1502-51 DATE: August 10, 2005

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Attn: RO/US

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TRANSMITTAL LETTER UNDER RULE 26*BIS*.1(A)

Sir:

The following notice is being submitted in connection to the above-identified international application.

The priority of the following earlier application(s) is hereby claimed: U.S. Patent Application Serial No. 60/599,927 filed 09 August 2004; U.S. Patent Application Serial No. 60/614,503 filed 30 September 2004; and U.S. Patent Application Serial No. 60/639,182 filed 22 December 2004.

CERTIFICATION UNDER 37 C.F.R. §1.10

I hereby certify that this correspondence and the documents referred to as enclosed are being deposited with the United States Postal Service on date below in an envelope as "Express Mail Post Office to Addressee" Mail Label Number EV464571488US addressed to: Commissioner for Patents, Mail Stop PCT, P.O. Box 1450, Alexandria, VA 22313-1450.

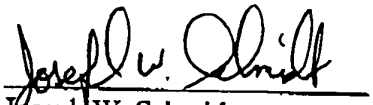
Dated: August 10, 2005

Joseph W. Schmidt

The receiving Office is requested to prepare and transmit to the International Bureau a certified copy of the all the earlier application(s) identified above. Enclosed is a check for $60.00 to cover the fee for the priority documents. Please charge any deficiency or credit any overpayment in the total fees indicated to Deposit Account No. **50-2140**. TWO (2) COPIES OF THIS SHEET ARE ENCLOSED.

Please contact applicant's undersigned representative should there be any questions.

Respectfully submitted,
Carter, DeLuca, Farrell & Schmidt, LLP

By: 
Joseph W. Schmidt
Registration No. 36,920

Carter, DeLuca, Farrell & Schmidt, LLP
445 Broad Hollow Road
Suite 225
Melville, New York 11747
Tel.: (631) 501-5700
Fax: (631) 501-3526

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UNITED STATES PATENT AND TRADEMARK OFFICE

OFFICE OF THE CHIEF INFORMATION OFFICER

Date: 10/24/05

Dear: Joseph W. Schmidt

This is in response to your correspondence dated 8-10-05

Your order for printed copies of the following U. S. Patent (s), Design Patent(s) Plant(s)Trademark(s) and/or a Patent Application(s) cannot be filled for the following reason(s).
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Sincerely,

A. Bennett

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International Division

PATENT OFFICE DATE STAMP WILL ACKNOWLEDGE RECEIPT OF:

1. Transmittal Letter Under Rule 26*BIS*.1(A)
2. Check in the amount of $60.00
3. Copies of Revocation Power of Attorney with New Power of Attorney signed by inventors for each priority application
4. Certificate of Express Mail No. EV 762881940 US

Applicant: Tyco Healthcare Group LP
Filed: August 8, 2005
For: MEDICAL SKIN APPLICATOR APPARATUS
Docket: 1502-51
Dated: November 22, 2005

JWS/td

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1. Transmittal Letter Under Rule 26*BIS*.1(A)
2. Check in the amount of $60.00
3. Copies of Revocation Power of Attorney with New Power of Attorney signed by inventors for each priority application
4. Certificate of Express Mail No. EV 762881940 US

Applicant: Tyco Healthcare Group LP
Filed: August 8, 2005
For: MEDICAL SKIN APPLICATOR APPARATUS
Docket: 1502-51
Dated: November 22, 2005

JWS/td

IAP4 Rec'd PCT/PTO 22 NOV 2005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

INTERNATIONAL APPLICATION NO.: To Be Assigned

INTERNATIONAL FILING DATE: 08 August 2005

PRIORITY DATE CLAIMED: 09 August 2004

TITLE OF INVENTION: **MEDICAL SKIN APPARATUS APPLICATION**

APPLICANT: Tyco Healthcare Group LP

DOCKET: 1502-51 PCT DATE: November 22, 2005

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P.O. Box 1450
Alexandria, VA 22313-1450
Attn: RO/US

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International Division

TRANSMITTAL LETTER UNDER RULE 26*BIS*.1(A)

Sir:

The following notice is being submitted in connection to the above-identified international application.

The priority of the following earlier application(s) is hereby claimed: U.S. Patent Application Serial No. 60/599,927 filed 09 August 2004; U.S. Patent Application Serial No. 60/614,503 filed 30 September 2004; and U.S. Patent Application Serial No. 60/639,182 filed 22 December 2004.

CERTIFICATION UNDER 37 C.F.R. §1.10

I hereby certify that this correspondence and the documents referred to as enclosed are being deposited with the United States Postal Service on date below in an envelope as "Express Mail Post Office to Addressee" Mail Label Number EV762881940US addressed to: Commissioner for Patents, Mail Stop PCT, P.O. Box 1450, Alexandria, VA 22313-1450.

Dated: November 22, 2005

Tricia D'Agostino

Attached is a copy of the Revocation of Power of Attorney with New Power of Attorney and Change of Correspondence Address signed by each inventor for each of above-identified priority applications.

The receiving Office is requested to prepare and transmit to the International Bureau a certified copy of the all the earlier application(s) identified above. Enclosed is a check for $60.00 to cover the fee for the priority documents. Please charge any deficiency or credit any overpayment in the total fees indicated to Deposit Account No. **50-2140**. TWO (2) COPIES OF THIS SHEET ARE ENCLOSED.

Please contact applicant's undersigned representative should there be any questions.

Respectfully submitted,
Carter, DeLuca, Farrell & Schmidt, LLP

By: _____
Joseph W. Schmidt
Registration No. 36,920

Carter, DeLuca, Farrell & Schmidt, LLP
445 Broad Hollow Road
Suite 225
Melville, New York 11747
Tel.: (631) 501-5700
Fax: (631) 501-3526

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Legal Staff
International Division

JWS/td

PATENT

Attorney Docket No: 1502-51

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Frank A. Cable, Jr.

Serial No.: 60/599,927 Group: Art Unit To Be Assigned

Filed: August 9, 2004

For: SKIN APPLICATOR

CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8(a)

Date of Deposit: November 22, 2005

I hereby certify that the following:

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Tricia D'Agostino

Carter, DeLuca, Farrell & Schmidt, LLP
445 Broad Hollow Road, Suite 225
Melville, New York 11747
(631) 501-5700
(631) 501-3526 (fax)

PTO/SB/82 (04-05)
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REVOCATION OF POWER OF ATTORNEY WITH NEW POWER OF ATTORNEY AND CHANGE OF CORRESPONDENCE ADDRESS

Application Number	60/599,927
Filing Date	August 9, 2004
First Named Inventor	Frank A. Cable, Jr.
Art Unit	To Be Assigned
Examiner Name	To Be Assigned
Attorney Docket Number	1502-51 PCT

I hereby revoke all previous powers of attorney given in the above-identified application.

☐ A Power of Attorney is submitted herewith.

OR

☒ I hereby appoint the practitioners associated with the Customer Number: 55825

☒ Please change the correspondence address for the above-identified application to:

☒ The address associated with Customer Number: 55825

OR

☐ Firm or Individual Name			
Address			
City		State	Zip
Country			
Telephone		Email	

I am the:

☒ Applicant/Inventor.

☐ Assignee of record of the entire interest. See 37 CFR 3.71.
Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)

SIGNATURE of Applicant or Assignee of Record

Signature			11/14/05
Name	Frank A. Cable, Jr.		
Date		Telephone	(413)593-7662

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

This collection of information is required by 37 CFR 1.36. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 3 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: **Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

PATENT

Attorney Docket No: 1502-51

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Frank A. Cable, Jr. et al.

Serial No.: 60/614,503 Group: Art Unit To Be Assigned

Filed: September 30, 2004

For: SKIN APPLICATOR

CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8(a)

Date of Deposit: November 22, 2005

I hereby certify that the following:

[X] Revocation of Power of Attorney with New Power of Attorney And Change of Correspondence Address

[X] Return postcard

are being deposited with the United States Postal Service as first class mail on the Date of Deposit indicated above, postpaid in an envelope addressed to the: Commissioner for Patents, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450.

Tricia D'Agostino

Carter, DeLuca, Farrell & Schmidt, LLP
445 Broad Hollow Road, Suite 225
Melville, New York 11747
(631) 501-5700
(631) 501-3526 (fax)

PTO/SB/82 (04-05)
Approved for use through 11/30/2005. OMB 0651-0035
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

REVOCATION OF POWER OF ATTORNEY WITH NEW POWER OF ATTORNEY AND CHANGE OF CORRESPONDENCE ADDRESS

Application Number	60/614,503
Filing Date	September 30, 2004
First Named Inventor	Frank A. Cable, Jr. et al.
Art Unit	To Be Assigned
Examiner Name	To Be Assigned
Attorney Docket Number	1502-51 PCT

I hereby revoke all previous powers of attorney given in the above-identified application.

☐ A Power of Attorney is submitted herewith.

OR

☒ I hereby appoint the practitioners associated with the Customer Number: 55825

☒ Please change the correspondence address for the above-identified application to:

☒ The address associated with Customer Number: 55825

OR

☐ Firm or Individual Name			
Address			
City		State	Zip
Country			
Telephone		Email	

I am the:

☒ Applicant/Inventor.

☐ Assignee of record of the entire interest. See 37 CFR 3.71.
Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)

SIGNATURE of Applicant or Assignee of Record

Signature	F.A.C. 11/14/05
Name	Frank A. Cable, Jr.
Date	Telephone (413) 593-7662

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 2 forms are submitted.

This collection of information is required by 37 CFR 1.36. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 3 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

PTO/SB/82 (04-05)
Approved for use through 11/30/2005. OMB 0651-0035
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REVOCATION OF POWER OF ATTORNEY WITH NEW POWER OF ATTORNEY AND CHANGE OF CORRESPONDENCE ADDRESS

Application Number	60/614,503
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Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)

SIGNATURE of Applicant or Assignee of Record

Signature			
Name	Mark Tauer		
Date	11/14/05	Telephone	(413) 593-7667

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 2 forms are submitted.

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PATENT

Attorney Docket No: 1502-51

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Frank A. Cablc, Jr. et al.

Serial No.: 60/639,182 Group: Art Unit To Be Assigned

Filed: December 22, 2004

For: SKIN APPLICATOR

CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8(a)

Date of Deposit: November 22, 2005

I hereby certify that the following:

[X] Revocation of Power of Attorney with New Power of Attorney And Change of Correspondence Address

[X] Return postcard

are being deposited with the United States Postal Service as first class mail on the Date of Deposit indicated above, postpaid in an envelope addressed to the: Commissioner for Patents, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450.

Tricia D'Agostino

Carter, DeLuca, Farrell & Schmidt, LLP
445 Broad Hollow Road, Suite 225
Melville, New York 11747
(631) 501-5700
(631) 501-3526 (fax)

PTO/SB/82 (04-05)
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U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
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REVOCATION OF POWER OF ATTORNEY WITH NEW POWER OF ATTORNEY AND CHANGE OF CORRESPONDENCE ADDRESS

Application Number	60/639,182
Filing Date	December 22, 2004
First Named Inventor	Frank A. Cable, Jr. et al.
Art Unit	To Be Assigned
Examiner Name	To Be Assigned
Attorney Docket Number	1502-51 PCT

I hereby revoke all previous powers of attorney given in the above-identified application.

☐ A Power of Attorney is submitted herewith.

OR

☒ I hereby appoint the practitioners associated with the Customer Number: 55825

☒ Please change the correspondence address for the above-identified application to:

☒ The address associated with Customer Number: 55825

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Address			
City		State	Zip
Country			
Telephone		Email	

I am the:

☒ Applicant/Inventor.

☐ Assignee of record of the entire interest. See 37 CFR 3.71.
Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)

SIGNATURE of Applicant or Assignee of Record

Signature	F. A. Cable 11/14/05		
Name	Frank A. Cable, Jr.		
Date		Telephone	(413) 593-7662

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

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REVOCATION OF POWER OF ATTORNEY WITH NEW POWER OF ATTORNEY AND CHANGE OF CORRESPONDENCE ADDRESS

Application Number	60/639,182
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☒ Applicant/Inventor.

☐ Assignee of record of the entire interest. See 37 CFR 3.71.
Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)

SIGNATURE of Applicant or Assignee of Record

Signature			
Name	Mark Tauer		
Date	11/14/05	Telephone	(413) 593-7667

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

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If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

****
*** RX REPORT ***
****

RECEPTION OK

TX/RX NO	7392
RECIPIENT ADDRESS	16315013526
DESTINATION ID	
ST. TIME	02/07 12:42
TIME USE	02'21
PGS.	20
RESULT	OK

PATENT COOPERATION TREATY

From the RECEIVING OFFICE

To:

JOSEPH W. SCHMIDT, ESQ.
CARTER, DELUCA, FARRELL & SCHMIDT LLP
445 BROADHOLLOW ROAD
SUITE 225
MELVILLE, NEW YORK 11747

PCT

NOTIFICATION RELATING TO PRIORITY CLAIM

(PCT Rules 26*bis*.1 and 26*bis*.2 and
Administrative Instructions, Sections 302 and 314)

Date of mailing *(day/month/year)* 28 FEB 2007

Applicant's or agent's file reference
1502-51

IMPORTANT NOTIFICATION

International application No.
PCT/US2005/028162

International filing date *(day/month/year)*
08 Aug 2005

Applicant
TYCO HEALTHCARE GROUP, LP

The applicant is hereby **notified** of the following in respect of the priority claim(s) made in the international application.

1. ☐ **Correction of priority claim.** In accordance with the applicant's notice received on _____ the following priority claim has been corrected to read as follows:

   ☐ even though the indication of the number of the earlier application is missing
   ☐ even though the following indication in the priority claim is not the same as the corresponding indication appearing in the priority document:

2. ☑ **Addition of priority claim.** In accordance with the applicant's notice received on 10 August 2005 the following priority claim has been added: 60/599,927 (09 August 2004); 60/614,503 (30 September 2004);

   ☐ even though the indication of the number of the earlier application is missing 60/639,182 (22 December 2004)
   ☐ even though the following indication in the priority claim is not the same as the corresponding indication appearing in the priority document:

3. ☑ **As a result of the correction and/or addition** of (a) priority claim(s) under items 1 and/or 2, **the (earliest) priority date is:**
   08 August 2004

4. ☐ The priority claim *(see also item 5, below, if applicable)* is **considered not to have been made** because:

   ☐ the applicant failed to respond to the invitation under Rule 26*bis*.2(a) (Form PCT/RO/110) within the prescribed time limit
   ☐ the applicant's notice was received after the expiration of the prescribed time limit under Rule 26*bis*.1(a)
   ☐ the applicant's notice failed to correct the priority claim so as to comply with the requirements of Rule 4.10

   The applicant may, before the technical preparations for international publication have been completed and subject to the payment of a fee, request the International Bureau to publish, together with the international application, information concerning the priority claim. See Rule 26*bis*.2(c) and the *PCT Applicant's Guide*, Volume I, Annex B2(IB).

5. ☐ The priority claim cannot be corrected/added since the applicant's notice was received on _____ after expiration of the prescribed time limit under Rule 26*bis*.1(a).

6. ☐ In case where **multiple priorities** have been claimed, the above item(s) relate to the following priority claim(s):

7. A copy of this notification has been sent to the International Bureau and
   ☑ to the International Searching Authority

Name and mailing address of the receiving Office	Authorized officer
Mail Stop PCT, Commissioner for Patents P.O. Box 1450, Alexandria, VA 22313-1450 Facsimile No. 571-273-3201	Anthony Smith Telephone No. 571-272-3298

Form PCT/RO/111 (April 2006)

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

17 SEP 2007

COOPER & DUNHAM, LLP
1185 AVENUE OF THE AMERICAS
NEW YORK, NEW YORK 10036

In re Application of	:
QUARK BIOTECH, INC. et al.	: DECISION ON
PCT No.: PCT/US05/29236	:
Int. Filing Date: 16 August 2005	: PETITION
Priority Date: 16 August 2004	:
Attorney's Docket No.: 72958-A-PCT	: UNDER 37 CFR 1.181
For: Therapeutic Uses Of Inhibitors Of RTP801	:

This decision is in response to applicant's "Communication Requesting The Reissuance Of Written Opinion," filed on 18 May 2007, and treated as a petition under 37 CFR 1.181.

BACKGROUND

On 16 August 2005, applicants filed PCT/US05/29236 claiming an earliest priority date of 16 August 2004. Applicants designated the United States Patent and Trademark Office as the International Searching Authority (ISA/US) in Box VII of the Request Form (Form PCT/RO/101).

On 05 October 2005, the United States Receiving Office (RO/US) mailed the following: Notification Concerning Payment of Fees (Form PCT/RO/102); Notification of the International Application Number and International Filing Date (Form PCT/RO/105) and, Invitation To Correct Defects In The International Application (Form PCT/RO/106).

On 18 April 2007, the ISA/US mailed the "Notification of Transmittal of the International Search Report and the Written Opinion" (Form PCT/ISA/220), the Search Report (ISR) (Form PCT/ISA/210) and the Written Opinion of the International Searching Authority (Form PCT/ISA/237).

On 18 May 2007, applicants submitted the instant petition requesting that the Written Opinion be reissued because "on page 4, Box V of the Written Opinion, the citations and explanation section is missing."

DISCUSSION

A review of the papers in the instant international application shows that applicants' assertion is correct. Specifically, on page 4, Box V of the Written Opinion (Form PCT/ISA/237), the citations and explanations section supporting the examiner's reasoning is missing.

Accordingly, a new Written Opinion is warranted.

CONCLUSION

For the reasons set forth above, applicants' petition under 37 CFR 1.181 is **GRANTED.**

The Written Opinion of the International Searching Authority (Form PCT/ISA/237), mailed 18 April 2007 is **VACATED**.

This application is being forwarded to the ISA/US for further processing in accordance with this decision, including providing a new International Search Report and Written Opinion.

Leonard Smith
PCT Legal Examiner
Office of PCT Legal Administration

Stefan Staicovici
PCT Legal Examiner
Office of PCT Legal Administration
Telephone: (571) 272-1208
Facsimile: (571) 273-0459

CC: The International Bureau of WIPO
34, chemin des Colombettes
1211 Geneva 20
Switzerland

United States Patent and Trademark Office

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

STEVEN M. HOFFBERG
MIDLE & HOFFBER LLP
10 BANK STREET -SUITE 460
WHITE PLAINS, NY 10606

In re Application of	:	
MONTAGNIER	:	
PCT No.: PCT/US2005/029296	:	
Int. Filing Date: 17 August 2005	:	
Priority Date: 20 August 2004	:	
Attorney's Docket No.: MONT 206.1	:	DECISION
For: SENSITIVE DETECTION OF BACTERIA BY	:	
IMPROVED NESTED POLYMERASE CHAIN	:	
REACTION TARGETING THE 16S RIBOSOMAL	:	
RNA GENE AND IDENTIFICATION OF BACTERIAL..	:	

This is in response to applicants' correspondence filed on 11 January 2007 and 18 December 2006 (which in effect requests consideration of postcard evidence).

BACKGROUND

Applicants filed this purported international application with the United States receiving Office (RO/US), on 17 August 2005.

On 13 December 2006, applicants filed a notice seeking to correct the priority claim to United States priority application 11/204,854.

On 15 December 2006, the International Bureau of WIPO (IB) mailed a Notification Relating To Priority Claim (Form PCT/IB/318) reflecting the correction of the priority claim.

DISCUSSION

In view of the fact that the International Bureau has processed the correction to the priority claim, applicants' communication dated 11 January 2007 (which seeks to establish, via postcard evidence, that the RO/US timely received a notice to correct the priority claim) is moot.

DECISION

Applicants' request is **DISMISSED AS MOOT**, without prejudice.

Please direct any further correspondence with respect to this matter to the Assistant Commissioner for Patents, Mail Stop PCT, P.O. Box 1450, Alexandria, VA 22313-1450, and address the contents of the letter to the attention of the Office of PCT Legal Administration.

/George Dombroske/
George Dombroske
PCT Legal Examiner
Office of PCT Legal Administration
Tel: (571) 272-3283
Fax: (571) 273-0459

UNITED STATES PATENT AND TRADEMARK OFFICE
PCT/US05/30715 . 29.11.2006

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

29 NOV 2006

Ronald E. Smith
SMITH & HOPEN, P.A.
15950 Bay Vista Drive, Suite 220
Clearwater, FL 33760

In re Application of
UNIVERSITY OF SOUTH FLORIDA
PCT No.: PCT/US05/30715
Int. Filing Date: 30 August 2005
Priority Date: 27 August 2004
Agent's File Reference: 1372.277.PRWO
For: METHOD OF MANUFACTURING SILICON TOPOLOGICAL CAPACITORS

DECISION ON RENEWED PETITION UNDER 37 CFR 1.10(d)

This decision is in response to applicants' "Renewed Petition under 37 CFR 1.10(d)" filed 27 September 2006, which requests that the filing date of International Application No. PCT/US05/30715 be corrected from 30 August 2005 to 29 August 2005. No petition fee is due. The petition is **DISMISSED** as follows:

BACKGROUND

On 27 December 2005, applicants filed a petition under 37 CFR 1.10(d) which requested that the international filing date be corrected from 30 August 2005 to 29 August 2005.

On 14 March 2006, the USPTO rendered a decision dismissing the petition under 37 CFR 1.10(d) on the grounds that applicants did not provide corroborating evidence from the USPS or evidence which came into being within one business day from the date of deposit with the USPS to support the requested 29 August 2005 international filing date.

On 27 April 2006, applicants filed a renewed petition under 37 CFR 1.10(d) accompanied by an affidavit and a case history log.

On 27 July 2006, the USPTO rendered a decision dismissing the renewed petition under 37 CFR 1.10(d) on the grounds that the log did not clearly indicate that the present international application was sent prior to the 29 August 2005 log entry and that the affidavit signed by Deborah Preza did not indicate that Ms. Preza personally delivered "Express Mail" Label No. EV624410324US to the USPS on 29 August 2005 or that she had first hand knowledge of said delivery.

On 27 September 2006, applicants filed the present renewed petition under 37 CFR 1.10(d) accompanied by a new affidavit signed by Deborah Preza.

DISCUSSION

A review of the present renewed petition reveals that the renewed affidavit and counsel's arguments is unpersuasive. Neither the renewed affidavit nor the log submitted with the 27 April 2006

renewed petition under 37 CFR 1.10(d) show when and where the present application was deposited as Express Mail. Applicants have not provided acceptable evidence from the USPS or evidence which came into being within one business day of the date of deposit with the USPS to support the 29 August 2005 date. Accordingly, the present renewed petition does not overcome the objections noted in the decision mailed 27 July 2006. The requirements under 37 CFR 1.10(d)(3) remain outstanding.

CONCLUSION

For the above reasons, applicant's renewed petition under 37 CFR 1.10(d) is **DISMISSED without prejudice.**

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a letter entitled "Renewed Petition Under 37 CFR 1.10(d)".

Any further correspondence with respect to this matter should be directed to the Commissioner for Patents, Mail Stop PCT, P.O. Box 1450, Alexandria, VA 22313-1450.

Leonard Smith
Supervisory PCT Legal Examiner
Office of PCT Legal Administration

Jeremy Fleming
Paralegal Specialist
Office of PCT Legal Administration

JSF/LS:jf

(571) 272-3284

UNITED STATES PATENT AND TRADEMARK OFFICE
PCT/US2005/030715 - 27/07/2006

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United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

27 JUL 2006

Ronald E. Smith
SMITH & HOPEN, P.A.
15950 Bay Vista Drive, Suite 220
Clearwater, FL 33760

In re Application of
UNIVERSITY OF SOUTH FLORIDA
PCT No.: PCT/US05/30715
Int. Filing Date: 30 August 2005
Priority Date: 27 August 2004
Agent's File Reference: 1372.277.PRWO
For: METHOD OF MANUFACTURING SILICON TOPOLOGICAL CAPACITORS

DECISION ON RENEWED PETITION UNDER 37 CFR 1.10(d)

This decision is in response to applicants' "Renewed Petition under 37 CFR 1.10(d)" filed 27 April 2006, which requests that the filing date of International Application No. PCT/US05/30715 be corrected from 30 August 2005 to 29 August 2005. No petition fee is due. The petition is **DISMISSED** as follows:

BACKGROUND

On 27 December 2005, applicants filed a petition under 37 CFR 1.10(d) which requested that the international filing date be corrected from 30 August 2005 to 29 August 2005.

On 14 March 2006, the USPTO rendered a decision dismissing the petition under 37 CFR 1.10(d) on the grounds that applicants did not provide corroborating evidence from the USPS or evidence which came into being within one business day from the date of deposit with the USPS to support the requested 29 August 2005 international filing date.

DISCUSSION

A review of the log submitted by applicants to support the requested 29 August 2005 international filing date reveals that the evidence is unpersuasive. The entry dated 29 August 2005 by Deborah Preza is defective in that it indicates, inter alia, preparation of an international application but does not specify that the application in question was sent prior to the log entry. In contrast, the entry dated 27 December 2005 clearly indicates both preparation and mailing (including the "Express Mail" label number) of a petition. Furthermore, the other entries in the log for the date in question seem to indicate that the package had not been mailed as of Ms. Preza's entry. Specifically, the log indicates two actions being taken with respect to the filing after Ms. Preza's 10:38 am entry; at 12:40 pm the application appears to have been modified in view of comments from the applicant and at 3:21 pm the application papers were signed. Given the above discrepancies, Ms. Preza's 10:38 am log entry cannot be accepted at this time as evidence that the application was filed by Express Mail on the date in question. The affadavit signed by Deborah Preza is also defective in that it does not state that Ms. Preza personally delivered "Express Mail" Label No. EV624410324US to the USPS on 29 August 2005 or that she had first hand knowledge of said delivery. Consequently, the log filed with the present petition

does not support the requested 29 August 2005 date of deposit. The requirements under 37 CFR 1.10(d)(3) remain outstanding.

CONCLUSION

For the above reasons, applicant's renewed petition under 37 CFR 1.10(d) is **DISMISSED without prejudice.**

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a letter entitled "Renewed Petition Under 37 CFR 1.10(d)".

Any further correspondence with respect to this matter should be directed to the Commissioner for Patents, Mail Stop PCT, P.O. Box 1450, Alexandria, VA 22313-1450.

Richard Cole
PCT Legal Examiner
Office of PCT Legal Administration

JSF/RC:jf

Jeremy Fleming
Paralegal Specialist
Office of PCT Legal Administration

(571) 272-3284

03 OCT 2005

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United States Patent and Trademark Office
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ROBERT O. FOX
LUEDEKA NEELY AND GRAHAM PC
P.O. BOX 1871
KNOXVILLE, TN 37901

In re Application of	:	
DANIEL, D. Steven	:	
PCT No.: PCT/US05/30899	:	DECISION
Int. Filing Date: 31 August 2005	:	
Priority Date: 30 August 2004	:	ON PETITIONS UNDER
Docket No.: 59460.T1	:	
For: ELECTROMECHANICAL VALVE ACTUATOR	:	37 CFR 1.10 (d), (h) and (i)

This decision is in response to applicant's "Petition," filed on 19 July 2005. Applicant indicates that it is a petition under 37 CFR 1.10(d), (h) and (i).

BACKGROUND

Applicant filed international application PCT/US05/30899 via Express Mail.

On 19 September 2005, applicant filed the instant petition to correct the international filing date.

DISCUSSION

In the instant petition, applicant requests that the filing date be amended to 30 August 2005. The mailing label lists the "date in" as "8/31/05." Under 37 CFR 1.10(a), correspondence delivered to the Office by "Express Mail" will be considered filed on the date of deposit with the USPS. "The date of deposit with the USPS is shown by the 'date-in' on the 'Express Mail' mailing label or other official USPS notation." 37 CFR 1.10(a).

Applicant argues that he attempted to deposit the package with USPS on 30 August 2005 and deposited in the Express Mail drop box after the last scheduled pickup on 30 August 2005. 37 CFR 1.10(d) allows an applicant to petition to correct an incorrectly entered "Date In" of an Express Mail receipt and states that:

Section 1.10(d) requires that the petition be (1) filed promptly, that the (2) original submission bear the Express Mail mailing label number and that (3) applicant prove to the satisfaction of the Director that the package was deposited with "Express Mail Post Office to Addressee" service prior to the last scheduled pickup for that day.

Items (1) and (2) have been met. However, applicant does not even claim that item (3) occurred. Applicant claims to have been unable to deposit the package with Express Mail prior to the last scheduled pickup of the drop box. Assuming *arguendo*, that evidence of impossibility of deposit would be equivalent to evidence of deposit, applicant has not

provided evidence from USPS, nor evidence that came into being after deposit, or in this case, after attempted deposit and within one business day. MPEP 513.

37 CFR 1.10(h) states:

(h) Any person who attempts to mail correspondence addressed asset out in § 1.1 (a) to the Office with sufficient postage utilizing the "Express Mail Post Office to Addressee" service of the USPS, but has the correspondence refused by an employee of the USPS due to an interruption or emergency in "Express Mail" service, may petition the Director to consider such correspondence as filed on a particular date in the Office, provided that:

(1) The petition is filed promptly after the person becomes aware of the refusal of the correspondence;

(2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the attempted mailing by "Express Mail";

(3) The petition includes the original correspondence or a copy of the original correspondence showing the number of the "Express Mail" mailing label thereon; and

(4) The petition includes a statement by the person who originally attempted to deposit the correspondence with the USPS which establishes, to the satisfaction of the Director, the original attempt to deposit the correspondence and that the correspondence or copy of the correspondence is the original correspondence or a true copy of the correspondence originally attempted to be deposited with the USPS on the requested filing date. The Office may require additional evidence to determine if the correspondence was refused by an employee of the USPS due to an interruption or emergency in "Express Mail" service.

Applicant claims to have experienced a postal service interruption, but has provided no proof. Applicant claims that the post office was unavailable at a posted open time. A review of the USPS website indicates that the 37950-9998 post office is currently open until 6:00pm. The website does not furnish information for the last Express Mail pickup time. A refusal by an employee to open a door after the post office is closed for the day is not a postal service interruption.

Further, applicant claims variously to have been at the post office from 30-50 minutes. What is particularly unclear is why applicant did not wait for the postal employee to arrive to clean out the box and hand the mail carrier the package. If the employee had refused, applicant could have gotten a declaration as to the box being jammed.

Applicant's claims are not sufficient. While applicant claims to have been unable to use the drop box, drop box users are encouraged to use an Express Mail log as described in MPEP 513, such a log made within one business day might have been sufficient documentation. Photographic evidence of the jammed boxed might also have helped applicant's petition. Otherwise, applicant must supply evidence from USPS as to the interruption.

Items (1), (2) and (3) have been satisfied. Item (4) has not been satisfied.

37 CFR 1.10(i) is not applicable as the alleged interruption is not one declared by the Director.

CONCLUSION

For the reasons listed above, applicant's petitions under 37 CFR 1.10(d), (h) and (i) to correct the international filing date are **DISMISSED** without prejudice.

PCT/US05/30899 03102005

Any reconsideration on the merits of this petition must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.10."

The application is being returned to the RO/US for continued processing. Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Erin P. Thomson

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05 JUN 2006

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In re Application of	:	
DANIEL, D. Steven	:	
PCT No.: PCT/US05/30899	:	DECISION
Int. Filing Date: 31 August 2005	:	
Priority Date: 30 August 2004	:	ON PETITIONS UNDER
Docket No.: 59460.T1	:	
For: ELECTROMECHANICAL VALVE ACTUATOR	:	37 CFR 1.10 (d), (h) and (i)

This decision is in response to applicant's "Renewed Petition Under 37 CFR 1.10," filed on 02 December 2005.

BACKGROUND

Applicant filed international application PCT/US05/30899 via Express Mail.

On 19 September 2005, applicant filed the instant petition to correct the international filing date.

On 03 October 2005, the Office mailed Decision On Petition Under 37 CFR 1.10, dismissing applicants' petition without prejudice.

On 28 October 2005, the Office mailed *inter alia* Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105), indicating that the application had an international filing date of 31 August 2005.

On 02 December 2005, applicant filed a renewed petition under 37 CFR 1.10.

DISCUSSION

Applicant requests that the filing date be amended to 30 August 2005. The mailing label lists the "date in" as "8/31/05." Under 37 CFR 1.10(a), correspondence delivered to the Office by "Express Mail" will be considered filed on the date of deposit with the USPS. "The date of deposit with the USPS is shown by the 'date-in' on the 'Express Mail' mailing label or other official USPS notation." 37 CFR 1.10(a).

Applicant argues that he attempted to deposit the package with USPS on 30 August 2005, but deposited it in the Express Mail drop box after the last scheduled pickup on 30 August 2005 because the drop box was jammed. 37 CFR 1.10(d) allows an applicant to petition to correct an incorrectly entered "Date In" of an Express Mail receipt.

Section 1.10(d) requires that the petition be (1) filed promptly, that the (2) original submission bear the Express Mail mailing label number and that (3) applicant prove to the satisfaction of the Director that the package was deposited with "Express Mail Post Office to Addressee" service prior to the last scheduled pickup for that day.

Items (1) and (2) were previously satisfied. However, as previously noted, applicant does not even claim that item (3) occurred. Applicant claims to have been unable to deposit the package with Express Mail prior to the last scheduled pickup of the drop box. This is more properly treated under 37 CFR 1.10(h).

37 CFR 1.10(h) states:

(h) Any person who attempts to mail correspondence addressed asset out in § 1.1 (a) to the Office with sufficient postage utilizing the "Express Mail Post Office to Addressee" service of the USPS, but has the correspondence refused by an employee of the USPS due to an interruption or emergency in "Express Mail" service, may petition the Director to consider such correspondence as filed on a particular date in the Office, provided that:

(1) The petition is filed promptly after the person becomes aware of the refusal of the correspondence;

(2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the attempted mailing by "Express Mail";

(3) The petition includes the original correspondence or a copy of the original correspondence showing the number of the "Express Mail" mailing label thereon; and

(4) The petition includes a statement by the person who originally attempted to deposit the correspondence with the USPS which establishes, to the satisfaction of the Director, the original attempt to deposit the correspondence and that the correspondence or copy of the correspondence is the original correspondence or a true copy of the correspondence originally attempted to be deposited with the USPS on the requested filing date. The Office may require additional evidence to determine if the correspondence was refused by an employee of the USPS due to an interruption or emergency in "Express Mail" service.

Applicant claims to have experienced a postal service interruption, but has not provided from evidence of such interruption. Applicant claims that the post office was unavailable at a posted open time. Applicant claims to have attempted to deposit mail from 6:20pm to 7:10pm, with applicant stating that the branch was open until 7:00pm on 30 August 2005. Applicant has not furnished proof of the hours. The undersigned called the USPS branch in Knoxville, TN for 37950-9998 and spoke with the Window Supervisor, Lynn Mauk. Mr. Mauk reviewed personnel reporting records and informed the undersigned that the branch's hours were until 6:00pm and did not change to 7:00pm until September 10, 2005. He explained that the hours are seasonal and change after Labor Day each year. A refusal by an employee to open a door after the post office is closed for the day is not a postal service interruption.

Applicant's claims are not sufficient. While applicant claims to have been unable to use the drop box, drop box users are encouraged to use an Express Mail log as described in MPEP 513, such a log made within one business day might have been sufficient documentation. Photographic evidence of the *jammed* boxed might also have helped applicant's petition. Otherwise, applicant must supply evidence from USPS as to the interruption.

Items (1), (2) and (3) were previously satisfied. Item (4) has not been satisfied.

37 CFR 1.10(i) is not applicable as the alleged interruption is not one declared by the Director.

CONCLUSION

For the reasons listed above, applicant's petitions under 37 CFR 1.10(d), (h) and (i) to correct the international filing date are **DISMISSED** without prejudice.

Any reconsideration on the merits of this petition must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.10."

The application is being returned to the RO/US for continued processing. Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Erin P. Thomson

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UNITED STATES PATENT AND TRADEMARK OFFICE

13 SEP 2007

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BURR & BROWN
PO BOX 7068
SYRACUSE, NY 13261-7068

In re Application of
SENSIS CORPORATION et al.
PCT No.: PCT/US05/32366
Int. Filing Date: 12 September 2005
Priority Date: 10 September 2004
Attorney's Docket No.: 909_032 WO
For: Method And Apparatus For Propping Devices

: DECISION ON
: PETITION
: UNDER 37 CFR 1.181

This decision is in response to applicant's "Request for Correction Of Error," filed on 21 June 2006 and treated as a petition under 37 CFR 1.181. No petition fee is required.

BACKGROUND

On 12 September 2005, applicants filed PCT/US05/32366 claiming an earlier priority date of 10 September 2004. Applicants designated the United States Patent and Trademark Office as the Receiving Office (RO/US) and the International Searching Authority (ISA/US).

On 02 November 2005, the United States Receiving Office (RO/US) mailed a "Notification Of The International Application Number And Of The International Filing Date" (Form/PCT/RO/105) according an international filing date of 12 September 2005 to the above-identified application.

On 24 April 2006, the ISA/US mailed the "Notification of Transmittal of the International Search Report and the Written Opinion" (Form PCT/ISA/220), the Search Report (ISR) (Form PCT/ISA/210) and the Written Opinion of the International Searching Authority (Form PCT/ISA/237). Specifically, the Written Opinion of the International Searching Authority (Form PCT/ISA/237) indicated that because the priority date indicated is more than one (1) year from the international filing date, the written opinion has been established as if no priority has been claimed (see Form PCT/ISA/237, Box No. II, Items "2" and "3").

On 21 June 2006, applicants filed the instant "Request for Correction Of Error," that has been treated as a petition under 37 CFR 1.181. Specifically, applicants indicate that the priority claim is valid.

On 05 June 2007, applicants filed a "Second Request For Correction Of Error In The Written Opinion And The International Preliminary Examination Report," that has been treated as a petition under 37 CFR 1.181. Specifically, applicants indicate once more that the priority claim is valid.

DISCUSSION

The evidence of record is sufficient to establish that the priority claim is valid. Specifically, applicants claim priority to provisional application US Serial No. 60/609,191, filed on Friday, 10 September 2004. The instant international application PCT/US05/32366 was filed on Monday, 12 September 2005.

PCT Rule 80.5 states that:

> If the expiration of any period during which any document or fee must reach a national Office or intergovernmental organization falls on a day:
>
> (i) on which such Office or organization is not open to the public for the purposes of the transaction of official business;
>
> (ii) on which ordinary mail is not delivered in the locality in which such Office or organization is situated;
>
> (iii) which, where such Office or organization is situated in more than one locality, is an official holiday in at least one of the localities in which such Office or organization is situated, and in circumstances where the national law applicable by that Office or organization provides, in respect of national applications, that, in such a case, such period shall expire on a subsequent day; or
>
> (iv) which, where such Office is the government authority of a Contracting State entrusted with the granting of patents, is an official holiday in part of that Contracting State, and in circumstances where the national law applicable by that Office provides, in respect of national applications, that, in such a case, such period shall expire on a subsequent day;
>
> the period shall expire on the next subsequent day on which none of the said four circumstances exists.

In this case, the twelve (12) month period for having a valid priority claim expired on Saturday, 10 September 2005. However, because the United States Patent and Trademark Office is closed ("not open to the public for the purposes of the transaction of official business") on Saturday and Sunday, the period to file an international application having a valid priority claim expired on the next business day, which was Monday, 12 September 2005.

Therefore, it is appropriate, on the present record, to accept that applicants' priority claim is valid.

Accordingly, a new International Search Report and Written Opinion are warranted.

CONCLUSION

For the reasons set forth above, applicants' petition under 37 CFR 1.181 is **GRANTED.**

The International Search Report (Form PCT/ISA/210) and the Written Opinion of the International Searching Authority (Form PCT/ISA/237), mailed 24 April 2006, are **VACATED**.

Because the petition filed 21 June 2006 has been granted, the petition filed 05 June 2007 is **MOOT**.

This application is being forwarded to the ISA/US for further processing in accordance with this decision, including providing a new International Search Report and Written Opinion.

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PCT Legal Examiner
Office of PCT Legal Administration

Stefan Staicovici
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Office of PCT Legal Administration
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CC: The International Bureau of WIPO
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Switzerland

28 FEB 2007

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RODNEY D. DEKRUIF
REINHART BOERNER VAN DEUREN S.C.
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MILWAUKEE WI WISCONSIN 53202

In re Application of
NORTHWESTERN UNIVERSITY
PCT No.: PCT/US05/32833
Int. Filing Date: 14 September 2005
Priority Date: 14 September 2004
Atty. Docket No.: 8536-PCT
For: CARBONYL-FUNCTION THIOPHENE COMPOUNDS AND RELATED DEVICE STRUCTURES

: DECISION ON PETITION
: UNDER 37 CFR 1.10(c)

This is a decision on applicant's "Petition For Corrected Filing Date under 37 CFR 1.10(c)", filed in the United States Patent and Trademark Office (USPTO) on 23 January 2007. Applicant, in effect, requests that the USPTO accord a filing date of 14 September 2005 to the above-identified application papers. No petition fee is required.

BACKGROUND

Applicant filed international application No. PCT/US05/32833, which claimed a priority date of 14 September 2004.

On 17 January 2006, a Notification of the International Application Number and of the International Filing Date was mailed to applicant indicating that the International filing date of the application is 15 September 2005.

On 23 January 2007, applicant filed the present request, which included a copy of the Customer Receipt of the "Express Mail" mailing label Express Mail # EV717267625US. The mailing label was addressed to the "Mail Stop PCT, Commissioner for Patents, PO BOX 1450, Alexandria, VA 22313-1450". The "Date In" is blank and the Customer Copy bears a USPS barrel-stamp "SEP 14 2005".

DISCUSSION

37 CFR 1.10(c) states:

> Any person filing correspondence under this section that was received by the Office and delivered by the "Express Mail Post Office to Addressee" service of the USPS, who can show that there is a discrepancy between the filing date accorded by the Office to the correspondence and the date of deposit as shown by the "date-in" on the "Express Mail" mailing label or other official USPS notation, may petition the Commissioner to accord the correspondence a filing date as of the "date-in" on the "Express Mail" mailing label or other official USPS notation, provided that:

(1) The petition is filed promptly after the person becomes aware that the Office has accorded, or will accord, a filing date other than the USPS deposit date;
(2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail;" and
(3) The petition includes a true copy of the "Express Mail" mailing label showing the "date-in," and of any other official notation by the USPS relied upon to show the date of deposit.

The petition contains a copy of the "Express Mail" Mailing Label # EV717267625US, which bears a USPS barrel stamp date of "SEP 14 2005". The original Express Mail envelope bearing a Date-In of "5/15/05" is contained in the application file. The transmittal letter having "Express Mail" mailing label Express Mail # EV717267625US thereon is contained in the application file. Furthermore, the declaration of Margaret Dema, USPS employee who accepted the Express Mail deposit on September 14, 2005 accompanied the petition. The evidence of record is sufficient to establish with reasonable certainty that the international application papers were deposited with the United States Postal Service as an "Express Mail" Mailing on 14 September 2005. Specifically, the "Express Mail" label number (" EV717267625US") appears on "Express Mail" certificate on the PCT International Application Transmittal Letter. The indication of the "Express Mail" label number appearing on the Transmittal Letter ties the "Express Mail" label and the Transmittal Letter together such that it is clear that the international application papers were deposited on 14 September 2005.

CONCLUSION

Applicant's petition requesting that the international application papers be accorded a filing date of **14 September 2005** is **GRANTED**.

The Notification of the International Application Number and of the International Filing Date (FORM PCT/RO/US/105) mailed on 17 January 2006 is hereby VACATED. A corrected Notification of the International Application Number and of the International Filing Date will be mailed indicating an international filing date of 14 September 2005.

This application will be forwarded to the United States Receiving Office (RO/US) for further processing in accordance with this decision.

Cynthia M. Kratz
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cc: The International Bureau of WIPO
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1211, Geneva 20 Switzerland

Enclosure: FORM PCT/RO/US/105 and Corrected 1st page of PCT/RO/101

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Alexandria, VA 22313-1450
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0 8 JUN 2007

Todd E. Garcia, Ph.D.
FISH & RICHARDSON P.C.
225 Franklin Street
Boston, MA 02110

In re Application of
RHODE ISLAND HOSPITAL, A LIFESPAN-PARTNER
PCT No.: PCT/US05/33775
Int. Filing Date: 20 September 2005
Priority Date: 21 September 2004
Agent's File Reference: 18121-003WO2
For: WNT PROTEINS AND DETECTION AND TREATMENT OF CANCER

DECISION UNDER
37 CFR 1.10(c)

This is in response to applicants' 12 January 2006 communication, which is being treated as a petition under 37 CFR 1.10(c) requesting that the filing date of International Application No. PCT/US05/33775 be corrected from 21 September 2005 to 20 September 2005. No petition fee is due. The petition is **GRANTED** as follows:

BACKGROUND

As indicated in the "NOTIFICATION OF THE INTERNATIONAL APPLICATION NUMBER AND OF THE INTERNATIONAL FILING DATE" (Form PCT/RO/105 mailed 14 December 2005), International Application No. PCT/US05/33775 was accorded a filing date of 21 September 2005 by the United States Receiving Office (RO/US).

On 12 January 2006, the present petition was filed requesting that International Application No. PCT/US05/33775 be accorded a filing date of 20 September 2005 pursuant to the "Express Mail" provisions under 37 CFR 1.10.

DISCUSSION

37 CFR 1.10(c) provides that:

Any person filing correspondence under this section that was received by the Office and delivered by the "Express Mail Post Office to Addressee" service of the USPS, who can show that there is a discrepancy between the the filing date accorded by the Office to the correspondence and the date of deposit as shown by the "date-in" on the "Express Mail" mailing label or other official USPS notation, may petition the Commissioner to accord the correspondence a filing date as of the "date-in" on the "Express Mail" mailing label or other official USPS notation, provided that:

(1) The petition is filed promptly after the person becomes aware that the Office has accorded, or will accord, a filing date other than the USPS deposit date;

(2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail"; and

(3) The petition includes a true copy of the "Express Mail" mailing label showing the "date-in", and of any other official notation by the USPS relied upon to show the date of deposit.

The present petition was filed promptly. 37 CFR 1.10(c)(1). "Express Mail" Label No. EV366530758US was indicated on the transmittal letter which accompanied the original application papers. 37 CFR 1.10(c)(2). The copy of the "Express Mail" mailing label filed with the present petition indicates that the date of deposit for the present international application is 20 September 2005. Additionally, the "Track & Confirm" database of the USPS indicates that the date of deposit is 20 September 2005. Accordingly, correction of the international filing date to 20 September 2005 is appropriate.

CONCLUSION

For the above reasons, the request to correct the filing date is **GRANTED**. The Form PCT/RO/105 mailed 14 December 2005 is hereby **VACATED.**

A copy of this decision along with a corrected Form PCT/RO/105 and first page of the PCT Request indicating a 20 September 2005 international filing date are being sent to the International Bureau.

Richard Cole
PCT Legal Examiner
Office of PCT Legal Administration

JSF/RC:jf

Enclosures: a copy of corrected Form PCT/RO/105 and a copy of the corrected copy of first page of the PCT Request.

Jeremy Fleming
Paralegal Specialist
Office of PCT Legal Administration

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0 8 JUN 2007

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In re Application of	:	
SUPERPOWER, INC.	:	
PCT No.: PCT/US05/34003	:	DECISION ON PETITION
Int. Filing Date: 22 September 2005	:	
Priority Date: 22 September 2004	:	UNDER 37 CFR 1.10
Atty. Docket No.: 1014-SP232-WO	:	
For: SUPERCONDUCTOR COMPONENTS	:	

This decision is in response to applicant's "PETITION UNDER RULE 181" filed in the United States Patent and Trademark Office (USPTO) on 09 November 2006 to change the international filing date for the present international application to 22 September 2005. The petition is being treated as a petition under 37 CFR 1.10(c). No petition fee is required.

BACKGROUND

Applicant filed the above-captioned international application in the USPTO. The international application claimed priority to an earlier United States application filed 22 September 2004.

The United States Receiving Office (US/RO) accorded the application an international filing date of 21 September 2005. See "Notification of The International Application Number And of The International Filing Date" (Form PCT/RO/105) mailed 22 September 2006.

On 09 November 2006, applicant filed the present petition urging that applicant had filed the international application with the U.S. Postal Service on 22 September 2005 as an "Express Mail" mailing but that the USPTO incorrectly entered an international filing date of 21 September 2005.

DISCUSSION

37 CFR 1.10(c) states: Any person filing correspondence under this section that was received by the Office and delivered by the "Express Mail Post Office to Addressee" service of the USPS, who can show that there is a discrepancy between the filing date accorded by the Office to the correspondence and the date of deposit as shown by the "date-in" on the "Express Mail" mailing label or other official USPS notation, may petition the Commissioner to accord the correspondence a filing date as of the "date-in" on the "Express Mail" mailing label or other

official USPS notation, provided that:

(1) The petition is filed promptly after the person becomes aware that the Office has accorded, or will accord, a filing date other than the USPS deposit date;

(2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail;" and

(3) The petition includes a true copy of the "Express Mail" mailing label showing the "date-in," and of any other official notation by the USPS relied upon to show the date of deposit.

Applicant has satisfied all three items above. In addition, a review of the USPS track and confirm website finds acceptance of the parcel in question by the USPS on "April 07, 2006, 3:24 pm." Therefore, it is proper to grant applicant's petition at this time.

CONCLUSION

Applicant's petition under 37 CFR 1.10 is **GRANTED**.

The "Notification of The International Application Number And of The International Filing Date" (Form PCT/RO/105) mailed 26 May 2006 is hereby **VACATED**.

A corrected Form PCT/RO/105 and page one of the PCT Request accompany this decision.

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UNITED STATES PATENT AND TRADEMARK OFFICE

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12 DEC 2006

Laurence C. Begin
L.C. Begin & Associates, PLLC
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In re Application of
AUTOMOTIVE SYSTEMS LABORATORY, Inc.
PCT No.: PCT/US05/35447
Int. Filing Date: 30 September 2005
Priority Date: 30 September 2004
Atty. Docket No.: 5702-96101
For: DUAL-FLOW INFLATOR

DECISION ON PETITION

UNDER 37 CFR 1.10

This decision is in response to applicant's correspondence filed in the United States Patent and Trademark Office (USPTO) on 06 November 2006. The petition is being treated as a petition under 37 CFR 1.10(c). No petition fee is required.

BACKGROUND

Applicant filed the above-captioned international application in the USPTO. The international application claimed priority to earlier United States applications filed 30 September 2004 and 29 September 2005.

The United States Receiving Office (US/RO) accorded the application an international filing date of 29 September 2005. See "Notification of The International Application Number And of The International Filing Date" (Form PCT/RO/105) and "Invitation to Correct Priority Claim" (Form PCT/RO/110) mailed 05 October 2006.

On 06 November 2006, applicant filed the present petition urging that applicant had filed the international application with the U.S. Postal Service on 30 September 2005 as an "Express Mail" mailing but that the USPTO incorrectly entered an international filing date of 29 September 2005.

DISCUSSION

37 CFR 1.10(c) states: Any person filing correspondence under this section that was received by the Office and delivered by the "Express Mail Post Office to Addressee" service of the USPS, who can show that there is a discrepancy between the filing date accorded by the Office to the correspondence and the date of deposit as shown by the "date-in" on the "Express Mail" mailing label or other official USPS notation, may petition the Commissioner to accord the correspondence a filing date as of the "date-in" on the "Express Mail" mailing label or other

official USPS notation, provided that:

(1) The petition is filed promptly after the person becomes aware that the Office has accorded, or will accord, a filing date other than the USPS deposit date;

(2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail;" and

(3) The petition includes a true copy of the "Express Mail" mailing label showing the "date-in," and of any other official notation by the USPS relied upon to show the date of deposit.

Applicant has satisfied all three items above. In addition, a review of the application file finds the original Express Mail envelope contained therein showing a "Date-in" date of 9/30/05. Therefore, it is proper to grant applicant's petition at this time.

CONCLUSION

Applicant's petition under 37 CFR 1.10 (c) is **GRANTED**.

The "Notification of The International Application Number And of The International Filing Date" (Form PCT/RO/105) and "Invitation to Correct Priority Claim" (Form PCT/RO/110) mailed 05 October 2006 are hereby **VACATED**.

A corrected "Notification of the International Application Number and of thc International Filing Date" (Form PCT/RO/105) according the application papers an international filing date of 30 September 2005 and corrected first page of the PCT request form are enclosed with this decision.

The application is being returned to the United States Receiving Office for processing in accordance with this decision.

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CC: International Bureau of WIPO
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Switzerland

PCT/US05/035447 PATENT COOPERATION TREATY

From the RECEIVING OFFICE

To:
LAURENCE C. BEGIN
L.C. BEGIN & ASSOCIATES, PLLC
510 HIGHLAND AVENUE
PMB 403
MILFORD, MICHIGAN 483081

PCT

NOTIFICATION OF THE INTERNATIONAL APPLICATION NUMBER AND OF THE INTERNATIONAL FILING DATE

(PCT Rule 20.5(c))

Date of mailing *(day/month/year)* 11 DEC 2006

Applicant's or agent's file reference
5702-96101

IMPORTANT NOTIFICATION

International application No.	International filing date *(day/month/year)*	Priority date *(day/month/year)*
PCT/US2005/035447	30 Sep 2005	30 Sep 2004

Applicant
AUTOMOTIVE SYSTEMS LABORATORY, INC.

Title of the invention
DUAL-FLOW INFLATOR

1. The applicant is hereby notified that the international application has been accorded the international application number and the international filing date indicated above.

2. The applicant is further notified that the record copy of the international application:

☒ was transmitted to the International Bureau on 05 Oct 2006.

☐ has not yet been transmitted to the International Bureau for the reason indicated below and a copy of this notification has been sent to the International Bureau*:

☐ because the necessary national security clearance has not yet been obtained.

☐ because *(reason to be specified)*:

* The International Bureau monitors the transmittal of the record copy by the receiving Office and will notify the applicant (with Form PCT/IB/301) of its receipt. Should the record copy not have been received by the expiration of 14 months from the priority date, the International Bureau will notify the applicant (Rule 22.1(c)).

3. FOREIGN TRANSMITTAL LICENSE INFORMATION Completed by: DP

☐ Additional license for foreign transmittal not required. This subject matter is covered by a license already granted or the equivalent U.S. national application. Refer to that license for information concerning its scope.

☐ License for foreign transmittal not required. 37 CFR. 5.11(e)(1) or 37 CFR 5.11(e)(2) However, a license may be required for additional subject matter. See 37 CFR 5.15(b).

☒ Foreign transmittal license granted 35 U.S.C. 184; 37 CFR 5.11 on 29 Sep 2006 (date):

☐ 37 CFR 5.15(a) ☒ 37 CFR 5.15(b)

Name and mailing address of the receiving Office	Authorized officer
Mail Stop PCT, Commissioner for Patents P.O. Box 1450, Alexandria, VA 22313-1450	Derek Putonen
Facsimile No. 571-273-3201	Telephone No. 571-272-3294

Form PCT/RO/105 (July 1992)

PCT/US05/35447 12122005

PCT

REQUEST

The undersigned requests that the present international application be processed according to the Patent Cooperation Treaty.

For receiving Office use only
PCT/US 05/35447
International Application No.

International Filing Date 30 SEP 2005

PCT INTERNATIONAL APPLICATION
RO/US
Name of receiving Office and "PCT International Application"

Applicant's or agent's file reference *(if desired) (12 characters maximum)* 5702-96101

Box No. I TITLE OF INVENTION
DUAL-FLOW INFLATOR

Box No. II APPLICANT ☐ This person is also inventor

Name and address: *(Family name followed by given name; for a legal entity, full official designation. The address must include postal code and name of country. The country of the address indicated in this Box is the applicant's State (that is, country) of residence if no State of residence is indicated below.)*

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Teleprinter No.

Applicant's registration No. with the Office

State *(that is, country)* of nationality:
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State *(that is, country)* of residence:
US

This person is applicant for the purposes of: ☒ all designated States ☐ all designated States except the United States of America ☐ the United States of America only ☐ the States indicated in the Supplemental Box

Box No. III FURTHER APPLICANT(S) AND/OR (FURTHER) INVENTOR(S)

Name and address: *(Family name followed by given name; for a legal entity, full official designation. The address must include postal code and name of country. The country of the address indicated in this Box is the applicant's State (that is, country) of residence if no State of residence is indicated below.)*

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United States of America

This person is:
☐ applicant only
☐ applicant and inventor
☒ inventor only (*If this check-box is marked, do not fill in below.*)

Applicant's registration No. with the Office

State *(that is, country)* of nationality:
US

State *(that is, country)* of residence:
US

This person is applicant for the purposes of: ☐ all designated States ☐ all designated States except the United States of America ☐ the United States of America only ☐ the States indicated in the Supplemental Box

☐ Further applicants and/or (further) inventors are indicated on a continuation sheet.

Box No. IV AGENT OR COMMON REPRESENTATIVE; OR ADDRESS FOR CORRESPONDENCE

The person identified below is hereby/has been appointed to act on behalf of the applicant(s) before the competent International Authorities as: ☒ agent ☐ common representative

Name and address: *(Family name followed by given name; for a legal entity, full official designation. The address must include postal code and name of country.)*

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LESLIE S. GARMAISE
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In re Application of	:	
Sand Codex LLC	:	DECISION
PCT No.: PCT/US05/37226	:	
Int. Filing Date: 17 October 2005	:	ON
Priority Date: 15 October 2004	:	
Attorney's Docket No.: 489/15 PCT	:	PETITION
For: System And Method For Managing	:	
Communication And/Or Storage Of Image Data	:	

This is in response to applicants' petitions filed on 08 March 2006, 10 March 2006, 23 March 2006 and 12 February 2007.

BACKGROUND

Applicants filed this international application with the United States receiving Office on 17 October 2005.

On 13 February 2006, a Notification of International Filing Date... (Form PCT/RO/105) was mailed to applicants, along with *inter alia* an Invitation to Correct Defects (Form PCT/RO/106) and a Notification Regarding Certain Changes Made *Ex Officio* (Form PCT/RO/146).

DISCUSSION

Petitioner asserts that this international application was processed improperly in that the changes made ex officio do not correspond to the correct contents of the international application, and that the wrong drawing sheets were scanned as the drawings to be used. Review of the international application papers as filed on 17 October 2005 reveals that the following papers are present in the application file: a PCT Request (Form PCT/RO/101), 5 sheets; Fee Calculation Sheet (Form PCT/RO/101)(Annex), 1 sheet; Description, 356 sheets; claims, 7 sheets (numbered 357-363); Abstract, 1 sheet (numbered 364), and Drawings, 9 sheets (numbered 1/9 - 9/9). Also filed were a Transmittal Letter and a credit card payment form. The total number of sheets is therefore 381. The Request form, as filed, did not itemize the numbers of sheets of each part of the application in Box No. IX. However, the application file includes a photocopy of a return postcard receipt stamped with international application no. "PCT/US05/37226" and itemizing a "Transmittal Letter (1 pg.)," a "PCT Request (5 pgs.)," a "Fee Calculation Sheet (1 pg.)," a "Specification, with Appendices (364 pgs.)," a "Credit Card Payment Form for $6,694.00," and "Twelve (12 Sheets of Drawings." The number "12" referring to drawing sheets was crossed out and replaced with a "9." The postcard receipt was stamped as "Rec'd PCT/PTO 17 OCT 2005." This postcard receipt corroborates the number of sheets which are actually present in the application file.

Meanwhile, the Transmittal Letter filed on 17 October 2005 itemized a Request (5 sheets), 356 sheets of description, 7 sheets of claims, 1 sheet of abstract, 12 sheets of drawings, and a credit card

payment form. The accompanying Fee Calculation Sheet (Form PCT/RO/101)(Annex) authorized payment for 351 "sheets in excess of 30." This indicates that applicants in fact did substantially intend to pay for these sheets to be considered as part of the international application. It is noted that the "Supplemental Information..." filed on 10 March 2006 states that

> Applicants incorrectly indicated in the outgoing paperwork for the '226 application that there were twelve (12) sheets of drawings instead of the actual nine (9) sheets. Applicants regret this error. However, upon accepting this correction, it is clear that Applicants' paperwork, copies of which are provided herewith, support Applicants' stated page count.

In view of the totality of the evidence currently of record, it would be appropriate to conclude that **the international application as filed on 17 October 2005 included the following components: a PCT Request (Form PCT/RO/101), 5 sheets; a Fee Calculation Sheet (Form PCT/RO/101)(Annex), 1 sheet; a Description, 356 sheets; claims, 7 sheets (numbered 357-363); an Abstract, 1 sheet (numbered 364), and Drawings, 9 sheets (numbered 1/9 - 9/9). Also filed were a Transmittal Letter and a credit card payment form.** The total number of sheets filed was therefore 381, of which 348 are chargeable as sheets over 30. Despite the number of sheets over 30 (351) identified on the Fee Calculation Sheet, corresponding to a fee of $4176.00, applicants were actually charged $1968.00 (corresponding to 164 sheets over 30). In view of the foregoing discussion, the correct total amount for sheets over 30 was $4176.00. Therefore, $2208.00 in extra sheets fees is payable. This amount is being charged to counsel's Deposit Account No. 11-0223, per the authorization included in the correspondence filed on 10 March 2007.

The Invitation to Correct Defects (Form PCT/RO/106) and a Notification Regarding Certain Changes Made *Ex Officio* (Form PCT/RO/146) are hereby **VACATED**. A corrected copy of sheet 5 of the PCT Request, showing the correct number of application sheets, is attached hereto.

DECISION

Applicants' petition is **GRANTED**, for the reasons described *supra*.

This application is being returned to the United States receiving Office (RO/US) for further treatment consistent with this decision; that is, processing of the application in view of the correct number of sheets of each type as indicated in bold and underlined above.

George Dombroske
PCT Legal Examiner
Office of PCT Legal Administration
Tel: (571) 272-3283
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cc: International Bureau of WIPO
34, chemin des Colombettes
1211 Geneva 20, Switzerland

enc.: Form PCT/RO/101, fifth sheet

29 MAR 2006
PCT/US2005/037666 29 MAR 2006

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Ann I. Dennan
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100 Galleria Parkway, Suite 1750
Atlanta, GA 30339

In re Application of	:	
THE FORCE, INC. *et al*	:	
PCT No.: PCT/US2005/037666	:	**DECISION**
Int. Filing Date: 18 October 2005	:	
Priority Date: None	:	**UNDER**
Attorney Docket No.: 730602-2020	:	
For: PARTS MARKING SYSTEM AND METHOD	:	**37 CFR 1.10(d)**

This decision is in response to the "Petition to Correct Priority Claim" filed 09 February 2006 which is treated as a petition under 37 CFR 1.10(d). No fee is required.

BACKGROUND

Applicant filed international application PCT/US2005/037666 using Express Mail service claiming priority to two U.S. provisional applications filed 15 October 2004 and 15 October 2005.

On 09 December 2005, the United States Receiving Office (RO/US) mailed a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) indicating that the international filing date of the subject application is 18 October 2005 with a priority date of 15 October 2004. An Invitation to Correct Priority Claim (Form PCT/RO/110) was also mailed for the second priority claim.

On 26 January 2006, applicant filed a "Response to Invitation to Correct Priority Claim" which included the application number for the second priority claim.

On 09 February 2006, applicant filed a petition to change the international filing date which was accompanied by, *inter alia*, exhibits A - G.

DISCUSSION

A review of the subject application shows that the Addressee Copy of Express Mail No. EL994687639US is located in the file with a "Date In" of "10 18 05." Moreover, the USPS Track/Confirm records for Express Mail No. EL994687639US verifies that it was accepted in Huntsville, AL on 18 October 2005 at 1:44 p.m. Thus, the international

filing date of 18 October 2005 is appropriate. *See* 37 CFR 1.10(a).

Applicant argues that the international filing date is "based upon incorrect entry by the U.S. Postal Service (USPS)" Petitioner claims that the above-identified international application should be given an international filing date of 17 October 2005. 37 CFR 1.10(d) allows applicants to petition to correct an incorrectly entered "Date In" of an Express Mail receipt and states that:

> (d) Any person filing correspondence under this section that was received by the Office and delivered by the "Express Mail Post Office to Addressee" service of the USPS, who can show that the"date-in" on the "Express Mail" mailing label or other official notation entered by the USPS was incorrectly entered or omitted by the USPS, may petition the Commissioner to accord the correspondence a filing date as of the date the correspondence is shown to have been deposited with the USPS, provided that:
>
> (1) The petition is filed promptly after the person becomes aware that the Office has accorded, or will accord, a filing date based upon an incorrect entry by the USPS;
>
> (2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail";
>
> (3) The petition includes a showing which establishes, to the satisfaction of the Commissioner, that the requested filing date was the date the correspondence was deposited in the "Express Mail Post Office to Addressee" service prior to the last scheduled pickup for that day. Any showing pursuant to this paragraph must be corroborated by evidence from the USPS or that came into being after deposit and within one business day of the deposit of the correspondence in the "Express Mail Post Office to Addressee" service of the USPS.

The present petition is considered to have been filed promptly. Further, a review of the above-identified application verifies that the transmittal letter included the number of the Express Mail mailing label. Thus, items (1) and (2) of 37 CFR 1.10(d) are satisfied.

Regarding item (3), petitioner claims that their showing that the correspondence was deposited on 17 October 2005 is corroborated by evidence that came into being after deposit and within one business day of the deposit of the correspondence using

Express Mail. Specifically, petitioner points to: (1) a copy log; (2) billing records of Ann Dennen; and (3) a copy of an email sent by Shana East on 18 October 2005.

A review of this evidence clearly shows that the above-identified international application was completed on 17 October 2005. The declaration by Ann Dennen, billing records, the declaration of Shana East and the copy log support this assertion and there is no reason to dispute this. However, this evidence does not show that the documents were delivered to the USPS on 17 October 2005.

Item (3) of 37 CFR 1.10(d) requires that any showing must be corroborated by evidence from the USPS or that came into being after deposit and within one business day of the deposit of the Express Mail correspondence. No evidence from the USPS was submitted. Instead, petitioner included a copy of the mail log for correspondence mailed to the USPTO. The mail log indicates that the documents for attorney docket no. 730602-2020 (the subject application) were mailed on "10-17."

However, this mail log fails to meet the reliability standard required by 37 CFR 1.10(d) as the mail log was completed prior to deposit with the USPS. *See* Shana East Decl. at ¶ 8 ("the person preparing the parcel would make an entry in the mailing log at the same time the parcel is prepared."). Ms. Buchanan does not discuss completing the mail log in her declaration.

Section 513 of the MPEP clearly indicates that the evidence must by completed after the deposit with the USPS and states, in part:

> Evidence that came into being within one day after the deposit of the correspondence as "Express Mail" may be in the form of a log book which contains information such as the "Express Mail" number; the application number, attorney docket number or other such file identification number; the place, date and time of deposit; the time of the last scheduled pick-up for that date and place of deposit; the depositor's initials or signature; and the date and time of entry in the log.
>
> **Due to the questionable reliability of evidence from a party other than the USPS that did not come into being contemporaneously with the deposit of the correspondence with the USPS, 37 CFR 1.10(d) specifically requires that any petition under 37 CFR 1.10(d) be corroborated . . . by evidence that came into being after deposit and within one business day after the deposit of the correspondence as "Express Mail."**

Therefore, the mail log clearly cannot be considered to meet item (3) of 37 CFR

1.10(d). Petitioner has not submitted any other corroborating evidence.

CONCLUSION

Applicant's petition under 37 CFR 1.10(d) is **DISMISSED** without prejudice.

Any reconsideration on the merits of this petition must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.10(d)."

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.

James Thomson

James Thomson
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Tel.: (571) 272-3302

UNITED STATES PATENT AND TRADEMARK OFFICE
PCT/US2005/037666 18 OCT 2006

Commissioner for Patents
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04 OCT 2006

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In re Application of
THE FORCE, INC. *et al*
PCT No.: PCT/US2005/037666
Int. Filing Date: 18 October 2005
Priority Date: None
Attorney Docket No.: 730602-2020
For: PARTS MARKING SYSTEM AND METHOD

DECISION ON

RENEWED PETITION

UNDER 37 CFR 1.10(d)

This is a decision on a renewed petition under 37 CFR 1.10(d) filed 26 March 2006.

BACKGROUND

On 29 March 2006, a decision dismissing applicant's petition under 37 CFR 1.10(d) was mailed. Applicant failed to satisfy item (3) of 37 CFR 1.10(d) and was given two months to respond.

On 26 May 2006, applicant filed the renewed petition.

DISCUSSION

In the initial petition, petitioner failed to satisfy item (3) of 37 CFR 1.10(d).[1] Specifically, petitioner failed to show that the Express Mail documents were delivered to the USPS on 17 October 2005. The mailing log submitted was made prior to deposit of the correspondence.

In the renewed response, petitioner argues that the email sent by Shana East on 18 October 2005 at 3:13 p.m. (EST) to the docketing department of Thomas, Kayden, Horstemeyer & Risley, LLP was within one business day of the deposit of the

[1] 37 CFR 1.10(d)(3) - The petition includes a showing which establishes, to the satisfaction of the Commissioner, that the requested filing date was the date the correspondence was deposited in the Express Mail Post Office to Addressee service prior to the last scheduled pickup for that day. Any showing pursuant to this paragraph must be corroborated by evidence from the USPS or that came into being after deposit and within one business day of the deposit of the correspondence in the "Express Mail Post Office to Addressee" service of the USPS.

correspondence with the USPS. Moreover, section 513 of the MPEP suggests that a client letter could satisfy the reliability standard if it was prepared after the deposit of the correspondence rather than "prior to" such deposit. Petitioner claims that the email by Ms. East is "similar to the contemplated client letter in that the email, like a client letter that reports the date of filing of a patent application

Petitioner's claim has been carefully considered and rejected.

Section 513 of the MPEP clearly indicates that petitioner's burden of proof to change a USPS receipt date verified by a "disinterested USPS employee" is high and states that notations in the Express Mail log books must be entered by the person who deposited the correspondence after deposit and within one business day to be of value in supporting petitions under 37 CFR 1.10(c-e).

Here, the evidence submitted was an email to the docketing department drafted by Shana East noting that the subject application was filed on 17 October 2005. However, Ms. Shana East is not the person who deposited the correspondence. The documents were deposited by Ms. Ciera Buchanan. Therefore, Ms. East has no first-hand knowledge that the documents were deposited on that day. As such, the email by Ms. East is not of sufficient reliability to meet item (3) of 37 CFR 1.10(d).

CONCLUSION

For the reasons discussed above, applicant's renewed petition under 37 CFR 1.10(d) is **DISMISSED** without prejudice.

Any reconsideration on the merits of this petition must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.10(d)."

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.

James Thomson

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24 SEP 2007

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In re Application of
THE FORCE, INC. *et al*
PCT No.: PCT/US2005/037666
Int. Filing Date: 18 October 2005
Priority Date: None
Attorney Docket No.: 730602-2020
For: PARTS MARKING SYSTEM AND METHOD

DECISION ON SECOND RENEWED PETITION UNDER 37 CFR 1.10(d)

This is a decision on a second renewed petition under 37 CFR 1.10(d) filed 01 December 2006.

BACKGROUND

On 04 October 2006, a decision dismissing applicant's renewed petition under 37 CFR 1.10(d) was mailed. Applicant again failed to satisfy item (3) of 37 CFR 1.10(d) and was given two months to respond.

On 01 December 2006, applicant filed a second renewed petition.

DISCUSSION

Petitioner requests reconsideration of the decision mailed 04 October 2006 and argues that 37 CFR 1.10(d)(3) was satisfied by the evidence previously submitted. Applicant refers to a decision in U.S. Application No. 11/252,408 which was deposited on the same day and was granted. Applicant claims that this decision held that the email by Shana East was "corroborating evidence that came into being after deposit and within one business day of deposit as required by 37 CFR 1.10(d)(3).

Applicant argues that there is nothing in 37 CFR 1.10(d)(3) or the MPEP to suggest that any piece of evidence, when viewed in isolation, must satisfy both requirements of 37 CFR 1.10(d)(3) (that the correspondence was deposited prior to the last scheduled pickup for that day and corroborating evidence from the USPS or that came into being after deposit and within one business day of the deposit.) Applicant claims that the relevant inquiry is "whether the evidence, as a whole, sufficiently establishes that the first requirement of 37 CFR 1.10(d)(3) is satisfied and then whether there is corroborating evidence that came into being after deposit and within one business day of the deposit.

Petitioner's claim has been considered and dismissed.

As indicated in the decision dated 29 March 2006, the Addressee Copy of Express Mail No. EL994687639US was located in the file and has a "Date In" of "10 18 05." Moreover, the USPS Track/Confirm records for Express Mail No. EL994687639US verifies that it was accepted in Huntsville, AL on 18 October 2005 at 1:44 p.m. Accordingly, the USPS indicates that the documents were deposited on 18 October 2005, not 17 October 2005.

Applicant claims that the USPS was mistaken and asserts that the evidence submitted including the declarations by Ann Dennan, Shana East and Ciera Buchanan, as well as Exhibits A-G, as a whole are sufficient to establish that the documents were deposited on 17 October 2005.

That is not the case. The evidence submitted on 09 February 2007 was only sufficient to show that the above-identified international application was completed on 17 October 2005. The evidence did not show, as a whole, that the documents were delivered to the USPS prior to the last scheduled pickup on 17 October 2005. Moreover, the email dated 18 October 2005 is considered hearsay. While it is likely Ms. East's belief that the documents in question were deposited with the USPS prior to the last pickup of the day on 17 October 2005, Ms. East has no first-hand knowledge of this matter. As such, the email does not show that the "date-in" provided by the USPS was wrong.

Applicants are also warned in the MPEP of the dangers of USPS drop boxes because they do not receive an Express Mail mailing label with the date-in clearly marked. However, section 513 provides applicants an appropriate procedure to protect themselves if applicants must use drop boxes and states that:

> Parties who do use drop boxes can protect themselves from uncertainty due to illegible mailing labels by routinely maintaining a log of "Express Mail" deposits in which notations are entered by the person who deposited the correspondence as "Express Mail" within one business day after deposit with the USPS. Such evidence could be useful to later support a petition filed under 37 CFR 1.10(c), (d) or (e). Evidence that came into being after deposit and within one day after the deposit of the correspondence as "Express Mail" may be in the form of a log book which contains information such as the "Express Mail" number; the application number, attorney docket number or other such file identification number; the place, date and time of deposit; the time of the last scheduled pick-up for that date and place of deposit; the depositor's initials or signature; and the date and time of entry in the log.

Here, applicants failed to follow this guidance as the mailing log was completed

prior to mailing. *See* First East Decl. at ¶ 8. In light of the available evidence, applicants have not established to the satisfaction of the Commissioner that the above captioned application was deposited via Express Mail at the USPS prior to the last pickup on 17 October 2005.

CONCLUSION

For the reasons discussed above, applicant's second renewed petition under 37 CFR 1.10(d) is **DISMISSED** without prejudice.

Any reconsideration on the merits of this petition must be filed within **TWO (2) MONTHS** from the mail date of this decision.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.

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04 JAN 2008

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In re Application of
THE FORCE, INC. *et al*
PCT No.: PCT/US2005/037666
Int. Filing Date: 18 October 2005
Priority Date: None
Attorney Docket No.: 730602-2020
For: PARTS MARKING SYSTEM AND METHOD

DECISION ON THIRD RENEWED PETITION UNDER 37 CFR 1.10(d)

This is a decision on the third renewed petition under 37 CFR 1.10(d) filed 26 November 2007.

BACKGROUND

On 24 September 2007, a decision dismissing applicant's second renewed petition under 37 CFR 1.10(d) was mailed. Applicant again failed to satisfy item (3) of 37 CFR 1.10(d) and was given two months to respond.

On 26 November 2007, applicant filed a third renewed petition.

DISCUSSION

Applicant requests reconsideration of the decision mailed 24 September 2007 and argues that 37 CFR 1.10(d)(3) was satisfied by the evidence previously submitted.

In the third renewed petition, applicant included a Supplemental Declaration by Ms. East stating that the "according to information posted by the U.S. Postal Service . . . the first time scheduled for pickup for all deposit boxes . . . is 1:15 p.m. Monday through Friday." Applicant acknowledges that the USPS Track/Confirm records indicate that the correspondence was accepted by the USPS on 18 October 2005 at 1:44 pm and states that the very existence of 37 CFR 1.10(d) "indicates a recognition that the USPS Track/Confirm records may be incorrect." We concur.

Applicant states that the USPS Track/Confirm records indicate when the correspondence was accepted by the USPS, not when the correspondence was actually deposited at the USPS. Moreover, 37 CFR 1.10(d)(3) is satisfied if it can be shown that a correspondence is deposited prior to the last scheduled pickup on the day in question, regardless of when actually accepted by the USPS. We also concur with this conclusion.

Applicant argues that the e-mail by Ms. East is not hearsay but "rather is evidence based on her first-hand knowledge of various facts." Counsel asserts that the e-mail by Ms. East need not show that the "date-in" of the USPS was wrong, but only that it corroborates other evidence submitted by applicant and that the email in conjunction with all of the other evidence satisfies 37 CFR 1.10(d)(3).

The email by Ms. East dated 18 October 2005 was discussed in the decision mailed 04 October 2006 and again in the decision mailed 24 September 2007. The email evidence is crucial in that 37 CFR 1.10(d) specifically requires that any petition be corroborated by evidence from the USPS, or that came into being after deposit and within one business day after the deposit of the correspondence as Express Mail. Applicant provided no evidence from the USPS. The only evidence that meets the time criteria established by 37 CFR 1.10(d) is the East email.

Section 513 of the MPEP discusses two specific examples of evidence contemplated to be used in a 37 CFR 1.10(d) petition and includes "an affidavit or declaration prepared more than one business day after the correspondence was deposited" or a "notation in a log book, entered after deposit by the person who deposited the correspondence with the USPS." Section 513 expands on the log book example in two paragraphs and states that this log book contains specific "information such as the "Express Mail" number; the application number, attorney docket number or other such file identification number; the place, date and time of deposit; the time of the last scheduled pick-up for that date and place of deposit; the depositor's initials or signature; and the date and time of entry in the log." While these examples are only suggestions, they indicate the degree of trustworthiness required to meet these criteria under 37 CFR 1.10(d) if the evidence is from a source other than the USPS.

A review of the East email shows that it does not contain the required trustworthiness characteristics contemplated by section 513 of the MPEP and discussed above. The email is a list of five applications with their docket number, title, inventor and date filed sent by Ms. East to "Docketing." Only two of the five applications noted in the email were filed on 17 October 2005. Moreover, Ms. East did not actually deposit the subject correspondence at the USPS. The correspondence was deposited by Ciera Buchanan. The email also does not indicate that the instant application was deposited with the USPS prior to the last scheduled pickup on 17 October 2005. For these reasons, we conclude that the East email is not of sufficient reliability to overcome the direct evidence from the USPS that the correspondence was deposited after the last scheduled pickup of the day.

Finally, applicant argues that it is unnecessary for an applicant to make a showing under 37 CFR 1.10(d)(3) only with evidence that came into being after deposit and within one business day. The fact that 37 CFR 1.10(d)(3) uses the term "corroborating" indicates that the showing may be made with evidence that does not meet the time standard. Applicant argues that "in a situation, such as in the instant case, where there is significant evidence that came into being before deposit, it is too

stringent of a standard to require an applicant to provide evidence similar to the log book entry described by M.P.E.P. §513, which . . . , by itself, makes a sufficient showing under 37 C.F.R. §1.10(d)(3)."

We concur that applicant may use other evidence in support of any petition under 37 CFR 1.10(d). However, the evidence submitted by applicant including the East email, supporting declarations and exhibits fail to meet the crucial threshold, which is, that Ms. Buchanan deposited the correspondence with the USPS prior to the last scheduled pickup on 17 October 2005.

As previously noted, section 513 of the MPEP discusses the dangers of using USPS drop boxes. Nonetheless, applicant's are provided with a safe harbor to protect themselves in these situations and states, in part:

> Parties who do use drop boxes can protect themselves from uncertainty due to illegible mailing labels by routinely maintaining a log of "Express Mail" deposits in which notations are entered by the person who deposited the correspondence as "Express Mail" within one business day after deposit with the USPS.

However, applicant did not follow these procedures. In light of the available evidence, applicant has not established to the satisfaction of the Commissioner that the above captioned application was deposited via Express Mail at the USPS prior to the last pickup on 17 October 2005.

CONCLUSION

For the reasons discussed above, applicant's third renewed petition under 37 CFR 1.10(d) is **DISMISSED** without prejudice.

Any reconsideration on the merits of this petition must be filed within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time are available.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.

James Thomson

James Thomson
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United States Patent and Trademark Office

Commissioner for Patents
United States Patent and Trademark Office
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16 MAR 2007

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1445 ROSS AVENUE, SUITE 3700
DALLAS, TX 75202

In re Application of	:	
Brantley	:	DECISION
PCT No.: PCT/US05/38366	:	
Int. Filing Date: 25 October 2005	:	ON
Priority Date: 25 October 2004	:	
Attorney's Docket No.: 50122-00004WOPT A	:	PETITION
For: Motorized Towable Sweeping Apparatus And Related Method	:	

This is in response to applicants' "Request For Refund" filed on 20 October 2006.

BACKGROUND

Applicants filed this international application with the United States receiving Office on 25 October 2005.

On 21 November 2005, a Notification Concerning Payment of Prescribed Fees (Form PCT/RO/102) was mailed to applicants, requiring the submission of $2,422.00 in fees. Said fees were subsequently charged to counsel's Deposit Account (no. 10-0447) on 13 January 2006.

On 15 December 2005, a Notification of International Filing Date... (Form PCT/RO/105) was mailed to applicants.

DISCUSSION

Petitioner asserts that the "PCT application was filed without an authorization to charge the deposit account; however, the deposit account was billed nonetheless. The PCT Fee Calculation Sheet transmittal is attached showing the Authorization to Charge Deposit Account box not checked for ease of reference." Review of the application file reveals that the PCT Fee Calculation Sheet (Form PCT/RO/101 (Annex)) filed on 25 October 2005 refers to "Deposit Account No.: 10-0447," but none of the boxes authorizing charges to be made to that Deposit Account were checked. Further review of the file reveals that no other Deposit Account authorization is present. Therefore, it was inappropriate to charge fees (totaling $2,422.00) to the Deposit Account in question on 13 January 2006, and accordingly those fees are being refunded.

In view of the erroneous fee payment noted above, the International Search Report and Written Opinion (Forms PCT/ISA/210 and PCT/ISA/237) mailed on 16 August 2006 were issued in error, and accordingly they are hereby **VACATED**.

DECISION

Applicants' refund request is **GRANTED**, for the reasons described *supra*.

Petitioner's Deposit Account No. 10-0447 is being credited in the amount of $2,422.00 for the fees improperly charged on 13 January 2006.

This application is being forwarded to PCT Central Files.

George Dombroske
PCT Legal Examiner
Office of PCT Legal Administration
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cc: International Bureau of WIPO

IAP15 Rec'd PCT/PTO 06 DEC 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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Alexandria, VA 22313-1450
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06 DEC 2007

Mark L. Yaskanin
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Denver, Colorado 80202-5141

In re Application of	:	
ABSOLUTE CLOSURE INNOVATIONS, INC. et. al.	:	DECISION ON
PCT No.: PCT/US2005/038691	:	
Int. Filing Date: 25 October 2005	:	REQUEST FOR
Priority Date: 25 October 2004	:	
Attorney's Docket No.: 3772-7-CON-CIP-PCT	:	REFUND
For: DEVICE FOR CREATING A SEAL BETWEEN FABRICS OR OTHER MATERIALS	:	

This decision is in response to the request for refund of the supplemental search fees filed 20 June 2007.

BACKGROUND

On 20 July 2005, applicants filed international application papers which were assigned application number PCT/US2005/038691.

On 26 May 2006, applicant filed a letter requesting that applicant's deposit account be debited for $2000 in order to pay the supplemental search fees.

On 20 June 2007, applicant filed the current paper requesting a refund of $2000 supplemental search fees, since only Group I was searched when the search report issued.

DISCUSSION

The supplemental search fees of $2000 were refunded on 11 September 2007. Therefore, this request is moot.

CONCLUSION

Applicant's request to refund the supplemental search fees is **MOOT**.

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

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Leonard Smith
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12 FEB 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

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KING OF PRUSSIA PA 19406-0939

In re Application of	:	
GLAXO GROUP LIMITED	:	
PCT No.: PCT/US05/39209	:	DECISION
Int. Filing Date: 28 October 2005	:	
Priority Date: 29 October 2004	:	
Docket No.: PU61104	:	
For: MUSCARINIC ACETYLCHOLINE	:	
RECEPTOR ANTAGONISTS	:	

This decision is in response to applicant's "RENEWED PETITION UNDER 37 CFR 1.10(d)" filed on 26 May 2006.

BACKGROUND

On 30 January 2006, the United States Receiving Office (RO/US) mailed a NOTIFICATION OF THE INTERNATIONAL APPLICATION NUMBER AND OF THE INTERNATIONAL FILING DATE (Form PCT/RO/105) according the above-identified international application an international filing date of 27 October 2005 and a priority date of 29 October 2005.

On 28 February 2006, applicant submitted a "REQUEST TO CORRECT FILE DATE" which was accompanied by, *inter alia*, a copy of the Customer Copy of the "Express Mail Post Office to Addressee" mailing label #EV453422094US. The submission was properly treated as a petition under 37 CFR 1.10(d).

On 05 April 2006, a decision was mailed dismissing applicant's petition under 37 CFR 1.10(d). Specifically, it was noted that the Customer Copy of the "Express Mail Post Office to Addressee" mailing label #EV453422094US included a "Date In" of 27 October 2005 and a stamp on the same copy which showed a date of "OCT 28" and that one could conclude that either of these two dates were correct.

On 26 May 2006, applicant submitted the instant "RENEWED PETITION UNDER 37 CFR 1.10(d)" which was accompanied by a track and confirm e-mail form the United States Postal Service (USPS) for Express Mail mailing label number EV453422094US showing an "Acceptance" date of 28 October 2005.

DISCUSSION

37 CFR 1.10(d) states:

> (d) Any person filing correspondence under this section that was received by the Office and delivered by the "Express Mail Post Office to Addressee" service of the USPS, who can show that the "date-in" on the "Express Mail" mailing label or other official notation entered by the USPS was incorrectly entered or omitted by the USPS, may petition the Commissioner to accord the correspondence a filing date as of the date the correspondence is shown to have been deposited with the USPS, provided that:
>
> (1) The petition is filed promptly after the person becomes aware that the Office has accorded, or will accord, a filing date based upon an incorrect entry by the USPS;
>
> (2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail"; and
>
> (3) The petition includes a showing which establishes, to the satisfaction of the Commissioner, that the requested filing date was the date the correspondence was deposited in the "Express Mail Post Office to Addressee" service prior to the last scheduled pickup for that day. Any showing pursuant to this paragraph must be corroborated by evidence from the USPS or that came into being after deposit and within one business day of the deposit of the correspondence in the "Express Mail Post Office to Addressee" service of the USPS.

As noted in the decision mailed 05 April 2006, a satisfactory showing under 37 CFR 1.10(d)(1) and (2) has been made.

A satisfactory showing under 37 CFR 1.10(d)(3) has now been made as well.

CONCLUSION

For the reasons listed above, applicant's petition under 37 CFR 1.10(d) to correct the international filing date is **GRANTED**.

The Notification of the International Application Number and of the International Filing Date (PCT/RO/105) mailed 30 January 2006 is **VACATED**.

The application is being returned to the RO/US for continued processing.

Daniel Stemmer
Legal Examiner
PCT Legal Affairs
Office of Patent Cooperation Treaty
Legal Administration
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Enc: Corrected Form PCT/RO/105
Request (Form PCT/RO/101), page 7

cc: International Bureau
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Switzerland

UNITED STATES PATENT AND TRADEMARK OFFICE

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0 4 APR 2007

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WASHINGTON, DC 2005

In re Application of
KABUSHIKI KAISHA TOSHIBA et al
PCT Application No.: PCT/US2005/040188
Int. Filing Date: 05 November 2005
Priority Date Claimed: 05 November 2004
Attorney Docket No.: 3119.111.US0000
For: NETWORK DISCOVERY MECHANISMS

DECISION

This is in response to applicant's "Renewed Petition Under 37 C.F.R. 1.182" filed 26 February 2007.

BACKGROUND

On 05 November 2005, applicant filed international application papers with the United States Receiving Office (RO/US). The submission was assigned the above-identified International Application Number and International Filing Date.

On 02 December 2005, the RO/US mailed a Notification Concerning Payment of Prescribed Fees (Form PCT/RO/102), which stated that fees totaling $3,374.00 were due.

On 05 December 2005, applicant filed a Credit Card Payment Form (Form PTO-2038) and an authorization to charge Deposit Account No. 14-1437 for any fee deficiency.[1]

On 20 January 2006, the RO/US mailed an Invitation to Pay Prescribed Fees Together With Late Payment Fee (Form PCT/RO/133), which stated that fees totaling $3,865.00 were due on or before 21 February 2006 in order to prevent withdrawal of the international application under PCT Rule 16*bis*.1(c).

On 17 February 2006, applicant filed a Credit Card Payment Form (Form PTO-2038) and an authorization to charge Deposit Account No. 14-1437 for any fee deficiency.[2]

[1, 2] As stated in the decision mailed 15 February 2007, a review of USPTO records revealed that Deposit Account No. 14-1437 did not contain sufficient funds to cover the outstanding fees.

On 24 March 2006, the RO/US mailed a Notification That International Application Considered to be Withdrawn (Form PCT/RO/117).

On 01 February 2007, applicant filed a petition under 37 CFR 1.182.

On 15 February 2007, this Office mailed a decision dismissing the 01 February 2007 petition.

On 26 February 2007, applicant filed the present renewed petition under 37 CFR 1.182.

DISCUSSION

The Credit Card Payment Form (Form PTO-2038) filed 05 December 2005 bears the s-signature "/cke/". The instructions accompanying Form PTO-2038 state, "The United States Patent and Trademark Office (USPTO) cannot process credit card payments without an authorized signature." The authorized signature on Form PTO-2038 indicates the cardholder's agreement to reimburse the credit card issuer for the stated dollar amount. Because the agreement is between the cardholder and the credit card issuer, whether the signature on Form PTO-2038 is proper depends on what the credit card issuer will accept as an authorized signature, not what the USPTO accepts as a properly formatted signature.

In the present case, although the USPTO questioned whether the credit card issuer would accept the s-signature as an authorized signature, the USPTO is not the party that will accept responsibility in the event the card issuer deems the s-signature to be invalid.. 37 CFR 10.18(b) provides that by presenting a paper to the USPTO, the practitioner certifies that the information contained therein is believed to be true. Thus, the submission of Form PTO-2038 with the signed transmittal letter on 05 December 2005 was a representation by the signing practitioner that the s-signature contained in Form PTO-2038 is an authorized signature with respect to the credit card issuer. Therefore, relying on the practitioner's duty set forth in 37 CFR 10.18(b), the USPTO could have attempted to process the credit card transaction requested by applicant on 05 December 2005.

CONCLUSION

For the reasons above, the renewed petition under 37 CFR 1.182 is GRANTED

The Invitation to Pay Prescribed Fees Together With Late Payment Fee (Form PCT/RO/133) mailed 20 January 2006 and the Notification That International Application Considered to be Withdrawn (Form PCT/RO/117) mailed 24 March 2006 are hereby VACATED.

The fees due on 05 December 2005 totaling $3374.00 will be charged to the credit card specified in Form PTO-2038 filed 01 February 2007.

The application is being forwarded to the RO/US for processing in accordance with this decision and will thereafter be forwarded to the United States International Searching Authority (ISA/US) for preparation of the International Search Report and Written Opinion of the International Searching Authority. A copy of this decision is being sent to the International Bureau.

Bryan Lin

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PCT Legal Office

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04 APR 2007

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WASHINGTON, DC 2005

In re Application of	:	
KABUSHIKI KAISHA TOSHIBA et al	:	
PCT Application No.: PCT/US2005/040188	:	DECISION
Int. Filing Date: 05 November 2005	:	
Priority Date Claimed: 05 November 2004	:	
Attorney Docket No.: 3119.111.US0000	:	
For: NETWORK DISCOVERY MECHANISMS	:	

This is in response to applicant's "Renewed Petition Under 37 C.F.R. 1.182" filed 26 February 2007.

BACKGROUND

On 05 November 2005, applicant filed international application papers with the United States Receiving Office (RO/US). The submission was assigned the above-identified International Application Number and International Filing Date.

On 02 December 2005, the RO/US mailed a Notification Concerning Payment of Prescribed Fees (Form PCT/RO/102), which stated that fees totaling $3,374.00 were due.

On 05 December 2005, applicant filed a Credit Card Payment Form (Form PTO-2038) and an authorization to charge Deposit Account No. 14-1437 for any fee deficiency.[1]

On 20 January 2006, the RO/US mailed an Invitation to Pay Prescribed Fees Together With Late Payment Fee (Form PCT/RO/133), which stated that fees totaling $3,865.00 were due on or before 21 February 2006 in order to prevent withdrawal of the international application under PCT Rule 16*bis*.1(c).

On 17 February 2006, applicant filed a Credit Card Payment Form (Form PTO-2038) and an authorization to charge Deposit Account No. 14-1437 for any fee deficiency.[2]

[1, 2] As stated in the decision mailed 15 February 2007, a review of USPTO records revealed that Deposit Account No. 14-1437 did not contain sufficient funds to cover the outstanding fees.

On 24 March 2006, the RO/US mailed a Notification That International Application Considered to be Withdrawn (Form PCT/RO/117).

On 01 February 2007, applicant filed a petition under 37 CFR 1.182.

On 15 February 2007, this Office mailed a decision dismissing the 01 February 2007 petition.

On 26 February 2007, applicant filed the present renewed petition under 37 CFR 1.182.

DISCUSSION

The Credit Card Payment Form (Form PTO-2038) filed 05 December 2005 bears the s-signature "/cke/". The instructions accompanying Form PTO-2038 state, "The United States Patent and Trademark Office (USPTO) cannot process credit card payments without an authorized signature." The authorized signature on Form PTO-2038 indicates the cardholder's agreement to reimburse the credit card issuer for the stated dollar amount. Because the agreement is between the cardholder and the credit card issuer, whether the signature on Form PTO-2038 is proper depends on what the credit card issuer will accept as an authorized signature, not what the USPTO accepts as a properly formatted signature.

In the present case, although the USPTO questioned whether the credit card issuer would accept the s-signature as an authorized signature, the USPTO is not the party that will accept responsibility in the event the card issuer deems the s-signature to be invalid.. 37 CFR 10.18(b) provides that by presenting a paper to the USPTO, the practitioner certifies that the information contained therein is believed to be true. Thus, the submission of Form PTO-2038 with the signed transmittal letter on 05 December 2005 was a representation by the signing practitioner that the s-signature contained in Form PTO-2038 is an authorized signature with respect to the credit card issuer. Therefore, relying on the practitioner's duty set forth in 37 CFR 10.18(b), the USPTO could have attempted to process the credit card transaction requested by applicant on 05 December 2005.

CONCLUSION

For the reasons above, the renewed petition under 37 CFR 1.182 is GRANTED

The Invitation to Pay Prescribed Fees Together With Late Payment Fee (Form PCT/RO/133) mailed 20 January 2006 and the Notification That International Application Considered to be Withdrawn (Form PCT/RO/117) mailed 24 March 2006 are hereby VACATED.

The fees due on 05 December 2005 totaling $3374.00 will be charged to the credit card specified in Form PTO-2038 filed 01 February 2007.

The application is being forwarded to the RO/US for processing in accordance with this decision and will thereafter be forwarded to the United States International Searching Authority (ISA/US) for preparation of the International Search Report and Written Opinion of the International Searching Authority. A copy of this decision is being sent to the International Bureau.

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03 AUG 2007

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In re Application of
SHURE ACQUISITION HOLDINGS, INC.
PCT No.: PCT/US2005/040704
Int. Filing Date: 09 November 2005
Priority Date: 09 November 2004
Attorney Docket No.: 010886.00873
For: EARPHONE FOR SOUND REPRODUCTION

DECISION

This decision is in response to applicant's "Request for Corrected International Search Report" submitted on 30 November 2006 and the "Request for Refund of the Further Search Fees" filed on 31 July 2007.

BACKGROUND

On 14 September 2006, the United States International Searching Authority (ISA/US) telephoned applicants informing them of a lack of unity in the above-captioned international application. The examiner noted that there were three different sets of claims (Claims 1 - 5; 6 - 20; 21 - 22).

On 21 September 2006, applicants submitted a "Response to Invitation to Pay Further Search Fees" requesting that only two sets of the claims (Claims 1 - 5, 6 - 20) be searched. Additional fees should be charged to Deposit Account No. 19-0733.

On 31 October 2006, a Notification of Transmittal of International Search Report and the Written Opinion . . . (Form PCT/ISA/220), an International Search Report (Form PCT/ISA/210), an Invitation to Pay Additional Fees and, Where Applicable, Protest Fee (Form PCT/ISA/206) and a Written Opinion of the International Searching Authority (Form PCT/ISA/220) were mailed. The written opinion stated that the required additional search fees were not paid by applicant; Therefore, the international search report covered only claims 1 - 5.

On 30 November 2006, applicant filed a "Request for Corrected International Search Report" requesting that the ISA/US issue a new international search report covering claims 1 - 20.

On 27 February 2007, the ISA/US mailed another Invitation to Pay Additional

PCT/US2005/040704

Fees and, Where Applicable, Protest Fee (Form PCT/ISA/206) inviting applicant to pay $2,000.00 in additional search fees. The ISA/US considers that there are three inventions claimed in the above-identified international application.

On 05 March 2007, the ISA/US mailed a Notification of Transmittal of International Search Report or the Declaration (Form PCT/ISA/220) and International Search Report (Form PCT/ISA/210) for claims 1 - 20.

On 19 June 2007, applicants made a telephone call to the PCT Help Desk on the status of the petition filed 30 November 2006.

On 30 November 2006, applicants filed a request for refund.

DISCUSSION

A review of the subject application shows that a proper International Search Report for claims 1- 20 was already performed by the ISA/US on 05 March 2007.

Accordingly, no further response to the 30 November 2006 request for a new international search report is required.

Moreover, USPTO financial records show that additional claim fees of $2,000.00 were charged for two additional inventions on 21 March 2007. This was inappropriate.

Applicants clearly requested that only one additional invention (claims 6 - 20) be searched.

CONCLUSION

Applicants' petition for a partial refund of the search fees is **GRANTED**.

A refund of $1,000 in search fees have been credited to Deposit Account No. 19-0733 as authorized.

A copy of this decision is being forwarded to the International Bureau.

James Thomson

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PCT/US2005/040704

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15 DEC 2006

Anthony M. Insogna
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In re Application of
MACROGENICS, INC.
PCT No.: PCT/US05/40962
Int. Filing Date: 10 November 2005
Priority Date: 10 November 2004
Attorney Docket No.: 11183-27-228
For: ENGINEERING FC ANTIBODY REGIONS TO CONFER EFFECTOR FUNCTION

DECISION ON PETITION UNDER 37 CFR 1.10

This decision is issued in response to applicant's "Petition for Correction of Filing Date under 37 CFR 1.10(c)" filed 28 September 2006 to accord an international filing date of 10 November 2005 to the above-identified international application. Additionally, this decision is issued in response to applicant's "Reply to Invitation to Correct Priority Claim and Request to Correct International Filing Dated" filed 06 October 2006. No petition fee is required.

BACKGROUND

The United States Receiving Office accorded an international filing date of 12 November 2005 to the above-identified international application.

On 28 September 2006, applicant filed the present petition which included a copy of the Customer Receipt of the "Express Mail" mailing label #EV531712509US. The mailing label was addressed to "Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" and shows a "Date In" of "11-10-05." The label further has a USPS postal stamp dated November 10 2005.

DISCUSSION

The evidence of record is sufficient to establish with reasonable certainty that the international application papers were deposited with the United States Postal Service as an "Express Mail" Mailing on 10 November 2005. Specifically, the "Express Mail" label number ("#EV531712509US") appears on "Express Mail" certificate on the Transmittal Letter to the United States Receiving Office. The indication of the "Express Mail" label number appearing on the Transmittal Letter ties the "Express Mail" label and the

Transmittal Letter together such that it is clear that the international application was deposited on 10 November 2005.

Applicant's evidence is being accepted that the international application was deposited in the "Express Mail Post Office to Addressee" service of the USPS on 10 November 2005. Accordingly, applicant's petition is accepted.

CONCLUSION

Applicant's petition requesting that the application papers be accorded an international filing date of 10 November 2005 is **GRANTED**.

The application is being returned to the United States Receiving Office for: (1) according an international filing date of 10 November 2005; (2) issuance of a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) indicating an international filing date of 10 November 2005; and (3) forwarding a copy of this decision to the International Bureau.

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UNITED STATES PATENT AND TRADEMARK OFFICE

0 9 SEP 2009

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In re Application of BRALLEY ET AL.	: DECISION ON
PCT Application No.: PCT/US05/43240	:
Int. Filing Date: 30 November 2005	: PETITION FOR REVIVAL
Priority Date: 30 November 2004	:
Attorney Docket No.: 142062.00008	: UNDER 37 CFR 1.137(b)
For: METHODS FOR FORMULATING AND CUSTOMIZING A MICRONUTRIENT SUPPLEMENT	:

This decision is in response to applicants' "Petition For Revival Of An International Application For Patent Designating the U.S. Abandoned Unintentionally - Under 37 CFR 1.137(b)" filed in the United States Patent and Trademark Office (USPTO) on 13 May 2009.

BACKGROUND

On 30 November 2005, applicants filed international application PCT/US05/43240, which claims priority date of 30 November 2004. The thirty-month period for paying the basic national fee in the United States expired midnight on 30 May 2007. Accordingly, PCT/US05/43240 became abandoned at midnight 30 May 2007 for failure to timely pay the basic national fee.

On 13 May 2009, applicants filed a submission for entry into the national stage in the United States, which was accompanied by, *inter alia*, the transmittal letter for entry into the national stage in the United States under 35 U.S.C 371 which was accompanied by the basic national fee and a petition under 37 C.F.R. 1.137(b). The application papers were not assigned a U.S. serial number because applicant filed the papers into the file for PCT/US05/43240.

DISCUSSION

A petition under 37 CFR 1.137(b) requesting that the application be revived on the grounds of unintentional abandonment must be accompanied by (1) a proper reply, (2) the petition fee required by law, (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 was unintentional, and (4) a terminal disclaimer and fee (if the international application was filed before June 8, 1995).

Regarding item (1), applicant has provided the required reply.

Regarding item (2), the $810 petition fee has been charged to the deposit account 50-1429 as authorized by applicant.

Regarding item (3) the petition includes a statement that "the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional" satisfies the requirements of 37 CFR 1.137(b)(3).

With regard to item (4), because the international application was filed after 08 June 1995, no terminal disclaimer is required.

CONCLUSION

For the reasons detailed above, applicants' petition under 37 CFR 1.137(b) is GRANTED.

The application is being forwarded to the United States Designated Elected Office (DO/EO/US) for further processing, including removing the papers from the PCT file and setting up a national stage file under 35 U.S.C. 371, assigning a US serial number, transferring the papers and fees, and preparation and mailing of a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905), which should indicate that a properly executed oath or declaration in compliance with 37 CFR 1.497 must be filed.

/Brian Whiteman/
Detailee
Office of PCT Legal Administration
Telephone: 571-272-6095
Facsimile: 571-273-0459

Leonard Smith
Supervisory Legal Examiner
Office of PCT Legal Administration

31 MAR 2006
UNITED STATES PATENT AND TRADEMARK OFFICE
31 MAR 2006
PCT/US05/43659 31032006

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Arthur Mezue
119 Scotch Pine Drive
Islandia, NY 11749

In re Application of
MEZUE, Arthur
PCT No.: PCT/US05/43659
Int. Filing Date: 11 July 2005
Priority Date: 26 July 2004
Docket No.: None
For: DETACHABLE LARGE DISPLAY UNIT FOR CELL PHONES

DECISION ON

PETITION

UNDER 37 CFR 1.181

This is a decision on applicant's "Request For an Application Fee Refund," filed in the United States Patent and Trademark Office on 05 December 2005.

BACKGROUND

On 11 July 2005, applicant submitted two specifications, declarations, filing receipts from a prior provisional application and some fees. Both sets of paperwork were assigned a US serial number.

On 17 August 2005, applicant submitted a request for a filing date and a copy of what applicant claims to have submitted on 11 July 2005.

On 05 December 2005, applicant filed the instant request for a refund.

DISCUSSION

As indicated above, the 11 July 2005 paperwork has been located. The paper work includes a request, a description, claims, drawings and a declaration. The request indicates that Mr. Mezue is a US citizen, that the filing is a PCT application, that the US is the international searching authority and lists the title of the invention.

Applicant provided a request at filing, but it was defective. Applicant's 17 August 2005 Request corrected the deficiency.

However, neither Request lists an applicant for any designated state other than the United States. Applicant can correct this by filing a request for a recording of a change under PCT Rule 92*bis* indicating the applicant for the designated states.

Applicant's request for a refund based on not having received a filing date is moot.

CONCLUSION

For the above reasons, applicant's petition under 37 CFR 1.181 is **DISMISSED AS MOOT**.

PCT/US05/43659 . 31032006

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

The application is being returned to RO/US for continued processing. The application has an international filing date of 11 July 2005.

Erin P. Thomson

Erin P. Thomson
Attorney Advisor
PCT Legal Administration

Telephone: 571-272-3292
Facsimile: 571-273-0459

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

05 DEC 2007

Arthur Mezue
119 Scotch Pine Drive
Islandia, NY 11749

In re Application of	:	
MEZUE, Arthur	:	
PCT No.: PCT/US05/43659	:	DECISION ON
Int. Filing Date: 11 July 2005	:	
Priority Date: 26 July 2004	:	PETITION
Docket No.: None	:	
For: DETACHABLE LARGE DISPLAY UNIT FOR CELL PHONES	:	UNDER 37 CFR 1.181

This application is before the Office of PCT Legal Administration to refund the appropriate fees in a withdrawn international application.

BACKGROUND

On 18 September 2006, the Office mailed Invitation to Pay Prescribed Fees Together With Late Fee (Form PCT/RO/133) indicating that $700 in unpaid fees and a $350 late payment fee were due within one (1) month, for a total of $1050. The invitation was returned to the Office as undeliverable.

On 08 November 2006, the Office mailed Notification that International Application Considered To Be Withdrawn (Form PCT/RO/117) indicating that applicant had not provided sufficient fees to cover the transmittal fee, the international filing fee, the search fee and the late payment fee.

DISCUSSION

As this application has been withdrawn, the Office is refunding the $1000 Search Fee and the $511 balance not allocated to a fee, for a total of $1511.

CONCLUSION

The application is being returned to RO/US for continued processing, including processing of the refund.

Erin P. Thomson

Erin P. Thomson
Attorney Advisor
PCT Legal Administration

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UNITED STATES PATENT AND TRADEMARK OFFICE

22 DEC 2008

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Antonio R. Durando
6902 N. Table Mountain Road
Tucson, Arizona 85718-1331

In re Application of:
EASYCARE, INC.
PCT No.: PCT/US05/44581
International Filing Date: 08 December 2005
Priority Date: 13 December 2004
Attorney's Docket No.: 2.00012PCT
For: SLIP-ON HORSE BOOT WITH REPLACEABLE PASTERN GAITER

DECISION ON REFUND REQUEST

This decision is issued in response to the "Request for Refund" filed 27 June 2007. No petition fee is required.

BACKGROUND

On 12 September 2006, the United States International Searching Authority (ISA/US) mailed an "Invitation To Pay Additional Fees" (Form PCT/ISA/206) informing applicant that the present application was considered to contain one additional invention and that an additional $1000 search fee was requiring for each of the additional invention that applicant desired to have searched.

On 06 October 2006, applicant filed a "Response To Invitation To Pay Additional Fees" which authorized the search of the additional invention and provided the required fee.

On 06 June 2007, the United States International Searching Authority (ISA/US) mailed the International Search Report (Form PCT/ISA/206) and Written Opinion of the International Searching Authority (Form PCT/ISA/237). The International Search Report indicated that "this international search report is restricted to the invention first mentioned in the claims."

On 27 June 2007, applicant submitted the "Request for Refund" considered herein.

DISCUSSION

Applicant requests a refund of the additional $1,000 fee paid in response to the Invitation to Pay Additional Fees (Form PCT/ISA/206). Applicant states in the present petition that "the International Search Report issued by the PTO on 15 June 2007 did not acknowledge the applicant's response and payment of the additional fee and, accordingly, it did not issue a Written Opinion covering claims corresponding to the second invention. . .

applicant request that the PTO not issue an Second Written Opinion covering the second set of claims." 35 U.S.C. 376 states, the Director may refund any part of the search fee, the national fee, the preliminary examination fee and any additional fees, where he determines such refund to be warranted. In accordance with 35 U.S.C. 376 and applicant's instruction, the additional invention will not be search and applicant will be refunded the supplemental search fee.

CONCLUSION

Applicant's request for refund is **GRANTED**.

Deposit Account No. 04-1935 will be credited with a refund of the $1,000 in additional search fee charged herein.

Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Tel: (571) 272-3298
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30 NOV 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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www.uspto.gov

Paul Fenster
FENSTER & COMPANY, INTELLECTUAL PROPERTY LTD.
P.O. Box 10256
49002 Petach Tikva
Israel

In re Application of	:	
HONG, Mun Kyung	:	
PCT No.: PCT/US2005/044855	:	
Int. Filing Date: 06 December 2005	:	**DECISION**
Priority Date: 06 December 2004	:	
Attorney's Docket No.: 492/04936	:	
For: ADJUSTABLE CATHETER	:	

This decision is in response to the "Petition to Accept Missing Pages" filed with the United States Receiving Office (RO/US) on 12 July 2006 which are treated as a petition under 37 CFR 1.181. No petition fee is required.

BACKGROUND

On 06 December 2005, applicant filed PCT/US2005/044855 claiming priority to a United States provisional application filed on 06 December 2004. The Request indicated that six pages of claims were included in Box No. IX. However, the above-identified application contained only three sheets of claims.

On 12 July 2006, applicant submitted the subject petition which was accompanied by, *inter alia*, a copy of a date-stamped postcard receipt and six sheets of claims.

DISCUSSION

The subject application was published by the International Bureau on 15 June 2006 as WO 2006/063328 with 27 claims on three sheets of claims.

Applicant asserts that the above-identified international application was originally filed with the RO/US containing six pages (1 - 44) of claims. However, a review of the subject application shows that only three pages of claims (1-27) are located in the application.

MPEP § 503 lists procedures to ensure receipt of any paper filed in the USPTO. A postcard receipt which itemizes and properly identifies the papers which are being filed serves as *prima facie* evidence of receipt in the USPTO of all the items listed

thereon on the date stamped thereon by the USPTO.

Applicant provided a copy of the date-stamped postcard receipt for the documents submitted 06 December 2005. The postcard receipt records that several documents including "6 Pages Claims" were received in the USPTO. The postcard receipt is stamped "IAP10 Rec'd PCT/PTO 06 DEC 2005" across its face. The attorney docket number, title and applicant name were listed on the postcard receipt.

Accordingly, applicant has provided *prima facie* evidence that six sheets of claims were originally received at the RO/US on 06 December 2005.

CONCLUSION

Applicant's petition under 37 CFR 1.181 is hereby **GRANTED**.

This application is being returned to the RO/US for further processing including adding the three sheets of claims to the international application.

A copy of this decision will be sent to the International Bureau along with the missing three sheets of claims.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302

cc: The International Bureau of WIPO
34, chemin des Colombettes
1211 Geneva 20
Switzerland

11 JUN 2007

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

SAMUEL H. WEINER
OSTROLENK, FABER, GERB & SOFFEN, LLP
1180 AVENUE OF THE AMERICAS
NEW YORK, NY 10036

In re Application of	:	
International Rectifier Corporation	:	DECISION
PCT No.: PCT/US05/45836	:	
Int. Filing Date: 14 December 2005	:	ON
Requested Priority Date: 14 December 2004	:	
Attorney's Docket No.: 2909(2-5102)	:	PETITION
For: Simple Partial Switching Power Factor Correction Circuit	:	

This is in response to applicants' "Petition To Correct International Filing Date" filed on 04 December 2006, which is being treated under 37 CFR 1.10(d).

BACKGROUND

Applicants filed this international application with the United States receiving Office via "Express Mail."

On 14 February 2006, a Notification Of The International Application Number And Of The International Filing Date (Form PCT/RO/105) indicating an international filing date of 15 December 2005 was mailed to applicants.

DISCUSSION

Petitioner requests that this international application be accorded an international filing date of 14 December 2005, rather than 15 December 2005 as indicated on Form PCT/RO/105. Petitioner indicates *inter alia* that "It is apparent that the U.S. Postal Service (USPS)made an error by indicating the 15 December 2005 date as the acceptance on the Express Mail label." Since petitioner is seeking relief from an allegedly incorrectly entered notation by the USPS, treatment under 37 CFR 1.10(d) is appropriate. 37 CFR 1.10(d) provides that

> Any person filing correspondence under this section that was received by the Office and delivered by the "Express Mail Post Office to Addressee" service of the USPS, who can show that the "date-in" on the "Express Mail" mailing label or other official notation entered by the USPS was incorrectly entered or omitted by the USPS, may petition the Director to accord the correspondence a filing date as of the date the correspondence is shown to have been deposited with the USPS, provided that:
>
> (1) The petition is filed promptly after the person becomes aware that the Office has accorded, or will accord, a filing date based upon an incorrect entry by the USPS;
>
> (2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail"; and
>
> (3) The petition includes a showing which establishes, to the satisfaction of the

Director, that the requested filing date was the date the correspondence was deposited in the "Express Mail Post Office to Addressee" service prior to the last scheduled pickup for that day. Any showing pursuant to this paragraph must be corroborated by evidence from the USPS or that came into being after deposit and within one business day of the deposit of the correspondence in the "Express Mail Post Office to Addressee" service of the USPS.

The instant petition complies with **37 CFR 1.10(d)(1)**.

The petition complies with **37 CFR 1.10(d)(2)** because an Express Mail mailing label number, EV606195615US, was recorded on the Transmittal Letter which accompanied and itemized the filing of this international application (the original copy of which is present in the application file).

With regard to **37 CFR 1.10(d)(3)**, inspection of the "Addressee Copy" of the Express Mail label in controversy reveals that a "date-in" of "12 15 05" is recorded thereon, and that it bears USPS plug stamps dated "DEC 15" (year illegible). The copy of the "Customer Copy. Which accompanies the petition bears the same "date-in." Furthermore, the USPS "Track & Confirm" Web page related to the Express Mail label number at issue reflects a date of "Acceptance" of "December 15, 2005." Despite these indications, petitioner urges that the correspondence was deposited as Express Mail on 14 December 2005. In support of this position, petitioner refers to a "signed Service Statement" which "clearly indicated that the package was picked up by the U.S. Postal Service from Ostrolenk, Faber, Gerb & Soffen, LLP's office located at 1180 Avenue of the Americas, New York, New York 10036-8403 on 14 December 2005." Inspection of the copy of the Service Statement accompanying the petition reveals that it itemizes the Express Mail mailing label in controversy, and that it was signed and dated by a USPS employee, with a "Date of Pickup" of "12/14/5." Based on this evidence, it would be appropriate to conclude that the Express Mail parcel was in fact deposited with the USPS on 14 December 2005. Therefore, 37 CFR 1.10(d)(3) has been satisfied.

DECISION

Applicants' petition is **GRANTED**.

A new Notification Of The International Application Number And Of The International Filing Date (Form PCT/RO/105) and a copy of the first page of the PCT Request (Form PCT/RO/101) bearing the corrected international filing date of **14 December 2005** are attached hereto.

George Dombroske
PCT Legal Examiner
Office of PCT Legal Administration
Tel: (571) 272-3283
Fax: (571) 273-0459

cc: International Bureau of WIPO

enc.: Form PCT/RO/105
Form PCT/RO/101, first page

UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O. Box 1450
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PCT/US05/46136 . 20062006

20 JUN 2006

Donn Harms
12702 Via Cortina, Suite 100
Del Mar, California 92014

In re Application of	:	
HAENER	:	
PCT No.: PCT/US05/46136	:	DECISION ON REQUEST
Int. Filing Date: 17 December 2005	:	
Priority Date: 17 December 2004	:	FOR REFUND
Attorney's Docket No.: 3559-PCT	:	
For: TWO PIECE INTERLOCKING BLOCK SYSTEM	:	

This decision is in response to applicant's "Request For Refund Per 37 CFR 1.446 (B)" filed 18 May 2006 in the United States Patent and Trademark Office (USPTO).

A close reading of the regulation finds that a refund is not appropriate. While applicant has subsequent to filing provided the application number for the corresponding U.S. National application. In order for the reduced search fee of $300.00 to apply, 37 C.F.R. 1.445(a)(2)(i) requires that applicant provide either the application number, if known, or if not known, the filing date, title, and name of the applicant (and preferably the application docket number) in the international application or accompanying papers at time of filing the international application. Applicant provided only the filing date and attorney docket number of the priority application.

Applicant argues that the title and name of applicant was provided at the time the international application was filed since this information is the same for the international application and the priority items. This argument is not persuasive. It is impossible to ascertain the title and applicant information for the priority item from the papers filed on 17 December 2005. Applicant's subsequent clarification is not timely under 37 C.F.R. 1.445(a)(2)(i) and thus a refund of $700.00 is not appropriate and applicant's request for a refund is **DISMISSED**.

Any further correspondence with respect to this matter should be directed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Derek A. Putonen
Attorney Advisor
Office of PCT Legal Administration
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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

28 MAR 2008

Stephen Bongini
FLEIT, KAIN, GIBBONS, GUTMAN,
BONGINI & BIANCO P.L.
One Boca Commerce Center
551 Northwest 77th Street, Suite 111
Boca Raton, FL 33487

In re Application of
WORLD HYDROGEN, INC.
Int. Appl. No.: PCT/US05/46635
Int. Filing Date: 21 December 2005
Priority Date: 21 December 2004
Attorney's Docket No.: 1745-I0001
For: DEVICE AND METHOD FOR PRODUCING HYDROGEN WITHOUT THE FORMATION OF CARBON DIOXIDE

: DECISION ON REQUEST TO WITHDRAW AS ATTORNEY OR AGENT

This Office is in receipt of a "Request to Withdraw as Attorney or Agent and Change of Correspondence Address" filed 13 February 2008 requesting withdrawal of Stephen Bongini, Jon A. Gibbons, Jose Gutman and Jeff Giunta as agents of record in the international application identified above. The request is approved for the purposes of the USPTO as of the mailing date of this decision. The correspondence address has been changed as follows:

WORLD HYDROGEN, INC.
10515 S.W. 55th Place
Gainesville, FL 32608

Please be advised that a renunciation of appointment of agents and/or a request to change the correspondence address under PCT Rule 92bis will not be recorded by the International Bureau after the expiration of 30 months from the earliest priority date.

Boris Milef
PCT Legal Examiner
Office of PCT Legal Administration

JSF/BM:jf

Jeremy Fleming
Paralegal Specialist
Office of PCT Legal Administration

Tel: (571) 272-3284
Fax: (571) 273-0459

UNITED STATES PATENT AND TRADEMARK OFFICE

26 NOV 2008

Commissioner for Patents
United States Patent and Trademark Office
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Alexandria, VA 22313-1450
www.uspto.gov

KATTEN MUCHIN ROSENMAN LLP
(C/O PATENT ADMINISTRATOR)
2900 K STREET NW, SUITE 200
WASHINGTON DC 20007-5118

In re Application of	:	
COLLIER, et al.	:	
PCT No.: PCT/US05/46772	:	DECISION ON PETITION
Application No.: 12/269,827	:	
Int. Filing Date: 21 December 2005	:	UNDER 37 CFR 1.137(b)
Priority Date: 23 December 2004	:	
Atty. Docket No.: 215105.01701	:	
For: MOLECULAR DIAGNOSTICS SYSTEM AND METHODS	:	

This decision is in response to applicant's petition under 37 CFR § 1.137(b) filed 12 November 2008 in the United States Patent and Trademark Office (USPTO).

BACKGROUND

On 21 December 2005, applicant filed international application PCT/US05/46772 which claimed priority to an earlier application filed 23 December 2004. Pursuant to 37 CFR 1.495, the thirty-month period for paying the basic national fee in the United States expired at midnight on 23 June 2007.

On 12 November 2008, applicant filed the present petition to revive under 37 CFR 1.137(b) accompanied by the electronic filing of a utility application under 35 U.S.C. 111(a).

DISCUSSION

37 CFR 1.137(b) permits the filing of a petition to revive an abandoned application where the abandonment resulted from an unintentional delay. A grantable petition under this section must include: (1) the required reply, unless previously filed; (2) the petition fee required by law; (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;" and (4) any terminal disclaimer and fee required pursuant to 37 CFR 1.137(c).

Applicant has satisfied items (2) and (3). It is noted that item (4) does not apply to the present application.

Regarding item (1), applicant did not file a U.S. National stage application under 35 U.S.C. 371 but rather a utility application under 35 U.S.C. 111(a). This reply is not proper. Any

intended filing of an international application as a national stage application must clearly and unambiguously be identified as such and must satisfy all of the conditions set forth in 35 U.S.C. 371(c). (See 37 CFR 1.494(f) and 37 CFR 1.495(g)). In addition, section 1893.03(a), page 1800-114 of the MPEP states that "[i]f there are any conflicting instructions as to whether the filing is under 35 U.S.C. 111(a) or 35 U.S.C. 371, the application will be accepted as filed under 35 U.S.C. 111(a)."

The required reply was payment of the full, U.S. basic national fee or the filing of a continuation application. Neither reply was filed, as such, it is not possible to grant applicant's petition at this time.

It is noted that the present application has been processed as a regular, utility application under 35 U.S.C. 111(a). Applicant is directed to 37 CFR 1.78 for information on filing a petition for acceptance of an unintentionally delayed claim of priority.

CONCLUSION

For the reasons stated above, applicant's petition to revive under 37 CFR 1.137(b) is **DISMISSED**.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.137(b)." No additional petition fee is required.

Please direct further correspondence with respect to this matter to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Derek A. Putonen
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Fax: (571) 273-0459

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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22 AUG 2006

Tue Nguyen
496 Olive Ave.
Fremont CA 94539

In re Application of	:	
VESELY et al.	:	
Application No.: 11/291,889	:	DECISION
Attorney Docket No.: PCTIZ 008	:	
For: BRAIN BALANCING BY BINAURAL BEAT	:	

This decision is in response to applicant's petition under 37 CFR 1.182 filed on 30 March 2006, which requests that the application be considered as an international application under PCT Article 11 rather than a national application filed under 35 U.S.C. 111(a) and 37 CFR 1.53(b). The petition fee has been paid.

BACKGROUND

On 28 November 2005, applicant filed, *inter alia*, a "UTILITY PATENT APPLICATION TRANSMITTAL", a PCT Request, a PCT Fee Calculation Sheet, a specification, claims, abstract, and drawings. The PCT Fee Calculation Sheet authorized the charging of $1,746 to a credit card. An authorization to charge fees for an application filed under 35 U.S.C. 111 was not included.

On 02 February 2006, applicants filed a submission requesting that the above-identified application be treated as an international application.

On 30 March 2006, applicants filed the instant petition under 37 CFR 1.182 along with the petition fee.

DISCUSSION

The "UTILITY PATENT APPLICATION TRANSMITTAL" filed 28 November 2005 and itemizing a specification and drawings states that it is "(Only for new nonprovisional applications under 37 C.F.R. 1.53(b))". Accordingly, this transmittal letter indicates that the filing is under 35 U.S.C. 111(a) and 37 CFR 1.53(b). However, the PCT Request filed 28 November 2005 states that "The undersigned requests that the present international application be processed according to the Patent Cooperation Treaty." Thus, there are conflicting instructions as to how the application should be processed.

Copied from 11291889 on 11/20/2007

Upon review of applicant's petition and the application papers submitted 28 November 2005, petitioner's contention that these papers were intended as the filing of an international application is accepted.

The assigned serial number 11/291,889 will be canceled. All future communication should be directed to international application number **PCT/US05/47658**.

CONCLUSION

For the reasons set forth above, applicants' petition under 37 CFR 1.182 is **GRANTED**.

All future communications regarding this application should be directed to international application number **PCT/US05/47658**.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Daniel Stemmer
Legal Examiner
PCT Legal Affairs
Office of Patent Cooperation Treaty
Legal Administration
Telephone: (571) 272-3301
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Copied from 11291889 on 11/20/2007

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MICHAEL A. GLENN
GLENN PATENT GROUP
3475 EDISON WAY, STE. L.
MENLO PARK, CA 94025

In re Application of
SEMI SOLUTIONS LLC
PCT No.: PCT/US05/47671
Int. Filing Date: 28 December 2005
Priority Date: 29 December 2004
Attorney's Docket No.: SEMI0004P
For: APPARATUS AND METHOD FOR IMPROVING DRIVE STRENGTH, LEAKAGE AND STABILITY OF DEEP SUBMICRON MOS TRANSISTORS AND MEMORY CELLS

: DECISION ON
:
: PETITION

This decision is in response to applicant's "Renewed Petition for Designated State Correction" filed via facsimile transmission on 11 January 2007, which has properly been treated as a petition under 37 CFR 1.181.

BACKGROUND

On 15 March 2006, the United States Receiving Office (RO/US) mailed a NOTIFICATION OF THE INTERNATIONAL APPLICATION NUMBER AND OF THE INTERNATIONAL FILING DATE (Form PCT/RO/105) according the application and international filing date of 28 December 2005 and a priority date of 29 December 2004.

On 10 November 2006, applicants submitted a "Petition for Designated State Correction" via facsimile transmission.

On 04 December 2006, a NOTIFICATION OF DECISION CONCERNING REQUEST FOR RECTIFICATION (Form PCT/RO/109) was mailed treating the submission filed 10 November 2006 as a request under PCT Rule 91.1 and dismissing that request as untimely.

On 11 January 2007, applicants filed a "Renewed Petition for Designated State Correction" which was accompanied by, *inter alia*, a letter dated 20 November 2006 from Jae H. Kim, Senior Legal Officer, PCT Legal Affairs Section, WIPO. The submissions filed 10 November 2006 and 11 January 2007 have properly been treated as a single petition under 37 CFR 1.181.

DISCUSSION

The petition requests that the United States Receiving Office (RO/US) issue a form indicating that Republic of Korea (KR) is a designated state. As noted above, in Box No. V on page 3 of the Request filed 28 December 2005, the boxes were checked. The Request indicates

that the checking of the Boxes signifies that the countries listed next to each box, Germany, the Republic of Korea, and the Russian Federation, are not designated for any kind of national protection.

Since the instant application did not contain a priority claim to an earlier application in any of the States listed in Box No. V of the Request filed 28 December 2005 (including KR), applicant should not have been able to indicate any of the States as not designated. Accordingly, the indication that the States listed in Box No. V are not designated is hereby CANCELLED EX OFFICIO BY THE RO/US. A form PCT/RO/146 and a corrected sheet No. 3 of the Request are attached. See PCT Receiving Office Guidelines (March 7, 2006), paragraph 102.

The letter dated 20 November 2006 has been considered. As noted above, the Request has been corrected to indicate that Germany (DE), Republic of Korea (KR) and Russian Federation (RU) are designated States.

CONCLUSION

For the reasons set forth above, the petition under 37 CFR 1.181 is **GRANTED**.

Germany (DE), Republic of Korea (KR) and Russian Federation (RU) are designated States.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

The application is being forwarded to PCT Central Files for storage.

Daniel Stemmer
Legal Examiner
PCT Legal Affairs
Office of Patent Cooperation Treaty
Legal Administration
Telephone: (571) 272-3301
Facsimile: (571) 273-0459

Enc.: Form PCT/RO/146 and corrected sheet No. 3 of the Request

CC: International Burea of WIPO

30 SEP 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
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Matthew L. Koziarz
CARLSON, GASKEY & OLDS, P.C.
400 West Maple Road
Suite 350
Birmingham, MI 48304

In re Application of	:	
UTC FUEL CELLS, LLC	:	
PCT No.: PCT/US05/47675	:	DECISION UNDER
Int. Filing Date: 29 December 2005	:	37 CFR 1.181
Priority Date: None	:	
Agent's File Reference: 67124-031	:	
For: STABILIZED FUEL CELL FLOW FIELD	:	
	:	

Applicants' petition under 37 CFR 1.181 requesting that the international filing date for the application identified above be corrected from 29 December 2005 to 30 December 2005 has been received. No petition fee is required. The petition is **DISMISSED** as follows:

BACKGROUND

On 29 December 2005, applicants filed international application PCT/US05/47675. The United States Receiving Office (RO/US) indicated on the return receipt postcard that the present international application was filed on 29 December 2005.

On 31 January 2007, applicants filed the present petition forwarding a copy of the return receipt postcard.

DISCUSSION

MPEP at section 503 provides that:

"A postcard receipt which itemizes and properly identifies the items which are being filed serves as prima facie evidence of receipt in the PTO of all the items listed thereon on the date stamped thereon by the PTO" (Emphasis added).

A review of the papers filed with the present petition reveals that applicants have not provided corroborating evidence that the 29 December 2005 filing date as shown on the return receipt postcard is incorrect. Accordingly, applicants' petition under 37 CFR 1.181 cannot be granted at this time.

CONCLUSION

Applicant's petition under 37 CFR 1.181 is **DISMISSED without prejudice.**

If reconsideration of the merits of this petition is desired, applicants are hereby accorded 2 (TWO) MONTHS from the mailing date of this decision to file a request for reconsideration. The reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.181".

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Mail Stop PCT, Alexandria, VA 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Richard Cole
PCT Legal Examiner
Office of PCT Legal Administration

JSF/RC:jf

Jeremy Fleming
Paralegal Specialist
Office of PCT Legal Administration

(571) 272- 3284

26 FEB 2009

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

Theodore W. Olds, Esq
Carlson, Gaskey & Olds, P.C.
400 West Maple Road, Suite 350
Birmingham, MI 49009

In re Application of :
Lifson, Alexander :
PCT Application No.: PCT/US2005/047704 :
Receipt Date: 30 November 2005 : DECISION
Atty. Docket No.: 60246-474 :
For: SUCTION VALVE PULSE WITH MODULATION CONTROL BASED ON EVAPORATOR OR CONDENSER PRESSURE :

This decision is issued in response to applicant's "Response to Notice to File Missing Parts of Nonprovisional Application" filed 10 March 2006 in the United States Patent and Trademark Office (USPTO). The response is being treated as a petition under 37 CFR 1.181. No petition fee is required.

BACKGROUND

On 30 November 2005, applicant filed papers with the United States Patent and Trademark Office (USPTO) addressed to "Mail Stop PCT." The papers consisted of a transmittal letter entitled "Patent Cooperation Treaty United States Patent and Trademark Office," a PCT Request, a specification, claims, abstract, drawing sheet; and fee calculation sheet. These papers were mistakenly placed in application number 11/291,092 and treated as a filing under 35 U.S.C. 111 and 37 CFR 1.53.

On 04 January 2006, the USPTO mailed a "Notice to File Missing Parts of Nonprovisional Application Filed Under 37 CFR 1.53(b)" affording applicant two months to provide payment of fees to avoid abandonment.

On 10 March 2006, applicant filed the present petition under 37 CFR 1.181. Petitioner requests, in effect, that the application papers filed 30 November 2005 be considered as a filing of an international application under the Patent Cooperation Treaty, not an application filed under 35 U.S.C. 111 and 37 CFR 1.53. Petitioner notes that a PCT Request (Form PCT/RO/101) was filed with the application on 30 November 2005. (The submission is assigned PCT/US2005/047704.)

DISCUSSION

A review of USPTO records, as well as evidence supplied by applicant, finds that the papers filed 30 November 2005 were improperly processed as a filing under 35 U.S.C. 111(a). As such, it is proper to grant applicant's petition at this time and have the papers filed 30 November 2005 reprocessed as an international application.

Applicant's request that the 7 page Request (PCT/RO/101), 5 pages of description, 3 pages of claims, 1 page abstract, 1 drawing sheet, a fee calculation sheet, and a Declaration of Inventorship under PCT Rule 4.17(iv) filed 30 November 2005 be converted to a PCT application and accorded an international filing date of 30 November 2005 is granted.

The filing fee ($2,323) submitted on 30 November 2005 has been forwarded to international application no. PCT/US2005/047704.

CONCLUSION

For the reasons above, the petition under 37 CFR 1.181 is **GRANTED**.

The "Notice to File Missing Parts of Nonprovisional Application Filed Under 37 CFR 1.53(b)" mailed 04 January 2006 is hereby **VACATED**.

Applicant should use international application number PCT/US2005/047704 in all future communications with the United States Patent and Trademark Office.

The application is being returned to the United States Receiving Office for issuance of a Notification Concerning Payment of Prescribed Fees (Form PCT/RO/102) and a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105).

Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Tel: (571) 272-3298
Fax: (571) 273-0459

PCT/US06/00118

PCT

REQUEST

The undersigned requests that the present international application be processed according to the Patent Cooperation Treaty.

For receiving Office use only

International Application No. PCT/US 06/00118

International Filing Date (04.01.06) 04 JANAURY 2006

Name of receiving Office and "PCT International Application" PCT INTERNATIONAL APPLICATION RO/US

Applicant's or agent's file reference *(if desired) (12 characters maximum)* CIMA 3.4-059 II

Box No. I TITLE OF INVENTION

TASTE MASKING SYSTEM FOR NON-PLASTICIZING DRUGS

Box No. II APPLICANT ☐ This person is also inventor

Name and address: *(Family name followed by given name; for a legal entity, full official designation. The address must include postal code and name of country. The country of the address indicated in this Box is the applicant's State (that is, country) of residence if no State of residence is indicated below.)*

CIMA LABS INC.
10000 Valley View Road
Eden Prairie, Minnesota 55344-9361
United States of America

Telephone No. (952) 947-8700

Facsimile No. (952) 947-8770

Teleprinter No

Applicant's registration No. with the Office

State *(that is, country)* of nationality: US

State *(that is, country)* of residence: US

This person is applicant for the purposes of: ☐ all designated States ☒ all designated States except the United States of America ☐ the United States of America only ☐ the States indicated in the Supplemental Box

Box No. III FURTHER APPLICANT(S) AND/OR (FURTHER) INVENTOR(S)

Name and address: *(Family name followed by given name, for a legal entity, full official designation. The address must include postal code and name of country. The country of the address indicated in this Box is the applicant's State (that is, country) of residence if no State of residence is indicated below.)*

HABIB, Walid
9945 Hemlock Way North
Maple Grove, Minnesota 55369
United States of America

This person is:
☐ applicant only
☒ applicant and inventor
☐ inventor only *(If this check-box is marked, do not fill in below.)*

Applicant's registration No. with the Office

State *(that is, country)* of nationality: EG

State *(that is, country)* of residence: US

This person is applicant for the purposes of: ☐ all designated States ☐ all designated States except the United States of America ☒ the United States of America only ☐ the States indicated in the Supplemental Box

☒ Further applicants and/or (further) inventors are indicated on a continuation sheet.

Box No. IV AGENT OR COMMON REPRESENTATIVE; OR ADDRESS FOR CORRESPONDENCE

The person identified below is hereby/has been appointed to act on behalf of the applicant(s) before the competent International Authorities as: ☒ agent ☐ common representative

Name and address: *(Family name followed by given name; for a legal entity, full official designation. The address must include postal code and name of country.)*

TESCHNER, Michael H.
Lerner, David, Littenberg, Krumholz & Mentlik, LLP
600 South Avenue West
Westfield, New Jersey 07090
United States of America

Telephone No. (908) 518-6313

Facsimile No (908) 654-0415

Teleprinter No.

Agent's registration No. with the Office 32,862

☐ **Address for correspondence:** Mark this check-box where no agent or common representative is/has been appointed and the space above is used instead to indicate a special address to which correspondence should be sent.

Continuation of Box No. III **FURTHER APPLICANT(S) AND/OR (FURTHER) INVENTOR(S)**

If none of the following sub-boxes is used, this sheet should not be included in the request.

Name and address: *(Family name followed by given name; for a legal entity, full official designation. The address must include postal code and name of country. The country of the address indicated in this Box is the applicant's State (that is, country) of residence if no State of residence is indicated below.)*

MOE, Derek
7284 Weston Lane North
Maple Grove, Minnesota 55311
United States of America

This person is:
- [ ] applicant only
- [x] applicant and inventor
- [ ] inventor only *(If this check-box is marked, do not fill in below.)*

Applicant's registration No. with the Office

State *(that is, country)* of nationality: US

State *(that is, country)* of residence: US

This person is applicant for the purposes of: [ ] all designated States [ ] all designated States except the United States of America [x] the United States of America only [ ] the States indicated in the Supplemental Box

Name and address: *(Family name followed by given name, for a legal entity, full official designation. The address must include postal code and name of country. The country of the address indicated in this Box is the applicant's State (that is, country) of residence if no State of residence is indicated below.)*

This person is:
- [ ] applicant only
- [ ] applicant and inventor
- [ ] inventor only *(If this check-box is marked, do not fill in below.)*

Applicant's registration No. with the Office

State *(that is, country)* of nationality:

State *(that is, country)* of residence:

This person is applicant for the purposes of: [ ] all designated States [ ] all designated States except the United States of America [ ] the United States of America only [ ] the States indicated in the Supplemental Box

Name and address: *(Family name followed by given name; for a legal entity, full official designation. The address must include postal code and name of country. The country of the address indicated in this Box is the applicant's State (that is, country) of residence if no State of residence is indicated below.)*

This person is:
- [ ] applicant only
- [ ] applicant and inventor
- [ ] inventor only *(If this check-box is marked, do not fill in below.)*

Applicant's registration No. with the Office

State *(that is, country)* of nationality:

State *(that is, country)* of residence:

This person is applicant for the purposes of: [ ] all designated States [ ] all designated States except the United States of America [ ] the United States of America only [ ] the States indicated in the Supplemental Box

Name and address: *(Family name followed by given name; for a legal entity, full official designation. The address must include postal code and name of country The country of the address indicated in this Box is the applicant's State (that is, country) of residence if no State of residence is indicated below.)*

This person is:
- [ ] applicant only
- [ ] applicant and inventor
- [ ] inventor only *(If this check-box is marked, do not fill in below.)*

Applicant's registration No. with the Office

State *(that is, country)* of nationality:

State *(that is, country)* of residence:

This person is applicant for the purposes of: [ ] all designated States [ ] all designated States except the United States of America [ ] the United States of America only [ ] the States indicated in the Supplemental Box

[ ] Further applicants and/or (further) inventors are indicated on another continuation sheet.

Supplemental Box *If the Supplemental Box is not used, this sheet should not be included in the request.*

1. *If, in any of the Boxes, except Boxes Nos VIII(i) to (v) for which a special continuation box is provided,* ***the space is insufficient*** *to furnish all the information: in such case, write "Continuation of box No ..." (indicate the number of the Box) and furnish the information in the same manner as required according to the captions of the Box in which the space was insufficient, in particular:*

(i) ***if more than two persons are to be indicated as applicants and/or inventors*** *and no "continuation sheet" is available in such case, write "Continuation of Box No III" and indicate for each additional person the same type of information as required in Box No. III. The country of the address indicated in this Box is the applicant's State (that is, country) of residence if no State of residence is indicated below;*

(ii) *if, in Box No. II or in any of the sub-boxes of Box No. III, the indication* ***"the States indicated in the Supplemental Box"*** *is checked: in such case, write "Continuation of Box No. II" or "Continuation of Box No. III" or "Continuation of Boxes No II and No. III" (as the case may be), indicate the name of the applicant(s) involved and, next to (each) such name, the State(s) (and/or, where applicable, ARIPO, Eurasian, European or OAPI patent) for the purposes of which the named person is applicant;*

(iii) *if, in Box No II or in any of the sub-boxes of Box No. III,* ***the inventor or the inventor/applicant is not inventor for the purposes of all designated States or for the purposes of the United States of America****: in such case, write "Continuation of Box No. II" or "Continuation of Box No. III" or "Continuation of Boxes No. II and No. III" (as the case may be), indicate the name of the inventor(s) and, next to (each) such name, the State(s) (and/or, where applicable, ARIPO, Eurasian, European or OAPI patent) for the purposes of which the named person is inventor,*

(iv) *if, in addition to the agent(s) indicated in Box No IV, there are* ***further agents****. in such case, write "Continuation of Box No. IV" and indicate for each further agent the same type of information as required in Box IV;*

(v) *if, in Box No. VI, there are* ***more than three earlier applications whose priority is claimed****: in such case, write "Continuation of Box No. VI" and indicate for each additional earlier application the same type of information as required in Box No. VI.*

2. *If the applicant intends to make an indication of the wish that the international application be treated, in certain designated States, as an application for a patent of addition, certificate of addition, inventor's certificate of addition or utility certificate of addition· in such a case, write the name or two-letter code of each designated State concerned and the indication* ***"patent of addition," "certificate of addition," "inventor's certificate of addition"*** *or* ***" utility certificate of addition,"*** *the number of the parent application or parent patent or other parent grant and the date of grant of the parent patent or other patent grant or the date of filing of the parent application (Rules 4.11(a)(iii) and 49bis.1(a) or (b)).*

3. *If the applicant intends to make an indication of the wish that the international application be treated, in the United States of America, as a continuation or continuation-in-part of an earlier application: in such a case, write "United States of America" or "US" and the indication* ***"continuation"*** *or* ***"continuation-in-part"*** *and the number and the filing date of the parent application (Rules 4.11(a)(iv) and 49bis.1(d)).*

Continuation of Box No. IV:

Lerner, Lawrence I.; Millet, Marcus J.; Sales, Bruce H.; Gilman, Keith E.; Cohen, Robert B.; Dompieri, Arnold B.; Teschner, Michael H.; Gewirtz, Gregory S.; David, Jonathan A.; David, Sidney; Foley, Shawn P.; Palisi, Thomas M.; Bobis, Daniel H.; Augustin, Raymond W.; Cohen, Harvey L.; Doherty, Michael J.; Dickey, Jeffrey S.; Zidel, Andrew T.; Braunstein, Michael D.; Charney, Scott E.; Littenberg, Joseph S.; Russ, Lawrence E.; Cockings, Orville R.; Kameros, Samantha M.; Garguilo, Raymond; Neff, Daryl K.; Capati, April M.; Hudson, Douglas T.; Hwang, Kelly Y.; Churchill, Raymond B.; Krumholz, Arnold H.; Botos, Richard J.; Cohen, David L.; Hanley, Matthew E.; Lerch, Joseph B.; Ng, George K.; Polito, Bruno; Smid, Dennis M.; Mentlik, William L.; Singhvi, Mayush; Bender-Zanoni, Joseph F.; Kocun, Kevin M.; Borchetta, Frank J.; Hages, Michael T.; Nelson, John R.; Kamage, Andrea Jo; Wepner, Roy H.; Goldman, Stephen B.; and Kochanski, Paul H.

Box No. V DESIGNATIONS

The filing of this request **constitutes under Rule 4.9(a), the designation** of all Contracting States bound by the PCT on the international filing date, for the grant of every kind of protection available and, where applicable, for the grant of both regional and national patents.

However,

☐ DE Germany **is not designated** for any kind of national protection.

☐ KR Republic of Korea **is not designated** for any kind of national protection.

☐ RU Russian Federation **is not designated** for any kind of national protection.

(The check-boxes above may be used to exclude (irrevocably) the designations concerned in order to avoid the ceasing of the effect, under the national law, of an earlier national application from which priority is claimed. See the Notes to Box No. V as to the consequences of such national law provisions in these and certain other States.)

Box No. VI PRIORITY CLAIM

The priority of the following earlier application(s) is hereby claimed:

	Filing date of earlier application *(day/month/year)*	Number of earlier application	Where earlier application is: national application: country or Member of WTO	Where earlier application is: regional application:* regional Office	Where earlier application is: international application receiving Office
item (1)	06 January 2005 (06.01.2005)	60/641,807	US		
item (2)	10 January 2005 (10.01.2005)	60/642,619	US		
item (3)					

☐ Further priority claims are indicated in the Supplemental Box.

The receiving Office is requested to prepare and transmit to the International Bureau a certified copy of the earlier application(s) *(only if the earlier application was filed with the Office which for the purposes of this international application is the receiving Office)* identified above as:

☒ all items ☐ item (1) ☐ item (2) ☐ item (3) ☐ other, see Supplemental Box

** Where the earlier application is an ARIPO application, indicate at least one country party to the Paris Convention for the Protection of Industrial Property or one Member of the World Trade Organization for which that earlier application was filed (Rule 4.10(b)(ii)):*

Box No. VII INTERNATIONAL SEARCHING AUTHORITY

Choice of International Searching Authority (ISA) *(if two or more International Searching Authorities are competent to carry out the international search, indicate the Authority chosen; the two-letter code maybe used):*

ISA /US

Request to use results of earlier search; reference to that search *(if an earlier search has been carried out by or requested from the International Searching Authority):*

Date *(day/month/year)* Number Country *(or regional Office)*

Box No. VIII DECLARATIONS

The following **declarations** are contained in Boxes Nos VIII (i) to (v) *(mark the applicable check-boxes below and indicate in the right column the number of each type of declaration)*:

			Number of declarations
☐	Box No. VIII (i)	Declaration as to the identity of the inventor :	
☒	Box No. VIII (ii)	Declaration as to the applicant's entitlement, as at the international filing date, to apply for and be granted a patent :	2
☒	Box No. VIII (iii)	Declaration as to the applicant's entitlement, as at the international filing date, to claim the priority of the earlier application :	2
☐	Box No. VIII (iv)	Declaration of inventorship (only for the purposes of the designation of the United States of America) :	
☐	Box No. VIII (v)	Declaration as to non-prejudicial disclosures or exceptions to lack of novelty :	

Box No. VIII (ii) DECLARATION: ENTITLEMENT TO APPLY FOR AND BE GRANTED A PATENT

The declaration must conform to the following standardized wording provided for in Section 212; see Notes to Boxes Nos VIII, VIII(i) to (v) (in general) and the specific Notes to Box No VIII(ii). If this Box is not used, this sheet should not be included in the request.

Declaration as to the applicant's entitlement, as at the international filing date, to apply for and be granted a patent (Rules 4.17(ii) and 51*bis*.1(a)(ii)), in a case where the declaration under Rule 4.17(iv) is not appropriate.

In relation to this International application CIMA LABS INC., is entitled to apply for and be granted a patent by virtue of the following:

An assignment from HABIB, Walid to CIMA LABS INC., dated 23.02.2005 (23.02.2005)

An assignment from MOE, Derek to CIMA LABS INC., dated 23.02.2005 (23.02.2005)

This declaration is made for the purposes of all designations except the designation of the United States of America.

[x] This declaration is continued on the following sheet, "Continuation of Box No. VIII (ii)".

Box No. VIII (iii) DECLARATION: ENTITLEMENT TO CLAIM PRIORITY

The declaration must conform to the following standardized wording provided for in Section 213; see Notes to Boxes Nos VIII, VIII(i) to (v) (in general) and the specific Notes to Box No. VIII (iii). If this Box is not used, this sheet should not be included in the request

Declaration as to the applicant's entitlement, as at the international filing date, to claim the priority of the earlier application specified below, where the applicant is not the applicant who filed the earlier application or where the applicant's name has changed since the filing of the earlier application (Rules 4.17(iii) and 51*bis*.1(a)(iii)):

In relation of this International application CIMA LABS INC., is entitled to claim priority of earlier Application No. 60/641,807 by virtue of the following:

An assignment from HABIB, Walid to CIMA LABS INC., dated 23.02.2005 (23.02.2005)

An assignment from MOE, Derek to CIMA LABS INC., dated 23.02.2005 (23.02.2005)

This declaration is made for the purposes of all designations except the designation of the United States of America.

[X] This declaration is continued on the following sheet, "Continuation of Box No. VIII (iii)".

Continuation of Box No. VIII (i) to (v) DECLARATION

If the space is insufficient *in any of Boxes Nos. VIII (i) to (v) to furnish all the information, including in the case where* ***more than two inventors are to be named*** *in Box No. VIII (iv), in such case, write "Continuation of Box No. VIII. " (indicate the item number of the Box) and furnish the information in the same manner as required for the purposes of the Box in which the space was insufficient If additional space is needed in respect of two or more declarations, a separate continuation box must be used for each such declaration. If this Box is not used, this sheet should not be included in the request*

Continuation of Box No. VIII (ii)

In relation to this International application CIMA LABS INC., is entitled to apply for and be granted a patent by virtue of the following:

An assignment from HABIB, Walid to CIMA LABS INC., dated 23.02.2005 (23.02.2005)

An assignment from MOE, Derek to CIMA LABS INC., dated 23.02.2005 (23.02.2005)

This declaration is made for the purposes of all designations except the designation of the United States of America.

Continuation of Box No. VIII (i) to (v) DECLARATION

If the space is insufficient in any of Boxes Nos VIII (i) to (v) to furnish all the information, including in the case where ***more than two inventors are to be named*** *in Box No. VIII (iv), in such case, write "Continuation of Box No VIII..." (indicate the item number of the Box) and furnish the information in the same manner as required for the purposes of the Box in which the space was insufficient If additional space is needed in respect of two or more declarations, a separate continuation box must be used for each such declaration If this Box is not used, this sheet should not be included in the request*

Continuation of Box No. VIII (iii)

In relation of this International application CIMA LABS INC., is entitled to claim priority of earlier Application No. 60/642,619 by virtue of the following:

An assignment from HABIB, Walid to CIMA LABS INC., dated 23.02.2005 (23.02.2005)

An assignment from MOE, Derek to CIMA LABS INC., dated 23.02.2005 (23.02.2005)

This declaration is made for the purposes of all designations except the designation of the United States of America.

Box No. IX CHECK LIST; LANGUAGE OF FILING

This international application **contains:**

(a) **on paper,** the following number of sheets:

request (including declaration sheets)	:	9
description (excluding sequence listings and/or tables related thereto)	:	44
claims	:	6
abstract	:	1
drawings	:	0
Sub-total number of sheets	:	60
sequence listings	:	
tables related thereto	:	
(for both, actual number of sheets if filed on paper, whether or not also filed in electronic form; see (c) below)		
Total number of sheets	:	60

(b) ☐ **only in electronic form** (Section 801(a)(i))
- (i) ☐ sequence listings
- (ii) ☐ tables related thereto

(c) ☐ **also in electronic form** (Section 801(a)(ii))
- (i) ☐ sequence listings
- (ii) ☐ tables related thereto

Type and number of carriers (diskette, CD-ROM, CD-R or other) on which are contained the
- ☐ sequence listing:
- ☐ tables related thereto:

(additional copies to be indicated under items 9(ii) and/or 10(ii), in right column)

This international application is **accompanied by** the following item(s) *(mark the applicable check-boxes below and indicate in right column the number of each item):*

		Number of items
1.	☒ fee calculation sheet	1
2.	☐ original separate power of attorney	:
3.	☐ original general power of attorney	:
4.	☐ copy of general power of attorney; reference number, if any:	:
5.	☐ statement explaining lack of signature	:
6.	☐ priority document(s) identified in Box No. VI as item(s):	:
7.	☐ translation of international application into *(language):*	:
8.	☐ separate indications concerning deposited microorganisms or other biological material	:
9.	☐ sequence listing in computer electronic form *(indicate type and number of carriers)*	
(i)	☐ copy submitted for the purposes of international search under Rule 13*ter* only (and not as part of the international application)	:
(ii)	☐ *(only where check-box (b)(i) or (c)(i) is marked in left column)* additional copies including, where applicable, the copy for the purposes of international search under Rule 13*ter*	:
(iii)	☐ together with relevant statement as to the identity of the copy or copies with the sequence listing part mentioned in left column	
10.	☐ tables in electronic form related to sequence listing *(indicate type and number of carriers)*	
(i)	☐ copy submitted for the purposes of international search under Section 802 (b-*quater*) only (and not as part of the international application)	:
(ii)	☐ *(only where check-box (b)(ii) or (c)(ii) is marked in left column)* additional copies including, where applicable, the copy for the purposes of international search under Section 802 (b-*quater*)	:
(iii)	☐ together with relevant statement as to the identity of the copy or copies with the tables mentioned in left column	:
11.	other *(specify):*	:

Figure of the drawings which should accompany the abstract:

Language of filing of the international application: English

Box No. X SIGNATURE OF APPLICANT, AGENT OR COMMON REPRESENTATIVE

Next to each signature, indicate the name of the person signing and the capacity in which the person signs (if such capacity is not obvious from reading the request)

Michael H. Teschner, Agent for Applicant(s)
LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK, LLP

For receiving Office use only (04.01.06)

1.	Date of actual receipt of the purported international application: IAP7 Rec'd PCT/PTO 04 JAN 2006	2. Drawings: ☐ received. ☐ not received:
3.	Corrected date of actual receipt due to later but timely received papers or drawings completing the purported international application:	
4.	Date of timely receipt of the required corrections under PCT Article 11(2).	
5.	International Searching Authority (if two or more are competent): ISA/US	6. ☐ Transmittal of search copy delayed until search fee is paid.

For International Bureau use only

Date of receipt of the record copy by the International Bureau:

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

14 MAY 2007

DANIEL J. NOBLITT
NOBLITT & GILMORE, LLC
4800 NORTH SCOTTSDALE ROAD
SUITE 6000
SCOTTSDALE, ARIZONA 85251

In re Application of :
RAYTHEON COMPANY :
PCT No.: PCT/US06/00792 : DECISION ON PETITION
Int. Filing Date: 10 January 2006 : UNDER 37 CFR 1.10
Priority Date: 10 January 2005 :
Attorney Docket No.: RAYTH.0216 :
For: METHODS AND APPARATUS FOR SELECTABLE VELOCITY PROJECTILE SYSTEM :

This decision is issued in response to applicant's "Request to Correct International Filing Date" under 37 CFR 1.10 filed 20 December 2006 to accord an international filing date of 10 January 2006 to the above-identified international application.

BACKGROUND

The United States Receiving Office accorded an international filing date of 11 January 2006 to the above-identified international application.

On 20 December 2006, applicant filed the present petition which included a copy of the Customer Receipt of the "Express Mail" mailing label #EQ350726258US. The mailing label was addressed to "Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" and shows a "Date In" of "01-10-06." The label further has a USPS postal stamp dated January 10, 2006.

DISCUSSION

The evidence of record is sufficient to establish with reasonable certainty that the international application papers were deposited with the United States Postal Service as an "Express Mail" Mailing on 10 January 2006. Specifically, the "Express Mail" label number ("#EQ350726258US") appears on "Express Mail" certificate on the Transmittal Letter to the United States Receiving Office. The indication of the "Express Mail" label number appearing on the Transmittal Letter ties the "Express Mail" label and the

Transmittal Letter together such that it is clear that the international application was deposited on 10 January 2006.

Applicant's evidence is being accepted that the international application was deposited in the "Express Mail Post Office to Addressee" service of the USPS on 10 January 2006. Accordingly, applicant's petition is accepted.

CONCLUSION

Applicant's petition requesting that the application papers be accorded an international filing date of 10 January 2006 is **GRANTED**.

The application is being returned to the United States Receiving Office for: (1) according an international filing date of 10 January 2006; (2) issuance of a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) indicating an international filing date of 10 January 2006; and (3) forwarding a copy of this decision to the International Bureau.

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Office of PCT Legal Administration
Tel: (571) 272-3298
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PCT/US06/03811 - 29062006

29 JUN 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Steven A. May
MOTOROLA, INC.
1303 East Algonquin Road
Schaumburg, IL 60196

In re Application of
MOTOROLA, INC.
PCT No.: PCT/US06/03811
Int. Filing Date: 31 January 2006
Priority Date: 31 January 2005
Agent's File Reference: CE13112R
For: METHOD AND APPARATUS FOR DYNAMICALLY CHANGING MODES OF A RELIABLE TRANSPORT PROTOCOL

DECISION UNDER
37 CFR 1.10(c)

This is in response to applicants' 23 May 2006 communication, which is being treated as a petition under 37 CFR 1.10(c) requesting that the filing date of International Application No. PCT/US06/03811 be corrected from 01 February 2006 to 31 January 2006. No petition fee is due. The petition is **GRANTED** as follows:

BACKGROUND

As indicated in the "NOTIFICATION OF THE INTERNATIONAL APPLICATION NUMBER AND OF THE INTERNATIONAL FILING DATE" (Form PCT/RO/105 mailed 18 April 2006), International Application No. PCT/US06/03811 was accorded a filing date of 01 February 2006 by the United States Receiving Office (RO/US).

On 23 May 2006, the present petition was filed requesting that International Application No. PCT/US06/03811 be accorded a filing date of 31 January 2006 pursuant to the "Express Mail" provisions under 37 CFR 1.10.

DISCUSSION

37 CFR 1.10(c) provides that:

Any person filing correspondence under this section that was received by the Office and delivered by the "Express Mail Post Office to Addressee" service of the USPS, who can show that there is a discrepancy between the the filing date accorded by the Office to the correspondence and the date of deposit as shown by the "date-in" on the "Express Mail" mailing label or other official USPS notation, may petition the Commissioner to accord the correspondence a filing date as of the "date-in" on the "Express Mail" mailing label or other official USPS notation, provided

that:

(1) The petition is filed promptly after the person becomes aware that the Office has accorded, or will accord, a filing date other than the USPS deposit date;

(2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail"; and

(3) The petition includes a true copy of the "Express Mail" mailing label showing the "date-in", and of any other official notation by the USPS relied upon to show the date of deposit.

The present petition has been filed promptly. 37 CFR 1.10(c)(1). In addition, a review of the original application papers reveals that "Express Mail" Label No. EV580331798US was placed on the "Express Mail" which accompanied the original application papers. 37 CFR 1.10(c)(2). The copy of the Customer Copy of "Certificate Of Express Mailing" Label No. EV580331798US of record in the application file indicates 31 January 2006 as the "Date-In". Furthermore, the "Track & Confirm" database of the USPS indicates that the date of deposit for the present international application is 31 January 2006. Accordingly, the requirements under 37 CFR 1.10(c) have been satisfied.

CONCLUSION

For the above reasons, the petition under 37 CFR 1.10(c) is **GRANTED.** Form PCT/RO/105 mailed 18 April 2006 is hereby **VACATED.**

A corrected Form PCT/RO/105 indicating a 31 January 2006 international filing date accompanies this decision. A copy of this decision and a copy of the corrected first sheet of the PCT Request will be sent to the International Bureau.

Boris Milef
PCT Legal Examiner
Office of PCT Legal Administration

JSF/BM:jf

Jeremy Fleming
Paralegal Specialist
Office of PCT Legal Administration

(571) 272-3284

Copy to:
THE INTERNATIONAL BUREAU OF WIPO
34 chemin des Colombettes
1211 Geneve 20 (SUISSE)

PCT/US2006/003811 31 JAN 2006

PATENT COOPERATION TREATY

From the RECEIVING OFFICE

To:
STEVEN A. MAY
1303 EAST ALGONQUIN ROAD
SCHAUMBURG, ILLINOIS 60196

PCT

NOTIFICATION OF THE INTERNATIONAL APPLICATION NUMBER AND OF THE INTERNATIONAL FILING DATE

(PCT Rule 20.5(c))

Date of mailing *(day/month/year)* 29 JUN 2006

Applicant's or agent's file reference
CE13112R

IMPORTANT NOTIFICATION

International application No.	International filing date *(day/month/year)*	Priority date *(day/month/year)*
PCT/US2006/003811	31 Jan 2006	31 Jan 2005

Applicant
MOTOROLA, INC.

Title of the invention METHOD AND APPARATUS FOR DYNAMICALLY CHANGING MODES OF A RELIABLE TRANSPORT PROTOCOL

1. The applicant is hereby notified that the international application has been accorded the international application number and the international filing date indicated above.

2. The applicant is further notified that the record copy of the international application:

☒ was transmitted to the International Bureau on 06 Apr 2006.

☐ has not yet been transmitted to the International Bureau for the reason indicated below and a copy of this notification has been sent to the International Bureau*:

☐ because the necessary national security clearance has not yet been obtained.

☐ because *(reason to be specified)*:

* The International Bureau monitors the transmittal of the record copy by the receiving Office and will notify the applicant (with Form PCT/IB/301) of its receipt. Should the record copy not have been received by the expiration of 14 months from the priority date, the International Bureau will notify the applicant (Rule 22.1(c)).

3. FOREIGN TRANSMITTAL LICENSE INFORMATION Completed by: JF

☐ Additional license for foreign transmittal not required. This subject matter is covered by a license already granted or the equivalent U.S. national application. Refer to that license for information concerning its scope.

☐ License for foreign transmittal not required. 37 CFR. 5.11(e)(1) or 37 CFR 5.11(e)(2). However, a license may be required for additional subject matter. See 37 CFR 5.15(b).

☒ Foreign transmittal license granted. 35 U.S.C. 184; 37 CFR 5.11 on 31 Mar 2006 (date):

☒ 37 CFR 5.15(a) ☐ 37 CFR 5.15(b)

Name and mailing address of the receiving Office	Authorized officer
Mail Stop PCT, Commissioner for Patents P.O. Box 1450, Alexandria, VA 22313-1450	Jeremy Fleming
Facsimile No. 703-305-3230	Telephone No. 571-272-3284

Form PCT/RO/105 (July 1992)

Home Copy

CE13112R PCT/US06/03811 29062006

PCT REQUEST

Original (for SUBMISSION)

0	For receiving Office use only	
0-1	International Application No.	PCT/US 06/03811
0-2	International Filing Date	(01/31/06) 31 JAN 2006
0-3	Name of receiving Office and "PCT International Application"	PCT INTERNATIONAL APPLICATION RO/US
0-4	Form PCT/RO/101 PCT Request	
0-4-1	Prepared Using	PCT-SAFE [EASY mode] Version 3.51.001.176 MT/FOP 20060101/0.20.4rc.2.7
0-5	Petition The undersigned requests that the present international application be processed according to the Patent Cooperation Treaty	
0-6	Receiving Office (specified by the applicant)	United States Patent and Trademark Office (USPTO) (RO/US)
0-7	Applicant's or agent's file reference	CE13112R
I	Title of Invention	METHOD AND APPARATUS FOR DYNAMICALLY CHANGING MODES OF A RELIABLE TRANSPORT PROTOCOL
II	Applicant	
II-1	This person is	applicant only
II-2	Applicant for	all designated States except US
II-4	Name	MOTOROLA, INC.
II-5	Address	1303 East Algonquin Road Schaumburg, Illinois 60196 United States of America
II-6	State of nationality	US
II-7	State of residence	US
II-8	Telephone No.	847-538-2725
II-9	Facsimile No.	847-576-3750

28 MAR 2007

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

SHERYL S. HOLLOWAY
BLAKELY SOKOLOFF TAYLOR & ZAFMAN
12400 WILSHIRE BLVD., 7th Floor
LOS ANGELES, CA 90025-1026

In re Application of :
SONY ELECTRONICS, INC. :
PCT No.: PCT/US06/03910 :
Int. Filing Date: 03 Febr 2006 : DECISION
Priority Date: 09 Mar 2005 :
Attorney's Docket No.: 080398.P548X :
For: System and Method for Dynamic Bandwidth :
Estimation of Network Links :

This decision is in response to applicant's petition filed 08 January 2007, requesting correction of the international filing date which is being treated as a petition under 37 CFR 1.10(c) to accord a date of 03 February 2006 to the above-identified application. No petition fee is required.

BACKGROUND

The United States Receiving Office (RO/US) accorded an international filing date of 06 February 2006 to the above-identified application.

On 08 January 2007, applicant filed the present petition, which included a copy of the Express Mail sales receipt, a copy of the Transmittal Letter to the RO/US (PTO-1382) and a copy of an "Express Mail Log" page. The Express Mail sales receipt indicates that a 10.10 oz. package was deposited with the United States Postal Service to be mailed by Express Mail to "ALEXANDRIA VA 22313" on 03 February 2006 at 6:02 PM. The Express Mail sales receipt shows the Express Mail label number "EV665828061US." The same Express Mail label number of "EV665828061US" appears on the Transmittal Letter and the "Express Mail Log" page.

DISCUSSION

The evidence of record is sufficient to establish with reasonable certainty that the international application papers were deposited with the United States Postal Service as an "Express Mail" mailing on 03 February 2006. Specifically, the "Express Mail" label number ("#EV665828061US") appears on the Express Mail sales receipt, the copy of the Transmittal Letter and the copy of the "Express Mail Log" page. The indication of the "Express Mail" label number appearing on the Transmittal Letter ties the "Express Mail" sales receipt and the

Transmittal Letter together such that it is clear that the international application was deposited on 03 February 2006.

CONCLUSION

Applicant's petition requesting that the application papers be accorded an international filing date of **03 February 2006** is **GRANTED**.

This application is being forwarded to the United States Receiving Office for further processing. A corrected PCT/RO/105 and front page of the Request will be mailed to the International Bureau.

Leonard Smith
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Stefan Staicovici
PCT Legal Examiner
Office of PCT Legal Administration
Telephone: (571) 272-1208

CC:
Attachments:
Corrected PCT/RO/105
Corrected front page of Request Form PCT/RO/101

International Bureau
PCT Receiving Office Section
34, chemin des Colombettes
1211 Geneva 20
Switzerland

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P.O. Box 1450
Alexandria, VA 22313-1450
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MAIL

OCT 0 3 2006

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

PSC SCANNING, INC. - STOEL RIVES LLP
C/O STOEL RIVES LLP
900 SW 5TH AVENUE
SUITE 2600
PORTLAND OR 97204

In re Application of:
James Daniel Wagner, et al.
Serial No.: 11/055,960
Filed: February 10, 2005
For: **RFID POWER RAMPING FOR TAG SINGULATION**

DECISION ON PETITION
TO CONVERT APPLICATION

This is a decision on the petition under 37 C.F.R. § 1.53(b)(2)(ii), filed December 19, 2005, to convert the above-identified application to a provisional application under 35 U.S.C. § 111(b) and 37 C.F.R. § 1.53(b)(2).

The petition is **GRANTED.**

The application is being returned to the Office of Initial Patent Examination (OIPE) for further processing as a PROVISIONAL application under 35 U.S.C. § 111(b) and 37 C.F.R. § 1.53(b)(2), including the assignment of a new provisional application number.

The new provisional application number will be communicated to the applicant by OIPE in due course.

Krista Zele
Special Program Examiner
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Communications
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UNITED STATES PATENT AND TRADEMARK OFFICE

27 AUG 2007

Commissioner for Patents
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TINA W. MCKEON
NEEDLE & ROSENBERG, P .C.
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999 PEACHTREE STREET
ATLANTA, GA 30309-3915

In re Application of	:	
UNIVERSITY OF ROCHESTER	:	DECISION
PCT No.: PCT/US06/04920	:	
Int. Filing Date: 13 February 2006	:	ON PETITION UNDER
Priority Date: 11 February 2005	:	
Docket No.: 21108.0057P1	:	37 CFR 1.10(c)
For: METHODS AND COMPOSTITIONS ...:		
PROTEIN (ARP) EXPRESSION	:	

This decision is in response to applicant's Petition Under 37 CFR 1.10(c), filed in the United States Patent and Trademark Office on 10 July 2007.

BACKGROUND

Applicant filed international application PCT/US06/04920 via Express Mail, claiming a priority date of 11 February 2005.

On 12 June 2007, the Office mailed Notification of International Application Number and of the International Filing Date (Form PCT/RO/105), indicating that the application had an international filing date of 12 February 2006 and an Invitation to Correct Priority Claim (Form PCT/RO/110).

On 10 July 2007, applicant submitted a petition to correct the international filing date of the application.

DISCUSSION

In the instant petition, applicant requests that the filing date be amended to13 February 2006. The mailing label lists the "date in" as 13 February 2006. Under 37 CFR 1.10(a), correspondence delivered to the Office by "Express Mail" will be considered filed on the date of deposit with the USPS. "The date of deposit with the USPS is shown by the 'date in' on the 'Express Mail' mailing label or other official USPS notation." 37 CFR 1.10(a).

Under 37 CFR 1.10(c), when a discrepancy exists between the filing date accorded to correspondence and the date of deposit with the USPS as shown by the "date in" or other official USPS notation, applicant may petition the office to accord the correspondence a filing date as of the "date in" on the Express Mail mailing label or other official USPS notation, provided that: (1) petition is promptly filed, (2) the number of the "Express Mail" mailing label was placed on the papers prior to the original mailing, and (3) that the petition includes

a true copy of the Express Mail mailing label and of any other official notation by the USPS relied upon to show the date of deposit.

Items (1), (2) and (3) have been met. (1) The petition was promptly filed. (2) The Express Mail mailing label number was included with the application papers. (3) Applicant provided a photocopy of the Express Mail mailing label.

CONCLUSION

For the reasons listed above, applicant's petition under 37 CFR 1.10(c) to correct the international filing date to 13 February 2006 is **GRANTED**.

The Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) mailed 12 June 2007, is **VACATED**.

The Invitation to Correct Priority Claim (Form PCT/RO/110) mailed 12 June 2007 is **VACATED**.

The application is being returned to the United States Receiving Office for continued processing.

Erin P. Thomson

Erin P. Thomson
Attorney Advisor
PCT Legal Administration

Telephone: 571-272-3292
Facsimile: 571-273-0459

cc: International Bureau
34, Chemin des Colombettes
1211 Geneva 20
Switzerland

Enc: Corrected Form PCT/RO/105
Request (Form PCT/RO/101), page 1

UNITED STATES PATENT AND TRADEMARK OFFICE
PCT/US06/05553 . 13112006

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
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13 NOV 2006

KURT F. JAMES
SENNIGER POWERS
#1 METROPOLITAN SQUARE, 16TH FLOOR
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In re Application of:
STEAM TECH, INC.
PCT No.: PCT/US06/05553
International Filing Date: 16 February 2006
Priority Date Claimed: 17 February 2005
Atty Docket No.: SKA9029.1
For: CONDENSATE REMOVAL DEVICE

DECISION ON PETITION

This decision is issued in response to applicant's "Petition to the PCT Legal Administration" filed on 06 November 2006, treated herein as a petition to accord the present application an international filing date of 16 February 2006. No petition fee is required.

BACKGROUND

On 16 February 2006, applicant filed materials to initiate international application PCT/US06/05553. The application claimed a priority date of 17 February 2005. As specifically indicated by applicant on the Transmittal Letter (Form PTO-1382) and Request (Form PCT/RO/101) filed on 16 February 2006, the submission included 5 pages of Request, 50 pages of Description, 1 page of Abstract and "14" pages of Claims.

~~On 14 March 2006, applicant filed a copy of 14 pages of claims.~~

The United States Receiving Office (RO/US) issued an "Invitation To Correct The Purported International Application" (Form PCT/RO/103) dated 28 March 2006 indicating that the 16 February 2006 submission failed to satisfy the requirements of PCT Article 11(1)(iii)(e) in that it did not contain a part that on its face appears to be a claim or claims. The RO/US also issued a "Notification Regarding Certain Corrections Made Ex Officio" (Form PCT/RO/146) dated 28 March 2006.

However, the RO/US also issued a "Notification Of The International Application Number And Of The International Filing Date" (Form PCT/RO/105) dated 28 March 2006 that stated that applicant's application had been accorded an international filing date of 16 February 2006.

On 06 November 2006, petitioner filed the instant "Petition (no Fee) to the PCT Legal Administration" considered herein. The submission includes a copy of the USPTO date-stamped

postcard receipt and a copy of the 14 pages of claims requesting that the submission be considered adequate for accordance of an international filing date.

DISCUSSION

Along with the response and a copy of the 14 sheets of claims, applicants provided a copy of a post card receipt filed with the international application with USPTO date-stamp "16 February 2006". The post card itemized the enclosures, *inter alia*: " (14) Sheets of Claims, (50) Sheets of DRAWINGS, (5) Sheets of Description, (1) Sheets of ABSTRACT", were sent with the Request. The postcard receipt also referenced the title of the invention, applicant's name, and attorney docket number.

DISCUSSION

The Office file record for the above-identified application is the official record of the papers originally deposited in the above-identified application. As stated in section 503 of the Manual of Patent Examining Procedure (Rev. August 2006)(MPEP):

> A postcard receipt which itemizes and properly identifies the items which are being filed serves as *prima facie* evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO.

In the instant case, the copy of the postcard receipt date stamped 16 February 2006 provided by applicant indicates, *inter alia*, that 14 pages of claims were submitted. This postcard receipt constitutes *prima facie* evidence that on 16 February 2006, the USPTO received a PCT Request (5 sheets), description (50 sheets), drawings (50 sheets), claims (14 sheets), and abstract (1 sheet).

The evidence submitted by applicant, the postcard receipt date stamped by the USPTO, is sufficient to overcome the *prima facie* evidence of the application file itself, that is, that 14 sheets of claims were submitted with the International application on 16 February 2006.

In light of the evidence provided, the "Invitation To Correct The Purported International Application" (Form PCT/RO/103) dated 28 March 2006 and the "Notification Regarding Certain Corrections Made Ex Officio" (Form PCT/RO/146) dated 28 March 2006 are hereby VACATED.

CONCLUSION

The petition under 37 CFR 1.181 is **GRANTED.**

PCT/US06/05553 13112006

The "Invitation To Correct The Purported International Application" (Form PCT/RO/103) dated 28 March 2006 and the "Notification Regarding Certain Corrections Made Ex Officio" (Form PCT/RO/146) dated 28 March 2006 are hereby **VACATED**.

The application will be forwarded to the United States Receiving Office for entry of the copy of the pages 51-64 of the claims and will be forwarded to the International Bureau and the International Searching Authority. The international application filing date will remain 16 February 2006.

A copy of this decision and pages 51-64 of the claims will be forwarded to the International Bureau for republication.

Cynthia M. Kratz
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PCT Legal Office

Telephone: 571-272-3286
Fax: 571-273-0459

cc: The International Bureau of WIPO
34, chemin des Colombettes
1211, Geneva 20 Switzerland

Enclosure: pages 51-64 of Claims (14 sheets)