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DARDI & HERBERT, PLLC
Moore Lake Plaza, Suite 205
1250 East Moore Lake Drive
Fridley MN 55432

MAILED

APR 09 2012

OFFICE OF PETITIONS

In re Application of :
Gurevich, et al. :
Application No. 61/593,474 : ON PETITION
Filed: February 1, 2012 :
Attorney Docket No. **5085.01US01** :

This is a decision on the petition under 37 CFR 1.182, filed March 14, 2012, to correct the name of the first named inventor cited on this application in USPTO records.

The petition is **granted.**

The name of the first named inventor for the above-cited application is corrected to "Gary Gurevich."

A corrected filing receipt is enclosed.

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3222.

/Kenya A. McLaughlin/

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

Enclosure: Corrected Filing Receipt

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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
61/593,474	02/01/2012		125	5085.01US01		

CONFIRMATION NO. 2898

CORRECTED FILING RECEIPT

62274
DARDI & HERBERT, PLLC
Moore Lake Plaza, Suite 205
1250 East Moore Lake Drive
Fridley, MN 55432

OC000000053518491

Date Mailed: 04/03/2012

Receipt is acknowledged of this provisional patent application. It will not be examined for patentability and will become abandoned not later than twelve months after its filing date. 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)

Gary Gurevich, Wheeling, IL;
Jeff Zwelling, Santa Monica, CA;
Yaniv Shalev, Kefar Sava, ISRAEL;

Power of Attorney:
Peter Dardi--39650

If Required, Foreign Filing License Granted: 02/09/2012
The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is **US 61/593,474**
Projected Publication Date: None, application is not eligible for pre-grant publication
Non-Publication Request: No
Early Publication Request: No
**** SMALL ENTITY ****
Title

SYSTEMS AND METHODS FOR IDENTIFYING A RETURNING WEB CLIENT

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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SYNGENTA BIOTECHNOLOGY, INC.
PATENT DEPARTMENT
3054 CORNWALLIS ROAD
P.O. BOX 12257
RESEARCH TRIANGLE PARK NC 27709-2257

MAILED
APR 10 2012
OFFICE OF PETITIONS

In re Application of :
Lee, et al. :
Application No. 61/599,583 : ON PETITION
Filed: February 16, 2012 :
Attorney Docket No. **72597_US_PSP1**

This is a decision on the petition under 37 CFR 1.182, filed March 8, 2012, to change the name of the third named inventor cited on this application in USPTO records.

The petition is **granted.**

The name of the third named inventor for the above-cited application is changed to "Cheryl M. Defontes."

A corrected filing receipt is enclosed.

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3222.

/Kenya A. McLaughlin/

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

Enclosure: Corrected Filing Receipt

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 NUMBER	FILING or 371(c) DATE	GRP ART UNIT	FIL FEE REC'D	ATTY.DOCKET.NO	TOT CLAIMS	IND CLAIMS
61/599,583	02/16/2012		250	72597_US_PSP1		

CONFIRMATION NO. 6805

CORRECTED FILING RECEIPT

22847
SYNGENTA BIOTECHNOLOGY, INC.
PATENT DEPARTMENT
3054 CORNWALLIS ROAD
P.O. BOX 12257
RESEARCH TRIANGLE PARK, NC 27709-2257

Date Mailed: 04/03/2012

Receipt is acknowledged of this provisional patent application. It will not be examined for patentability and will become abandoned not later than twelve months after its filing date. 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)

Mikyong LEE, Research Triangle Park, NC;
Jeng Shong CHEN, Research Triangle Park, NC;
Cheryl M. Defontes, Research Triangle Park, NC;
Jared CONVILLE, Research Triangle Park, NC;
Narenda V. PALEKAR, Research Triangle Park, NC;

Power of Attorney:
Gregory Warren--48385

If Required, Foreign Filing License Granted: 03/02/2012
The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is **US 61/599,583**
Projected Publication Date: None, application is not eligible for pre-grant publication
Non-Publication Request: No
Early Publication Request: No
Title

ENGINEERED PESTICIDAL PROTEINS

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.

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LICENSE FOR FOREIGN FILING UNDER

Title 35, United States Code, Section 184

Title 37, Code of Federal Regulations, 5.11 & 5.15

GRANTED

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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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The Dow Chemical Company
P.O. BOX 1967
2040 Dow Center
Midland MI 48641

MAILED
APR 10 2012
OFFICE OF PETITIONS

In re Application of :
Molitor et al. :
Application No. 61/602,840 :
Filed: February 24, 2012 : DECISION
Attorney Docket Number: 72190 US PSP: ON PETITION
Title: PREPARATION AND USE OF :
CYCLODODECATRIENE TRIALDEHYDE AND :
RELATED COMPOUNDS :

This is a decision on the "PETITION PURSUANT TO 37 C.F.R. §1.53(e)(2), IN RESPONSE TO THE NOTICE OF INCOMPLETE PROVISIONAL APPLICATION," filed March 16, 2012, requesting the above-identified application be accorded a filing date of February 24, 2012.

The application was deposited on February 24, 2012 without drawings. On March 15, 2012, the Office of Data Management sent a Notice of Incomplete Provisional Application (Notice), setting forth that the application appeared to have been deposited without drawings. The Notice indicated that a filing date had not been accorded, and that a filing date would be accorded upon the depositing of drawings.

In response, on March 15, 2012, Applicant filed the present petition. Applicant has not submitted the missing drawings, and has asserted that they are not required.

35 U.S.C. § 113 sets forth that applicants "shall furnish a drawing where necessary for the understanding of the subject matter sought to be patented." Applicant has stated, over his registration number, that "Applicants confirm that the figures are not necessary for a filing date."

Because of this affirmative representation, the present application is deemed to be an application which does not require a drawing for an understanding of the invention. Accordingly, the application, as originally filed, is entitled to a filing date of February 24, 2012.

Accordingly, the petition is **GRANTED**.

The portion of the Notice which indicates that a filing date has not been accorded is hereby **VACATED**.

However, the petition fee will not be refunded, as the Office of Data Management formality examiner properly mailed the notice. It is noted that page five of the specification describe Figures 1 - 3.

The Office of Patent Application Processing (OPAP) will be advised of this decision. Pursuant to this decision, the application will be referred to OPAP for:

- **correction of the filing date to February 24, 2012**;
- **for indication in Office records, as appropriate, that "0" sheets of drawings were present on filing,** and;
- **for issuance of a filing receipt**.

The general phone number for OPAP is 571-272-4000. Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3225.[1]

Paul Shanoski
Senior Attorney
Office of Petitions

1 Applicant will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Applicant is reminded that no telephone discussion may be controlling or considered authority for any further action(s) of Applicant.

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PLAGER LAW OFFICES
16152 BEACG BLVD.
SUITE 207
HUNTINGTON BEACH, CA 92647

MAILED

MAR 26 2012

OFFICE OF PETITIONS

In re Application of
Jon Thompson
Application No. 61/603,240
Filed: February 25, 2012
Attorney Docket No. THOMPSON-LZ-PP.001

DECISION ON PETITION
TO WITHDRAW
FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent under 37 C.F.R. § 1.36(b) filed March 2, 2012.

The request is **NOT APPROVED**.

The Office will no longer approve requests from practitioners to withdraw from application where the requesting practitioners is acting, or has acted, in a representative capacity pursuant to 37 CFR 1.34. In these situations, the practitioner is responsible for the correspondence the practitioner files in the application while acting in a representative capacity. As such, there is no need for the practitioner to obtain the Office's permission to withdraw from representation. However, practitioners acting in a representative capacity, like practitioners who have power of attorney in the application, remain responsible for noncompliance with 37 CFR 1.56, as well as 37 CFR 10.18, with respect to the documents they file.

A review of the file record indicates that Plager Law Offices does not have power of attorney in this patent application. See 37 C.F.R. § 10.40. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is not applicable.

All future communications from the Office will continue to be directed to the below-listed address until otherwise properly notified by the applicant.

Telephone inquires concerning this decision should be directed to undersigned at 571-272-1642.

All other inquiries concerning the examination or status of this application should be directed to the Technology Center.

/AMW/
April M. Wise
Petitions Examiner
Office of Petitions

cc: JON THOMPSON
7739 PARAISO CIRCLE
BOERNE, TX 78015

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MARSHALL, GERSTEIN & BORUN LLP
233 SOUTH WACKER DRIVE
6300 WILLIS TOWER
CHICAGO IL 60606-6357

MAILED
APR 10 2012
OFFICE OF PETITIONS

In re Application of
James D. Reiss et al
Application No. 61/605,537
Filed: March 1, 2012
Attorney Docket No. 16014/46750

DECISION ON REQUEST FOR REFUND

This is a decision on the Request For Refund filed March 29, 2012.

The request is **DISMISSED**.

Applicant files the above request for refund and states that "Applicants request a refund in the amount of $125.00 covering the fee for Filing Fee filed March 1, 2012. An attempt to file a provisional application appeared to have failed and the application was filed a second time on the same day. Because the original transaction was not confirmed and caused us to file the application a second time, identical applications 61/605,533 and 61/605,537 are on file."

A review of Office records for the provisional applications (61/605,533 and 61/605,537) filed on March 1, 2012, show that the applications are not identical as applicant claims. The identifiers of the provisional applications are different.

Applicant's attention is directed to MPEP 607.02 which states that:

When an applicant or patentee takes an action "by mistake" (e.g., files an application or maintains a patent in force "by mistake"), the submission of fees required to take that action (e.g., a filing fee submitted with such application or a maintenance fee submitted for such patent) is **not** a "fee paid by mistake" within the meaning of 35 U.S.C. 42(d).

37 CFR 1.26(a) also provides that a change of purpose after the payment of a fee, as when a party desires to withdraw the filing of a patent application for which the fee was paid, will not entitle the party to a refund of such fee.

In view of the above, the request for refund is dismissed because the filing fee was due for the filing of the provisional application.

Any questions concerning this matter may be directed to the undersigned at (571) 272-3208.

/KOC/
Karen Creasy
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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THOMAS LEE FILLIOS SR.
30 SOUTH BRCMEN STREET
BOSTON MA 02128

MAILED

NOV 07 2011

OFFICE OF PETITIONS

In re Application of :
Thomas Lee FILLIOS, SR. :
Application No. 61/626,962 : DECISION ON PETITION
Filed: October 05, 2011 : TO MAKE SPECIAL UNDER
Attorney Docket No. 000 : 37 CFR 1.102(c)(1)
:

This is a decision on the petition under 37 CFR 1.102(c)(1), filed October 05, 2011, to make the above-identified application special based on applicant's age as set forth in M.P.E.P. § 708.02, Section IV.

The petition is **GRANTED**.

A grantable petition to make an application special under 37 CFR 1.102(c)(1) and MPEP § 708.02, Section IV: Applicant's Age must be accompanied by evidence showing that at least one of the applicants is 65 years of age, or more, such as a birth certificate or a statement by applicant. No fee is required

The instant petition includes a statement by Thomas Lee Fillios, Sr. attesting that he is over 65 years of age. Accordingly, the above-identified application has been accorded "special" status.

Telephone inquiries concerning this decision should be directed to the undersigned at 571-272-4231.

All other inquiries concerning either the examination or status of the application should be directed to the Technology Center.

The application is being forwarded to the Technology Center for action on the merits commensurate with this decision.

Michelle R. Eason
Paralegal Specialist
Office of Petitions

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JOHN R. POTTS
38 TROLLEY ROAD
CORTLANDT MANOR NY 10567

MAILED

OCT 24 2011

OFFICE OF PETITIONS

In re Application of :
John Randall Potts et al. :
Application No. 61/627,704 : DECISION GRANTING PETITION
Deposited: September 11, 2011 :
Title of Invention: NATURAL SHAPING COMFORTABLE BRASSIERE :

This is a decision on the petition filed September 30, 2011 to convert application no. 29/401,342 to a provisional application. The petition is being treated under 37 CFR 1.182.

The petition is **DISMISSED as involving moot issues.**

Since the Office of Patent Application Processing has determined that the above-identified application number was erroneously assigned to your documents and assigned application number 61/627,704 as the correct application number, and in view of the NOTICE OF CORRECTED APPLICATION NUMBER mailed October 18, 2011, the petition will not be considered and will not receive any further treatment from the Office of Petitions.

This matter is being referred to the Office of Patent Application Processing for further pre-examination processing.

Telephone inquiries related to this decision should be directed to the undersigned Petitions Attorney at (571) 272-3212.

/Patricia Faison-Ball/

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

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SCHWARTZ LAW FIRM PC
SOUTHPARK TOWERS
SUITE 1135
6100 FAIRVIEW ROAD
CHARLOTTE NC 28210

MAILED

DEC 14 2011

OFFICE OF PETITIONS

In re Application of :
David B. Higgins :
Application No. 61/628,349 : ON PETITION
Filed: October 28, 2011 :
Attorney Docket No. 656/1 :

This is a decision on the petition under 37 CFR 1.10(c), filed December 1, 2011, to accord the above application a filing date of October 28, 2011.

The petition is **GRANTED.**

Petitioner argues that the above-identified application was filed on October 28, 2011, not October 31, 2011. In support thereof, petitioner has included a copy of the Express Mail mailing label for Express mail number EG 883043825 US. The Express Mail mailing label contains a "date in" entry of October 28, 2011.

37 CFR 1.10(c) states that any person filing correspondence under 37 CFR 1.10, who can show that there is a discrepancy between the filing date accorded by the Office and the date of deposit as shown by the "date-in" on the Express Mail mailing label may petition the Commissioner to accord the correspondence a filing date as of the "date-in" on the Express Mail mailing label, provided:

(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 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.

Petitioner has fulfilled requirements (1), (2), and (3) above. The Express Mail mailing label bears a "date-in" entry of October 28, 2011.

Given the basis for granting this petition, no petition fee was required, and none has been charged.

The matter is being forwarded to the Office of Patent Application Processing for further processing with a filing date of **October 28, 2011, not October 31, 2011.**

Telephone inquiries concerning this decision should be directed to the undersigned at (571)272-3207.

Cliff Congo
Petitions Attorney
Office of Petitions

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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David Funnell
61 Surrey St
Medford MA 02155

MAILED
JAN 30 2012
OFFICE OF PETITIONS

In re Application of :
David Martin Funnell :
Application No. 61/630,693 : DECISION ON PETITION
Filed: December 19, 2011 : TO MAKE SPECIAL UNDER
: 37 CFR 1.102(c)(1)
:

This is a decision on the petition under 37 CFR 1.102(c)(1), filed December 19, 2011, to make the above-identified application special based on applicant's age as set forth in M.P.E.P. § 708.02, Section IV.

The petition is **GRANTED**.

A grantable petition to make an application special under 37 CFR 1.102(c)(1) and MPEP § 708.02, Section IV: Applicant's Age must be accompanied by evidence showing that at least one of the applicants is 65 years of age, or more, such as a birth certificate or a statement by applicant. No fee is required

The instant petition includes a statement from the applicant declaring that he is 65 years of age or older. Accordingly, the above-identified application has been accorded "special" status.

Telephone inquiries concerning this decision should be directed to Terri Johnson at 571-272-2991.

All other inquiries concerning either the examination or status of the application should be directed to the Technology Center.

The application is being forwarded to the Office of Patent Application Processing for further processing.

/Terri Johnson/
Terri Johnson
Petitions Examiner
Office of Petitions

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 NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
13/282,340	10/26/2011	Robert Yale Lary	

CONFIRMATION NO. 5687

Robert Yale Lary
2110 Plantation Drive
Richmond, TX 77406

CONVERSION REQUEST

OC000000051567374

Date Mailed: 12/19/2011

DECISION DISMISSING REQUEST UNDER 37 CFR 1.53(c)(2) TO CONVERT TO PROVISIONAL

This is a decision on the request under 37 CFR 1.53(c)(2) received in the U.S. Patent and Trademark Office on **12/05/2011,** to convert the above-identified application to a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c).

The request is dismissed because it does not comply with all the requirements of 37 CFR 1.53(c)(2).

A grantable request under 37 CFR 1.53(c)(2) to convert a non-provisional application to a provisional application must be accompanied by the processing fee set forth in 37CFR 1.17(q) and be filed prior to the earliest of: abandonment of the application filed under 37 CFR 1.53(b); payment of the issue fee on the application filed under 37 CFR 1.53(b); expiration of twelve months after the filing date of the application filed under 37 CFR 1.53(b); or the filing of a request for a statutory invention registration under 37 CFR 1.293 in the application filed under 37 CFR 1.53(b). The present request is not grantable because:

It is not accompanied by the fee required by 37 CFR 1.17(q).

Any request for reconsideration of this decision must be filed within TWO MONTHS of the date of this decision. This time limit may NOT be extended pursuant to 37 CFR 1.136. The request must be accompanied by the items noted above.

Any inquiries related to this decision should be directed to Application Assistance Unit at (571) 272-4000, or (571) 272-4200, or 1-888-786-0101.

A copy of this notice MUST be returned with the reply.

JANICE L TIPPETT
Office of Patent Application Processing (OPAP)
(571) 272-4200, or 1-888-786-0101

Copied from 13282340 on 01/04/2012

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

PATENT ELEMENTS
ATTN: CHRIS ALDER
812 S. STREEPER ST.
BALTIMORE MD 21224

MAILED

APR 02 2012

OFFICE OF PETITIONS

In re Application of :
Woodruff :
Application No. 61/632,091 : DECISION
Filed/Deposited: 5 March, 2012 :
Attorney Docket No. CA-2012-01 :

This is a decision on the petition filed on 5 March, 2012, and properly considered pursuant to 37 C.F.R. §1.53 and §1.182.

For the reasons set forth below, the petition pursuant to 37 C.F.R. §1.53 and §1.182 is **DISMISSED**.

This is **not** a final agency action within the meaning of 5 U.S.C. §704.

BACKGROUND

The instant application was deposited on 18 January, 2012.

On 15 February, 2012, the Office of Patent Application Processing (OPAP) mailed a Notice of Incomplete Application ("Date Mailed: 2/15/2012"), indicating therein that the application had not been accorded a filing date because it had been filed without at least one drawing pursuant to the provisions of 35 U.S.C. §113, "where necessary for the understanding of the subject matter sought to be patented."

Thus, the application was not accorded a filing date.

OPAP indicated that Petitioner might: contend *via* petition (with fee[1] and support, *inter alia*,

[1] The regulations at 37 C.F.R. §1.182 provide:

§ 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).

(e.g., a date-stamped receipt card (*see*: MPEP §503[2])) that the drawing figures were present on deposit, and provide a copy of the drawing figures; submit the drawings and accept the date of submission as the filing date; or accept the application as deposited without drawings but with a statement that drawings were not necessary for the understanding of the subject matter sought to be patented.

OPAP set a two- (2-) month period for reply.

On 5 March, 2012, Petitioner submitted:

- A paper entitled (improvidently/improperly) as a "Response to Notice of Missing Parts" (sic);

---

[2] MPEP §503 provides in pertinent part:

§503 Application Number and Filing Receipt

* * *

A return postcard should be attached to *each* patent application for which a receipt is desired. It is important that the return postcard itemize all of the components of the application. If the postcard does not itemize each of the components of the application, it will not serve as evidence that any component which was not itemized was received by the United States Patent and Trademark Office (USPTO). It should be recognized that the identification of an application by application number does not necessarily signify that the USPTO has accepted the application as complete (37 C.F.R. §1.53(a)).

* * *

RETURN POSTCARD

If a receipt for any item (e.g., paper or fee) filed in the USPTO is desired, it may be obtained by enclosing with the paper a self-addressed postcard specifically identifying the item. To ensure the receipt of return receipt postcards, users must either: (A) purchase already stamped postcards from the United States Postal Service (USPS) or affix postage stamps to their postcards; or (B) if a postage meter is used, ensure that the meter postmark does not show the date. Any return receipt postcard containing a dated meter postmark may not be delivered by the USPS to the address provided on the postcard. Users are reminded that they are solely responsible for placing the proper postage on self-addressed postcards that are submitted to the USPTO for the purpose of obtaining a receipt for correspondence being filed in the USPTO. Users should check with the USPS regarding postage and what size cards are acceptable to the USPS. Any return receipt postcard that does not contain sufficient postage or is not acceptable may not be delivered by the USPS to the address provided on the postcard, and, if returned to the USPTO, may be discarded.

The USPTO will stamp the receipt date on the postcard and place it in the outgoing mail. 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.

The identifying data on the postcard should be so complete as to clearly identify the item for which a receipt is requested. For example, the postcard should identify the applicant's name, application number (if known), confirmation number (if known), filing date, interference number, title of the invention, etc. The postcard should also identify the type of paper being filed, e.g., new application, affidavit, amendment, notice of appeal, appeal brief, drawings, fees, motions, supplemental oath or declaration, petition, etc., and the number of pages being submitted. If a new application is being filed, 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).

The postcard receipt will not serve as *prima facie*evidence of receipt of any item which is not adequately itemized on the postcard. For example, merely listing on the postcard "a complete application" or "patent application" will not serve as a proper receipt for each of the required components of an application (e.g., specification (including claims), drawings (if necessary), oath or declaration and the application filing fee) or 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. Each separate component should be specifically and properly itemized on the postcard. Furthermore, merely incorporating by reference in the postcard receipt, the items listed in a transmittal letter will not serve as *prima facie* evidence of receipt of those items.

The person receiving the item(s) in the USPTO will check the listing on the postcard against the item(s) being filed to be sure they are properly identified and that all the items listed on the postcard are presently being submitted to the USPTO. If any of the items listed on the postcard are not being submitted to the USPTO, those items will be crossed off and the postcard initialed by the person receiving the items.

Upon return of a postcard receipt from the USPTO, the postcard receipt should be promptly reviewed by the person who filed the items to ensure that every item specifically denoted on the postcard was received by the USPTO. If the postcard receipt has been annotated to indicate that a particular item denoted on the postcard was not received by the USPTO, the postcard receipt will not serve as *prima facie* evidence of receipt of that item in the USPTO.

>For acknowledgement receipt that is automatically and electronically sent to the person filing correspondence via the USPTO electronic filing system (EFS-Web), see MPEP § 502.05.< (Emphasis supplied.)

***

- No receipt card (*see*: MPEP §503);
- No fee as required pursuant to the regulations at 37 C.F.R. §1.182;
- A statement that:

> This communication is in response to the undated (sic) notice of incomplete provisional application mailed by the Office to the applicant.
>
> The Office's position is preposterous for at least two reasons. First, pursuant to 35 USC 113 drawings are not required to be submitted with the present application. Second drawings were in fact submitted with the present provisional application. Nevertheless, a duplicate set of drawings are (sic) provided herewith.

- Three sheets of drawings, FIGS. 1 and 2, FIGS. 3 and 4, FIG. 5, but no fee, and no showing whatsoever that the drawings were present on deposit of the application.

On 22 March, 2012, OPAP mailed a filing receipt ("Date Mailed: 03/22/2012") setting forth a filing date of 5 March, 2012.

ANALYSIS

After the instant application was deposited on 18 January, 2012:

On 15 February, 2012, the Office of Patent Application Processing (OPAP) mailed a Notice of Incomplete Application ("Date Mailed: 2/15/2012"),[3] indicating therein that the application had not been accorded a filing date because it had been filed without at least one drawing pursuant to the provisions of 35 U.S.C. §113 (first sentence), "where necessary for the understanding of the subject matter sought to be patented." Thus, the application was not accorded a filing date. OPAP indicated that Petitioner might: contend via petition (with support, *inter alia*, of e.g., a date-stamped receipt card (*see*: MPEP §503)) that the drawing figures were present on deposit, and provide a copy of the drawing figures; submit the drawings and accept the date of submission as the filing date; or accept the application as deposited without drawings but with a statement that drawings were not necessary for the understanding of the subject matter sought to be patented.

OPAP set a two- (2-) month period for reply.

On 5 March, 2012, Petitioner submitted:

[3] A copy is provided for Petitioner's reference.

- A paper entitled (improvidently/improperly) as a "Response to Notice of Missing Parts" (sic);

- No fee as required pursuant to the regulations at 37 C.F.R. §1.182;

- A statement that:

> This communication is in response to the undated (sic) notice of incomplete provisional application mailed by the Office to the applicant.
>
> The Office's position is preposterous for at least two reasons. First, pursuant to 35 USC 113 drawings are not required to be submitted with the present application. Second drawings were in fact submitted with the present provisional application. Nevertheless, a duplicate set of drawings are (sic) provided herewith.

- No receipt card (*see*: MPEP §503);

- Three sheets of drawings, FIGS. 1 and2, 3 and 4, 5, but no fee, and no showing whatsoever that the drawings were present on deposit of the application.

On 22 March, 2012, OPAP mailed a filing receipt ("Date Mailed: 03/22/2012") setting forth a filing date of 5 March, 2012.

It is notable that:

- At the (unnumbered) fourth and fifth pages of the specification submitted on 18 January, 2012, there are references to drawing FIGS. 1, 2, 3, 4 and 5, but—as discussed above—no showing that any of the drawing figures were present on deposit.

- At the (numbered) first and second pages of the claims, each of the eleven (11) claims set forth identifies the claimed elements as "[a] portable liquid dispensing device" or '[t]he device" (sic)—thus, there was no suggestion that what was presented and claimed was a process or method or composition.

It is the practice of the Office to treat an application that contains at least one process or method claim as an application for which a drawing is not necessary for the understanding of the invention under 35 U.S.C. §113 (first sentence) (see : MPEP §601.01, and specifically MPEP §601.01(f)(A)).

However, in view of the express statements of the application:

- (Specification), cited above, that drawings were to be included; and

- (Claims): cited above, that the invention was a "device" and did not include a process or method or composition claim, and

- Further, in view not only of what appeared to be Petitioner's misstatement of the statutory provision and/or unclear statement of intent (set forth above) with regard to that provision, but also of Petitioner's failure to submit the required fee,

at this writing the Office does not accept the application in the context of a submission under MPEP §601.01, and specifically MPEP §601.01(f)(A)).

Petitioner is reminded and cautioned that such limited amendment of provisional applications as is permitted is discussed in the guidance in the Commentary at MPEP §601.01(b).)[4]

CONCLUSION

The petition is **dismissed**; the error was not Office error; the fee was not submitted and the petition is not considered substantively.

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[4] The guidance in the Commentary at MPEP §601.01(b) expressly provides:

> **601.01(b) Provisional Applications Filed Under 35 U.S.C. §111(b) [R-3]**
>
> A provisional application will be given a filing date in accordance with 37 C.F.R. §1.53(c) as of the date the written description and any necessary drawings are filed in the Office. The filing date requirements for a provisional application set forth in 37 C.F.R. §1.53(c)parallel the requirements for a nonprovisional application set forth in 37 C.F.R. §1.53(b), except that no claim is required. Amendments, other than those required to make the provisional application comply with applicable regulations, are not permitted after the filing date of the provisional application.
>
> When the specification or drawing are omitted, 37 C.F.R. §1.53(e) requires that the applicant be notified and given a time period in which to submit the missing element to complete the filing. See MPEP §601.01(f) and §601.01(g) for treatment of applications filed without drawings, or filed without all figures of drawings, respectively.
>
> 37 C.F.R. §1.53(c)(1) requires all provisional applications be filed with a cover sheet, which may be an application data sheet (37 C.F.R. §1.76) or a cover letter identifying the application as a provisional application. The Office will treat an application as having been filed under paragraph (b), unless the application is clearly identified as a provisional application. A provisional application, which is identified as such, but which does not have a complete cover sheet as required by 37 C.F.R. §1.51(c)(1) will be treated as a provisional application. However, the complete cover sheet and a surcharge will be required to be submitted at a later date in conformance with 37 C.F.R. §1.53(g).
>
> When the provisional application does not have a complete cover sheet or the appropriate fee, the applicant will be notified pursuant to 37 C.F.R. §1.53(g) and given a time period in which to provide the necessary fee or cover sheet and to pay the surcharge as set forth in 37 C.F.R. §1.16*>(g)< in order to avoid abandonment of the application. The time period will usually be set at 2 months from the date of notification. This time period may be extended under 37 C.F.R. §1.136(a). If the filing fee is not timely paid, the Office may dispose of the provisional application. If no correspondence address has been provided, applicant has 2 months from the filing date to file the basic filing fee, cover sheet, and to pay the surcharge as set forth in 37 C.F.R. §1.16*>(g)< in order to avoid abandonment of the provisional application. Copies of a provisional application will be provided by the USPTO upon request and payment of the fee set forth in 37 C.F.R. §1.19(b) unless the provisional application has been disposed of (see 37 C.F.R. §1.53(e) and (g)).
>
> The basic filing fee must be paid in a provisional application on filing or within the time period set forth in 37 C.F.R. §1.53(g), and the provisional application must be entitled to a filing date under 37 C.F.R. §1.53(c), if any claim for benefits under 35 U.S.C. §119(e) based on that application is made in a subsequently filed nonprovisional application. 37 C.F.R. §1.78(a)(4).
>
> 37 C.F.R. §1.53(e)(2) requires that any request for review of a refusal to accord an application a filing date be made by way of a petition accompanied by the fee set forth in 37 C.F.R. §1.17*>(f)< (see MPEP § 506.02). (Emphasis supplied.)
>
> ***

The application is released to the Office of Patent Application Processing (OPAP) for further processing as necessary and no change will be made to the presently accorded filing date of 5 March, 2012, with 13 (unnumbered) pages of specification (description, claims, abstract) and three (3) sheets of drawings all as deposited on 18 January, 2012, and 5 March, 2012, respectively.

Telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214—it is noted, however, that all practice before the Office is in writing (see: 37 C.F.R. §1.2[5]) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).

/John J. Gillon, Jr./
John J. Gillon, Jr.
Senior Attorney
Office of Petitions

[5] The regulations at 37 C.F.R. §1.2 provide:

§1.2 Business to be transacted in writing.

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

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 NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
61/632,091	01/18/2012	Melinda Woodruff	CA-2012-01

CONFIRMATION NO. 3326

Patent Elements
ATTN: Chris Alder
812 S. Streeper St.
Baltimore, MD 21224

FORMALITIES LETTER

OC000000052311272

Date Mailed: 02/15/2012

NOTICE OF INCOMPLETE PROVISIONAL APPLICATION

FILED UNDER 37 CFR 1.53(c)

A filing date has NOT been accorded to the above-identified PROVISIONAL APPLICATION papers for the following reason(s) indicated below.

All of the items noted below **must** be submitted within **TWO MONTHS** of the date of this Notice, unless otherwise indicated, or the proceedings on the application will be terminated (37 CFR 1.53(e)).

The filing date will be the date of receipt of all items required below, unless otherwise indicated. Any assertions that the items required were submitted, or are not necessary for a filing date, must be by way of petition directed to the attention of the Office of Petitions accompanied by the $400.00 petition fee (37 CFR 1.17(f)). If the petition states that the application is entitled to a filing date, a request for a refund of the petition fee may be included in the petition.

- The application was deposited without drawings. 35 U.S.C. 113 (first sentence) requires a drawing "where necessary for the understanding of the subject matter sought to be patented."
  Applicant should reconsider whether the drawings are necessary under 35 U.S.C. 113 (first sentence).

Applicant is cautioned that correction of the above items may cause the specification and drawings page count to exceed 100 pages. If the specification and drawings exceed 100 pages, applicant will need to submit the required application size fee.

Replies should be mailed to:

Mail Stop Missing Parts
Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

Registered users of EFS-Web may alternatively submit their reply to this notice via EFS-Web.
https://sportal.uspto.gov/authenticate/AuthenticateUserLocalEPF.html

For more information about EFS-Web please call the USPTO Electronic Business Center at **1-866-217-9197** or visit our website at http://www.uspto.gov/ebc.

If you are not using EFS-Web to submit your reply, you must include a copy of this notice.

/bnguyen/

Office of Data Management, Application Assistance Unit (571) 272-4000, or (571) 272-4200, or 1-888-786-0101

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 NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
13/020,019	02/03/2011	Raul David Molina	

CONFIRMATION NO. 1577

Raul Molina
10141 SW 40th Street
Miami, FL 33165

CONVERSION REQUEST

OC000000052262817

Date Mailed: 01/30/2012

DECISION GRANTING REQUEST TO CONVERT TO PROVISIONAL

This is a decision on the request under 37 CFR 1.53(c)(2) received in the U.S. Patent and Trademark Office on **10/21/2011,** to convert the above-identified application to a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c).

The request is granted.

The application will be processed in the Office of Patent Application Processing (OPAP) as a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c), including the assignment of a new provisional application number.

The provisional application number is **61/632,396.** The filing receipt for the provisional application number will be mailed to the applicant by OPAP in due course.

SHIRLEY A HOLMES
Office of Patent Application Processing (OPAP)
(571) 272-4200, or 1-888-786-0101

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
13/274,326	10/15/2011	Jackson L. Crisp	

CONFIRMATION NO. 1569

Jackson L. Crisp
2885 Sanford Ave. SW #16633
Grandville, MI 49481

CONVERSION REQUEST

OC000000052773910

Date Mailed: 03/01/2012

DECISION GRANTING REQUEST TO CONVERT TO PROVISIONAL

This is a decision on the request under 37 CFR 1.53(c)(2) received in the U.S. Patent and Trademark Office on **02/03/2012,** to convert the above-identified application to a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c).

The request is granted.

The application will be processed in the Office of Patent Application Processing (OPAP) as a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c), including the assignment of a new provisional application number.

The provisional application number is **61/632,397.** The filing receipt for the provisional application number will be mailed to the applicant by OPAP in due course.

SHIRLEY A HOLMES
Office of Patent Application Processing (OPAP)
(571) 272-4200, or 1-888-786-0101

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 NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
13/355,351	01/20/2012	William Leland Goin	

CONFIRMATION NO. 4161

William Goin
9100 Mountain Ridge Dr. #5C
Austin, TX 78759

CONVERSION REQUEST

OC000000052592975

Date Mailed: 02/24/2012

DECISION GRANTING REQUEST TO CONVERT TO PROVISIONAL

This is a decision on the request under 37 CFR 1.53(c)(2) received in the U.S. Patent and Trademark Office on **01/26/2012,** to convert the above-identified application to a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c).

The request is granted.

The application will be processed in the Office of Patent Application Processing (OPAP) as a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c), including the assignment of a new provisional application number.

The provisional application number is **61/632,398.** The filing receipt for the provisional application number will be mailed to the applicant by OPAP in due course.

SHIRLEY A HOLMES
Office of Patent Application Processing (OPAP)
(571) 272-4200, or 1-888-786-0101

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 NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
13/196,734	08/02/2011	Sylvain Roy	3712044.03520

CONFIRMATION NO. 4395

29200
K&L Gates LLP
P.O. Box 1135
Chicago, IL 60690-1135

CONVERSION REQUEST

OC000000052595265

Date Mailed: 02/22/2012

DECISION GRANTING REQUEST TO CONVERT TO PROVISIONAL

This is a decision on the request under 37 CFR 1.53(c)(2) received in the U.S. Patent and Trademark Office on **11/04/2011,** to convert the above-identified application to a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c).

The request is granted.

The application will be processed in the Office of Patent Application Processing (OPAP) as a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c), including the assignment of a new provisional application number.

The provisional application number is **61/632,399.** The filing receipt for the provisional application number will be mailed to the applicant by OPAP in due course.

SHIRLEY A HOLMES
Office of Patent Application Processing (OPAP)
(571) 272-4200, or 1-888-786-0101

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
13/269,378	10/07/2011		68482-8041.US00

CONFIRMATION NO. 8660

22918
PERKINS COIE LLP
P.O. BOX 1208
SEATTLE, WA 98111-1208

CONVERSION REQUEST

OC000000052594702

Date Mailed: 02/22/2012

DECISION GRANTING REQUEST TO CONVERT TO PROVISIONAL

This is a decision on the request under 37 CFR 1.53(c)(2) received in the U.S. Patent and Trademark Office on **11/09/2011,** to convert the above-identified application to a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c).

The request is granted.

The application will be processed in the Office of Patent Application Processing (OPAP) as a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c), including the assignment of a new provisional application number.

The provisional application number is **61/632,400.** The filing receipt for the provisional application number will be mailed to the applicant by OPAP in due course.

SHIRLEY A HOLMES
Office of Patent Application Processing (OPAP)
(571) 272-4200, or 1-888-786-0101

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
13/267,891	10/07/2011	David McClain	ACUD 11.05 NP

CONFIRMATION NO. 5336

78713
Nguyen & Tarbet
6039 E. Grant Rd.
Tucson, AZ 85712

CONVERSION REQUEST

OC000000052602901

Date Mailed: 02/22/2012

DECISION GRANTING REQUEST TO CONVERT TO PROVISIONAL

This is a decision on the request under 37 CFR 1.53(c)(2) received in the U.S. Patent and Trademark Office on **11/03/2011,** to convert the above-identified application to a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c).

The request is granted.

The application will be processed in the Office of Patent Application Processing (OPAP) as a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c), including the assignment of a new provisional application number.

The provisional application number is **61/632,401.** The filing receipt for the provisional application number will be mailed to the applicant by OPAP in due course.

SHIRLEY A HOLMES
Office of Patent Application Processing (OPAP)
(571) 272-4200, or 1-888-786-0101

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.
13/267,891	10/07/2011	David McClain	ACUD 11.05 NP	5336

78713 7590 12/14/2011

Nguyen & Tarbet
6039 E. Grant Rd.
Tucson, AZ 85712

EXAMINER	
ART UNIT	PAPER NUMBER
2614	

NOTIFICATION DATE	DELIVERY MODE
12/14/2011	ELECTRONIC

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

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

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jnguyen@ntiplaw.com
qln.law@gmail.com
dmoroyoqui@ntiplaw.com

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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

Nguyen & Tarbet
6039 E. Grant Rd.
Tucson AZ 85712

In re Application of:
MCCLAIN, DAVID
Serial No.: **13/267,891**
Filed: **October 7, 2011**
Attorney Docket Number: **ACUD 11.05 NP**
For: **SYSTEMS FOR ENHANCEMENT OF AUDIO SIGNALS**

DECISION ON PETITION
TO CONVERT APPLICATION

This is a decision on the petition for conversion under 37 C.F.R. § 1.53(c)(2), filed with appropriate fee on November 3, 2011, to convert the above-identified application to a provisional application under 35 U.S.C. § 111(b) and 37 C.F.R. § 1.53(c)(2).

The petition is **GRANTED**.

The application is being referred to the Office of Patent Application Processing for further processing as a PROVISIONAL application under 35 U.S.C. § 111(b) and 37 C.F.R. § 1.53(c), including the assignment of a new provisional application number.

The new provisional application number will be communicated to the applicant by the Office of Patent Application Processing in due course.

Any inquiry regarding this decision should be directed to Daniel Swerdlow, Quality Assurance Specialist, at (571) 272-7531.

/Daniel Swerdlow/

Daniel Swerdlow
Quality Assurance Specialist
Technology Center 2600
Communications

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UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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Alexandria, Virginia 22313-1450
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APPLICATION NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
13/267,893	10/07/2011	David McClain	ACUD 11.06 NP

CONFIRMATION NO. 5652

78713
Nguyen & Tarbet
6039 E. Grant Rd.
Tucson, AZ 85712

CONVERSION REQUEST

OC000000052595407

Date Mailed: 02/22/2012

DECISION GRANTING REQUEST TO CONVERT TO PROVISIONAL

This is a decision on the request under 37 CFR 1.53(c)(2) received in the U.S. Patent and Trademark Office on **11/03/2011,** to convert the above-identified application to a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c).

The request is granted.

The application will be processed in the Office of Patent Application Processing (OPAP) as a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c), including the assignment of a new provisional application number.

The provisional application number is **61/632,402.** The filing receipt for the provisional application number will be mailed to the applicant by OPAP in due course.

SHIRLEY A HOLMES
Office of Patent Application Processing (OPAP)
(571) 272-4200, or 1-888-786-0101

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/267,893	10/07/2011	David McClain	ACUD 11.06 NP	5652

78713 7590 12/14/2011

Nguyen & Tarbet
6039 E. Grant Rd.
Tucson, AZ 85712

EXAMINER	
ART UNIT	PAPER NUMBER
2614	

NOTIFICATION DATE	DELIVERY MODE
12/14/2011	ELECTRONIC

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

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

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jnguyen@ntiplaw.com
qln.law@gmail.com
dmoroyoqui@ntiplaw.com

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Nguyen & Tarbet
6039 E. Grant Rd.
Tucson AZ 85712

In re Application of:
MCCLAIN, DAVID
Serial No.: **13/267,893**
Filed: **October 7, 2011**
Attorney Docket Number: **ACUD 11.05 NP**
For: **SYSTEMS FOR ENHANCEMENT OF AUDIO SIGNALS**

DECISION ON PETITION
TO CONVERT APPLICATION

This is a decision on the petition for conversion under 37 C.F.R. § 1.53(c)(2), filed with appropriate fee on November 3, 2011, to convert the above-identified application to a provisional application under 35 U.S.C. § 111(b) and 37 C.F.R. § 1.53(c)(2).

The petition is **GRANTED.**

The application is being referred to the Office of Patent Application Processing for further processing as a PROVISIONAL application under 35 U.S.C. § 111(b) and 37 C.F.R. § 1.53(c), including the assignment of a new provisional application number.

The new provisional application number will be communicated to the applicant by the Office of Patent Application Processing in due course.

Any inquiry regarding this decision should be directed to Daniel Swerdlow, Quality Assurance Specialist, at (571) 272-7531.

/Daniel Swerdlow/

Daniel Swerdlow
Quality Assurance Specialist
Technology Center 2600
Communications

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www.uspto.gov

APPLICATION NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
13/234,918	09/16/2011	John P. Broussard	205-0307US

CONFIRMATION NO. 2380

90116
(Weatherford) Wong Cabello Lutsch Rutherford & Brucculeri LLP
20333 Tomball Parkway, 6th floor
Houston, TX 77070

CONVERSION REQUEST

OC000000052602635

Date Mailed: 02/22/2012

DECISION GRANTING REQUEST TO CONVERT TO PROVISIONAL

This is a decision on the request under 37 CFR 1.53(c)(2) received in the U.S. Patent and Trademark Office on **12/27/2011,** to convert the above-identified application to a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c).

The request is granted.

The application will be processed in the Office of Patent Application Processing (OPAP) as a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c), including the assignment of a new provisional application number.

The provisional application number is **61/632,403.** The filing receipt for the provisional application number will be mailed to the applicant by OPAP in due course.

SHIRLEY A HOLMES
Office of Patent Application Processing (OPAP)
(571) 272-4200, or 1-888-786-0101

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APPLICATION NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
13/153,410	06/04/2011	Esmael Dinan	DB-11-1002U

CONFIRMATION NO. 8955

92629
Esmael H. Dinan
13633 Cedar Run Lane
Herndon, VA 20171

CONVERSION REQUEST

OC000000052643613

Date Mailed: 02/27/2012

DECISION GRANTING REQUEST TO CONVERT TO PROVISIONAL

This is a decision on the request under 37 CFR 1.53(c)(2) received in the U.S. Patent and Trademark Office on **08/23/2011,** to convert the above-identified application to a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c).

The request is granted.

The application will be processed in the Office of Patent Application Processing (OPAP) as a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c), including the assignment of a new provisional application number.

The provisional application number is **61/632,404.** The filing receipt for the provisional application number will be mailed to the applicant by OPAP in due course.

SHIRLEY A HOLMES
Office of Patent Application Processing (OPAP)
(571) 272-4200, or 1-888-786-0101

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/153,410	06/04/2011	Esmael Dinan	DB-11-1002U	8955

92629 7590 10/19/2011

Esmael H. Dinan
13633 Cedar Run Lane
Herndon, VA 20171

EXAMINER	
ART UNIT	PAPER NUMBER
2431	

NOTIFICATION DATE	DELIVERY MODE
10/19/2011	ELECTRONIC

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

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

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

dinan@dinantech.com

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Esmael H. Dinan
13633 Cedar Run Lane
Herndon VA 20171

In re Application of: Esmael Dinan)
Application No. 13/153,410)
Filed: June 4, 2011) **DECISION ON PETITION**
Docket No. DB-11-1002U)
Title: **ENHANCED VOICE AND DATA TRANSMISSION USING ORTHOGONAL SUBCARRIERS**)

This is a decision on the petition for conversion to a provisional application under 37 CFR 1.53(c)(2).

The petition filed on August 23, 2011 requests conversion from a non-provisional application to a provisional application under 37 CFR 1.53(c)(2) and includes the required petition and the required fees as set forth in 37 CFR 1.17(q) and 1.16(k). It was also filed within the time frames as set forth in 37 CFR 1.53(c)(2)(i)-(iv).

The petition is **GRANTED**. The application is being forwarded to the Office of Initial Patent Examination for further processing.

/Christopher Grant/
Christopher Grant
WQAS, TC 2400
Networks, Multiplex, Cable and Security
(571) 272-7294

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APPLICATION NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
13/346,519	01/09/2012	Gregory E. Tolla	SEMS:213US

CONFIRMATION NO. 2777

73905
SNR DENTON US LLP
P.O. BOX 061080
CHICAGO, IL 60606-1080

CONVERSION REQUEST

OC000000052643509

Date Mailed: 02/21/2012

DECISION GRANTING REQUEST TO CONVERT TO PROVISIONAL

This is a decision on the request under 37 CFR 1.53(c)(2) received in the U.S. Patent and Trademark Office on **02/07/2012,** to convert the above-identified application to a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c).

The request is granted.

The application will be processed in the Office of Patent Application Processing (OPAP) as a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c), including the assignment of a new provisional application number.

The provisional application number is **61/632,405.** The filing receipt for the provisional application number will be mailed to the applicant by OPAP in due course.

SHIRLEY A HOLMES
Office of Patent Application Processing (OPAP)
(571) 272-4200, or 1-888-786-0101

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APPLICATION NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
13/344,781	01/06/2012	Dinesh Mana	11PLAS0176-US-NP

CONFIRMATION NO. 8787

23413
CANTOR COLBURN LLP
20 Church Street
22nd Floor
Hartford, CT 06103

CONVERSION REQUEST

OC000000053316565

Date Mailed: 04/02/2012

DECISION GRANTING REQUEST TO CONVERT TO PROVISIONAL

This is a decision on the request under 37 CFR 1.53(c)(2) received in the U.S. Patent and Trademark Office on **03/14/2012,** to convert the above-identified application to a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c).

The request is granted.

The application will be processed in the Office of Patent Application Processing (OPAP) as a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c), including the assignment of a new provisional application number.

The provisional application number is **61/632,414.** The filing receipt for the provisional application number will be mailed to the applicant by OPAP in due course.

SHIRLEY A HOLMES
Office of Patent Application Processing (OPAP)
(571) 272-4200, or 1-888-786-0101

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 NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
13/083,160	04/08/2011	Jacob Beverage	09712-0556001 / Z-617

CONFIRMATION NO. 7552

26161
FISH & RICHARDSON P.C. (BO)
P.O. BOX 1022
MINNEAPOLIS, MN 55440-1022

CONVERSION REQUEST

OC000000053727035

Date Mailed: 04/18/2012

DECISION GRANTING REQUEST TO CONVERT TO PROVISIONAL

This is a decision on the request under 37 CFR 1.53(c)(2) received in the U.S. Patent and Trademark Office on **02/29/2012,** to convert the above-identified application to a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c).

The request is granted.

The application will be processed in the Office of Patent Application Processing (OPAP) as a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c), including the assignment of a new provisional application number.

The provisional application number is **61/632,415.** The filing receipt for the provisional application number will be mailed to the applicant by OPAP in due course.

SHIRLEY A HOLMES
Office of Patent Application Processing (OPAP)
(571) 272-4200, or 1-888-786-0101

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/083,160	04/08/2011	Jacob Beverage	09712-0556001 / Z-617	7552

26161 7590 03/30/2012
FISH & RICHARDSON P.C. (BO)
P.O. BOX 1022
MINNEAPOLIS, MN 55440-1022

EXAMINER	
GRANT, CHRISTOPHER C	
ART UNIT	PAPER NUMBER
2403	

NOTIFICATION DATE	DELIVERY MODE
03/30/2012	ELECTRONIC

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

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

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

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United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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MAR 2? 2012

DIRECTOR OFFICE
TECHNOLOGY CENTER 2400

Chris C. Bowley
FISH & RICHARDSON P.C. (BO)
P.O. BOX 1022
MINNEAPOLIS MN 55440-1022

In re Application of:
Jacob Beverage et al.
Application No. 13/083,160
Filed: April 8, 2011
For: **IDENTIFYING BEST-FOCUS OF AN INTERFEROMETRIC IMAGING SYSTEM**

DECISION ON

PETITION UNDER

37 C.F.R. § 1.53 (c) (2)

This is a decision on the petition for conversion to a provisional application under 37 CFR 1.53(c)(2).

The petition filed on February 29, 2012 requests conversion to a provisional application under 37 CFR 1.53(c)(2) and includes the required petition and the required fees as set forth in 37 CFR 1.17(q) and 1.16. It was also filed within the time frames as set forth in 37 CFR 1.53(c)(2)(i)-(iv).

The petition is **GRANTED**. The application is being forwarded to the Office of Patent Processing Services (OPPS) (formerly Office of Initial Patent Examination, OIPE) for further processing.

Any inquiry concerning this decision should be directed to Christopher Grant at (571) 272-7294.

/Christopher Grant/
Christopher Grant
QAS, Technology Center 2400

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UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
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Alexandria, Virginia 22313-1450
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APPLICATION NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
12/484,833	06/15/2009	KUSHAGRA VAID	327069.01/MFCP.147997

CONFIRMATION NO. 2067

45809
SHOOK, HARDY & BACON L.L.P.
(MICROSOFT CORPORATION)
INTELLECTUAL PROPERTY DEPARTMENT
2555 GRAND BOULEVARD
KANSAS CITY, MO 64108-2613

CONVERSION REQUEST

OC000000053821513

Date Mailed: 04/20/2012

DECISION GRANTING REQUEST TO CONVERT TO PROVISIONAL

This is a decision on the request under 37 CFR 1.53(c)(2) received in the U.S. Patent and Trademark Office on **01/13/2010,** to convert the above-identified application to a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c).

The request is granted.

The application will be processed in the Office of Patent Application Processing (OPAP) as a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c), including the assignment of a new provisional application number.

The provisional application number is **61/632,416.** The filing receipt for the provisional application number will be mailed to the applicant by OPAP in due course.

SHIRLEY A HOLMES
Office of Patent Application Processing (OPAP)
(571) 272-4200, or 1-888-786-0101

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.
12/484,833	06/15/2009	KUSHAGRA VAID	327069.01/MFCP.147997	2067

45809 7590 01/26/2012

SHOOK, HARDY & BACON L.L.P.
(MICROSOFT CORPORATION)
INTELLECTUAL PROPERTY DEPARTMENT
2555 GRAND BOULEVARD
KANSAS CITY, MO 64108-2613

EXAMINER	
PEUGH, BRIAN R	

ART UNIT	PAPER NUMBER
2187	

MAIL DATE	DELIVERY MODE
01/26/2012	PAPER

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

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

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UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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SHOOK, HARDY & BACON L.L.P.
(MICROSOFT CORPORATION)
INTELLECTUAL PROPERTY DEPARTMENT
2555 GRAND BOULEVARD
KANSAS CITY MO 64108-2613

In re Application of: VAID et al.	)	
Application No. 12/484,833	)	*SUA SPONTE*
Atty Docket No. 327069.01/MFCP.147997	)	WITHDRAWAL OF OFFICE ACTION
Filed: June 15, 2009	)	
For: APPLICATION-TRANSPARENT HYBRIDIZED CACHING FOR HIGH-PERFORMANCE STORAGE	)	

A review of the application reveals that a Petition to Convert the Instant Application to a Provisional Application was filed by Applicants on January 13, 2010, and said Petition was Granted by the office on January 26, 2010. Notwithstanding, an Office Action in the instant application was mailed to the applicant on September 16, 2011. Since the Application has been Granted the petition to be converted to a Provisional Application, mailing of an Office Action in the instant Application was clearly in error and hence, the Office Action mailed on September 16, 2011is hereby **VACATED**.

The Office Action of 16 September 2011 has been closed from public view as of mailing of this letter.

It is noted that the instant application has been published on 16 December 2010. Thus, the aforementioned Office Action has already been made available to the public and subject to copying by the public. According, the Office cannot guarantee that the Office Action being closed as a result of this decision was not previously accessed by the public.

The application is being forwarded to the Office of Initial Patent Examination for further processing.

Inquiries to this decision may be directed to Quality Assurance Specialist, Mano Padmanabhan at (571) 272-4210.

Mano Padmanabhan
Quality Assurance Specialist, TC 2100, WG 2180
Computer Architecture, Software, and Information Security

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UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/484,833	06/15/2009	KUSHAGRA VAID	327069.01/MFCP.147997	2067

45809 7590 01/26/2012

SHOOK, HARDY & BACON L.L.P.
(MICROSOFT CORPORATION)
INTELLECTUAL PROPERTY DEPARTMENT
2555 GRAND BOULEVARD
KANSAS CITY, MO 64108-2613

EXAMINER	
PEUGH, BRIAN R	

ART UNIT	PAPER NUMBER
2187	

MAIL DATE	DELIVERY MODE
01/26/2012	PAPER

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

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

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SHOOK, HARDY & BACON L.L.P.
(MICROSOFT CORPORATION)
INTELLECTUAL PROPERTY DEPARTMENT
2555 GRAND BOULEVARD
KANSAS CITY MO 64108-2613

In re Application of: VAID et al.	)	
Application No. 12/484,833	)	*SUA SPONTE*
Atty Docket No. 327069.01/MFCP.147997	)	WITHDRAWAL OF OFFICE ACTION
Filed: June 15, 2009	)	
For: APPLICATION-TRANSPARENT HYBRIDIZED CACHING FOR HIGH-PERFORMANCE STORAGE	)	

A review of the application reveals that a Petition to Convert the Instant Application to a Provisional Application was filed by Applicants on January 13, 2010, and said Petition was Granted by the office on January 26, 2010. Notwithstanding, an Office Action in the instant application was mailed to the applicant on September 16, 2011. Since the Application has been Granted the petition to be converted to a Provisional Application, mailing of an Office Action in the instant Application was clearly in error and hence, the Office Action mailed on September 16, 2011is hereby **VACATED**.

The Office Action of 16 September 2011 has been closed from public view as of mailing of this letter.

It is noted that the instant application has been published on 16 December 2010. Thus, the aforementioned Office Action has already been made available to the public and subject to copying by the public. According, the Office cannot guarantee that the Office Action being closed as a result of this decision was not previously accessed by the public.

The application is being forwarded to the Office of Initial Patent Examination for further processing.

Inquiries to this decision may be directed to Quality Assurance Specialist, Mano Padmanabhan at (571) 272-4210.

Mano Padmanabhan
Quality Assurance Specialist, TC 2100, WG 2180
Computer Architecture, Software, and Information Security

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Alexandria, Virginia 22313-1450
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APPLICATION NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
12/484,833	06/15/2009	KUSHAGRA VAID	327069.01/MFCP.147997

CONFIRMATION NO. 2067

45809
SHOOK, HARDY & BACON L.L.P.
(MICROSOFT CORPORATION)
INTELLECTUAL PROPERTY DEPARTMENT
2555 GRAND BOULEVARD
KANSAS CITY, MO 64108-2613

CONVERSION REQUEST

OC000000053821513

Date Mailed: 04/20/2012

DECISION GRANTING REQUEST TO CONVERT TO PROVISIONAL

This is a decision on the request under 37 CFR 1.53(c)(2) received in the U.S. Patent and Trademark Office on **01/13/2010,** to convert the above-identified application to a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c).

The request is granted.

The application will be processed in the Office of Patent Application Processing (OPAP) as a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c), including the assignment of a new provisional application number.

The provisional application number is **61/632,416.** The filing receipt for the provisional application number will be mailed to the applicant by OPAP in due course.

SHIRLEY A HOLMES
Office of Patent Application Processing (OPAP)
(571) 272-4200, or 1-888-786-0101

Copied from 12484833 on 04/20/2012

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 NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
13/329,205	12/16/2011	Daouda Traore	

CONFIRMATION NO. 1082

Amani Innovations, LLC
1412 Boulder Court
Hanover, MD 21076

CONVERSION REQUEST

OC000000052513559

Date Mailed: 02/09/2012

DECISION DISMISSING REQUEST UNDER 37 CFR 1.53(c)(2) TO CONVERT TO PROVISIONAL

This is a decision on the request under 37 CFR 1.53(c)(2) received in the U.S. Patent and Trademark Office on **01/09/2012,** to convert the above-identified application to a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c).

The request is dismissed because it does not comply with all the requirements of 37 CFR 1.53(c)(2).

A grantable request under 37 CFR 1.53(c)(2) to convert a non-provisional application to a provisional application must be accompanied by the processing fee set forth in 37CFR 1.17(q) and be filed prior to the earliest of: abandonment of the application filed under 37 CFR 1.53(b); payment of the issue fee on the application filed under 37 CFR 1.53(b); expiration of twelve months after the filing date of the application filed under 37 CFR 1.53(b); or the filing of a request for a statutory invention registration under 37 CFR 1.293 in the application filed under 37 CFR 1.53(b). The present request is not grantable because:

It is not accompanied by the fee required by 37 CFR 1.17(q).

Any request for reconsideration of this decision must be filed within TWO MONTHS of the date of this decision. This time limit may NOT be extended pursuant to 37 CFR 1.136. The request must be accompanied by the items noted above.

Any inquiries related to this decision should be directed to Application Assistance Unit at (571) 272-4000, or (571) 272-4200, or 1-888-786-0101.

A copy of this notice MUST be returned with the reply.

JANICE L TIPPETT
Office of Patent Application Processing (OPAP)
(571) 272-4200, or 1-888-786-0101

Copied from 13329205 on 02/09/2012

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MAILED

APR 09 2012

OFFICE OF PETITIONS

DENNIS MARTINEZ
1605 WEDGEWOOD DR.
BAKERSFIELD CA 93311

In re Application of :
Dennis Martinez et al :
Application No. 61/632,726 : DECISION ON REQUEST FOR REFUND
Filed: January 30, 2012 :
For: REALITY SHOW PEOPLE DOING :
THEIR LAUNDRY AT THE :
LAUNDROMAT :

This is a decision on the Request For Refund filed March 19, 2012.

The request is **DISMISSED**.

Applicant files the above request for refund and states that "On March 16, 2012 we received a letter from your office denied payment that was sent January 26, 2012 for the amount $125.00. The reason my husband and I sent a check for $125.00 is that we wanted to Patent a reality show and was told by your office the [sic] fill out an application along with a check $125.00 application number 61632726. Two weeks later you sent us a letter saying the application was not complete. We called your office and was told we needed a Copywrite not a Patent. Since my husband a [sic] **I** was told the wrong information we "Petition a request for a refund."

However, the $125.00 filing fee was due for the filing of the provisional application on January 30, 2012. Therefore, applicant's attention is directed to MPEP 607.02 which states that:

When an applicant or patentee takes an action "by mistake" (e.g., files an application or maintains a patent in force "by mistake"), the submission of fees required to take that action (e.g., a filing fee submitted with such application or a maintenance fee submitted for such patent) is **not** a "fee paid by mistake" within the meaning of 35 U.S.C. 42(d).

37 CFR 1.26(a) also provides that a change of purpose after the payment of a fee, as when a party desires to withdraw the filing of a patent application for which the fee was paid, will not entitle the party to a refund of such fee.

Further, as to applicant's assertion that he/she was given the wrong information, applicant will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, applicant is

reminded that no telephone discussion may be controlling or considered authority for applicant's further action(s).

Regrettably, and in view of the above, the request for refund is dismissed.

Any questions concerning this matter may be directed to the undersigned at (571) 272-3208.

/KOC/
Karen Creasy
Petitions Examiner
Office of Petitions

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APPLICATION NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
13/295,091	11/13/2011	Devin Campbell Gibson	

CONFIRMATION NO. 1375

CONVERSION REQUEST

AIR MAIL
Devin Gibson
Taylor Saukarookoff
204-955 Leon Ave
1726 Hayashi Rd.
Kelowna, V1Y 6K1
CANADA

OC000000052429346

Date Mailed: 02/06/2012

DECISION GRANTING REQUEST TO CONVERT TO PROVISIONAL

This is a decision on the request under 37 CFR 1.53(c)(2) received in the U.S. Patent and Trademark Office on **12/21/2011,** to convert the above-identified application to a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c).

The request is granted.

The application will be processed in the Office of Patent Application Processing (OPAP) as a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c), including the assignment of a new provisional application number.

The provisional application number is **61/632,804.** The filing receipt for the provisional application number will be mailed to the applicant by OPAP in due course.

JANICE L TIPPETT
Office of Patent Application Processing (OPAP)
(571) 272-4200, or 1-888-786-0101

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
13/348,597	01/11/2012	Elliot Botvinick	UCI009.002PR

CONFIRMATION NO. 3416

20995
KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

CONVERSION REQUEST

OC000000052430165

Date Mailed: 02/07/2012

DECISION GRANTING REQUEST TO CONVERT TO PROVISIONAL

This is a decision on the request under 37 CFR 1.53(c)(2) received in the U.S. Patent and Trademark Office on **01/13/2012,** to convert the above-identified application to a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c).

The request is granted.

The application will be processed in the Office of Patent Application Processing (OPAP) as a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c), including the assignment of a new provisional application number.

The provisional application number is **61/632,805.** The filing receipt for the provisional application number will be mailed to the applicant by OPAP in due course.

JANICE L TIPPETT
Office of Patent Application Processing (OPAP)
(571) 272-4200, or 1-888-786-0101

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APPLICATION NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
13/064,249	03/14/2011	Donell Dejuana Pridgen	

CONFIRMATION NO. 1323

Donell Pridgen
54 Benoni Circle
Middle River, MD 21220

CONVERSION REQUEST

OC000000052460022

Date Mailed: 02/07/2012

DECISION GRANTING REQUEST TO CONVERT TO PROVISIONAL

This is a decision on the request under 37 CFR 1.53(c)(2) received in the U.S. Patent and Trademark Office on **11/14/2011,** to convert the above-identified application to a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c).

The request is granted.

The application will be processed in the Office of Patent Application Processing (OPAP) as a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c), including the assignment of a new provisional application number.

The provisional application number is **61/632,806.** The filing receipt for the provisional application number will be mailed to the applicant by OPAP in due course.

JANICE L TIPPETT
Office of Patent Application Processing (OPAP)
(571) 272-4200, or 1-888-786-0101

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APPLICATION NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
13/064,249	03/14/2011	Donell Dejuana Pridgen	

CONFIRMATION NO. 1323

Donell Pridgen
54 Benoni Circle
Middle River, MD 21220

CONVERSION REQUEST

OC000000049788575

Date Mailed: 09/12/2011

DECISION DISMISSING REQUEST UNDER 37 CFR 1.53(c)(2) TO CONVERT TO PROVISIONAL

This is a decision on the request under 37 CFR 1.53(c)(2) received in the U.S. Patent and Trademark Office on , to convert the above-identified application to a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c).

The request is dismissed because it does not comply with all the requirements of 37 CFR 1.53(c)(2).

A grantable request under 37 CFR 1.53(c)(2) to convert a non-provisional application to a provisional application must be accompanied by the processing fee set forth in 37CFR 1.17(q) and be filed prior to the earliest of: abandonment of the application filed under 37 CFR 1.53(b); payment of the issue fee on the application filed under 37 CFR 1.53(b); expiration of twelve months after the filing date of the application filed under 37 CFR 1.53(b); or the filing of a request for a statutory invention registration under 37 CFR 1.293 in the application filed under 37 CFR 1.53(b). The present request is not grantable because:

It is not accompanied by the fee required by 37 CFR 1.17(q).

Any request for reconsideration of this decision must be filed within TWO MONTHS of the date of this decision. This time limit may NOT be extended pursuant to 37 CFR 1.136. The request must be accompanied by the items noted above.

Any inquiries related to this decision should be directed to Application Assistance Unit at (571) 272-4000, or (571) 272-4200, or 1-888-786-0101.

A copy of this notice MUST be returned with the reply.

SHIRLEY A HOLMES
Office of Patent Application Processing (OPAP)
(571) 272-4200, or 1-888-786-0101

Copied from 13064249 on 02/09/2012

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APPLICATION NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
13/288,717	11/03/2011	Kirk Moritz	APPM/016199/FEP/RTP/PJT

CONFIRMATION NO. 1089

44257
PATTERSON & SHERIDAN, LLP - - APPM/TX
3040 POST OAK BOULEVARD, SUITE 1500
HOUSTON, TX 77056

CONVERSION REQUEST

OC000000052509000

Date Mailed: 02/09/2012

DECISION GRANTING REQUEST TO CONVERT TO PROVISIONAL

This is a decision on the request under 37 CFR 1.53(c)(2) received in the U.S. Patent and Trademark Office on **01/23/2012,** to convert the above-identified application to a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c).

The request is granted.

The application will be processed in the Office of Patent Application Processing (OPAP) as a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c), including the assignment of a new provisional application number.

The provisional application number is **61/632,807.** The filing receipt for the provisional application number will be mailed to the applicant by OPAP in due course.

JANICE L TIPPETT
Office of Patent Application Processing (OPAP)
(571) 272-4200, or 1-888-786-0101

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RICHARD ARON OSMAN
530 Lawrence Expy # 332
Sunnyvale CA 94085

In re Application of:
Jensen et al.
Serial No.: 13/041,409
Filed: March 6, 2011
Attorney Docket No.: **CMCC-2157**

: CONVERSION TO PROVISIONAL

This is in response to applicant's request, filed January 29, 2012, to convert this application to a provisional application.

The petition is **GRANTED**.

Should there be any questions regard the conversion process please contact Janice Tippett at 703-756-1477.

Should there be any questions with regard to this letter please contact Marianne C. Seidel by letter addressed to the Director, Technology Center 1600, PO BOX 1450, ALEXANDRIA, VA 22313-1450, or by telephone at 571-272-0584 or by facsimile transmission at Office facsimile number, 571-273-8300.

/MC Seidel/
Marianne C. Seidel, Quality Assurance Specialist
Technology Center 1600

Copied from 13041409 on 02/09/2012

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APPLICATION NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
13/041,409	03/06/2011	Frances E. Jensen	CMCC-2157

CONFIRMATION NO. 5033

23379
RICHARD ARON OSMAN
530 Lawrence Expy # 332
Sunnyvale, CA 94085

CONVERSION REQUEST

OC000000052511282

Date Mailed: 02/10/2012

DECISION GRANTING REQUEST TO CONVERT TO PROVISIONAL

This is a decision on the request under 37 CFR 1.53(c)(2) received in the U.S. Patent and Trademark Office on **01/29/2012,** to convert the above-identified application to a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c).

The request is granted.

The application will be processed in the Office of Patent Application Processing (OPAP) as a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c), including the assignment of a new provisional application number.

The provisional application number is **61/632,808.** The filing receipt for the provisional application number will be mailed to the applicant by OPAP in due course.

JANICE L TIPPETT
Office of Patent Application Processing (OPAP)
(571) 272-4200, or 1-888-786-0101

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
13/162,970	06/17/2011	Priya Prakash	042933/404266

CONFIRMATION NO. 8689

10949
Nokia Corporation and Alston & Bird LLP
c/o Alston & Bird LLP
Bank of America Plaza, 101 South Tryon Street
Suite 4000
Charlotte, NC 28280-4000

CONVERSION REQUEST

OC000000052511718

Date Mailed: 02/09/2012

DECISION GRANTING REQUEST TO CONVERT TO PROVISIONAL

This is a decision on the request under 37 CFR 1.53(c)(2) received in the U.S. Patent and Trademark Office on **01/31/2012,** to convert the above-identified application to a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c).

The request is granted.

The application will be processed in the Office of Patent Application Processing (OPAP) as a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c), including the assignment of a new provisional application number.

The provisional application number is **61/632,809.** The filing receipt for the provisional application number will be mailed to the applicant by OPAP in due course.

JANICE L TIPPETT
Office of Patent Application Processing (OPAP)
(571) 272-4200, or 1-888-786-0101

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
13/172,211	06/29/2011	Markus Siurumaa	042933/407529

CONFIRMATION NO. 6871

10949
Nokia Corporation and Alston & Bird LLP
c/o Alston & Bird LLP
Bank of America Plaza, 101 South Tryon Street
Suite 4000
Charlotte, NC 28280-4000

CONVERSION REQUEST

OC000000052824387

Date Mailed: 02/28/2012

DECISION GRANTING REQUEST TO CONVERT TO PROVISIONAL

This is a decision on the request under 37 CFR 1.53(c)(2) received in the U.S. Patent and Trademark Office on **02/15/2012,** to convert the above-identified application to a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c).

The request is granted.

The application will be processed in the Office of Patent Application Processing (OPAP) as a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c), including the assignment of a new provisional application number.

The provisional application number is **61/632,810.** The filing receipt for the provisional application number will be mailed to the applicant by OPAP in due course.

JANICE L TIPPETT
Office of Patent Application Processing (OPAP)
(571) 272-4200, or 1-888-786-0101

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APPLICATION NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
13/346,460	01/09/2012	Surajit Sen	

CONFIRMATION NO. 8280

Steven P. Tozzi
364 Lee Avenue
River Edge, NJ 07661

CONVERSION REQUEST

OC000000052825252

Date Mailed: 02/28/2012

DECISION GRANTING REQUEST TO CONVERT TO PROVISIONAL

This is a decision on the request under 37 CFR 1.53(c)(2) received in the U.S. Patent and Trademark Office on **02/01/2012,** to convert the above-identified application to a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c).

The request is granted.

The application will be processed in the Office of Patent Application Processing (OPAP) as a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c), including the assignment of a new provisional application number.

The provisional application number is **61/632,811.** The filing receipt for the provisional application number will be mailed to the applicant by OPAP in due course.

JANICE L TIPPETT
Office of Patent Application Processing (OPAP)
(571) 272-4200, or 1-888-786-0101

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APPLICATION NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
13/363,394	02/01/2012	Lee Michael DeGross	

CONFIRMATION NO. 8115

101034
Lee M. DeGross
400 Park Place, #1H
Fort Lee, NJ 07024

CONVERSION REQUEST

OC000000052831308

Date Mailed: 02/28/2012

DECISION GRANTING REQUEST TO CONVERT TO PROVISIONAL

This is a decision on the request under 37 CFR 1.53(c)(2) received in the U.S. Patent and Trademark Office on **02/11/2012,** to convert the above-identified application to a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c).

The request is granted.

The application will be processed in the Office of Patent Application Processing (OPAP) as a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c), including the assignment of a new provisional application number.

The provisional application number is **61/632,812.** The filing receipt for the provisional application number will be mailed to the applicant by OPAP in due course.

JANICE L TIPPETT
Office of Patent Application Processing (OPAP)
(571) 272-4200, or 1-888-786-0101

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APPLICATION NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
13/299,479	11/18/2011	Miles Stuart Congreve	BJS-4687-39

CONFIRMATION NO. 3878

23117
NIXON & VANDERHYE, PC
901 NORTH GLEBE ROAD, 11TH FLOOR
ARLINGTON, VA 22203

CONVERSION REQUEST

Date Mailed: 03/07/2012

DECISION GRANTING REQUEST TO CONVERT TO PROVISIONAL

This is a decision on the request under 37 CFR 1.53(c)(2) received in the U.S. Patent and Trademark Office on **03/05/2012,** to convert the above-identified application to a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c).

The request is granted.

The application will be processed in the Office of Patent Application Processing (OPAP) as a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c), including the assignment of a new provisional application number.

The provisional application number is **61/632,813.** The filing receipt for the provisional application number will be mailed to the applicant by OPAP in due course.

JANICE L TIPPETT
Office of Patent Application Processing (OPAP)
(571) 272-4200, or 1-888-786-0101

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
13/404,908	02/24/2012	Alan Devoe	DEVOFC-19P

CONFIRMATION NO. 4144

26875
WOOD, HERRON & EVANS, LLP
2700 CAREW TOWER
441 VINE STREET
CINCINNATI, OH 45202

CONVERSION REQUEST

OC000000053101604

Date Mailed: 03/13/2012

DECISION GRANTING REQUEST TO CONVERT TO PROVISIONAL

This is a decision on the request under 37 CFR 1.53(c)(2) received in the U.S. Patent and Trademark Office on **02/27/2012,** to convert the above-identified application to a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c).

The request is granted.

The application will be processed in the Office of Patent Application Processing (OPAP) as a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c), including the assignment of a new provisional application number.

The provisional application number is **61/632,814.** The filing receipt for the provisional application number will be mailed to the applicant by OPAP in due course.

JANICE L TIPPETT
Office of Patent Application Processing (OPAP)
(571) 272-4200, or 1-888-786-0101

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APPLICATION NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
13/371,163	02/10/2012	Avionaom Zelenki	LPI-005

CONFIRMATION NO. 7113

42532
PROSKAUER ROSE LLP
ONE INTERNATIONAL PLACE
BOSTON, MA 02110

CONVERSION REQUEST

OC000000053102835

Date Mailed: 03/14/2012

DECISION GRANTING REQUEST TO CONVERT TO PROVISIONAL

This is a decision on the request under 37 CFR 1.53(c)(2) received in the U.S. Patent and Trademark Office on **03/07/2012,** to convert the above-identified application to a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c).

The request is granted.

The application will be processed in the Office of Patent Application Processing (OPAP) as a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c), including the assignment of a new provisional application number.

The provisional application number is **61/632,815.** The filing receipt for the provisional application number will be mailed to the applicant by OPAP in due course.

JANICE L TIPPETT
Office of Patent Application Processing (OPAP)
(571) 272-4200, or 1-888-786-0101

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APPLICATION NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
12/907,476	10/19/2010	Jun Qu	26158

CONFIRMATION NO. 2069

73840
Scully Scott Murphy & Presser PC
400 Garden City Plaza, Suite 300
Garden City, NY 11530

CONVERSION REQUEST

OC000000053114079

Date Mailed: 03/13/2012

DECISION GRANTING REQUEST TO CONVERT TO PROVISIONAL

This is a decision on the request under 37 CFR 1.53(c)(2) received in the U.S. Patent and Trademark Office on **12/10/2010,** to convert the above-identified application to a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c).

The request is granted.

The application will be processed in the Office of Patent Application Processing (OPAP) as a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c), including the assignment of a new provisional application number.

The provisional application number is **61/632,816.** The filing receipt for the provisional application number will be mailed to the applicant by OPAP in due course.

JANICE L TIPPETT
Office of Patent Application Processing (OPAP)
(571) 272-4200, or 1-888-786-0101

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.
12/907,476	10/19/2010	Jun Qu	26158	2069

73840 7590 02/17/2011
Scully Scott Murphy & Presser PC
400 Garden City Plaza, Suite 300
Garden City, NY 11530

EXAMINER	
ART UNIT	PAPER NUMBER
1725	

MAIL DATE	DELIVERY MODE
02/17/2011	PAPER

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

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

Copied from 12907476 on 03/13/2012

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

2/17/2011

CST

In re application of	:	
Jun Qu et al	:	
Serial No. 12/907,476	:	DECISION
Filed: October 19, 2010	:	ON PETITION
For: MULTIJUNCTION HYBRID SOLAR CELL INCORPORATING VERTICALLY-ALIGNED SILICON NANOWIRES WITH THIN FILMS	:	

This is a decision on the REQUEST TO CONVERT NONPROVISIONAL APPLICATION TO PROVISIONAL APPLICATION, filed December 10, 2010.

A review of the application record indicates that all of the requirements for converting the above-identified application to a provisional application under 37 CFR 1.53(c)(2) have been met.

The petition is **GRANTED.**

This application will be forwarded to the Office of Patent Application Processing (OPAP) for conversion to a provisional application.

/ Christine Tierney /

Christine Tierney
Quality Assurance Specialist
Technology Center 1700

Copied from 12907476 on 03/13/2012

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

APPLICATION NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
13/186,012	07/19/2011	Alex Rickard	

CONFIRMATION NO. 3462

52146
Thomas L. Peterson
1233 20th Street
Suite 703
Washington, DC 20036

CONVERSION REQUEST

OC000000053228142

Date Mailed: 03/20/2012

DECISION GRANTING REQUEST TO CONVERT TO PROVISIONAL

This is a decision on the request under 37 CFR 1.53(c)(2) received in the U.S. Patent and Trademark Office on **03/02/2012,** to convert the above-identified application to a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c).

The request is granted.

The application will be processed in the Office of Patent Application Processing (OPAP) as a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c), including the assignment of a new provisional application number.

The provisional application number is **61/632,817.** The filing receipt for the provisional application number will be mailed to the applicant by OPAP in due course.

JANICE L TIPPETT
Office of Patent Application Processing (OPAP)
(571) 272-4200, or 1-888-786-0101

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
13/215,197	08/22/2011	Ziyang Lu	10683-CON1/TLE

CONFIRMATION NO. 1753

58377
MENTOR GRAPHICS CORP.
PATENT GROUP
8005 SW BOECKMAN ROAD
WILSONVILLE, OR 97070-7777

CONVERSION REQUEST

OC000000053510190

Date Mailed: 04/04/2012

DECISION GRANTING REQUEST TO CONVERT TO PROVISIONAL

This is a decision on the request under 37 CFR 1.53(c)(2) received in the U.S. Patent and Trademark Office on **04/02/2012,** to convert the above-identified application to a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c).

The request is granted.

The application will be processed in the Office of Patent Application Processing (OPAP) as a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c), including the assignment of a new provisional application number.

The provisional application number is **61/632,818.** The filing receipt for the provisional application number will be mailed to the applicant by OPAP in due course.

JANICE L TIPPETT
Office of Patent Application Processing (OPAP)
(571) 272-4200, or 1-888-786-0101

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
13/235,184	09/16/2011	Keith Adams	26295-19485

CONFIRMATION NO. 1039

87851
Facebook/Fenwick
Silicon Valley Center
801 California Street
Mountain View, CA 94041

CONVERSION REQUEST

OC000000053510516

Date Mailed: 04/04/2012

DECISION GRANTING REQUEST TO CONVERT TO PROVISIONAL

This is a decision on the request under 37 CFR 1.53(c)(2) received in the U.S. Patent and Trademark Office on **03/23/2012,** to convert the above-identified application to a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c).

The request is granted.

The application will be processed in the Office of Patent Application Processing (OPAP) as a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c), including the assignment of a new provisional application number.

The provisional application number is **61/632,819.** The filing receipt for the provisional application number will be mailed to the applicant by OPAP in due course.

JANICE L TIPPETT
Office of Patent Application Processing (OPAP)
(571) 272-4200, or 1-888-786-0101

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
13/341,195	12/30/2011	Shishir Kumar	852463.436

CONFIRMATION NO. 1025

30423
SEED INTELLECTUAL PROPERTY LAW GROUP PLLC
701 FIFTH AVE
SUITE 5400
SEATTLE, WA 98104

CONVERSION REQUEST

OC000000053511311

Date Mailed: 04/04/2012

DECISION GRANTING REQUEST TO CONVERT TO PROVISIONAL

This is a decision on the request under 37 CFR 1.53(c)(2) received in the U.S. Patent and Trademark Office on **03/08/2012,** to convert the above-identified application to a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c).

The request is granted.

The application will be processed in the Office of Patent Application Processing (OPAP) as a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c), including the assignment of a new provisional application number.

The provisional application number is **61/632,820.** The filing receipt for the provisional application number will be mailed to the applicant by OPAP in due course.

JANICE L TIPPETT
Office of Patent Application Processing (OPAP)
(571) 272-4200, or 1-888-786-0101

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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Alexandria, Virginia 22313-1450
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APPLICATION NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
13/355,275	01/20/2012	Carl E. Mero	SEMS:173US

CONFIRMATION NO. 5007

73905
SNR DENTON US LLP
P.O. BOX 061080
CHICAGO, IL 60606-1080

CONVERSION REQUEST

OC000000053511883

Date Mailed: 04/03/2012

DECISION GRANTING REQUEST TO CONVERT TO PROVISIONAL

This is a decision on the request under 37 CFR 1.53(c)(2) received in the U.S. Patent and Trademark Office on **03/30/2012,** to convert the above-identified application to a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c).

The request is granted.

The application will be processed in the Office of Patent Application Processing (OPAP) as a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c), including the assignment of a new provisional application number.

The provisional application number is **61/632,821.** The filing receipt for the provisional application number will be mailed to the applicant by OPAP in due course.

JANICE L TIPPETT
Office of Patent Application Processing (OPAP)
(571) 272-4200, or 1-888-786-0101

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
13/363,380	02/01/2012	Anthony A. McKINNEY	EBIO-0701CIP

CONFIRMATION NO. 1009

CONVERSION REQUEST

91584
Jeffrey J. King, Esq.
Patent Networks Law Group PLLC
5000 Carillon Point
Suite 400
Kirkland, WA 98033

OC000000053512421

Date Mailed: 04/04/2012

DECISION GRANTING REQUEST TO CONVERT TO PROVISIONAL

This is a decision on the request under 37 CFR 1.53(c)(2) received in the U.S. Patent and Trademark Office on **03/30/2012,** to convert the above-identified application to a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c).

The request is granted.

The application will be processed in the Office of Patent Application Processing (OPAP) as a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c), including the assignment of a new provisional application number.

The provisional application number is **61/632,822.** The filing receipt for the provisional application number will be mailed to the applicant by OPAP in due course.

JANICE L TIPPETT
Office of Patent Application Processing (OPAP)
(571) 272-4200, or 1-888-786-0101

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 NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
13/421,790	03/15/2012	Jay Yagnik	10029-03258

CONFIRMATION NO. 6650

94724
Patent Law Works LLP/Google - Social
165 South Main St
Suite 2
Salt Lake City, UT 84111

CONVERSION REQUEST

Date Mailed: 04/11/2012

DECISION GRANTING REQUEST TO CONVERT TO PROVISIONAL

This is a decision on the request under 37 CFR 1.53(c)(2) received in the U.S. Patent and Trademark Office on **03/19/2012,** to convert the above-identified application to a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c).

The request is granted.

The application will be processed in the Office of Patent Application Processing (OPAP) as a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c), including the assignment of a new provisional application number.

The provisional application number is **61/632,823.** The filing receipt for the provisional application number will be mailed to the applicant by OPAP in due course.

JANICE L TIPPETT
Office of Patent Application Processing (OPAP)
(571) 272-4200, or 1-888-786-0101

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	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
13/347,460	01/10/2012	Timur HICYILMAZ	0384.0005C

CONFIRMATION NO. 9941

27896
EDELL, SHAPIRO & FINNAN, LLC
1901 RESEARCH BOULEVARD
SUITE 400
ROCKVILLE, MD 20850

CONVERSION REQUEST

Date Mailed: 04/11/2012

DECISION GRANTING REQUEST TO CONVERT TO PROVISIONAL

This is a decision on the request under 37 CFR 1.53(c)(2) received in the U.S. Patent and Trademark Office on **02/03/2012,** to convert the above-identified application to a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c).

The request is granted.

The application will be processed in the Office of Patent Application Processing (OPAP) as a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c), including the assignment of a new provisional application number.

The provisional application number is **61/632,824.** The filing receipt for the provisional application number will be mailed to the applicant by OPAP in due course.

JANICE L TIPPETT
Office of Patent Application Processing (OPAP)
(571) 272-4200, or 1-888-786-0101

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
13/359,378	01/26/2012	Dingrong BAI	RECM-019/03US 314670-2039

CONFIRMATION NO. 1535

14327
Cooley LLP
777 6th Street, N.W.
ATTN: Patent Group
Washington, DC 20001

CONVERSION REQUEST

Date Mailed: 04/10/2012

DECISION GRANTING REQUEST TO CONVERT TO PROVISIONAL

This is a decision on the request under 37 CFR 1.53(c)(2) received in the U.S. Patent and Trademark Office on **04/06/2012,** to convert the above-identified application to a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c).

The request is granted.

The application will be processed in the Office of Patent Application Processing (OPAP) as a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c), including the assignment of a new provisional application number.

The provisional application number is **61/632,825.** The filing receipt for the provisional application number will be mailed to the applicant by OPAP in due course.

JANICE L TIPPETT
Office of Patent Application Processing (OPAP)
(571) 272-4200, or 1-888-786-0101

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 NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
13/410,215	03/01/2012	Yong Xu	670095.410C3

CONFIRMATION NO. 5603

500
SEED INTELLECTUAL PROPERTY LAW GROUP PLLC
701 FIFTH AVE
SUITE 5400
SEATTLE, WA 98104

CONVERSION REQUEST

OC000000053656651

Date Mailed: 04/11/2012

DECISION GRANTING REQUEST TO CONVERT TO PROVISIONAL

This is a decision on the request under 37 CFR 1.53(c)(2) received in the U.S. Patent and Trademark Office on **04/06/2012,** to convert the above-identified application to a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c).

The request is granted.

The application will be processed in the Office of Patent Application Processing (OPAP) as a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c), including the assignment of a new provisional application number.

The provisional application number is **61/632,826.** The filing receipt for the provisional application number will be mailed to the applicant by OPAP in due course.

JANICE L TIPPETT
Office of Patent Application Processing (OPAP)
(571) 272-4200, or 1-888-786-0101

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

SOLOMON S. FINEBLUM
APT 4
199 ROSEMARY ST
NEEDHAM MA 02494

MAILED
MAR 26 2012
OFFICE OF PETITIONS

In re Application of	:	
Solomon S. Fineblum	:	
Application No. 61/633,186	:	DECISION ON PETITION
Effectively Filed: February 7, 2012	:	TO MAKE SPECIAL UNDER
Attorney Docket No.	:	37 CFR 1.102(c)(1)
	:	

This is a decision on the petition under 37 CFR 1.102(c)(1), filed February 7, 2012, to make the above-identified application special based on applicant's age as set forth in M.P.E.P. § 708.02, Section IV.

The petition is **GRANTED**.

A grantable petition to make an application special under 37 CFR 1.102(c)(1) and MPEP § 708.02, Section IV: Applicant's Age must be accompanied by evidence showing that at least one of the applicants is 65 years of age, or more, such as a birth certificate or a statement by applicant. No fee is required

The instant petition includes a statement by inventor Solomon S. Fineblum attesting to his/her age. The above-identified application has been accorded "special" status.

Telephone inquiries concerning this decision should be directed to Kimberly Inabinet at 571-272-4618.

All other inquiries concerning either the examination or status of the application should be directed to the Technology Center.

Upon completion of the pre-examination processing by the Office of Patent Application Processing, this application will be referred to a Technology Center for action on the merits commensurate with this decision.

/Kimberly Inabinet/

Kimberly Inabinet
Petitions Examiner
Office of Petitions

Doc Code: PET.GREEN
Document Description: Petition for Green Tech Pilot

PTO/SB/420 (03-11)

PETITION TO MAKE SPECIAL UNDER THE GREEN TECHNOLOGY PILOT PROGRAM

Attorney Docket Number:	Application Number (if known):	Filing date: 2/17/2012

First Named Inventor: Dale R. Smith

Title: Electromechanical Roadway Energy Scavenging Device

APPLICANT HEREBY REQUESTS TO PARTICIPATE IN THE GREEN TECHNOLOGY PILOT PROGRAM FOR THE ABOVE-IDENTIFIED APPLICATION. See Instruction Sheet on page 2.

This petition must be timely filed electronically using the USPTO electronic filing system, EFS-Web.

1. By filing this petition:

   Applicant is requesting early publication: Applicant hereby requests early publication under 37 CFR 1.219 and the publication fee set forth in 37 CFR 1.18(d) accompanies this request.

2. By filing this petition: applicant is agreeing to make an election without traverse in a telephonic interview and elect an invention that meets the eligibility requirements for the Green Technology Pilot Program, if the Office determines that the claims are not obviously directed to a single invention. See Instruction Sheet.

3. This request is accompanied by statements of special status for the eligibility requirement.

4. The application contains no more than three (3) independent claims and twenty (20) total claims.

5. The application does not contain any multiple dependent claims.

6. Other attachments: SB16, Invention description

Signature	Date 2/17/2012
Name (Print/Typed) Dale Smith, Bradley Layton, Samuel Brown	Registration Number

Note: *Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required in accordance with 37 CFR 1.33 and 11.18. Please see 37 CFR 1.4(d) for the form of the signature. If necessary, submit multiple forms for more than one signature, see below*.*

☐ *Total of _____ forms are submitted.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Copied from 29413708 on 03/22/2012

Instruction Sheet for
Petition to Make Special Under the Green Technology Pilot Program

(Not to be Submitted to the USPTO)

The following is a summary of the requirements (for more information see the notices (i) "Pilot Program for Green Technologies Including Greenhouse Gas Reduction," (ii) "Elimination of Classification Requirement in the Green Technology Pilot Program," and (iii) "Expansion and Extension of the Green Technology Pilot Program," available on the USPTO web site at http://www.uspto.gov/patents/init_events/green_tech.jsp):

(1) The application must be a non-reissue, non-provisional utility application filed under 35 U.S.C. 111(a), or an international application that has entered the national stage in compliance with 35 U.S.C. 371, irrespective of the filing date of the application. Reexamination proceedings are excluded from this pilot program.

(2) The application must contain three or fewer independent claims and twenty or fewer total claims. The application must not contain any multiple dependent claims. For an application that contains more than three independent claims or twenty total claims, or multiple dependent claims, applicant must file a preliminary amendment in compliance with 37 CFR 1.121 to cancel the excess claims and/or the multiple dependent claims at the time the petition to make special is filed.

(3) The claims must be directed to a single invention that materially enhances the quality of the environment, or that materially contributes to: (1) the discovery or development of renewable energy resources; (2) the more efficient utilization and conservation of energy resources; or (3) green house gas emission reduction (see the eligibility requirements of sections II and III of the notice (i) cited above). The petition must include a statement that, if the USPTO determines that the claims are directed to multiple inventions (e.g., in a restriction requirement), applicant will agree to make an election without traverse in a telephonic interview, and elect an invention that meets the eligibility requirements in section II or III of the notice (i) cited above.

(4) The petition to make special must be timely filed electronically using the USPTO electronic filing system, EFS-Web, and selecting the document description of "Petition for Green Tech Pilot" on the EFS-Web screen. Applicant should use form PTO/SB/420, which is available as a Portable Document Format (PDF) fillable form in EFS-Web and on the USPTO Web site.

(5) The petition to make special must be filed at least one day prior to the date that a first Office action (which may be an Office action containing only a restriction requirement) appears in the Patent Application Information Retrieval (PAIR) system. Applicant may check the status of the application using PAIR.

(6) The petition to make special must be accompanied by a request for early publication in compliance with 37 CFR 1.219 and the publication fee set forth in 37 CFR 1.18(d).

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Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

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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.
29/413,708	02/17/2012	Dale R. Smith		6000

7590 03/05/2012

Human Powered Future, PLLC
8 Columbine Rd
Missoula, MT 59802

EXAMINER	
ART UNIT	PAPER NUMBER
2913	

MAIL DATE	DELIVERY MODE
03/05/2012	PAPER

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

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

Copied from 29413708 on 03/22/2012

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

3/5/12

Human Powered Future, PLLC
8 Columbine Rd
Missoula MT 59802

In re Application of :
Dale R. Smith et al. : DECISION ON PETITION
Application No. 29/413,708 : TO MAKE SPECIAL UNDER
Filed: February 17, 2012 : THE GREEN TECHNOLOGY
: PILOT PROGRAM

This is a decision on the petition under 37 CFR 1.102, filed February 17, 2012, to make the above-identified application special under the pilot program for applications pertaining to Green Technologies as set forth in 74 Federal Register Notice 64666 (December 8, 2009) and amended by 75 Federal Register Notice 28554 (May 21, 2010), 75 Federal Register Notice 69049 (November 10, 2010) and 76 Federal Register Notice 77979 (December 15, 2011).

The latest Notice extended the Green Technology Pilot Program to a total of 3,500 applications or March 30, 2012, whichever occurs earlier. As the program limit of 3500 granted petitions was reached for applications ready for decision on petition as of February 16, 2012, the program is now terminated. No further applications will be considered.

Additionally, it is noted that grantable petition to make an application special under 37 CFR 1.102 and the pilot program as set forth in 74 FR 64666 must be directed to a nonprovisional **utility** application filed under 35 USC 111(a) or be a national stage entry under 35 USC 371.

The present application is a design application. Accordingly, this application is not eligible in the Green Technology Pilot Program.

Accordingly , the petition is **DENIED**.

Additional information regarding the Green Technology Petition Pilot can be found at: http://www.uspto.gov/patents/init_events/green_tech.jsp.

/Blaine Copenheaver/

Blaine Copenheaver
Quality Assurance Specialist
Technology Center 1700

Copied from 29413708 on 03/22/2012

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APR 05 2012

OFFICE OF PETITIONS

BASF SE
CARL-BOSCH-STRASSE 38
LUDWIGSHAFEN D6705-6
GERMANY

In re Application of :
Weber :
Application No. 61/685,889 :
Filed: May 18, 2011 :
Attorney Docket No. :
PF0000072197 SE :

DECISION
ON PETITION

This is a decision on the petition pursuant to 37 C.F.R. § 1.182 filed on November 9, 2011, requesting that the above-identified application be processed as a provisional application.

The petition is **GRANTED**.

A review of the application papers present on filing reveals that Applicants paid the provisional application filing fee and submitted an Application Data Sheet which identifies this application as a provisional application, however this application was filed electronically as a design application.[1] Applicants state that they intended to file a provisional application, but inadvertently designated the submission as a design when filing the application electronically.

It is clear, based on the provisional application filing fee and the Application Data Sheet that Applicants intended to file a provisional application, but inadvertently filed a design application.

Accordingly, the Office has converted this application to a provisional application as requested using the application papers filed on May 18, 2011. See the filing receipt mailed April 2, 2012 which refers to this application as a provisional application.

[1] See Electronic Acknowledgement Receipt dated May 18, 2011, and petition, page 1.

The $400 petition fee will be charged to Deposit Account No. 03-2775 in due course, as authorized on the second page of this petition.

As the petition was necessitated by an error on the part of Applicants however, the petition fee will not be refunded.

Telephone inquiries **regarding this decision** should be directed to the undersigned at (571) 272-3225.[2]

Paul Shanoski
Senior Attorney
Office of Petitions

[2] Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for any further action(s) of Petitioner.

UNITED STATES PATENT AND TRADEMARK OFFICE

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Alexandria, VA 22313-1450
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February 21, 2012

Patent No. : 7,067,818 C2
Appl. No. : 90/000,535
Inventor(s) : Dale A. Harrison
Issued : November 22, 2011
Title : **VACUUM ULTRAVIOLET REFLECTOMETER AND METHOD**
Docket No. : **1003-1074.2**

Re: Request for Certificate of Correction

Consideration has been given your request for the issuance of a certificate of correction for the above-identified patent.

Assignees' names and addresses (assignment data) printed in a patent, are based *solely* on information supplied in the appropriate space for identifying the assignment data, i.e., item 3 of the Issue Fee Transmittal Form PTOL-85B. In this particular instance, the name of the current assignee for the utility patent 7,067,818 B2 "Silicon Valley Bank" was printed on the face of the Reexamination Certificate 7,067,818 C2 (90/000,535). According to USPTO records, there are no changes to the assignee that occurred since acknowledgement was made that "Silicon Valley Bank" is the assignee of the utility patent. Therefore, when the reexamination certificate was issued, the name of the current assignee for the utility patent was used for printing on the title page. The assignee name needs to be corrected in the utility patent initially and thereafter a certificate of correction would be warranted for the reexamination certificate(s). Granting of a request under 37 CFR 3.81(b) is required to correct applicant's error providing ***incorrect or erroneous*** assignment data, *before* issuance of a Certificate of Correction under 37 CFR 1.323 *(see Manual of Patent Examining Procedures (M.P.E.P) Chp.1400, sect. 1481).* This procedure is required *at any time after the issue fee is paid*, including after issuance of the patent. The assignee requesting to replace the current assignee is requri

In view of the foregoing, your request, in this mater, is hereby denied.

All petitions for correction of Assignees' names under rule 3.81(b) should:

(A) state that the assignment was submitted for recordation as set forth in 37 CFR 3.11 before issuance of the patent;

(B) include a request for a certificate of correction under 37 CFR 1.323 along with the fee set forth in 37 CFR 1.20(a); (unless fee (currently $100) was previously paid for consideration of request for certificate of correction)

(C) include the processing fee set forth in 37 CFR 1.17(i).

The petition under 37 CFR 3.81(b) should be directed to the following address or facsimile number:

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
(Hours of operation are 8:30 a.m. to midnight, Eastern Standard Time, Monday through Friday)

By fax: (571) 273-8300
ATTN: Office of Petitions

EFS-Web (Web-based Electronic Filing System) accessible through the Electronic Business Center (EBC);

Antonio Johnson
For Mary F. Diggs
Decisions & Certificates
of Correction Branch
(571)272-0483

D. Kligler I.P. Services LTD
P.O. Box 57651
Tel Aviv 61576 IL ISRAEL

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,592	12/16/2010	7,202,822	3008.002REX1	8986

26111 7590 12/12/2011

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 12/12/2011

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,414	08/04/2010	7,202,822	3008.002REX0	1120

26111 7590 12/12/2011

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 12/12/2011

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
MORRISON & FOERSTER LLP
12531 HIGH BLUFF DRIVE
SUITE 100
SAN DIEGO, CA 92130-2040

Date:

MAILED

DEC 12 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000592
PATENT NO. : 7202822
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
NOVAK DRUCE & QUIGG, LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET, FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date: MAILED

DEC 12 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001414
PATENT NO. : 7202822
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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DEC 12 2011

CENTRAL REEXAMINATION UNIT

Sterne, Kessler, Goldstein & Fox, P.L.L.C. (For Patent Owner)
1100 New York Avenue, N.W.
Washington, D.C. 20005

Morrison & Foerster, LLP (For *Inter Partes* '592 Requester)
12531 High Bluff Drive
Suite 100
San Diego, CA 92130-2040

Novak, Druce & Quigg, LLP (For *Inter Partes* '1414 Requester)
(NDQ Reexamination Group)
1000 Louisiana Street
Fifty-third Floor
Houston, TX 77002

Inter Partes Reexamination Proceeding
Control No. 95/000,592
Filed: December 16, 2010
For: U.S. Patent No.: 7,202,822

Inter Partes Reexamination Proceeding
Control No. 95/001,414
Filed: August 4, 2010
For: U.S. Patent No. 7,202,822

DECISION DISMISSING PETITION TO TERMINATE *INTER PARTES* REEXAMINATION PROCEEDING AND PETITION TO EXPUNGE INFORMATION

This is a decision on the following patent owner petitions:[1]

1. The September 30, 2011 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182" (the September 30, 2011 petition to terminate); and

2. The September 30, 2011 petition entitled "Petition under 37 C.F.R. §§ 1.59 & 1.182 to Expunge Information Submitted under MPEP § 724.02" (the September 30, 2011 petition to expunge).

Patent owner's petition to terminate filed on September 30, 2011, patent owner's petition to expunge filed on September 30, 2011, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

[1] In a companion decision, patent owner's September 16, 2011 petition entitled "Petition to Terminate Inter Partes Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182", requesting termination of *inter partes* reexamination proceeding 95/000,610, was granted. *Inter partes* reexamination proceeding 95/000,610 was severed from the merger of *inter partes* reexamination proceedings 95/000,610, 95/000,592 and 95/001,414, which resulted in the present merged proceeding of *inter partes* reexamination control numbers 95/000,592 and 95/001,414.

SUMMARY

Patent owner's petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding 95/000,592, filed on September 30, 2011, is **dismissed**.

Patent owner's petition under 37 CFR 1.59 and 1.182 to expunge information submitted under MPEP § 724.02, filed on September 30, 2011, is **dismissed**.

DECISION

The September 30, 2011 Petition to Terminate

The patent owner argues that termination of *inter partes* reexamination proceeding control number 95/000,592 (the '592 proceeding) is required by 35 U.S.C. 317(b), which provides, in pertinent part (emphasis added):

> Once a **final decision** has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit . . . then . . . an inter partes reexamination requested by that party or its privies on the basis of . . . issues [which that party or its privies raised or could have raised in such civil action] may not thereafter be maintained by the Office . . .

The Office analyzes whether a reexamination proceeding must be terminated pursuant to 35 U.S.C. 317(b) by determining:

1. Whether the third party requester was a party to the litigation;
2. Whether the decision is final, i.e., after all appeals;
3. Whether the court decided that the requester/party had not sustained its burden of proving the invalidity of any claim in suit of the patent, which claim is also under reexamination; and
4. Whether the issue(s) raised in the reexamination proceeding are the same issue(s) that were raised or could have been raised by the requester in the civil action.

The patent owner informs the Office that the patent under reexamination, U.S. Patent 7,202,822 (the '822 patent), was the subject of a civil action in district court, i.e., *Fractus, S.A. v. Samsung Electronics, Co., Ltd.et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.). The patent owner states that "[o]n September 22, 2011 the district court . . . entered a Final Consent Judgment against Kyocera [the requester of the '592 *inter partes* reexamination proceeding] finding that Kyocera had not sustained its burden to prove the invalidity of the '822 patent's claims 1, 4, 5, 7-9, 12, 13, 15, 18, 20-25, 29-31, 35 44, 46, 48, 52 and 53, all of which were in-suit [*sic*]". The patent owner refers to a "Final Consent Judgment, attached as Exhibit A".

As an initial matter, the Office has not received, to date, any paper entitled "Exhibit A" or any paper entitled "Final Consent Judgment" as an *attachment to the instant petition to terminate.* However, in its concurrently-filed petition entitled "Petition under 37 C.F.R. §§ 1.59 & 1.182 to Expunge Information Submitted under MPEP § 724.02" (the September 30, 2011 petition to expunge, discussed below), the patent owner informs the Office that "[t]he Final Consent

Judgment has been filed herewith UNDER SEAL" (emphasis in original).[2] The Office presumes that the consent judgment, which has apparently been separately filed with the Office under seal as referenced in patent owner's September 30, 2011 petition to expunge, is the same consent judgment referred to by the patent owner as "attached" to patent owner's September 30, 2011 petition to terminate.[3]

In the present petition to terminate, however, the consent judgment is the sole basis on which the patent owner relies to show that the provisions of 35 U.S.C. 317(b) have been met. For example, the patent owner states that the consent judgment "constitutes a final decision under 35 U.S.C. § 317(b), requiring that the Office terminate this reexamination as to [the above-listed claims] of the '822 patent". The patent owner further relies on the consent judgment throughout the present petition by either quoting or making reference to the consent judgment. See, for example, the sections entitled "Factual Background" and "Legal Argument".

For this reason, in order to rely on the consent judgment as the basis for the determination of whether the provisions of 35 U.S.C. 317(b), as outlined in the above-listed elements 1 – 4, have been met, the Office would be required to enter the consent judgment into the record prior to its consideration. The Office would then analyze the consent judgment, and refer to it in the decision as the basis for its determination. Any paper that has been entered into the record must be open to inspection by the general public. See 37 CFR 1.11(d), which provides, in pertinent part:

> All papers or copies thereof relating to a reexamination proceeding which have been entered of record in the patent or reexamination file are open to inspection by the general public . . .

However, in its concurrently-filed petition to expunge, which is discussed below, the patent owner expressly requests that the consent judgment be *expunged* from the record after the concurrently-filed petition to terminate has been decided.

The patent owner has thus requested conflicting forms of relief. The patent owner requests the Office to base its determination whether to terminate the '592 proceeding on a consent judgment by the district court, which must be entered into the record in order to be considered, and which must be held open to inspection by the general public. The patent owner also requests the Office to expunge from the official record the only information on which the determination can be based. For this reason, no determination on the presently filed petition to terminate the '592 proceeding can be made, unless the patent owner chooses to submit the consent judgment for entry into the official record, which will be held open to the public.

Furthermore, it is well settled that one of the paramount responsibilities of the Office is to preserve the integrity and completeness of the administrative record. The Office bears an obligation to "provide an administrative record showing the evidence on which the findings are

---

[2] The September 30, 2011 petition to expunge is accompanied by a paper entitled "Transmittal Letter to Accompany Information Submitted under MPEP § 724.02", and a cover sheet containing a list of items, including an item referred to as "Exhibit A: Final Consent Judgment Filed Under Seal Under MPEP § 724.02". The Office's image file wrapper system, IFW, also includes a record of an "artifact sheet" that indicates that an artifact of the type which includes material submitted under MPEP 724.02, was filed on September 30, 2011.

[3] If this is not the case, the patent owner is required to so inform the Office.

based." *In re Lee*, 277 F.3d 1338, 1342 (Fed. Cir. 2002). That administrative record must be maintained for a court's later review. See *U.S. v. Carlo Bianchi & Co.*, 373 U.S. 709, 714-15 (1963) (court review of administrative decisions is to be confined to "consideration of the decision of the agency . . . and of the evidence on which it was based"); *Camp v. Pitts*, 411 U.S. 138, 142 (1973) ("[T]he focal point for judicial review should be the administrative record already in existence, not some new record made initially in the reviewing court."). In addition, the Administrative Procedure Act (APA) governs judicial review of USPTO findings of fact. See 5 U.S.C. § 706; *Dickinson v. Zurko*, 57 U.S. 150, 152 (1999). Under the APA's standard of review, courts require substantial evidence based on the record as a whole. *In re Zurko*, 258 F.3d 1379, 1384 (Fed. Cir. 2001). The administrative record must be maintained for a court's later review even with respect to an issued patent. See, e.g., *Ray v. Lehman*, 55 F.3d 606, 608 (Fed. Cir. 1995) (holding USPTO's decision on a petition to reinstate an expired patent was reviewed on the record under APA).

In addition, as discussed in more detail below, the document(s) submitted under seal with the concurrently-filed petition to expunge, which apparently include(s) the consent judgment, will not be entered and considered in the absence of evidence that the Office will not be violating a protective order of the court by reviewing the document(s).

Accordingly, the September 30, 2011 petition to terminate is **dismissed**.

The September 30, 2011 Petition to Expunge

On September 30, 2011, the patent owner filed the present petition to expunge, with accompanying documents, including a paper entitled "Transmittal Letter to Accompany Information Submitted under MPEP § 724.02", and a cover sheet containing a list of items, including an item referred to as "Exhibit A: Final Consent Judgment Filed Under Seal Under MPEP § 724.02". The Office's image file wrapper system, IFW, also includes a record of an "artifact sheet" that indicates that an artifact of the type which includes material submitted under MPEP 724.02, was filed on September 30, 2011.

The patent owner states that on September 22, 2011, the district court, in the civil action *Fractus, S.A. v. Samsung Electronics, Co., Ltd.et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.), " . . . entered a Final Consent Judgment against Kyocera [the requester of the '592 *inter partes* reexamination proceeding]", and that the "Final Consent Judgment was filed with the district court . . . UNDER SEAL, and therefore has not been made public" (emphasis in original). The patent owner states that the consent judgment "is being filed in support of the concurrently filed [September 30, 2011 petition to terminate]". The patent owner requests, in its petition to expunge, that the consent judgment be expunged from the record and returned to the patent owner after the Office decides the concurrently-filed petition to terminate.

However, while the patent owner states that the consent judgment was filed (presumably by the patent owner) with the district court under seal, the patent owner has not provided any evidence showing whether the consent judgment is under a protective order by the court, and if so, whether Office personnel are permitted to review the protected information under the terms of the court's protective order. Nor has the patent owner provided evidence that Kyocera, the requester of the '592 proceeding, has consented to a waiver of any protective order by the court,

if appropriate. Before the consent judgment is reviewed by the Office, the patent owner must provide evidence that the Office will not be violating a protective order of the court by reviewing the document and making it available to the public, in the event that a decision is made to terminate based on the content of the consent judgment.

The parties have recourse through the courts to request the court's permission to submit the necessary materials in this merged proceeding. Therefore, there are adequate remedies to address this situation.

For these reasons, the document(s) submitted under seal with the present petition to expunge, which apparently include(s) the consent judgment, have not been reviewed, will not be entered into the record, and will not be considered.

Since the document(s) submitted under seal, which apparently include(s) the consent judgment, have not been entered into the record, there is no consent judgment to expunge from the record.

Accordingly, the September 30, 2011 petition to expunge information is **dismissed**.

The patent owner has **thirty (30) days from the mail date of this decision** to obtain the necessary evidence that the consent judgment, and any other documents submitted with the Office under seal with the consent judgment, may be submitted in this proceeding and become part of the public record.

The documents submitted with the present petition to expunge, including the document(s) submitted with the Office under seal and the document entitled "Transmittal Letter to Accompany Information Submitted Under MPEP § 724.02", will be retained pending a response to this decision, or the expiration of time for response to this decision, at which time the documents will be discarded unless the patent owner makes arrangements within the thirty-day period to retrieve them.

CONCLUSION

- Patent owner's September 30, 2011 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding control number 95/000,592 is **dismissed**.

- Patent owner's September 30, 2011 petition under 37 CFR 1.59 and 1.182 to expunge information submitted under MPEP 724.02 is **dismissed**.

- Any response to this decision must be filed **within thirty (30) days** of the mail date of this decision. If a timely response to this decision is not received within the thirty-day time period, the documents submitted with the September 30, 2011 petition to expunge, including the document(s) under seal and the document entitled "Transmittal Letter to Accompany Information Submitted Under MPEP § 724.02", will be discarded unless the patent owner makes arrangements within the thirty-day period to retrieve them.

- Any inquiry concerning this communication should be directed to Senior Legal Advisors Cynthia Nessler, at (571) 272-7724 or Pinchus Laufer, at (571) 272-7726.

Brian E. Hanlon

Brian E. Hanlon
Director
Office of Patent Legal Administration

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/001,339	09/28/1987		59780-2	9794

20995 7590 02/28/2011

KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 02/28/2011

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patents and Trademark Office
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
PILLSBURY WINTHROP SHAW PITTMAN, LLP
P O BOX 10500
MCLEAN, VA 22102

Date: MAILED

FEB 28 2011

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90001339
PATENT NO. : 7619912
ART UNIT : 3992

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

KNOBBE MARTENS OLSON & BEAR LLP (For Patent Owner)
2040 MAIN STREET
FOURTEENTH FLOOR
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MCLEAN, VA 22102

FISH & RICHARDSON P.C. (For second *Inter Partes* Requester)
PO BOX 1022
MINNEAPOLIS, MN 55440

ORRICK, HERRINGTON & SUTCLIFFE LLP (For third *Inter Partes* Requester)
IP PROSECUTION DEPARTMENT
4 PARK PLAZA, SUITE 1600
IRVINE, CA 92614

MAILED

FEB 23 2011

CENTRAL REEXAMINATION UNIT

Inter Partes Reexamination Proceeding :
Control No. 95/000,578 :
Filed: October 20, 2010 :
For: U.S. Patent No. 7,619,912 :
:
Inter Partes Reexamination Proceeding : **DECISION,**
Control No. 95/000,579 : ***SUA SPONTE,***
Filed: October 21, 2010 : **TO MERGE**
For: U.S. Patent No. 7,619,912 : **REEXAMINATION**
: **PROCEEDINGS**
Inter Partes Reexamination Proceeding :
Control No. 90/001,339 :
Filed: June 8, 2010 :
For: U.S. Patent No. 7,619,912 :

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 November 17, 2009, U.S. Patent No. 7,619,912 (the '912 patent) issued to Bhakta *et al.* with 51 claims.

2. On April 20, 2010, a first request for *inter partes* reexamination of claims 1-51 of the '912 patent, assigned control No. 95/001,339 ("the '1339 proceeding"), was filed by a third party requester. The real party in interest was not identified.

3. On April 27, 2010, the Office issued a notice of failure to comply with inter partes reexamination request filing requirements under 37 CFR 1.915(d).

4. On May 7, 2010, a corrected original request for *inter partes* reexamination was filed.

5. On June 4, 2010, the Office issued *sua sponte* a decision vacating the '1339 proceeding due to the third party requester's failure to identify the real party of interest for the request for reexamination.

6. On June 8, 2010, the third party requester responded to the June 4, 2010 Office decision and identified the real party in interest, Inphi, Corp. ("the '1339 requester"). The Office reinstated the '1339 proceeding, according it a filing date of June 8, 2010.

7. On September 1, 2010, *inter partes* reexamination was ordered on claims 1-51 of the '912 patent in the '1339 proceeding. An Action Closing Prosecution (ACP) Office action confirming all the claims was concurrently issued.

8. On October 20, 2010, a second request for *inter partes* reexamination of claims 1, 3-4, 6-11, 15, 18-22, 24-25, 27-29, 31-34, 36-39, 41-45 and 50 of the '912 patent, assigned control No. 95/000,578 ("the '578 proceeding"), was filed by a third party requester on behalf of real party in interest SMART Modular Technologies (WWH), Inc. ("the '578 requester").

9. On October 21, 2010, a third request for *inter partes* reexamination of claims 1, 3-4, 6-11, 15, 18-22, 24-25, 27-29, 31-34, 36-39, 41-45 and 50 of the '912 patent, assigned control No. 95/000,579 ("the '579 proceeding"), was filed by a third party requester on behalf of real party in interest Google, Inc. ("the '579 requester").

10. On January 14, 2011, *inter partes* reexamination was ordered on claims 1, 3-4, 6-11, 15, 18-22, 24-25, 27-29, 31-34, 36-39, 41-45 and 50 of the '912 patent in the '579 proceeding. An Office action was not concurrently issued in the proceeding. The order indicated that an Office action would issue in due course.

11. On January 18, 2011, *inter partes* reexamination was ordered on claims 1, 3-4, 6-11, 15, 18-22, 24-25, 27-29, 31-34, 36-39, 41-45 and 50 of the '912 patent in the '578 proceeding. An Office action was not concurrently issued in the proceeding. The order indicated that an Office action would issue in due course.

12. To date, no Office action has issued in the '578 or 579 *inter partes* proceedings, and no further Office action has issued in the '1339 *inter partes* proceeding.

DECISION

I. MERGER OF PROCEEDINGS

Reexamination is ordered in the three above-captioned proceedings for overlapping claims of the same patent. All three proceedings are *inter partes* reexamination proceedings. All proceedings are still pending, and have not been terminated. Therefore, consideration of merger is ripe at this point in time.

The 95/000,578, 95/000,579 and 95/001,339 *inter partes* proceedings are merged. The merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN ALL PROCEEDINGS

Patent owner is required to maintain the same claims (and specification) in all files throughout the merged proceeding. Currently the claims are identical for all three proceedings. Therefore a "housekeeping amendment" is NOT needed.

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

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

B. *Inter partes* Third Party Requester Participation:

1. Comment rights:

Upon merger of proceedings all *inter partes* requesters 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 the statutory time period of 30 days from date of service of patent owner's response.

No *inter partes* requester has a right to comment on any issue raised outside the confines of the

[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.

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.

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.

It is to be noted that, because neither the '578 and '579 *inter partes* third party requester propose any rejections of claims 2, 5, 12-14, 16-17, 23, 26, 30, 35, 40, 46-49 and 51 in their requests for reexamination, neither requester has any appeal rights as to those claims as they appear in the '912 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 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.

G. 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 Nos. 95/000,578 and 95/000,579 and 95/001,339 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above in Part III of this decision.

2. Any questions concerning this communication should be directed to Joseph F. Weiss, Jr., Legal Advisor, at 571-272-7759.

Pinchus M. Laufer
Senior Legal Advisor
Office of Patent Legal Administration

February 25, 2011

UNITED STATES PATENT AND TRADEMARK OFFICE

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John S. Pratt, Esq.
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(For Patent Owner)

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NOV 05 2010

CENTRAL REEXAMINATION UNIT

Holmes J. Hawkins, III
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1180 Peachtree Street
Atlanta, GA 30309

(For Third Party Requester)

In re Reissue Application of
George Madray, Jr.
Application No.: 09/610,064
Filed: July 5, 2000
For: U.S. Patent No. 5,076,791

In re George Madray, Jr.
Reexamination Proceeding
Control No.: 90/005,292
Filed: March 10, 1999
For: U.S. Patent No.: 5,076,791

: SUPPLEMENT TO
: PRIOR DECISION
: TO MERGE
: REISSUE AND
: REEXAMINATION
: PROCEEDINGS

This decision is supplemental to the Office's prior merger decision mailed April 11, 2006, which *sua sponte* merged reissue application No. 09/610,064 and reexamination control No. 90/005,292 into a single proceeding.

The above-identified prior merger decision continues to be in effect, and all further examination in the merged proceeding should continue to be conducted in accordance with the above-identified prior merger decision, except as it is supplemented by this decision – as follows:

If a request for continued examination (RCE) is filed under 37 CFR 1.114, as is permitted for the reissue application, then 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, a request for continued examination (RCE) is not available in the reexamination proceeding, and any response to the outstanding Office action (e.g.,

response to a final rejection) at that stage in the reexamination proceeding must be made taking into account the non-availability of RCE practice. Any failure to timely respond would result in the termination of the prosecution pursuant to 37 CFR 1.550(d).

In addition, if a final Office action should be issued subsequent to the mail date of this decision in this merged proceeding, any request for extension for time (to respond to any such subsequent final action) 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 Office action issued in the present merged proceeding subsequent to the mail date of this decision.

The merged proceeding will otherwise continue as per the above-identified prior merger decision.

CONCLUSION

1. Reissue application No. 09/610,064 and reexamination control No. 90/005,292 remain merged as a single proceeding.

2. 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, a request for continued examination (RCE) is not available in the reexamination proceeding, and any response to the outstanding Office action (e.g., response to a final rejection) at that stage in the reexamination proceeding must be made taking into account the non-availability of RCE practice. Any failure to timely respond would result in the termination of the prosecution pursuant to per 37 CFR 1.550(d).

3. In addition, if a final Office action should be issued in this merged proceeding subsequent to the mail date of this decision, then any request for extension for time (to respond to any such subsequent action) 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 Office action issued subsequent to the mail date of this decision.

4. All further examination in the merged proceeding is to continue to be conducted in accordance with the above-identified prior merger decision.

5. Telephone inquiries related to this decision should be directed to Colleen Dunn at (571) 272-1170, or in her absence to Eric Keasel at (571) 272-4929 or to Mark Reinhart at (571) 272-1611.

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

11/04/10

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MAY 12 2011

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SUITE 2800
ATLANTA GA 30309

HOLMES J. HAWKINS III (For Requester)
KING & SPAULDING
1180 PEACHTREE STREET
ATLANTA, GA 30309

In re reissue application of :
George Madray Jr. :
Application No. 09/610,064 :
Filed: July 5, 2000 :
For: U.S. Patent No. 5,076,791 : DECISION
: SEVERING
In re George Madray Jr. : MERGER
Reexamination Proceeding :
Control No. 90/005,292 :
Filed: March 10, 1999 :
For: U.S. Patent No. 5,076,791 :

The merged proceeding consisting of reissue application 09/610,064 and *ex parte* reexamination proceeding 90/005,292 is before the Office for issuance of a decision to *sua sponte* sever the merged proceeding, in order to permit separate prosecution and examination of the reissue application and the *ex parte* reexamination proceeding.

REVIEW OF SALIENT FACTS

1. U.S. Patent No. 5,076,791 (the '791 patent) issued December 31, 1991.

2. On March 10, 1999, a request for ex parte reexamination of the '791 patent was filed by a third party requester, and the resulting reexamination proceeding was assigned Control Number 90/005,292 (the '5292 reexamination proceeding).

3. On May 10, 1999, reexamination was ordered for the '5292 reexamination proceeding.

4. On July 5, 2000, the patent owner filed a reissue application based on the '791 patent, which was assigned Application Number 09/610,064 (the '064 reissue application).

5. In a merger decision mailed April 11, 2006, the Office merged the '064 reissue application and the '5292 reexamination proceeding into a single combined proceeding. The reissue application and the reexamination file were then remanded to the Director of Examining Group 3700 for examination in accordance with the merger decision.

6. The merged proceeding of the '064 reissue application and the '5292 reexamination proceeding progressed to the point where, on October 25, 2010, a non-final office action was mailed. The time for response expired on November 26, 2010 and no response has been received from the patent owner.

DECISION

At page 6 of the merger decision mailed April 11, 2006, it was stated:

"If the applicant/patent owner fails to file a timely and appropriate response to any Office action, the reissue application will be held abandoned, and the merger will be dissolved. With respect to the reexamination proceeding, the USPTO 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. For any further action in the reexamination proceeding, any grounds of rejection that are not applicable under reexamination would be withdrawn (e.g., based on public use or sale), and any new grounds of rejection which are applicable under 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 reexamination following the dissolution would be noted by the examiner as not being proper under reexamination pursuant to 37 CFR 1.552(c). "

In this instance, the patent owner failed to file a timely and appropriate response to the non-final Office action of October 25, 2010. Accordingly, the merged proceeding of the '064 reissue

application and the '5292 reexamination proceeding is hereby dissolved and severed into two separate proceedings.

The '0643 reissue application and the '5292 reexamination proceeding are forwarded to the examiner in Technology Center 3700, for action as follows:

The reissue application will be held abandoned.

The reexamination prosecution will be terminated, and a reexamination certificate under 37 CFR 1.570 will be issued in accordance with the last action of the Office, unless further action in the reexamination proceeding is needed as a result of the difference in the rules relating to reexamination and reissue proceedings.

If further action in the reexamination proceeding is needed, any grounds of rejection which are not applicable under reexamination will be withdrawn (e.g., based on public use or sale), and any new grounds of rejection which are applicable under reexamination (e.g., improperly broadened claims) will be applied by the examiner. The existence of any questions/issues remaining which cannot be considered under reexamination following the dissolution will be noted by the examiner as not being proper for consideration in reexamination pursuant to 37 CFR 1.552(c).

CONCLUSION

1. The merged proceeding consisting of '064 reissue application and the '5292 *ex parte* reexamination proceeding is hereby severed into (1) a separate proceeding, for the '064 reissue application, for reissue of the '791 patent, and (2) a separate proceeding, the '5292 *ex parte* reexamination, for reexamination of the '791 patent. The two proceedings will be addressed separately and concurrently.

2. Jurisdiction over the '064 reissue application proceeding and the '5292 reexamination proceeding is returned to the examiner in Technology Center 3700 for immediate action on the proceedings, toward resolution of the proceedings, and not inconsistent with this decision.

3. Telephone inquiries related to this decision should be directed to Linda Sholl at (571) 272-4391.

/Linda Sholl/
Linda Sholl
Quality Assurance Specialist
Technology Center 3700

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UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/005,592	12/21/1999			1057

7590 08/02/2010

BRUCE DICKENS
DICKENS-SOEDER 2000 LLC
3892 CEDRON STREET
IRVINE, CA 92606

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 08/02/2010

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

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AUG 02 2010

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

STANLEY B. GREEN
CONNOLLY BOVE LODGE AND HUTZ LLP
1990 M STREET N.W. SUITE 800
WASHINGTON, DC 20036

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/005,628, 90/005,592, 90/005,727, 90/006,541, 09/512,592

PATENT NO. 5806063.

ART UNIT 2161.

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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BRUCE DICKENS
DICKENS-SOEDER 2000, LLC
3892 CEDRON STREET
IRVINE, CA 92606

(For Patent Owner)

PAUL E. CRAWFORD
CONNOLLY BOVE LODGE & HUTZ, LLP
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(For Third Party Requester '5628)

ROSS F. HUNT, JR.
C/O LARSON AND TAYLOR
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ALEXANDRIA, VA 22312

(For Third Party Requester '5727)

STANLEY B. GREEN
CONNOLLY BOVE LODGE & HUTZ, LLP
1900 M STREET NW, SUITE 800
WASHINGTON, DC 20036

(For Third Party Requester '6541)

In re DICKENS
Reexamination Proceeding
Control No. 90/005,628
Request Deposited: February 6, 2000
For: U.S. Patent No. 5,806,063

In re DICKENS
Reexamination Proceeding
Control No. 90/005,727
Request Deposited: May 16, 2000
For: U.S. Patent No. 5,806,063

: DECISION
: DISSOLVING MERGED
: APPLICATION AND
: REEXAMINATION
: PROCEEDINGS

MAILED

AUG 02 2010

CENTRAL REEXAMINATION UNIT

In re DICKENS :
Reexamination Proceeding :
Control No. 90/006,541 :
Request Deposited: February 2, 2004 :
For: U.S. Patent No. 5,806,063 :

In re DICKENS :
Reexamination Proceeding :
Control No. 90/005,592 :
Request Deposited: December 21, 1999 :
For: U.S. Patent No. 5,806,063

In re Reissue Application of DICKENS :
Serial No. 09/512,592 :
Filed: February 23, 2000 :
For: U.S. Patent No. 5,806,063 :

In a decision mailed March 12, 2004, the instant reexamination proceedings and then copending reissue application No. 09/512,592 were *sua sponte* merged. Under section III, "Conduct of the Merged Reissue Application Examination and Reexamination Proceedings", paragraph No. 5, it was stated that if the application/patent owner fails to file a timely and appropriate response to any Office action, the merged proceeding will be terminated as follows: The reissue application will be held abandoned, and the merger will be dissolved as to the reissue application. With respect to the four reexamination proceedings that will remain merged as one proceeding, the Commissioner will proceed to issue a reexamination certificate under § 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.

On June 11, 2010 a Notice of Abandonment was mailed by the Office in reissue application No. 09/512,592 for failure to timely a appropriately respond to the BPAI decision of March 29, 2010. Accordingly, in view of the abandonment of the reissue application and guidelines set forth in section III of the decision merging the reissue application with the four reexamination proceedings, the merger is hereby deemed dissolved.

Upon mailing of this decision, the reexamination proceedings will be forwarded to an examiner in the Central Reexamination Unit for the issuance of an appropriate action.

Any inquiry concerning this decision should be directed to Jessica Harrison, Supervisory Primary Examiner at telephone No. (571) 272-4449.

/J Harrison/

Jessica J. Harrison
Supervisory Patent Examiner, AU 3992
Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/005,628	02/02/2000		7278*1	5028

7590 08/02/2010

BRUCE DICKENS
DICKENS-SOEDER 2000 LLC
3892 CEDRON STREET
IRVINE, CA 92606

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 08/02/2010

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

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AUG 02 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/005,727, 90/005,592, (90/005,628) 90/006,541, 09/512,592

PATENT NO. 5806063.

ART UNIT 2161.

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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EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/005,628, 90/005,592, 90/005,727, 90/006,541, 09/512,592

PATENT NO. 5806063.

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EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/005,727, 90/005,592, 90/005,628, 90/006,541, 09/512,592

PATENT NO. 5806063.

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

PAUL E. CRAWFORD
CONNOLY BOVE LODGE AND HUTZ LLP
1200 MARKET STREET
WILMINGTON, DE 19801

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/005,727, 90/005,592, 90/005,628, 90/006,541, 09/512,592

PATENT NO. 5806063.

ART UNIT 2161.

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

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

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CENTRAL REEXAMINATION UNI

BRUCE DICKENS
DICKENS-SOEDER 2000, LLC
3892 CEDRON STREET
IRVINE, CA 92606

(For Patent Owner)

PAUL E. CRAWFORD
CONNOLLY BOVE LODGE & HUTZ, LLP
1200 MARKET STREET
WILMINGTON, DE 19801

(For Third Party Requester '5628)

ROSS F. HUNT, JR.
C/O LARSON AND TAYLOR
1199 NORTH FAIRFAS STREET, SUTIE 900
ALEXANDRIA, VA 22312

(For Third Party Requester '5727)

STANLEY B. GREEN
CONNOLLY BOVE LODGE & HUTZ, LLP
1900 M STREET NW, SUITE 800
WASHINGTON, DC 20036

(For Third Party Requester '6541)

In re DICKENS
Reexamination Proceeding
Control No. 90/005,628
Request Deposited: February 6, 2000
For: U.S. Patent No. 5,806,063

In re DICKENS
Reexamination Proceeding
Control No. 90/005,727
Request Deposited: May 16, 2000
For: U.S. Patent No. 5,806,063

: DECISION
: DISSOLVING MERGED
: APPLICATION AND
: REEXAMINATION
: PROCEEDINGS

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AUG 02 2010

CENTRAL REEXAMINATION UNIT

In re DICKENS
Reexamination Proceeding
Control No. 90/006,541
Request Deposited: February 2, 2004
For: U.S. Patent No. 5,806,063

In re DICKENS
Reexamination Proceeding
Control No. 90/005,592
Request Deposited: December 21, 1999
For: U.S. Patent No. 5,806,063

In re Reissue Application of DICKENS
Serial No. 09/512,592
Filed: February 23, 2000
For: U.S. Patent No. 5,806,063

In a decision mailed March 12, 2004, the instant reexamination proceedings and then copending reissue application No. 09/512,592 were *sua sponte* merged. Under section III, "Conduct of the Merged Reissue Application Examination and Reexamination Proceedings", paragraph No. 5, it was stated that if the application/patent owner fails to file a timely and appropriate response to any Office action, the merged proceeding will be terminated as follows: The reissue application will be held abandoned, and the merger will be dissolved as to the reissue application. With respect to the four reexamination proceedings that will remain merged as one proceeding, the Commissioner will proceed to issue a reexamination certificate under § 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.

On June 11, 2010 a Notice of Abandonment was mailed by the Office in reissue application No. 09/512,592 for failure to timely a appropriately respond to the BPAI decision of March 29, 2010. Accordingly, in view of the abandonment of the reissue application and guidelines set forth in section III of the decision merging the reissue application with the four reexamination proceedings, the merger is hereby deemed dissolved.

Upon mailing of this decision, the reexamination proceedings will be forwarded to an examiner in the Central Reexamination Unit for the issuance of an appropriate action.

Any inquiry concerning this decision should be directed to Jessica Harrison, Supervisory Primary Examiner at telephone No. (571) 272-4449.

/J Harrison/

Jessica J. Harrison
Supervisory Patent Examiner, AU 3992
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/005,727	05/16/2000	5806063	G00000307	7094

7590 08/02/2010

EXAMINER	
ART UNIT	PAPER NUMBER

BRUCE DICKENS
DICKENS-SOEDER 2000 LLC
3892 CEDRON STREET
IRVINE, CA 92606

DATE MAILED: 08/02/2010

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

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AUG 02 2010

CENTRAL REEXAMINATION UNIT

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ROSS F. HUNT JR.
LARSON & TAYLOR
1199 NORTH FAIRFAX ST., SUITE 900
ALEXANDRIA, VA 22314

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/005,727, 90/005,592, 90/005,628, 90/006,541, 09/512,592

PATENT NO. 5806063.

ART UNIT 2161.

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

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

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AUG 02 2010

CENTRAL REEXAMINATION UNI

BRUCE DICKENS
DICKENS-SOEDER 2000, LLC
3892 CEDRON STREET
IRVINE, CA 92606

(For Patent Owner)

PAUL E. CRAWFORD
CONNOLLY BOVE LODGE & HUTZ, LLP
1200 MARKET STREET
WILMINGTON, DE 19801

(For Third Party Requester '5628)

ROSS F. HUNT, JR.
C/O LARSON AND TAYLOR
1199 NORTH FAIRFAS STREET, SUTIE 900
ALEXANDRIA, VA 22312

(For Third Party Requester '5727)

STANLEY B. GREEN
CONNOLLY BOVE LODGE & HUTZ, LLP
1900 M STREET NW, SUITE 800
WASHINGTON, DC 20036

(For Third Party Requester '6541)

In re DICKENS
Reexamination Proceeding
Control No. 90/005,628
Request Deposited: February 6, 2000
For: U.S. Patent No. 5,806,063

In re DICKENS
Reexamination Proceeding
Control No. 90/005,727
Request Deposited: May 16, 2000
For: U.S. Patent No. 5,806,063

: DECISION
: DISSOLVING MERGED
: APPLICATION AND
: REEXAMINATION
: PROCEEDINGS

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CENTRAL REEXAMINATION UNIT

In re DICKENS
Reexamination Proceeding
Control No. 90/006,541
Request Deposited: February 2, 2004
For: U.S. Patent No. 5,806,063

In re DICKENS
Reexamination Proceeding
Control No. 90/005,592
Request Deposited: December 21, 1999
For: U.S. Patent No. 5,806,063

In re Reissue Application of DICKENS
Serial No. 09/512,592
Filed: February 23, 2000
For: U.S. Patent No. 5,806,063

In a decision mailed March 12, 2004, the instant reexamination proceedings and then copending reissue application No. 09/512,592 were *sua sponte* merged. Under section III, "Conduct of the Merged Reissue Application Examination and Reexamination Proceedings", paragraph No. 5, it was stated that if the application/patent owner fails to file a timely and appropriate response to any Office action, the merged proceeding will be terminated as follows: The reissue application will be held abandoned, and the merger will be dissolved as to the reissue application. With respect to the four reexamination proceedings that will remain merged as one proceeding, the Commissioner will proceed to issue a reexamination certificate under § 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.

On June 11, 2010 a Notice of Abandonment was mailed by the Office in reissue application No. 09/512,592 for failure to timely a appropriately respond to the BPAI decision of March 29, 2010. Accordingly, in view of the abandonment of the reissue application and guidelines set forth in section III of the decision merging the reissue application with the four reexamination proceedings, the merger is hereby deemed dissolved.

Upon mailing of this decision, the reexamination proceedings will be forwarded to an examiner in the Central Reexamination Unit for the issuance of an appropriate action.

Any inquiry concerning this decision should be directed to Jessica Harrison, Supervisory Primary Examiner at telephone No. (571) 272-4449.

/J Harrison/

Jessica J. Harrison
Supervisory Patent Examiner, AU 3992
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE
COMMISSIONER OF PATENTS AND TRADEMARKS
P.O. Box 1450
Alexandria, VA 22313-1450

February 27, 2012

Patent No.: 6,027,774 C1
Applicant : Neil Fine, et al.
Issued : June 13, 2006
For : **PHOTO DISPLAY GLOBE WITH LIQUID FILLED SHELL**
Docket No. : **011365**

Re: Request for Certificate of Correction

Consideration has been given your request for the issuance of a certificate of correction for the above-identified patent under the provisions of Rule 1.322/1.323.

Respecting the alleged errors in claims 1, 21, and 40 in the printed patent. The word "removable" was not present in the claims during exaimination or appeal and adding the word would change the scope of the claims. Therefore, the applicant's request to insert "removable" in the above mentioned claims is disapproved.

In the foregoing, your request is hereby denied.

Further correspondence concerning this matter should be filed and directed to Decisions and Certificates of Correction Branch.

Antonio Johnson
(571)272-0483
For Mary F. Diggs, Supervisor
Decisions & Certificates of Correction Branch
(703) 756-1580

Max Shaftal
Patzik, Frank & Samotny Ltd.
150 South Wacker Drive
Suite 900
Chicago IL 60606

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : October 25, 2011

TO SPE OF : ART UNIT 1798 SPE.

SUBJECT : Request for Certificate of Correction for Appl. No.: 90/006,099 Patent No.: 6,027,774 C1

Please respond to this request for a certificate of correction within 7 days.

FOR IFW FILES:

Please review the requested changes/corrections as shown in the **COCIN** document(s) in the IFW application image. No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Please complete the response (see below) and forward the completed response to scanning using document code **COCX**.

FOR PAPER FILES:

Please review the requested changes/corrections as shown in the attached certificate of correction. Please complete this form (see below) and forward it with the file to:

Certificates of Correction Branch (CofC)
Randolph Square Building
2800 South Randolph Street
Arlington, VA 22206

Should the word "removable" between "a" and "plug" in claims 1, 21, and 40 as requested by applicant? See COCIN dated 10-6-2011

Antonio Johnson

Certificates of Correction Branch

(571)272-0483 Fax – (571)270-9846

Thank You For Your Assistance

The request for issuing the above-identified correction(s) is hereby:
Note your decision on the appropriate box.

- ☐ **Approved** — **All** changes apply.
- ☐ **Approved in Part** — Specify below which changes **do not** apply.
- **xDenied** — State the reasons for denial below.

Comments: The word removable was not present in the claims during examination or appeal and adding the word would change the scope of the claims

_____ SPE /Angela Ortiz/ Art Unit 1798

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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.
90/006,209	01/29/2002	5650054	101204-00004	4200

28316 7590 11/05/2010

BANNER & WITCOFF LTD.,
ATTORNEYS FOR CLIENT NO. 004954
28 STATE STREET
SUITE 1800
BOSTON, MA 02109-1701

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 11/05/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/621,637	07/17/2003	Yonsheng Shen	011361.00065	2587

22910 7590 11/05/2010

BANNER & WITCOFF, LTD.
28 STATE STREET
SUITE 1800
BOSTON, MA 02109-1701

EXAMINER	
OLSEN, KAJ K	

ART UNIT	PAPER NUMBER
1724	

MAIL DATE	DELIVERY MODE
11/05/2010	PAPER

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

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

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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Peter D. McDermott
Banner & Witcoff, LTD
28 State Street
Suite 1800
Boston, MA 02109-1775

(For Patent Owner)

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NOV 05 2010

CENTRAL REEXAMINATION UNIT

Robert B. Murray
Rothwell, Figg, Ernst & Manbeck PC
1425 K Street, NW, Suite 800
Washington D.C. 20005

(For Third Party Requester)

In re Reissue Application of
Yonsheng Chen, *et al.*
Application No.: 10/621,637
Filed: July 17, 2003
For: U.S. Patent No.5,650,054

In re Yonsheng Chen *et al.*
Reexamination Proceeding
Control No.: 90/006,209
Filed: January 29, 2002
For: U.S. Patent No.: 5,650,054

: SUPPLEMENT TO
: PRIOR DECISION
: TO MERGE
: REISSUE AND
: REEXAMINATION
: PROCEEDINGS

This decision is supplemental to the Office's prior merger decision mailed March 14, 2008, which *sua sponte* merged reissue application No. 10/621,637 and reexamination control No. 90/006,209 into a single proceeding.

The above-identified prior merger decision continues to be in effect, and all further examination in the merged proceeding should continue to be conducted in accordance with the above-identified prior merger decision, except as it is supplemented by this decision – as follows:

If a request for continued examination (RCE) is filed under 37 CFR 1.114, as is permitted for the reissue application, then 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, a request for continued examination (RCE) is not available in the reexamination proceeding, and any response to the outstanding Office action (e.g.,

response to a final rejection) at that stage in the reexamination proceeding must be made taking into account the non-availability of RCE practice. Any failure to timely respond would result in the termination of the prosecution pursuant to 37 CFR 1.550(d).

In addition, if a final Office action should be issued subsequent to the mail date of this decision in this merged proceeding, any request for extension for time (to respond to any such subsequent final action) 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 Office action issued in the present merged proceeding subsequent to the mail date of this decision.

The merged proceeding will otherwise continue as per the above-identified prior merger decision.

CONCLUSION

1. Reissue application No. 10/621,637 and reexamination control No. 90/006,209 remain merged as a single proceeding.

2. 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, a request for continued examination (RCE) is not available in the reexamination proceeding, and any response to the outstanding Office action (e.g., response to a final rejection) at that stage in the reexamination proceeding must be made taking into account the non-availability of RCE practice. Any failure to timely respond would result in the termination of the prosecution pursuant to per 37 CFR 1.550(d).

3. In addition, if a final Office action should be issued in this merged proceeding subsequent to the mail date of this decision, then any request for extension for time (to respond to any such subsequent action) 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 Office action issued subsequent to the mail date of this decision.

4. All further examination in the merged proceeding is to continue to be conducted in accordance with the above-identified prior merger decision.

5. Telephone inquiries related to this decision should be directed to Colleen Dunn at (571) 272-1170, or in her absence to Eric Keasel at (571) 272-4929 or to Mark Reinhart at (571) 272-1611.

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

11/04/10

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NOV 05 2010

CENTRAL REEXAMINATION UNIT

Pillsbury Winthrop Shaw Pittman, LLP (For Patent Owner)
P.O. Box 10500
McLean, VA 22102

In re Reissue Application of
Paul Artemi
Application No.: 11/397,053
Filed: April 4, 2006
For: U.S. Patent No. 5,584,455

In re Paul Artemi
Reexamination Proceeding
Control No.: 90/006,286
Filed: May 10, 2002
For: U.S. Patent No.: 5,584,455

: SUPPLEMENT TO
: PRIOR DECISION
: TO MERGE
: REISSUE AND
: REEXAMINATION
: PROCEEDINGS

This decision is supplemental to the Office's prior merger decision mailed February 17, 2009, which *sua sponte* merged reissue application No. 11/397,053 and reexamination control No. 90/006,286 into a single proceeding.

The above-identified prior merger decision continues to be in effect, and all further examination in the merged proceeding should continue to be conducted in accordance with the above-identified prior merger decision, except as it is supplemented by this decision – as follows:

If a request for continued examination (RCE) is filed under 37 CFR 1.114, as is permitted for the reissue application, then 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, a request for continued examination (RCE) is not available in the reexamination proceeding, and any response to the outstanding Office action (e.g., response to a final rejection) at that stage in the reexamination proceeding must be made taking into account the non-availability of RCE practice. Any failure to timely respond would result in the termination of the prosecution pursuant to 37 CFR 1.550(d).

In addition, if a final Office action should be issued subsequent to the mail date of this decision in this merged proceeding, any request for extension for time (to respond to any such subsequent final action) 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 Office action issued in the present merged proceeding subsequent to the mail date of this decision.

The merged proceeding will otherwise continue as per the above-identified prior merger decision.

CONCLUSION

1. Reissue application No. 11/397,053 and reexamination control No. 90/006,286 remain merged as a single proceeding.

2. 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, a request for continued examination (RCE) is not available in the reexamination proceeding, and any response to the outstanding Office action (e.g., response to a final rejection) at that stage in the reexamination proceeding must be made taking into account the non-availability of RCE practice. Any failure to timely respond would result in the termination of the prosecution pursuant to per 37 CFR 1.550(d).

3. In addition, if a final Office action should be issued in this merged proceeding subsequent to the mail date of this decision, then any request for extension for time (to respond to any such subsequent action) 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 Office action issued subsequent to the mail date of this decision.

4. All further examination in the merged proceeding is to continue to be conducted in accordance with the above-identified prior merger decision.

5. Telephone inquiries related to this decision should be directed Colleen Dunn at (571) 272-1170, or in her absence to Eric Keasel at (571) 272-4929 or to Mark Reinhart at (571) 272-1611.

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

11/04/10

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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,317	07/03/2002	6319526	01473.302800	9581

25763 7590 12/22/2010

DORSEY & WHITNEY LLP
INTELLECTUAL PROPERTY DEPARTMENT
SUITE 1500
50 SOUTH SIXTH STREET
MINNEAPOLIS, MN 55402-1498

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 12/22/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Eugene J. Bernard
Townsend and Townsend and Crew LLP
Two Embarcadero Center, 8th Floor
San Francisco, CA 94111

Date:

MAILED

DEC 22 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90006317
PATENT NO. : 6319526
ART UNIT : 3900

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
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www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,003	01/08/2002	6319526	01473.302300	4575

25763 7590 12/22/2010

DORSEY & WHITNEY LLP
INTELLECTUAL PROPERTY DEPARTMENT
SUITE 1500
50 SOUTH SIXTH STREET
MINNEAPOLIS, MN 55402-1498

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 12/22/2010

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www.uspto.gov

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
EUGENE J. BERNARD
TOWNSEND AND TOWNSEND AND CREW LLP
TWO EMBARCADERO CENTER, 8TH FLOOR
SAN FRANCISCO, CA 94111

Date:

MAILED

DEC 22 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000003
PATENT NO. : 6319526
TECHNOLOGY CENTER : 3999
ART UNIT : 3991

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

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

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

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

United States Patent and Trademark Office

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United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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DEC 22 2010

CENTRAL REEXAMINATION UNIT

DORSEY & WHITNEY LLP
INTELLECTUAL PROPERTY DEPARTMENT
SUITE 1500
50 SOUTH SIXTH STREET
MINNEAPOLIS MN 55402-1498

(For Patent Owner)

Eugene J. Bernard, Ph.D., Esq.
TOWNSEND & TOWNSEND & CREW LLP
TWO EMBARCADERO CENTER, 8TH FLR
SAN FRANCISCO, CA 94111

(For Third Party Requester)

In re Dahlstrom et al.
Inter Partes Reexamination Proceeding
Control No. 95/000,003
Filed: January 8, 2002
For: U.S. Patent No. 6,319,526 B1

DECISION
DISMISSING PETITION
UNDER § 1.182

In re Dahlstrom et al.
Ex Parte Reexamination Proceeding
Control No. 90/006,317
Filed: July 3, 2002
For: U.S. Patent No. 6,319,526 B1

This is a decision on the November 5, 2010 patent owner petition entitled "PETITION UNDER 37 CFR § 1.182 REQUEST FOR CONTINUED EXAMINATION."

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

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

PERTINENT BACKGROUND

- On November 20, 2001, U.S. Patent No. 6,319,526 ("the '526 patent) was issued to Dahlstrom *et al.*, having 113 claims.

- On January 8, 2002, a request for *inter partes* reexamination was filed by the third party requester, the real party in interest being Leprino Foods Company, and the resulting reexamination proceeding was assigned control number 95/000,003 ("the '003 proceeding").

- On April 4, 2002, reexamination was ordered for claims 1-14, 16-33, 35-59, 61-69, 89-11, and 113 of the '526 patent. On the same date, an Office action was mailed, rejecting claims 1-14, 16-33, 35-39, 61-69, 89-111, and 113. In this Office action, U.S. Patent 6,120,809 to Rhodes ("Rhodes '809") was used in anticipation rejections of claims 1-4, 7-14, 16-22, 25-29, 31, 32, 35, 36, 38, 40-48, 51, 62-69, 89-92, and 95-101; the Rhodes '809 patent was also used in obviousness rejections of claims 5, 6, 10, 12-4, 23-25, 30, 33, 37, 39, 45-47, 49, 50, 52-59, 61, 65, 68, 89, 93, 94, 102-111, and 113.

- On June 3, 2002, patent owner filed a response to the April 4, 2002 Office action, including amendments to claims 26, 36, 52, and 89, cancellation of claim 15, and addition of claims 114-163. The response included a discussion of the disclosure of the Rhodes '809 patent. Third party requester comments were filed on July 3, 2002.

- On July 3, 2002, the same third party requester[1] filed a request for *ex parte* reexamination of claims 1-113 of the '526 patent, and the resulting reexamination proceeding was assigned control number 90/006,317. Reexamination was ordered on August 20, 2002 for claims 1-14, 16-69, and 89-113 of the '526 patent.

- On January 30, 2003, the Office merged the '003 and '6317 reexamination proceedings.

- Prosecution progressed until, on April 29, 2010, a Right of Appeal Notice was issued by the Office.[2] Claims 1-14, 16-103, 114-123, and 125-136 were listed as being under reexamination in the proceeding. All of the claims under reexamination in the proceeding were also listed as being rejected.

- On May 24, 2010, patent owner filed petitions under § 1.181 and § 1.183 for the purpose of requesting entry of declarations, including those submitted on January 29, 2010, and

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[1] *Ex parte* reexamination was requested "by Leprino Foods Company, through its attorneys," as stated in the June 3, 2002 request.

[2] The lengthy prosecution of the merged reexamination proceeding from January 2003 through April 2010 included, *inter alia*, issuance of a NIRC and its subsequent withdrawal in 2006, revival of the proceeding in September 2008 subsequent to a late-filed patent owner appellant's brief, appeal and full briefing by the parties in 2008-2009, and reopening of prosecution in 2009. The full details are not included here, but may be found in the instant petition at pages 3-7, as well in the Office decision dismissing patent owner's petition under § 1.181, mailed on the same date herewith.

refused entry in the Right of Appeal Notice of April 29, 2010. Patent owner's May 24, 2010 petition under § 1.183 was dismissed in an Office action mailed on June 2, 2010.

- On May 28, 2010, patent owner filed a Notice of Appeal.
- On June 4, 2010, third party requester filed a petition under § 1.182 requesting that the appeal proceed directly to the Board of Patent Appeals and Interferences.
- On July 28, 2010, patent owner filed an appellant's brief.
- On October 5, 2010, the Office issued an Examiner's Answer.
- On November 5, 2010, patent owner filed the following papers:
    - A rebuttal brief in response to the October 5, 2010 Examiner's Answer.
    - The instant petition entitled "PETITION UNDER 37 CFR § 1.182 FOR REQUEST FOR CONTINUED REEXAMINATION."
    - A petition entitled "PETITION UNDER 37 C.F.R. § 1.183 FOR REQUEST TO DELAY APPEAL PROCEEDINGS BEFORE THE BOARD UNTIL PATENT OWNER'S 37 CFR § 1.182 PETITION HAS BEEN ACTED UPON."

PERTINENT STATUTES AND REGULATIONS

35 U.S.C. § 314 provides, in pertinent part:

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

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

37 C.F.R. § 1.182 provides:

> All **situations not specifically provided** for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Director, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f). (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."[3] 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 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, where relief is requested under § 1.182, any continuation of prosecution in a reexamination proceeding must be in accord with the statutory mandate of 35 U.S.C. § 314(c), stating that "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." Therefore, any Office decision granting continuation of prosecution in a

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[3] 1292 *Off. Gaz. Pat. Office* 20, March 1, 2005.

reexamination proceeding must further its handling of the proceeding with special dispatch.

In this instance, patent owner petitions for reopening of prosecution after full briefing at the appeal stage to enter four newly presented declarations under 37 C.F.R. § 1.131 as well as "narrowing amendments to further clarify the invention."[4] Patent owner seeks relief under the provisions of March 2005 Notice discussed above. Patent owner's plea for relief is grounded in the position that entry of the declarations would remove the Rhodes '809 patent from prior art status, thereby overcoming the rejections based upon that patent, and furthermore, that the claim amendments proposed with the petition would overcome the rejections of record.

To be consistent with the requirement of special dispatch, the showing of a *bona fide* effort made during the proceeding must explain why the need for the patent owner's proposed response could not have been anticipated earlier, and only became apparent as a result of a new issue arising at, or subsequent to, the close of prosecution in the proceeding. In this case, the record is to the contrary. It is apparent from the prosecution history that the issue for which the amendment and evidence submissions are stated to address arose in the initial Office action of April 4, 2002. In this first Office action on the merits of the proceeding, the examiner presented a rejection based on the disclosure of the Rhodes '809 patent. Patent owner petitioner responded to the rejections based upon Rhodes in patent owner's response to the first Office action on the merits, including claim amendments, but no submissions of evidence. Thus, patent owner had the opportunity to address this issue prior to the closing of prosecution. In view of the abovementioned facts, and of advanced stage of the proceeding, reopening prosecution for entry of § 1.131 affidavits, claim amendments, and new claims would cause the Office to sanction entry of amendments and evidence which patent owner had earlier opportunities to properly submit in the proceeding. Therefore, as such reopening would not be consistent with the Office's requirement to handle reexamination proceedings with special dispatch, the instant petition will not be granted.

Furthermore, to the extent that patent owner petitioner is contending that any action by the examiner in the proceeding has been improper, the proper avenue for seeking relief from improper closure of prosecution in an *inter partes* reexamination is through supervisory review under § 1.181. Patent owner is concurrently seeking identical relief (e.g., to remove the Rhodes '809 patent as prior art through § 1.131 declarations) via such a petition under § 1.181, filed on May 24, 2010. As the relief for which patent owner seeks has been provided for elsewhere in the regulations, relief under § 1.182 would be inappropriate under the facts and circumstances of this proceeding.[5]

Therefore, the instant patent owner petition is **dismissed**.

CONCLUSION

1. The patent owner petition is **dismissed.**

[4] Petition at 1.

[5] Note that a situation which is covered by § 1.181 does not become "not provided for" merely because the § 1.181 petition is dismissed or denied by the Office.

2. A copy of this decision will be made of record in the reexamination file.

3. Telephone inquiries related to this decision should be directed to the undersigned, at (571) 272-7700.

/Michael Cygan/

Michael Cygan
Legal Advisor
Office of Patent Legal Administration

November 22, 2010

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.
90/006,317	07/03/2002	6319526	01473.302800	9581

25763 7590 12/22/2010

DORSEY & WHITNEY LLP
INTELLECTUAL PROPERTY DEPARTMENT
SUITE 1500
50 SOUTH SIXTH STREET
MINNEAPOLIS, MN 55402-1498

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 12/22/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Eugene J. Bernard
Townsend and Townsend and Crew LLP
Two Embarcadero Center, 8th Floor
San Francisco, CA 94111

Date:

MAILED

DEC 22 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90006317
PATENT NO. : 6319526
ART UNIT : 3900

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

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,003	01/08/2002	6319526	01473.302300	4575

25763 7590 12/22/2010

DORSEY & WHITNEY LLP
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
EUGENE J. BERNARD
TOWNSEND AND TOWNSEND AND CREW LLP
TWO EMBARCADERO CENTER, 8TH FLOOR
SAN FRANCISCO, CA 94111

Date:

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CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000003
PATENT NO. : 6319526
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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DORSEY & WHITNEY LLP
INTELLECTUAL PROPERTY DEPARTMENT
SUITE 1500
50 SOUTH SIXTH STREET
MINNEAPOLIS MN 55402-1498

(For Patent Owner) CENTRAL REEXAMINATION UNIT

Eugene J. Bernard, Ph.D., Esq.
TOWNSEND & TOWNSEND & CREW LLP
TWO EMBARCADERO CENTER, 8TH FLR
SAN FRANCISCO, CA 94111

(For Third Party Requester)

In re Dahlstrom et al.
Inter Partes Reexamination Proceeding
Control No. 95/000,003
Filed: January 8, 2002
For: U.S. Patent No. 6,319,526 B1

In re Dahlstrom et al.
Ex Parte Reexamination Proceeding
Control No. 90/006,317
Filed: July 3, 2002
For: U.S. Patent No. 6,319,526 B1

DECISION DISMISSING PETITION UNDER § 1.183

This is a decision on the November 5, 2010 patent owner petition entitled "PETITION UNDER 37 C.F.R. § 1.183 FOR REQUEST TO DELAY APPEAL PROCEEDINGS BEFORE THE BOARD UNTIL PATENT OWNER'S 37 CFR § 1.182 PETITION HAS BEEN ACTED UPON."

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

The petition under 37 C.F.R. § 1.183 is **dismissed.**

PERTINENT BACKGROUND

- On November 20, 2001, U.S. Patent No. 6,319,526 ("the '526 patent) was issued to Dahlstrom *et al.*, having 113 claims.

- On January 8, 2002, a request for *inter partes* reexamination was filed by the third party requester, and the resulting reexamination proceeding was assigned control number 95/000,003 ("the '003 proceeding").

- On April 4, 2002, reexamination was ordered for claims 1-14, 16-33, 35-59, 61-69, 89-11, and 113 of the '526 patent. On the same date, an Office action was mailed, rejecting claims 1-14, 16-33, 35-39, 61-69, 89-111, and 113. In this Office action, U.S. Patent 6,120,809 to Rhodes ("Rhodes '809") was used in anticipation rejections of claims 1-4, 7-14, 16-22, 25-29, 31, 32, 35, 36, 38, 40-48, 51, 62-69, 89-92, and 95-101; the Rhodes '809 patent was also used in obviousness rejections of claims 5, 6, 10, 12-4, 23-25, 30, 33, 37, 39, 45-47, 49, 50, 52-59, 61, 65, 68, 89, 93, 94, 102-111, and 113.

- On June 3, 2002, patent owner filed a response to the April 4, 2002 Office action, including amendments to claims 26, 36, 52, and 89, cancellation of claim 15, and addition of claims 114-163. The response included a discussion of the disclosure of the Rhodes '809 patent. Third party requester comments were filed on July 3, 2002.

- On July 3, 2002, third party requester filed a request for *ex parte* reexamination of claims 1-113 of the '526 patent, and the resulting reexamination proceeding was assigned control number 90/006,317. Reexamination was ordered on August 20, 2002 for claims 1-14, 16-69, and 89-113 of the '526 patent.

- On January 30, 2003, the Office merged the '003 and '6317 reexamination proceedings.

- Prosecution progressed until, on April 29, 2010, a Right of Appeal Notice was issued by the Office.[1] Claims 1-14, 16-103, 114-123, and 125-136 were listed as being under reexamination in the proceeding. All of the claims under reexamination in the proceeding were also listed as being rejected.

- On May 24, 2010, patent owner filed petitions under § 1.181 and § 1.183 for the purpose of requesting entry of declarations, including those submitted on January 29, 2010, and refused entry in the Right of Appeal Notice of April 29, 2010. Patent owner's May 24, 2010 petition under § 1.183 was dismissed in an Office action mailed on June 2, 2010.

- On May 28, 2010, patent owner filed a Notice of Appeal.

---

[1] The lengthy prosecution of the merged reexamination proceeding from January 2003 through April 2010 included, *inter alia*, issuance of a NIRC and its subsequent withdrawal in 2006, revival of the proceeding in September 2008 subsequent to a late-filed patent owner appellant's brief, appeal and full briefing by the parties in 2008-2009, and reopening of prosecution in 2009. The full details are not included here, but may be found in the instant petition at pages 3-7, as well in the Office decision dismissing patent owner's petition under § 1.181, mailed on the same date herewith.

- On June 4, 2010, third party requester filed a petition under § 1.182 requesting that the appeal proceed directly to the Board of Patent Appeals and Interferences.

- On July 28, 2010, patent owner filed an appellant's brief.

- On October 5, 2010, the Office issued an Examiner's Answer.

- On November 5, 2010, patent owner filed the following papers:

    - A rebuttal brief in response to the October 5, 2010 Examiner's Answer.

    - A petition entitled "PETITION UNDER 37 CFR § 1.182 FOR REQUEST FOR CONTINUED REEXAMINATION."

    - The instant petition entitled "PETITION UNDER 37 C.F.R. § 1.183 FOR REQUEST TO DELAY APPEAL PROCEEDINGS BEFORE THE BOARD UNTIL PATENT OWNER'S 37 CFR § 1.182 PETITION HAS BEEN ACTED UPON."

PERTINENT REGULATIONS

37 C.F.R. § 1.183 provides:

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

37 C.F.R. § 1.181(f) provides, in pertinent part:

> 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.

37 C.F.R. § 41.64(a) provides:

> (a) Jurisdiction over the proceeding passes to the Board upon transmittal of the file, including all briefs and examiner's answers, to the Board.

DECISION

The instant petition is filed under § 1.183, which permits relief "[i]n an extraordinary situation, where justice requires" waiver of any requirement of the rules. Such relief may not involve waiver of any statutory requirement.

Patent owner petitioner filed the instant petition to request that the jurisdiction over the proceeding not pass to the Board upon completion of the file, as provided for in 37 C.F.R. § 41.64, until patent owner's petition has been acted upon. Petitioner states that this request be granted because (1) petitioner is attempting to advance prosecution of the reexamination proceeding and (2) petitioner has "limited options" as to actions available, since neither refiling under §§ 1.53(b) or 1.53(d), nor the RCE procedure under § 1.114 is available to the patent owner petitioner.[2]

Patent owner petitioner requests that jurisdiction not pass to the Board until patent owner's petition under § 1.182 has been acted upon. On the same date herewith, that petition has been acted upon, and a decision dismissing that petition has been mailed. Patent owner petitioner's desired outcome has therefore occurred, causing the question of any waiver of the rules to become moot. Therefore, the instant patent owner petition is **dismissed**.

CONCLUSION

1. The patent owner petition is **dismissed.**

2. A copy of this decision will be made of record in the reexamination file.

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

Robert A. Clarke
Deputy Director
Office of Patent Legal Administration

November 22, 2010

[2] Petition at 9. Petitioner's additional remarks at pages 7-8 appear to be a "cut-and-paste" of arguments presented in the cofiled petition under § 1.182, and do not address the merits of the relief requested in the instant petition.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,317	07/03/2002	6319526	01473.302800	9581

25763 7590 12/22/2010

DORSEY & WHITNEY LLP
INTELLECTUAL PROPERTY DEPARTMENT
SUITE 1500
50 SOUTH SIXTH STREET
MINNEAPOLIS, MN 55402-1498

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 12/22/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Eugene J. Bernard
Townsend and Townsend and Crew LLP
Two Embarcadero Center, 8th Floor
San Francisco, CA 94111

Date:

MAILED

DEC 22 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90006317
PATENT NO. : 6319526
ART UNIT : 3900

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,003	01/08/2002	6319526	01473.302300	4575

25763 7590 12/22/2010

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SAN FRANCISCO, CA 94111

Date:
MAILED

DEC 2 2 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000003
PATENT NO. : 6319526
TECHNOLOGY CENTER : 3999
ART UNIT : 3991

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

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

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

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

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CENTRAL REEXAMINATION UNIT

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50 SOUTH SIXTH STREET
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For Patent Owner

Eugene J. Bernard Ph.D. Esq.
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TWO EMBARCADERO CENTER, 8TH FLOOR
SAN FRANCISCO, CA 94111

For Requester

Inter Partes Reexamination Proceeding
Control No. 95/000,003
Filed: January 8, 2002

Ex Parte Reexamination Proceeding
Control No. 90/006,317
Filed: July 3, 2002

For: US Patent No. 6,319,526

DECISION ON
PETITION UNDER
37 CFR 1.181

This is a decision on the petition filed May 24, 2010 to request the declarations of Donald Dahlstrom, William Aimutis and James Wiegand, submitted January 29, 2010, be entered onto the record and to considered by the Examiner

The petition is before the Director of Technology Center 1600, who oversees the Central Reexamination Unit, for consideration.

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

REVIEW OF FACTS

1. U.S. Patent No. 6,319,526 issued to Dahlstrom et al on November 20, 2001.

2. On January 8, 2002, a request for *inter partes* reexamination of the '526 patent was filed by a third party requester, which proceeding was assigned control no. 95/000,003.

3. On April 4, 2002, reexamination was ordered and a non-final Office action was mailed I the '003 proceeding.

4. On June 3, 2002, Patent Owner filed a non-compliant response to the Office action.

5. On July 3, 2002, Requester filed comments on Patent Owner's response.

6. On July 3, 2002, a request for *ex parte* reexamination was filed by the same requester, which proceeding was assigned control no. 90/006,317.

7. On July 9, 2002, Patent Owner filed a corrected amendment in the '003 proceeding.

8. On August 20, 2002 reexamination was ordered in the '6317 proceeding.

9. On January 30, 2003, the '003 and '6317 proceedings were merged.

10. The merged proceeding progressed to the point of mailing a Notice of Intent to Issue Reexamination Certificate on August 28, 2006 in which claims 1-14 and 16-163 were canceled.

11. On September 19, 2006, Patent Owner filed a petition under 37 CFR 1.182 requesting withdrawal of the cancellation of claims 1-14 and 16-163 and requesting entry and consideration of Patent Owner's late response and amendment accompanying the instant petition.

12. On October 27, 2006, a decision dismissing the petition and granting *sua sponte* relief by withdrawal of the NIRC in the merged proceeding. The proposed amendment accompanying the petition was NOT in compliance with 37 CFR 1.530.

13. On June 23, 2007, an Action Closing Prosecution (ACP) was mailed.

14. On July 26, 2007, Patent Owner filed comments after ACP accompanied by a proposed amendment.

15. Also on July 26, 2007, Patent Owner filed a petition requesting waiver of 37 CFR 1.951 as to patent owner's one opportunity to file comments. (Dismissed 9/27/2007)

16. On August 24, 2007, Requester filed comments after ACP.

17. On January 29, 2008, Patent Owner filed a reissue application of the '526 patent. The Office assigned the application USSN 12/011,746.

18. On April 1, 2008, a Right of Appeal Notice (RAN) was issued noting the Patent Owner's amendment submitted after ACP was not entered due to failure to comply with amendment entry criteria set forth in 37 CFR 1.953 and 1.116.

19. On April 30, 2008. Patent Owner filed a Notice of Appeal.

20. On July 23, 2008, Patent Owner filed a petition under 37 CFR 1.137(b) for entry of late papers accompanied by an Appellant Brief.

21. Also on July 23, 2008, Patent Owner submitted a petition under 1.183 requesting entry of an amendment attached thereto. (Dismissed October 25, 2008)

22. On September 3, 2008, the Office issued a decision granting the revival of the merged reexamination proceeding.

23. On October 3, 2008, Requester filed a respondent brief.

24. On February 23, 2009, an Examiner's Answer was mailed.

25. On March 23, 2009, Patent Owner filed a rebuttal brief.

26. On April 8, 2009, the Office issued a Notice of Defective Paper to Patent Owner. The Notice indicated the Appellant's brief as too long and including an insufficient evidence appendix.

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32. On August 31, 2009, Patent Owner filed a petition under 37 CFR 1.183 to permit entry of a concurrently filed declaration under 37 CFR 1.131, which was granted on November 4, 2009.

33. On September 28, 2009, the Office issued an Examiner's Answer.

34. On October 28, 2009, Patent Owner filed a rebuttal brief.

35. On October 29, 2009, the Office issued a Notice of Defective Rebuttal Brief.

36. On November 3, 2009, Patent Owner resubmitted the rebuttal brief.

37. On November 17, 2009, Requester filed a response to the declaration entered by the November 4, 2009 decision.

38, On November 24, 2009, Requester filed a request for an oral hearing.

39. On December 17, 2009, the Office mailed a second ACP.

40. On January 29, 2010, Patent Owner filed a response to the second ACP along with declarations of Dahlstrom, Aimutis and Wiegand under 37 CFR 1.131. On the same day, Patent Owner filed a petition under 37 CFR 1.183 in regard to the Aimutis declaration, which was dismissed on March 25, 2010.

41. On February 25, 2010, Requester filed comments in response to the ACP and Patent Owners response.

42. On April 29, 2010, the Office mailed a second Right of Appeal Notice (RAN), which denied entry of the declarations filed on January 29, 2010.

43. On May 24, 2010, the Patent Owner filed a request for reconsideration of the March 25, 2010 decision, which was dismissed on June 2, 2010, and the instant petition under 37 CFR 1.181.

44. Prosecution has proceeded to the issuance of an Examiner's Answer on October 5, 2010 and the submission of a Rebuttal Brief on November 5, 2010.

DECISION

The present petition under 37 CFR 1.181 requests that the declarations of Dahlstrom, Aimutis and Wiegand under 37 CFR 1.131, submitted on January 29, 2010, (hereinafter "the declarations") and the new evidence cited in the January 29, 2010 response be entered into the record and considered by the Examiner. The patent owner (petitioner) states that the examiner erred in deciding not to enter the declarations because the declarations were submitted in response to the examiner's response to the earlier-filed declaration by Clint Garoutte (hereinafter "the Garoutte declaration") in the second ACP and that the examiner erred in requiring signatures of the inventors on the declarations. See pages 4-11 of the petition. The petitioner also states that the examiner erred in not entering the January 29, 2010 response because the cited evidence could not have been presented earlier because it was cited in response to new arguments raised in the appeal. See, e.g., pages 11-12 of the petition. The petitioner requests the following relief:

1. Clarification of the requirement regarding who can sign a declaration filed under 37 CFR 1.131;
2. Vacatur of the RAN and reopening of prosecution, or alternatively, issuance of another ACP with consideration of declarations that meet the requirements set forth in the March 25, 2010 decision; or
3. Requirement for the examiner to enter and consider the declarations.

See pages 12-13 of the petition.

In response to patent owner's arguments that the examiner erred in deciding not to enter the declarations and response filed January 29, 2010, the director finds there are not good and sufficient reasons to enter the proposed amendment. First, 35 U.S.C. 314(c) requires that all *inter partes* reexamination proceedings to be acted upon with "special dispatch." The rules and procedures of the Office were established through notice and comment in order to achieve special dispatch in a reasonable manner. Office rules and procedures encourage examiners to look at the facts involved in a particular proceeding and to weigh the equities before issuing a right of appeal notice and/or an action closing prosecution. Furthermore, MPEP 2673 states that:

> It should be kept in mind that a patent owner cannot, as a matter of right, amend claims rejected in the ACP, add new claims after an ACP, nor reinstate previously canceled claims. A showing under 37 CFR 1.116(b) is required and will be evaluated by the examiner for all proposed amendments after the ACP, except where an amendment merely cancels claims, adopts examiner's suggestions, removes issues for appeal, or in some other way requires only a cursory review by the examiner.
>
> Where the entry of the proposed amendment (after the ACP) would result in any ground of rejection being withdrawn or any additional claim indicated as patentable, the proposed amendment generally raises new issues requiring more than cursory review by the examiner. The examiner would need to indicate new grounds for patentability for any claim newly found patentable and/or the reason why the rejection was withdrawn and would also need to deal with any third party requester's comments on the proposed amendment (made pursuant to 37 CFR 1.951(b) in response to owner's proposed amendment). Thus, the examiner is not required to enter the proposed amendment.
>
> In view of the fact that the patent owner cannot continue the proceeding by refiling under 37 CFR 1.53(b) or 1.53(d) nor by filing a Request for Continued Examination under 37 CFR 1.114 and the patent owner cannot file an *inter partes* reexamination request (see MPEP § 2612), the examiner should consider the feasibility of entering a proposed amendment paper, where the entirety of the amendment would result *only* in an additional claim (or claims) being indicated as patentable. The examiner is encouraged to enter such an amendment unless the entry would cause an "undue burden" on the examiner. Where the examiner does not enter the amendment, the examiner should explain the "undue burden."

The second RAN, mailed April 29, 2010, sets forth specific reasons why the post-ACP declarations and response were not entered into the proceeding record. See pages 8-10 of the RAN. Specifically, the examiner explained that the declarations and the response introduced new issues and evidence that would require further consideration beyond a

nominal review. Furthermore, the examiner stated that the patent owner did not show good and sufficient reasons why the declarations and evidence were not earlier presented. Therefore, the examiner properly provided and explained the "undue burden" as stated in MPEP 2673. For these reasons, the examiner followed Office procedures and policies in consideration of the post-ACP response and evidence. Accordingly, the examiner did not abuse his discretion by the decision to not enter the post-ACP declarations and response filed January 29, 2010.

In the petition, petitioner argues that the examiner erred in holding that only the inventors can sign a declaration under 37 CFR 1.131 in the ACP dated December 17, 2009, and therefore, patent owner should be given an opportunity to file a declaration after the Office provides clarification of the requirements. See pages 4-6 of the petition. First, it is respectfully pointed out that patent owner received such clarification in the decision dated March 25, 2010. Second, the examiner's alleged error in requiring a petition under 37 CFR 1.183 was just one of the reasons why the Garoutte declaration (and not the declarations filed January 29, 2010) was ineffective. The Garoutte declaration is entered into the record, and therefore, patent owner can address on appeal any reason why the examiner found the Garoutte declaration to be ineffective, including the requirement as to who can sign the declaration. Third, even if the examiner did mistakenly "require" that only the inventors can sign a declaration under 37 CFR 1.131 and the patent owner imputed this "requirement" to future declarations, this alleged error is not dispositive. As explained in the paragraph above, the examiner gave proper reasons (e.g., undue burden in significant consideration of late-filed declarations and evidence without a showing of why such evidence was not earlier presented) for not entering the post-ACP declarations and the response, which was in accordance with Office policies and procedures. In other words, the examiner showed why entry of the post-ACP declarations and response would be an undue burden as required by 37 CFR 1.116, and such showing was not reliant on the issue of whether the patent owner can sign a declaration under 37 CFR 1.131. See pages 8-10 of the RAN. Therefore, the record shows that the examiner properly determined that the post-ACP declarations and response should not be entered.

In regard to the petitioner's arguments that the post-ACP declarations and response were improperly denied entry, the record shows that there was opportunities for patent owner to submit declarations and evidence. Specifically, this proceeding was filed on January 8, 2002 and has had a long prosecution history as evident from the statement of facts above. The first rejection based on U.S. Patent No. 6,120,809 to Rhodes ("Rhodes '809"), which is the primary reference used in the rejections and the reference the declarations attempt to disqualify as prior art, was first made on April 4, 2002. Another non-final Office action containing rejections based on Rhodes '809 was mailed on February 16, 2005 and a first ACP containing rejections based on Rhodes '809 has mailed on June 26, 2007. In summary, rejections based on Rhodes '809 have been consistently set forth in Office actions since April of 2002. Therefore, patent owner has had time to provide declarations and evidence under 37 CFR 1.131 to swear behind the Rhodes '809 patent prior to the filing of the January 29, 2010 declarations. More importantly, this proceeding has already been withdrawn from appeal once for consideration of the Garoutte declaration filed under 37 CFR 1.131 and supporting evidence. See the November 4, 2009 decision,

which resulted in the withdrawal of the appeal and the issuance of the second ACP on December 17, 2009. The record clearly shows that patent owner's late filing of a declaration and evidence under 37 CFR 1.131 pertaining to the Rhodes '809 patent, while justified by a showing in the August 31, 2009 petition under 37 CFR 1.183, has already significantly delayed prosecution in this proceeding.

The instant petition states that patent owner believes that they provided the required showing and evidence in the Garoutte declaration. See, e.g., pages 7-8 of the petition. Such arguments may be raised on appeal and as such, are not issues that can be addressed by petitions. See MPEP 1201. Patent owner then states that the declarations of January 29, 2010 were filed to address the deficiencies noted by the examiner regarding the Garoutte declaration in the second ACP. However, the examiner is required to state reasons why the Garoutte declaration is not effective under Office policies and procedures. See MPEP 715 et seq. This requirement to inform the patent owner of the reasons why a declaration under 37 CFR 1.31 is ineffective is not an invitation to file yet another declaration or a promise to consider future declarations or evidence. As stated above, patent owner may present arguments that the Garoutte declaration and its supporting evidence are sufficient on appeal. Therefore, patent owner is not without remedy even if the post-ACP declarations and evidence are not entered into the record. Thus, the petition does not present a persuasive reason why the need for the declarations and evidence could not have been earlier anticipated. As pointed out by the examiner in the second RAN, the request for entry of the post-ACP declarations and evidence fails for want of a persuasive explanation of why the post-ACP declarations and evidence cited in the response are necessary and were not earlier presented.

A further delay in the prosecution of the reexamination proceeding resulting from the practice of continually allowing the petitioner patent owner to perfect declarations filed under 37 CFR 1.131 within the confines of the reexamination proceeding must be weighed against the statutory mandate for special dispatch for reexamination proceedings (35 U.S.C. 305 and 314(c)). On balance, for the reasons discussed above, the record does not support entry of the post-ACP declarations and response that would result in further delay in the instant reexamination proceeding, and would be clearly against the statutory requirement for special dispatch in this instance.

In summary, the examiner appropriately applied Office policies and procedures in determining that the post-ACP declarations and response should not be entered, and issued a RAN in the interest of "special dispatch." As stated above, there has already been significant delays in the prosecution for this reexamination proceeding. Therefore, any further delays in advancing prosecution are clearly against the statutory mandate of "special dispatch." For the reasons set forth above, it is deemed that the examiner followed Office rules and procedures and did not abuse his discretion in deciding to not enter the post-ACP declarations and response. Accordingly, the patent owner's petition is denied as to the request to enter the declarations and response dated January 29, 2010, vacate the second RAN, reopen prosecution, and/or issue a new ACP. In regard to the request to provide clarification of the requirements for declarations filed under 37 CFR 1.131, petitioner patent owner should review MPEP 715.04, which clearly sets forth who

can sign a declaration under 37 CFR 1.131 and the corresponding requirements. See also the March 24, 2010 decision, which also sets forth clarification of the requirements.

Conclusion

1. The petition under 37 CFR 1.181 for reconsideration of the entry of the post-ACP declarations and evidence, vacating the RAN dated April 29, 2010, reopening of prosecution or issuing a new ACP in this reexamination proceeding is denied.

2. 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

3. Telephone inquiries with regard to this decision should be directed to Deborah Jones, Supervisory Patent Examiner in the Central Reexamination Unit, Art Unit 3991, at (571) 271-01535.

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

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Conclusion

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Central Reexamination Unit
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Irem Yucel
Director, Tchnology Center 1600

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,317	07/03/2002	6319526	01473.302800	9581

25763 7590 02/17/2011

DORSEY & WHITNEY LLP - MINNEAPOLIS
INTELLECTUAL PROPERTY PRACTICE GROUP (MP-23)
ATTENTION: PATENT PROSECUTION DOCKETING DEPARTMENT
50 SOUTH SIXTH STREET, SUITE 1500
MINNEAPOLIS, MN 55402-1498

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 02/17/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Eugene J. Bernard
Townsend and Townsend and Crew LLP
Two Embarcadero Center, 8th Floor
San Francisco, CA 94111

Date:

MAILED

FEB 17 2011

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90006317
PATENT NO. : 6319526
ART UNIT : 3900

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

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

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95/000,003	01/08/2002	6319526	01473.302300	4575

25763 7590 02/17/2011

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EUGENE J. BERNARD
TOWNSEND AND TOWNSEND AND CREW LLP
TWO EMBARCADERO CENTER, 8TH FLOOR
SAN FRANCISCO, CA 94111

Date:

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FEB 17 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000003
PATENT NO. : 6319526
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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DORSEY & WHITNEY LLP
INTELLECTUAL PROPERTY DEPARTMENT
SUITE 1500
50 SOUTH SIXTH STREET
MINNEAPOLIS MN 55402-1498

For Patent Owner

MAILED

FEB 17 2011

CENTRAL REEXAMINATION UNIT

Eugene J. Bernard Ph.D. Esq.
TOWNSEND & TOWNSEND & CREW LLP
TWO EMBARCADERO CENTER, 8TH FLOOR
SAN FRANCISCO, CA 94111

For Requester

Inter Partes Reexamination Proceeding
Control No. 95/000,003
Filed: January 8, 2002

Ex Parte Reexamination Proceeding
Control No. 90/006,317
Filed: July 3, 2002

For: US Patent No. 6,319,526

DECISION ON
PETITION UNDER
37 CFR 1.181

This is a decision on the third party Requester's petition filed June 4, 2010 to request that the jurisdiction of the proceeding be transferred to the Board of Patent Appeals and Interferences (BPAI) for a decision on the appeal. The petition is treated as a petition under 37 CFR 1.181.

The petition is before the Director of Technology Center 1600, who oversees the Central Reexamination Unit, for consideration.

The petition is dismissed as moot for the reasons set forth below.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,319,526 issued to Dahlstrom et al on November 20, 2001.

2. On January 8, 2002, a request for *inter partes* reexamination of the '526 patent was filed by a third party requester, which proceeding was assigned control no. 95/000,003.

3. On April 4, 2002, reexamination was ordered and a non-final Office action was mailed I the '003 proceeding.

4. On July 3, 2002, a request for *ex parte* reexamination was filed by the same requester, which proceeding was assigned control no. 90/006,317.

5. On August 20, 2002 reexamination was ordered in the '6317 proceeding.

6. On January 30, 2003, the '003 and '6317 proceedings were merged.

7. The merged proceeding progressed to the point of appeal. On April 30, 2008, Patent Owner filed a Notice of Appeal.

8. On July 23, 2008, Patent Owner filed a petition under 37 CFR 1.137(b) for entry of late papers accompanied by an Appellant Brief.

9. Also on July 23, 2008, Patent Owner submitted a petition under 1.183 requesting entry of an amendment attached thereto. (Dismissed October 25, 2008)

10. On October 3, 2008, Requester filed a respondent brief.

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12. On March 23, 2009, Patent Owner filed a rebuttal brief.

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28. On February 25, 2010, Requester filed comments in response to the ACP and Patent Owners response.

29. On April 29, 2010, the Office mailed a second Right of Appeal Notice (RAN), which denied entry of the declarations filed on January 29, 2010.

30. On May 24, 2010, the Patent Owner filed a request for reconsideration of the March 25, 2010 decision, which was dismissed on June 2, 2010, and the instant petition under 37 CFR 1.181. This petition was denied on December 22, 2010.

31. On June 4, 2010, the Requester filed the instant petition requesting the prosecution in this proceeding be advanced.

32. Prosecution has proceeded to the issuance of an Office communication on February 3, 2011 that states that the reexamination proceeding is being forwarded to the BPAI for decision on the appeal.

DECISION

The instant petition, which is treated as a petition under 37 CFR 1.181, requests that the jurisdiction of the proceeding be transferred to the Board of Patent Appeals and Interferences (BPAI) for a decision on the appeal. As pointed out, the Office mailed communication on February 3, 2011 that states that the reexamination proceeding is being forwarded to the BPAI for decision on the appeal. Therefore, the relief requested by the June 4, 2010 petition has already been given by the February 2, 2011 communication. Thus, Requester's June 4, 2010 petition is moot and hereby dismissed.

CONCLUSION

1. The petition dated June 4, 2010 is dismissed as moot.

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) 271-01535.

Irem Yucel, Director
Technology Center 1600

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25763 7590 04/12/2011

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MINNEAPOLIS, MN 55402-1498

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/12/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

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Townsend and Townsend and Crew LLP
Two Embarcadero Center, 8th Floor
San Francisco, CA 94111

Date:

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APR 12 2011

CENTRAL REEXAMINATION UNIT

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REEXAMINATION CONTROL NO. : 90006317
PATENT NO. : 6319526
ART UNIT : 3900

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APR 12 2011

CENTRAL REEXAMINATION UNIT

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(For Patent Owner)

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(For Third Party Requester)

In re Dahlstrom et al.
Inter Partes Reexamination Proceeding
Control No. 95/000,003
Filed: January 8, 2002
For: U.S. Patent No. 6,319,526 B1

DECISION DENYING PETITION UNDER § 1.182

In re Dahlstrom et al.
Ex Parte Reexamination Proceeding
Control No. 90/006,317
Filed: July 3, 2002
For: U.S. Patent No. 6,319,526 B1

This is a decision on the February 22, 2011 patent owner petition entitled "PETITION UNDER 37 CFR § 1.182 REQUEST FOR RECONSIDERATION."

On April 11, 2011, jurisdiction over the proceeding was transferred to the Office of Patent Legal Administration by the Board of Patent Appeals and Interferences for treatment of the February 22, 2011 patent owner petition. The patent owner petition is now before the Office of Patent Legal Administration for decision.

The petition is granted to the extent that the previous decision has been reconsidered, but **denied as to the underlying relief requested**.

PERTINENT BACKGROUND

1. On November 20, 2001, U.S. Patent No. 6,319,526 ("the '526 patent) was issued to Dahlstrom *et al.*, having 113 claims.

2. On January 8, 2002, a request for *inter partes* reexamination was filed by the third party requester, the real party in interest being Leprino Foods Company, and the resulting reexamination proceeding was assigned control number 95/000,003 ("the '003 proceeding").

3. On April 4, 2002, reexamination was ordered for claims 1-14, 16-33, 35-59, 61-69, 89-111, and 113 of the '526 patent. On the same date, an Office action was mailed, rejecting claims 1-14, 16-33, 35-39, 61-69, 89-111, and 113. In this Office action, U.S. Patent 6,120,809 to Rhodes ("Rhodes '809") was applied in anticipation rejections of claims 1-4, 7-14, 16-22, 25-29, 31, 32, 35, 36, 38, 40-48, 51, 62-69, 89-92, and 95-101; the Rhodes '809 patent was also applied in obviousness rejections of claims 5, 6, 10, 12-4, 23-25, 30, 33, 37, 39, 45-47, 49, 50, 52-59, 61, 65, 68, 89, 93, 94, 102-111, and 113.

4. On June 3, 2002, patent owner filed a response to the April 4, 2002 Office action, including amendments to claims 26, 36, 52, and 89, cancellation of claim 15, and addition of claims 114-163. The response included a discussion of the disclosure of the Rhodes '809 patent. Third party requester comments were filed on July 3, 2002.

5. On July 3, 2002, the same third party requester[1] filed a request for *ex parte* reexamination of claims 1-113 of the '526 patent, and the resulting reexamination proceeding was assigned control number 90/006,317 ("the '6317 proceeding"). Reexamination was ordered for the '6317 proceeding on August 20, 2002 for claims 1-14, 16-69, and 89-113 of the '526 patent.

6. On January 30, 2003, the Office merged the '003 and '6317 reexamination proceedings.

7. Prosecution continued, until on November 4, 2009, after an Examiner's Answer had been issued, the Office granted a petition filed August 31, 2009 for extraordinary relief under 37 C.F.R. § 1.183 to enter a declaration under § 1.131 by Clint Garoutte, "[b]ased on the facts and circumstances of the present case." This reopened prosecution of the proceeding.

8. On December 17, 2009, an Action Closing Prosecution ("ACP") was mailed, in which the declaration under § 1.131 by Clint Garoutte was considered on the merits but found to be unpersuasive as to the establishment of invention prior to the Rhodes '809 reference. The reexamination proceeding, which had been fully briefed by all parties and ready for docketing at the Board of Patent Appeals and Interferences prior to the November 4, 2009 decision, was reopened by this ACP.

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[1] *Ex parte* reexamination was requested "by Leprino Foods Company, through its attorneys," as stated in the June 3, 2002 request. *Inter partes* reexamination was likewise requested "by Leprino Foods Company, through its attorneys," as stated in the Jan. 8, 2002 request.

9. On January 29, 2010, patent owner again petitioned for extraordinary relief under 37 C.F.R. § 1.183. This petition requested relief from the requirements of § 1.131 declaration; in particular, to permit a party under § 1.47 to sign the declaration.[2] This petition was dismissed in a March 25, 2010 Office decision stating that extraordinary relief was not appropriate where an alternative relief; i.e., submission of the § 1.131 declaration by the assignee, was available.[3]

10. On April 29, 2010, a Right of Appeal Notice was issued by the Office.[4] Claims 1-14, 16-103, 114-123, and 125-136 were listed as being under reexamination in the proceeding. All of the claims under reexamination in the proceeding were listed as being rejected. The Right of Appeal Notice refused entry, pursuant to 37 C.F.R. § 1.116, to the January 29, 2010 declaration under § 1.131 as failing to provide good and sufficient reason why that declaration was not earlier presented.

11. On May 24, 2010, patent owner filed petitions under § 1.181 and § 1.183 for the purpose of requesting entry of declarations, including those submitted on January 29, 2010, that had been refused entry in the Right of Appeal Notice of April 29, 2010. Patent owner's May 24, 2010 petition under § 1.183 was dismissed in an Office decision mailed on June 2, 2010.

12. On May 28, 2010, patent owner filed a Notice of Appeal.

13. On June 4, 2010, third party requester filed a petition under § 1.182 requesting that the appeal proceed directly to the Board of Patent Appeals and Interferences.

14. On July 28, 2010, patent owner filed an appellant's brief.

15. On October 5, 2010, the Office issued an Examiner's Answer.

16. On November 5, 2010, patent owner filed the following papers:

    a. A rebuttal brief in response to the October 5, 2010 Examiner's Answer.

    b. A petition entitled "PETITION UNDER 37 CFR § 1.182 FOR REQUEST FOR CONTINUED REEXAMINATION." This petition requested entry of claim amendments and declarations under 37 C.F.R. § 1.131 by Clint Garoutte, James Weigand, William Aimutis, and Donald Dahlstrom.

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[2] § 1.131 states that it may be submitted by either an inventor, the patent owner or a party qualified under § 1.47.
[3] § 1.131 states that it may be submitted by a patent owner.
[4] The lengthy prosecution of the merged reexamination proceeding from January 2003 through April 2010 included, *inter alia*, issuance of a NIRC and its subsequent withdrawal in 2006, revival of the proceeding in September 2008 subsequent to a late-filed patent owner appellant's brief, appeal and full briefing by the parties in 2008-2009, and the aforementioned reopening of prosecution in 2009. The full details are not included here, but may be found in pages 2-7 of the instant patent owner petition.

c. A petition entitled "PETITION UNDER 37 C.F.R. § 1.183 FOR REQUEST TO DELAY APPEAL PROCEEDINGS BEFORE THE BOARD UNTIL PATENT OWNER'S 37 CFR § 1.182 PETITION HAS BEEN ACTED UPON."

17. On December 22, 2010, the Office issued decisions dismissing the November 5, 2010 petitions under §§ 1.182 and 1.183, and a decision denying the May 24, 2010 petition under § 1.181.

18. On February 3, 2011, the Office noted the November 5, 2010 patent owner's rebuttal brief, and forwarded the proceeding to the Board of Patent Appeals and Interferences for decision on the appeal.

19. On February 9, 2011, the Board of Patent Appeals and Interferences docketed the appeal as no. 2011-005022.

20. On February 22, 2011, patent owner filed the following papers:

a. A petition requesting reconsideration of the denial of the December 22, 2010 decision denying the May 24, 2010 petition under § 1.181.

b. The instant petition requesting reconsideration of the December 22, 2010 decision dismissing the November 5, 2010 petition under § 1.182.

c. A petition requesting delaying of the appeal proceedings until the instant reconsideration petition has been acted upon.

PERTINENT STATUTES AND REGULATIONS

35 U.S.C. § 314 provides, in pertinent part:

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

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

37 C.F.R. § 1.182 provides:

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

DECISION

1. The Instant Situation Does Not Justify Reopening of Prosecution

A. Background

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."[5] Notice was provided therein that a patent owner could file a petition under 37 CFR § 1.182 requesting continued prosecution on the merits in the reexamination proceeding to seek entry of an amendment and/or evidence that was denied entry after an action closing prosecution (ACP) in an *inter partes* reexamination proceeding or after a final rejection in an *ex parte* reexamination proceeding. A petition under § 1.182 may provide relief for a situation that is "not specifically provided for" in the regulations.[6]

By filing such a petition, the patent owner could, in limited situations, 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 (*ex parte* reexamination), or after an ACP (*inter partes* reexamination). This relief was made available via a 37 CFR § 1.182 petition, in appropriate circumstances. The 37 CFR § 1.182 petition will be referred to hereinafter as "the § 1.182 petition."

To qualify for relief of this nature, 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 and reduce the issues for appeal, or the issuance of a reexamination certificate, since this is a key factor in reducing pendency of a reexamination proceeding. It thus follows that the petition

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[5] 1292 *Off. Gaz. Pat. Office* 20, March 1, 2005.
[6] 37 C.F.R. § 1.182 (2004).

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/reduced for appeal or issuance of a reexamination certificate.

Where relief is requested under § 1.182, any continuation of prosecution in a reexamination proceeding must be considered taking into account the statutory mandate of 35 U.S.C. § 314(c), stating that "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." Therefore, any Office decision granting continuation of prosecution in a reexamination proceeding must further the resolution of the substantial new questions of patentability raised in the proceeding with special dispatch.

In this instance, the patent owner petitioned, on November 5, 2010, for reopening of prosecution after a full briefing at the appeal stage, in order to enter (a) four newly presented declarations under 37 C.F.R. § 1.131 and (b) "narrowing amendments to further clarify the invention."[7] Patent owner seeks such relief under the provisions of March 2005 Notice discussed above. Patent owner's plea for relief is grounded on the position that entry of the declarations would remove the Rhodes '809 patent from prior art status, thereby overcoming the rejections based upon that patent, and furthermore, that the claim amendments proposed with the petition would overcome the rejections of record.

In an Office decision issued on December 22, 2010, the November 5th petition was dismissed. It was pointed out in that decision that the issue for which the amendment and evidence submissions are stated to address arose in the initial Office action of April 4, 2002. In view of the previous ability of the patent owner to submit relevant affidavits and claim amendments, and the advanced stage of the proceeding, reopening prosecution for entry of § 1.131 affidavits, claim amendments, and new claims was found not to be consistent with the Office's requirement to handle reexamination proceedings with special dispatch. Furthermore, it was explained that, to the extent that patent owner petitioner is contending that an action taken by the examiner has been improper, the proper avenue for seeking relief from improper closure of prosecution in an *inter partes* reexamination is through supervisory review under § 1.181.

Upon reconsideration, the instant situation is again found not to justify a continuation of the reexamination proceeding through reopening of the lengthy prosecution thus far to consider the new affidavits, new amended claims, and new claims submitted on November 5, 2010.

B. Patent Owner Proposes to Amend the Claims for the First Time

With respect to the submission of new and amended claims for entry via the instant petition, patent owner has presented no colorable justification for the delay in submission of new and amended claims at this stage of the proceeding, more than nine years from the initial filing of the request for *inter partes* reexamination, and after patent owner's filing of a notice of appeal on May 28, 2010, patent owner's filing of an appellant's brief on July 28, 2010, and the issuance of an examiner's answer on October 5, 2010. The new and amended claims proposed to be entered

[7] Petition at 1.

and considered by the examiner were not occasioned by any new ground of rejection recently made in the reexamination or by a newly raised issue, but rather, are in response to the original issues raised in the initial Office action of April 4, 2002. Patent owner has had numerous occasions to enter such amended and new claims as a matter of right, and additional occasions for entry upon a showing of good and sufficient reasons why the amendment was necessary and was not earlier presented.

Since patent owner has had previous opportunities under the rules to enter the requested submission, the Office will not act now, to provide relief for "situations not specifically provided for," to regress the proceeding and delay the resolution of the substantial new question of patentability for which the instant *inter partes* reexamination was ordered in 2002. Such action by the Office to reopen prosecution for further consideration of new issues occasioned by entry of new and amended claims would not be consistent with the Office's mandate to handle *inter partes* reexamination with "special dispatch" as set forth in 35 U.S.C. §§ 304 and 314(c).

C. Patent Owner Had Prior Opportunity to Submit § 1.131 Declarations

As a further basis for this decision, patent owner has also had previous occasions to enter an affidavit such as that submitted on November 5, 2010. Prosecution was reopened on November 4, 2009 for that exact purpose. This reopening occurred when the Office granted a petition for extraordinary relief under 37 C.F.R. § 1.183 to enter a declaration under § 1.131 by Clint Garoutte, after substantial examination/prosecution, including an Examiner's Answer, had already occurred. Since patent owner has had at least one previous opportunity under the rules to enter the requested affidavit, the Office will not act now, to provide relief for "situations not specifically provided for" in its rules, to further delay the resolution of the substantial new question of patentability for which the instant *inter partes* reexamination was ordered in 2002. Such action by the Office to reopen prosecution for additional evidence, after patent owner has had prior opportunity to present such evidence, would not be consistent with the Office's mandate to handle *inter partes* reexamination with "special dispatch" as set forth in 35 U.S.C. §§ 304 and 314(c).

Clearly, reopening prosecution for additional evidence and amended and new claims would severely set back a proceeding already regressed once, and filed and ordered in the first half of 2002, and the equities do not favor the Office taking such action.

2. Petitioner's Arguments in the Instant Petition are Not Persuasive

In the instant petition, patent owner alleges error in the December 22, 2010 decision denying extraordinary relief based upon the following: (1) grant of a § 1.183 petition in November 2009 to enter a § 1.131 submission is inconsistent with denial of such relief now; (2) actions of the patent examiner "thwarted" consideration of the earlier § 1.131 submission; (3) entry of the instant § 1.131 submission would further prosecution and not delay it by removing the Rhodes reference as prior art; (4) the narrowing claim amendments could not have been provided earlier; (5) the ineffectiveness of patent owner's prior counsel should not be held against patent owner; and (6) common sense and fairness dictate that the requirement for special dispatch not trump substantive review of evidence.

First, the November 2009 reopening of prosecution provided a limited measure of relief for a specific set of facts. The November 2009 decision provided for entry of the August 31, 2009 Garoutte declaration and attached Exhibits A-P. The decision weighed the facts and circumstances existing at that time and provided for a single instance in which a specific declaration and attached exhibits would be entered. However, that decision did not provide for open-ended continuation of proceedings until such time as patent owner would decide that it had submitted a declaration that it was satisfied with. Nor did it "make [] events prior to November 2009 irrelevant to the special dispatch requirement" as alleged by petitioner. Further, the November 2009 decision did not, in any way, contemplate entry of narrowing claim amendments (that could have been submitted long ago) as are proposed for entry in the instant petition - entry of which would require significant further examination/prosecution.

The December 22, 2010 decision from which petitioner seeks reconsideration, and the present decision, clearly take into account the request for entry of the newly proposed amendment as well as the newly submitted § 1.131 evidence (which would result in significant delay if prosecution were reopened as requested) when evaluating whether the proposed submissions could have been proposed at an earlier date in accordance with special dispatch. The decisions take into account the extended prosecution which began in November 2001 and has already been delayed through the granting of extraordinary relief to enter § 1.131 evidence in 2009. The decisions also take into account the fact that the proceeding is currently docketed for appeal.

The instant petition under § 1.182 seeks a measure of relief not provided for under the existing rules, and which is subject to careful consideration of all of the relevant facts and circumstances in the proceeding. As detailed above, the facts and circumstances as they currently exist are not the same as had existed in November 2009, at the time the Office previously took the extraordinary measure of waiving rules to permit entry of evidence under § 1.131. The grant of relief at that time addressed the events that gave rise to the extraordinary circumstances, and extinguished the prior events as a basis to rely upon for further unrelated relief. The instant situation is not one where patent owner is unable to enter newly found evidence; rather, it is one where patent owner is seeking to continue an already prolonged prosecution until patent owner can, if possible, place in front of the Office a § 1.131 affidavit and a set of claims that patent owner is satisfied with. However, the rules governing the instant proceeding do not contemplate unlimited attempts to submit evidence and claim revision/addition; rather, the rules indicate that any amendment or evidence filed after prosecution is closed will be entered only under good and sufficient reasons why the amendment and evidence are necessary and not earlier presented. The rules are designed to provide an orderly procedure that can be relied upon by all parties, and that is not lightly set aside through waiver, or circumvented through reopening of prosecution.[8] Therefore petitioner's argument is not persuasive that relief to regress the proceeding must again be granted merely because similar relief was previously granted, upon different facts and circumstances.

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[8] *In re Sivertz*, 227 USPQ 255 (July 23, 1985) (citing *Myers v. Feigelman*, 455 F.2d 586, 601, 172 USPQ 580, 584 (CCPA 1972) (stating "the rules are designed to provide an orderly procedure and the parties are entitled to rely on their being followed in the absence of such circumstances as might justify waiving them under Rule 183. To hold that they may be ignored, in the absence of such circumstances, merely because no special damage has been shown would defeat the purpose of the rules")).

Second, petitioner alleges that the examiner erred in failing to ensure consideration of § 1.131 evidence. However, any question of error in actions taken by an examiner is addressable through petition under § 1.181. Relief under § 1.182 is unavailable where the situation is addressed elsewhere in the regulations.[9] Patent owner is in fact concurrently seeking review of the examiner's actions via such a petition seeking reconsideration of the decision denying relief under § 1.181, filed on February 22, 2011. Since the question of examiner error is specifically provided for by § 1.181, relief directed to asserted examiner error is not available under § 1.182. Therefore, petitioner's argument based upon examiner error is not persuasive.

Third, petitioner alleges that entry of the instant § 1.131 submission would further prosecution and not delay it by removing the Rhodes reference as prior art. However, there is no certainty as to whether entry of the § 1.131 submission would act to remove the Rhodes reference as prior art. A previous § 1.131 submission entered into the proceeding through the November 2009 decision granting relief under § 1.183 failed to result in removal of the Rhodes reference as prior art. Therefore, any such benefit to the furtherance of prosecution is merely speculative. Furthermore, the petition does not allege with specificity how entering the proposed narrowing amendments would further prosecution rather than delay prosecution. Therefore, such argument is not persuasive.

Fourth, petitioner alleges that the narrowing claim amendments could not have been provided earlier because "[p]rior counsel failed to see a key distinction between the Rhodes reference and claims as granted and that are currently under reexamination."[10] As stated in the December 22, 2010 decision, this issue arose in the initial Office action of April 4, 2002 – nearly nine years ago. Failure of the patent owner, or its designated agent, to appreciate the relevance of claim revision and certain evidence is not a good and sufficient cause for its entry at such a late point in an already extended prosecution.

Fifth, petitioner alleges that prior counsel was ineffective in failing to recognize potential narrowing amendments and in submitting declarations under § 1.131 which were found not persuasive. To the extent that this is alleged, the petitioner patent owner selected the prior counsel and agreed to be represented in all matters in front of the Office by that counsel. As stated in *Link v. Wabash R. Co.*:[11]

> There is certainly no merit to the contention that dismissal of petitioner's claim because of his counsel's unexcused conduct imposes an unjust penalty on the client. Petitioner voluntarily chose this attorney as his representative in the action, and he cannot now avoid the consequences of the acts or omissions of this freely selected agent.

Moreover, in *Huston v. Ladner*, the Federal Circuit held that it was not an abuse of discretion for the Office to hold (in an inter partes proceeding) that the alleged negligence of applicant's

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[9] § 1.182 states that it is directed to "[a]ll situations not specifically provided for in the regulations of this part."
[10] Petition at 15.
[11] *Link v. Wabash R. Co.*, 370 U.S. 626, 633-34 (1962).

original was not good cause to justify submitting additional evidence.[12] A "bad judgment, inexperience, or lack of competence" by an attorney in an interference proceeding was found to be properly chargeable to the patent applicant.[13]

For this reason, patent owner's argument that patent owner is not accountable for the acts of prior counsel is not persuasive.

Finally, petitioner argues that common sense and fairness dictate that the requirement for special dispatch not trump substantive review of evidence. The prior decision dismissing continued prosecution of the proceeding before the examiner, and the present decision, have applied common sense in the interest of fairness and equity to all parties affected by the *inter partes* reexamination (including the requester and the public which await resolution of the substantial new questions of this proceeding, and the Office which does not have endless resources), and find that patent owner has been presented sufficient prior opportunities to present the desired amendments and § 1.131 evidence.

Common sense would recognize that despite patent owner's allegations about the ability of prior counsel, it is the patent owner who would reasonably be expected to be in possession of any factual information pertinent to a question of prior invention under § 1.131. In view of the fact that the Rhodes '809 reference was first presented in a rejection on April 4, 2002, and that prosecution has afforded numerous opportunities for patent owner to enter revised/new claims and evidence submissions, including the extraordinary waiver permitting entry of § 1.131 evidence in November of 2009, patent owner is deemed to have had fair opportunity to enter the desired evidence. While a petition under § 1.182 may provide relief for an extraordinary situation otherwise not provided for in the rules, this "applies only where other rules are inapplicable and is not intended as a means for evading the requirements of other rules."[14] Patent owner may not now seek to evade or delay compliance with the requirements of § 1.131 through a petition under § 1.182. To the extent that patent owner's previous counsel's actions are relied upon to show a need for further opportunity for action by the patent owner, the previous counsel's actions are evidence that prior opportunities existed for entry of such evidence, and that patent owner, and/or owner's designated representative, chose not to take such opportunities.

Common sense and fairness would also recognize that all parties are entitled to rely upon the ordinary rules governing the course of a proceeding, which could not be expected to be delayed *ad infinitum* through continuous submissions of new evidence.[15] As pointed out, the question of fairness must also be considered with regard to the *inter partes* requester and the public, for whom resolution of the questions of patentability has been delayed due in part to extraordinary measures granted to patent owner to ensure that pertinent evidence be entered into the proceeding.

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[12] *Huston v. Ladner*, 973 F.2d 1564, 1566-67 (Fed. Cir. 1992).
[13] *Id.*
[14] *Hicks v. Costello*, 1903 Dec. Comm'r Pat 123, 125 (1903), 103 O.G. 1163 (December 23, 1902) (discussing Rule 213, which is the precursor of current 37 C.F.R. § 1.182),
[15] *See, e.g., In re Sivertz*, 227 USPQ 255 (July 23, 1985).

3. Summary

The above facts, while analyzed individually, have been evaluated in their totality to determine whether circumstances exist to justify granting reopening of prosecution to enter patent owner's desired evidence submission. As pointed out above, patent owner has been afforded fair opportunity to present any desired evidence, including evidence as to prior invention as desired in the instant petition.

Additionally, patent owner is concurrently seeking identical relief (e.g., to remove the Rhodes '809 patent as prior art through § 1.131 declarations) via such a petition seeking reconsideration of the decision denying relief under § 1.181, filed on February 22, 2011. As the relief for which patent owner seeks has been provided for elsewhere in the regulations, relief under § 1.182 would be inappropriate under the facts and circumstances of this proceeding.[16]

Therefore, the petition is granted to the extent that the previous decision has been reconsidered, but denied as to the underlying relief requested.

CONCLUSION

1. The petition requesting reconsideration of the December 22, 2010 decision is granted to the extent that the prior decision has been fully reconsidered, and is denied as to the underlying relief requested.

2. This decision may be viewed as a final agency action within the meaning of 5 U.S.C. § 704 for purposes of seeking judicial review upon entry of a final decision by the Board of Patent Appeals and Interferences. See MPEP 1002.02.

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

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

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

April 11, 2010
Kenpet/RCR/IP/

[16] Note that a situation which is covered by § 1.181 does not become "not provided for" merely because the § 1.181 petition is dismissed or denied by the Office.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,317	07/03/2002	6319526	01473.302800	9581

25763 7590 04/12/2011

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MINNEAPOLIS, MN 55402-1498

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/12/2011

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

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Date:

MAILED

APR 12 2011

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90006317
PATENT NO. : 6319526
ART UNIT : 3900

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

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,003	01/08/2002	6319526	01473.302300	4575

25763 7590 04/12/2011

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/12/2011

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Date:

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APR 12 2001

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000003
PATENT NO. : 6319526
TECHNOLOGY CENTER : 3999
ART UNIT : 3991

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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APR 12 2011

CENTRAL REEXAMINATION UN

DORSEY & WHITNEY LLP
INTELLECTUAL PROPERTY DEPARTMENT
SUITE 1500
50 SOUTH SIXTH STREET
MINNEAPOLIS MN 55402-1498

(For Patent Owner)

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(For Third Party Requester)

In re Dahlstrom et al.
Inter Partes Reexamination Proceeding
Control No. 95/000,003
Filed: January 8, 2002
For: U.S. Patent No. 6,319,526 B1

DECISION DENYING PETITION UNDER § 1.181

In re Dahlstrom et al.
Ex Parte Reexamination Proceeding
Control No. 90/006,317
Filed: July 3, 2002
For: U.S. Patent No. 6,319,526 B1

This is a decision on the February 22, 2011 patent owner petition entitled "PETITION UNDER 37 CFR § 1.181 REQUEST FOR RECONSIDERATION," which is being treated as a petition under 37 CFR 1.181(a)(3) requesting that the Director exercise his supervisory authority and overturn the December 22, 2010 decision of the Director of Technology Center 1600, who oversees the Central Reexamination Unit, which decision denied patent owner's request for entry and consideration of a declaration and supporting evidence submitted January 29, 2010.

On April 11, 2011, jurisdiction over the proceeding was transferred to the Office of Patent Legal Administration by the Board of Patent Appeals and Interferences for treatment of the February 22, 2011 patent owner petition. The patent owner petition is now before the Office of Patent Examination Policy for decision.

The petition to overturn the December 22, 2010 decision of the TC 1600 Director is granted to the extent that the previous decision has been reconsidered, and is **denied as to the underlying relief requested**.

PERTINENT BACKGROUND

1. On November 20, 2001, U.S. Patent No. 6,319,526 ("the '526 patent) was issued to Dahlstrom *et al.*, having 113 claims.

2. On January 8, 2002, a request for *inter partes* reexamination was filed by the third party requester, the real party in interest being Leprino Foods Company, and the resulting reexamination proceeding was assigned control number 95/000,003 ("the '003 proceeding").

3. On April 4, 2002, reexamination was ordered for claims 1-14, 16-33, 35-59, 61-69, 89-111, and 113 of the '526 patent. On the same date, an Office action was mailed, rejecting claims 1-14, 16-33, 35-39, 61-69, 89-111, and 113. In this Office action, U.S. Patent 6,120,809 to Rhodes ("Rhodes '809") was applied in anticipation rejections of claims 1-4, 7-14, 16-22, 25-29, 31, 32, 35, 36, 38, 40-48, 51, 62-69, 89-92, and 95-101; the Rhodes '809 patent was also applied in obviousness rejections of claims 5, 6, 10, 12-4, 23-25, 30, 33, 37, 39, 45-47, 49, 50, 52-59, 61, 65, 68, 89, 93, 94, 102-111, and 113.

4. On June 3, 2002, patent owner filed a response to the April 4, 2002 Office action, including amendments to claims 26, 36, 52, and 89, cancellation of claim 15, and addition of claims 114-163. The response included a discussion of the disclosure of the Rhodes '809 patent. Third party requester comments were filed on July 3, 2002.

5. On July 3, 2002, the same third party requester[1] filed a request for *ex parte* reexamination of claims 1-113 of the '526 patent, and the resulting reexamination proceeding was assigned control number 90/006,317 ("the '6317 proceeding").. Reexamination was ordered for the '6317 proceeding on August 20, 2002 for claims 1-14, 16-69, and 89-113 of the '526 patent.

6. On January 30, 2003, the Office merged the '003 and '6317 reexamination proceedings.

7. Prosecution continued, until on November 4, 2009, after an Examiner's Answer had been issued, the Office granted a petition filed August 31, 2009 for extraordinary relief under 37 C.F.R. § 1.183 to enter an accompanying declaration under § 1.131 by Clint Garoutte, "[b]ased on the facts and circumstances of the present case."

8. On December 17, 2009 an Action Closing Prosecution ("ACP") was mailed, in which the declaration under § 1.131 by Clint Garoutte was considered on the merits but found to be unpersuasive as to the establishment of invention prior to the Rhodes '809 reference. The

[1] *Ex parte* reexamination was requested "by Leprino Foods Company, through its attorneys," as stated in the June 3, 2002 request. *Inter partes* reexamination was likewise requested "by Leprino Foods Company, through its attorneys," as stated in the Jan. 8, 2002 request.

reexamination proceeding, which had been fully briefed by all parties and ready for docketing at the Board of Patent Appeals and Interferences prior to the November 4, 2009 decision, was reopened by this ACP.

9. On January 29, 2010, patent owner filed a response to the second ACP along with a declaration under § 1.131 signed by two of the three named inventors.

10. On January 29, 2010, patent owner again petitioned for extraordinary relief under 37 C.F.R. § 1.183. This petition requested relief from the requirements of § 1.131 declaration; in particular, to permit a party under § 1.47 to sign the declaration.[2] This petition was dismissed in a March 25, 2010 Office decision stating that extraordinary relief was not appropriate where an alternative relief; *i.e.*, submission of the § 1.131 declaration by the assignee, was available.[3]

11. On April 29, 2010, a Right of Appeal Notice was issued by the Office.[4] Claims 1-14, 16-103, 114-123, and 125-136 were listed as being under reexamination in the proceeding. All of the claims under reexamination in the proceeding were listed as being rejected. The Right of Appeal Notice refused entry, pursuant to CFR § 1.116(e), to the January 29, 2010 declaration under § 1.131 as failing to provide good and sufficient reason why that declaration was not earlier presented.

12. On May 24, 2010, patent owner filed petitions under § 1.181 and § 1.183 for the purpose of requesting entry of declarations, including that submitted on January 29, 2010, that had been refused entry in the Right of Appeal Notice of April 29, 2010. Patent owner's May 24, 2010 petition under § 1.183 was dismissed in an Office decision mailed on June 2, 2010.

13. On December 22, 2010, the Office issued decisions dismissing the November 5, 2010 petitions under §§ 1.182 and 1.183, and a decision denying the May 24, 2010 petition under § 1.181.

14. On February 22, 2011, patent owner filed the following papers:

    a. The instant petition requesting reconsideration of the denial of the December 22, 2010 decision denying the May 24, 2010 petition under § 1.181.
    b. A petition requesting reconsideration of the December 22, 2010 decision dismissing the November 5, 2010 petition under § 1.182.
    c. A petition requesting delaying of the appeal proceedings until the instant reconsideration petition has been acted upon.

---

[2] § 1.131 states that it may be submitted by either an inventor, the patent owner or a party qualified under § 1.47.

[3] § 1.131 states that it may be submitted by a patent owner.

[4] The lengthy prosecution of the merged reexamination proceeding from January 2003 through April 2010 included, *inter alia*, issuance of a NIRC and its subsequent withdrawal in 2006, revival of the proceeding in September 2008 subsequent to a late-filed patent owner appellant's brief, appeal and full briefing by the parties in 2008-2009, and the aforementioned reopening of prosecution in 2009. The full details are not included here, but may be found in pages 2-7 of the instant patent owner petition.

PERTINENT STATUTES AND REGULATIONS

35 U.S.C. § 314 provides, in pertinent part:

> (a) IN GENERAL. — Except as otherwise provided in this section, reexamination shall be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133. In any inter partes reexamination proceeding under this chapter, the patent owner shall be permitted to propose any amendment to the patent and a new claim or claims, except that no proposed amended or new claim enlarging the scope of the claims of the patent shall be permitted.
>
> .
> .
> .
>
> (c) SPECIAL DISPATCH. — Unless otherwise provided by the Director for good cause, all inter partes reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office.

37 C.F.R. § 1.116(e) provides:

> An affidavit or other evidence submitted after a final rejection or other final action (§ 1.113) in an application or in an *ex parte* reexamination filed under § 1.510, or an action closing prosecution (§ 1.949) in an *inter partes* reexamination filed under § 1.913 but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title), **may be admitted upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented**. (Emphasis added).

37 C.F.R. § 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)

DECISION

Petitioner (patent owner) seeks intervention by the Director to reverse the December 22, 2010 decision of the Technology Center (TC) Director of TC 1600, who oversees the CRU (which

decision denied patent owner's May 14, 2010 petition). Petitioner seeks this intervention on the grounds that the declaration and supporting evidentiary exhibits provided on January 29, 2009 were entitled to entry under the rules. Accordingly, petitioner seeks entry and consideration of the declaration and supporting exhibits submitted (January 29, 2010), after the issuance of the December 17, 2009 Action Closing Prosecution.

For the Director to intervene, petitioner must show that the December 22, 2010 decision by the TC 1600 Director was made in clear error. A petition under 37 CFR § 1.181, requesting that the Director of the USPTO exercise his or her supervisory authority and vacate the examiner's decision, will not be entertained except where there is a showing of clear error. See *Ex parte Hartley*, 1908 C.D. 224, 136 O.G. 1767 (Comm'r Pat. 1908). The TC 1600 Director's ultimate decision is entitled to an administrative presumption of correctness in the absence of a convincing showing of error. A review of the record indicates that the TC 1600 Director did not abuse her discretion, or act in an arbitrary and capricious manner, in the petition decision of December 22, 2010. The record establishes that the TC 1600 Director had a reasonable basis to support her findings and conclusion. Petitioner has therefore not provided a showing of clear error.

1. The January 29, 2010 Submission Was Properly Refused Entry

Patent owner is requesting evidence to be entered and considered after an action closing prosecution (ACP) in an *inter partes* reexamination proceeding. The rules of practice provide that such evidence "may be admitted upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented." Absent such a showing, the non-entry of such evidence is fully in accordance with the rules of practice.

Petitioner attempts to show that this declaration was submitted as early as possible by arguing that patent owner did not have the opportunity to file a § 1.131 declaration prior to August 2009 because the evidence was newly discovered at that time. Petitioner asserts that this was acknowledged by the Office via its grant of the petition under § 1.183 to enter that evidence. It is argued that, as a consequence of that asserted acknowledgment on the part of the Office, the filing of the new declaration in January 2010, in response to the Office action apprising patent owner of the deficiencies of the Garoutte declaration could not have been provided earlier. Petitioner asserts that any delay was therefore strictly attributable to the time that the Office used to review the Garoutte declaration.

The flaw in this line of reasoning is that, although the insufficiency of a response to an Office action may give rise to good and sufficient reason why a further response is needed, it does not provide good and sufficient reason as to why the better response was not provided in the first instance. This can be illustrated by considering the natural consequence of such reasoning. If an Office finding that a prior submission is not persuasive would amount to "good and sufficient reason," then 37 CFR § 1.116(e) would be a nullity, since the only time further evidence is adduced is where the examiner is maintaining a rejection of claims.[5]

[5] While there may be a rare exception in an *inter partes* reexamination to address requester rebuttal evidence or argument (even where the examiner finds the requester rebuttal evidence or argument insufficient to address patent

Patent owner provides no argument that would establish that the information and evidence supplied with the January 29, 2010 declaration could not have been supplied earlier. The prior entry of the "Garoutte" declaration (via the November 4, 2009 decision) through granting of extraordinary relief was based in part on patent owner's representations that the *existence of the documentary evidence was newly discovered at a late date despite extensive ongoing efforts to uncover any evidence*. However, in this instance, no evidence or argument is put forward to explain why the new declaration and the additional evidentiary exhibit could not have been provided earlier – *i.e.*, with the August 2009 submission.

The record is clear that patent owner has not provided good and sufficient reasons why the evidence was not presented earlier. The bulk of patent owner's arguments address reasons why the evidence is being submitted (*i.e.*, why it is believed to be "necessary") but does not address why the evidence was not presented ***earlier***. For the above reasons, the January 19, 2010 submission was properly refused entry.

2. The December 22, 2010 Decision Was Not In Error

Patent owner alleges error in the December 22, 2010 decision based upon the following: (1) review of the § 1.131 declaration (and supporting Exhibit Q) would not have constituted more than a nominal review; (2) the § 1.131 declaration could not have been earlier presented by former counsel; (3) the prior grant of a § 1.183 petition in November 2009 to enter a § 1.131 submission is inconsistent with not allowing the later filed § 1.131 submission to be entered (as the time delay was attributable to the Office reviewing the § 1.131 submission that was entered by that decision); and (4) fairness and equity dictate that the statutory requirement for "special dispatch" not trump substantive review of evidence.

With respect to the first allegation of error, patent owner's arguments directed to the amount of review the examiner would find necessary to evaluate the new declaration and evidence do not provide a reason as to why this evidence was not submitted earlier. It is however noted that this new declaration is not merely curing informalities such as an improper signature or failure to provide the hortatory language regarding loss of rights and 18 U.S.C. § 1001. The December 17, 2009 action closing prosecution (ACP) pointed out significant substantive evidentiary shortcomings in the "Garoutte" declaration that the January 19, 2010 declaration and evidence were provided to address. This would, by its very nature, require careful and detailed consideration by the examiner to determine whether the evidence taken in conjunction with the statements in the declaration is adequate to establish a date of invention that is earlier than the prior art date of the applied Rhodes reference. Regardless of the amount of review required, however, arguments directed to the necessary amount of review do not address the requirement under 37 CFR 1.116 that the "the affidavit or other evidence is necessary and was not earlier presented," and are thus not persuasive.

The second and third allegations of error relate to the timing aspects of the January 29, 2010

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owner's initial evidence, but patent owner wishes to enter further evidence as insurance *re* future review of the patent), 37 CFR 1.116(e) applies to *ex parte* applications and reexaminations, where there is never such an exception, and 37 CFR 1.116(e) must be interpreted in terms of all proceedings to which it applies.

submission. As explained below, these arguments do not show error in the TC 1600 Director's decision.

With respect to the second allegation of error, patent owner's argument - that previous counsel could not have presented this new declaration earlier because previous counsel thought the previously submitted "Garoutte" § 1.131 declaration was adequate and were not yet apprised of the insufficiency of the first submission - is not persuasive. Insofar as the Garoutte declaration was legally inadequate to establish prior invention, the misapprehension by previous counsel of what proof is required to establish prior invention by the named inventors does not redound to patent owner's benefit. As stated in *Link v. Wabash R. Co.*:[6]

> There is certainly no merit to the contention that dismissal of petitioner's claim because of his counsel's unexcused conduct imposes an unjust penalty on the client. Petitioner voluntarily chose this attorney as his representative in the action, and he cannot now avoid the consequences of the acts or omissions of this freely selected agent.

Moreover, in *Huston v. Ladner*, the Federal Circuit held that it was not an abuse of discretion for the Office to hold (in an *inter partes* proceeding) that the alleged negligence of applicant's original was not good cause to justify submitting additional evidence.[7] A "bad judgment, inexperience, or lack of competence" by an attorney in an interference proceeding was found to be properly chargeable to the patent applicant.[8]

For this reason, patent owner's argument - that patent owner is not accountable for the acts of prior counsel - is not persuasive.

With respect to the third allegation of error, patent owner's argument that the new submission was promptly presented in response to being informed of the shortcomings of the prior filing does not establish that the refusal to enter the submission was improper. As discussed above, although the insufficiency of a response to an Office action may gives rise to good and sufficient reason why a further response is needed, it does not provide good and sufficient reason as to why the better response was not provided in the first instance. No evidence or argument is put forward to explain why the new declaration and the additional evidentiary exhibit could not have been provided earlier – *i.e.*, with the August 2009 submission (for which prosecution was reopened). Therefore, patent owner's argument that the submission merits entry because it overcomes the shortcomings of the prior filing is not persuasive.

With respect to the fourth allegation of error, patent owner's arguments with respect to fairness, equity, and the loss of patent rights have no bearing on the determination of whether the examiner (and TC 1600 Director) acted correctly when refusing entry of the evidence after close of prosecution. Such considerations affect whether waiver of the rule or other relief should be granted and are considered under § 1.182 and/or § 1.183, and a companion petition to such effect has in fact been filed by patent owner.

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[6] *Link v. Wabash R. Co.*, 370 U.S. 626, 633-34 (1962).
[7] *Huston v. Ladner*, 973 F.2d 1564, 1566-67 (Fed. Cir. 1992).
[8] *Id.*

The consequences argued by patent owner, namely loss of patent rights, as supporting a finding of error in the previous decision denying relief under § 1.181 are merely general consequences of any rejection that is maintained. Such an argument fails because (a) it does not provide good and sufficient reasons why the evidence was not presented earlier, and (b) such a reading of the rule would result in evidence always being entered into the record for consideration – thus eviscerating the entire rule and creating a set of iterations (finding of evidence not persuasive followed by the next effort at providing a persuasive document) which would not be limited.

For the reasons set forth above, the record establishes that the TC 1600 Director had a reasonable basis to support her findings and conclusion. Petitioner has therefore not provided a showing of clear error. Therefore, the petition is granted to the extent that the previous decision has been reconsidered, but is **denied as to the underlying relief requested**.

CONCLUSION

1. The petition requesting reconsideration of the December 22, 2010 decision is granted only to the extent that the December 22, 2010 decision of the TC 1600 Director has been fully reconsidered, but is denied with respect to making any change therein. The petition is denied as to the underlying relief requested.

2. A review of the record indicates that the TC 1600 Director acted in accordance with stated Office policy in denying the petition of May 24, 2010.

3. This decision may be viewed as a final agency action within the meaning of 5 U.S.C. § 704 for purposes of seeking judicial review upon entry of a final decision by the Board of Patent Appeals and Interferences. See MPEP 1002.02.

4. A copy of this decision will be made of record in the reexamination file.

5. Any further correspondence with respect to this matter should be addressed as follows:

   By mail: Mail Stop
   Commissioner for Patents
   Post Office Box 1450
   Alexandria, VA 22313-1450

6. Telephone inquiries related to this decision should be directed to Pinchus M. Laufer, Senior Legal Advisor, at (571) 272-7726, or, in his absence, to Kenneth M. Schor, Senior Legal Advisor, at (571) 272-7710.

Robert W. Bahr
Senior Patent Counsel
Acting Associate Commissioner for
Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,317	07/03/2002	6319526	01473.302800	9581

25763 7590 04/13/2011

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/13/2011

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Inter Partes LEPRINO FOODS CO.
v.
LAND O' LAKES, INC.

Appeal 2011-005022
Reexamination Control No. 95/000,003 & 90/006,317
Patent No. 6,319,526
Technology Center 3900

DECISION ON PETITIONS

This is a decision on the "Petition under 37 C.F.R. § 1.183 for Request to Delay Appeal Proceedings before the Board until Patent Owner's 37 C.F.R. § 1.181 Petition for Reconsideration has been Acted Upon" of February 22, 2011 ("Petition #1") and a decision on the "Petition under 37 C.F.R. § 1.183 for Request to Delay Appeal Proceedings before the Board until Patent Owner's 37 C.F.R. § 1.182 Petition for Reconsideration has been Acted Upon" of February 22, 2011 ("Petition #2") in merged *Inter Partes* Reexamination Control No. 95/000,003 &

90/006,317. The petition fees of $400 pursuant to 37 C.F.R. §1.17(f) have been charged to petitioner's deposit account on February 22, 2011, for each petition.

A review of the record reveals that a decision on both the "Petition under 37 C.F.R. §1.181 For Request for Reconsideration" and the "Petition under 37 C.F.R. §1.182 For Request for Reconsideration" of February 22, 2011, was mailed on April 12, 2011. Upon the mailing of such petitions decisions, jurisdiction over this merged *Inter Partes* Reexamination proceeding immediately reverted back to the Board of Patent Appeals and Interferences. Since the petitions in question have been decided, Petitions #1 and #2 are **dismissed as moot.**

CONCLUSION

Petitions #1 and #2 are DISMISSED.

James T. Moore
Acting Chief Administrative Judge

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,541	02/07/2003	5806063	22058-00003-US	8322

7590 08/02/2010

EXAMINER	

ART UNIT	PAPER NUMBER

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DATE MAILED: 08/02/2010

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

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AUG 02 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/005,628, 90/005,592, 90/005,727, 90/006,541, 09/512,592

PATENT NO. 5806063.

ART UNIT 2161.

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

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

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AUG 02 2010

CENTRAL REEXAMINATION UNIT

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(For Third Party Requester '6541)

In re DICKENS
Reexamination Proceeding
Control No. 90/005,628
Request Deposited: February 6, 2000
For: U.S. Patent No. 5,806,063

In re DICKENS
Reexamination Proceeding
Control No. 90/005,727
Request Deposited: May 16, 2000
For: U.S. Patent No. 5,806,063

: DECISION
: DISSOLVING MERGED
: APPLICATION AND
: REEXAMINATION
: PROCEEDINGS

MAILED

AUG 02 2010

CENTRAL REEXAMINATION UNIT

In re DICKENS
Reexamination Proceeding
Control No. 90/006,541
Request Deposited: February 2, 2004
For: U.S. Patent No. 5,806,063

In re DICKENS
Reexamination Proceeding
Control No. 90/005,592
Request Deposited: December 21, 1999
For: U.S. Patent No. 5,806,063

In re Reissue Application of DICKENS
Serial No. 09/512,592
Filed: February 23, 2000
For: U.S. Patent No. 5,806,063

In a decision mailed March 12, 2004, the instant reexamination proceedings and then copending reissue application No. 09/512,592 were *sua sponte* merged. Under section III, "Conduct of the Merged Reissue Application Examination and Reexamination Proceedings", paragraph No. 5, it was stated that if the application/patent owner fails to file a timely and appropriate response to any Office action, the merged proceeding will be terminated as follows: The reissue application will be held abandoned, and the merger will be dissolved as to the reissue application. With respect to the four reexamination proceedings that will remain merged as one proceeding, the Commissioner will proceed to issue a reexamination certificate under § 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.

On June 11, 2010 a Notice of Abandonment was mailed by the Office in reissue application No. 09/512,592 for failure to timely a appropriately respond to the BPAI decision of March 29, 2010. Accordingly, in view of the abandonment of the reissue application and guidelines set forth in section III of the decision merging the reissue application with the four reexamination proceedings, the merger is hereby deemed dissolved.

Upon mailing of this decision, the reexamination proceedings will be forwarded to an examiner in the Central Reexamination Unit for the issuance of an appropriate action.

Any inquiry concerning this decision should be directed to Jessica Harrison, Supervisory Primary Examiner at telephone No. (571) 272-4449.

/J Harrison/

Jessica J. Harrison
Supervisory Patent Examiner, AU 3992
Central Reexamination Unit

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(For Patent Owner)

MAILED

NOV 05 20

CENTRAL REEXAMINATION UN.

In re Reissue Application of Robert Kling *et al.* Application No.: 10/875,090 Filed: June 24, 2004 For: U.S. Patent No. 5,855,574	: SUPPLEMENT TO : PRIOR DECISION : TO MERGE : REISSUE AND : REEXAMINATION
In re Robert Kling *et al.* Reexamination Proceeding Control No.: 90/006,782 Filed: September 24, 2003 For: U.S. Patent No.: 5,855,574	: PROCEEDINGS

This decision is supplemental to the Office's prior merger decision mailed July 21, 2005, which *sua sponte* merged reissue application No. 10/875,090 and reexamination control No. 90/006,782 into a single proceeding.

The above-identified prior merger decision continues to be in effect, and all further examination in the merged proceeding should continue to be conducted in accordance with the above-identified prior merger decision, except as it is supplemented by this decision – as follows:

If a request for continued examination (RCE) is filed under 37 CFR 1.114, as is permitted for the reissue application, then 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, a request for continued examination (RCE) is not available in the reexamination proceeding, and any response to the outstanding Office action (e.g., response to a final rejection) at that stage in the reexamination proceeding must be made taking into account the non-availability of RCE practice. Any failure to timely respond would result in the termination of the prosecution pursuant to 37 CFR 1.550(d).

In addition, if a final Office action should be issued subsequent to the mail date of this decision in this merged proceeding, any request for extension for time (to respond to any such subsequent final action) 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 Office action issued in the present merged proceeding

subsequent to the mail date of this decision.

The merged proceeding will otherwise continue as per the above-identified prior merger decision.

CONCLUSION

1. Reissue application No.10/875,090 and reexamination control No. 90/006,782 remain merged as a single proceeding.

2. 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, a request for continued examination (RCE) is not available in the reexamination proceeding, and any response to the outstanding Office action (e.g., response to a final rejection) at that stage in the reexamination proceeding must be made taking into account the non-availability of RCE practice. Any failure to timely respond would result in the termination of the prosecution pursuant to per 37 CFR 1.550(d).

3. In addition, if a final Office action should be issued in this merged proceeding subsequent to the mail date of this decision, then any request for extension for time (to respond to any such subsequent action) 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 Office action issued subsequent to the mail date of this decision.

4. All further examination in the merged proceeding is to continue to be conducted in accordance with the above-identified prior merger decision.

5. Telephone inquiries related to this decision should be directed to Colleen Dunn at (571) 272-1170, or in her absence to Eric Keasel at (571) 272-4929 or to Mark Reinhart at (571) 272-1611.

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

11/04/10

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DAVID R. KEMENY
BUCHANAN, INGERSOLL & ROONEY PC
POST OFFICE BOX 1404
ALEXANDRIA VA 22313-1404

(For Patent Owner)

MAILED

MAR 03 2011

CENTRAL REEXAMINATION UNIT

In re Kling *et al.*
Ex Parte Reexamination Proceeding
Control No.: 90/006,782
Filed: September 24, 2003
For: U.S. Patent No.: 5,855,574

In re Reissue Application of
Kling *et al.*
Control No.: 10/875,090
Filed: June 24, 2004
For: U.S. Patent No.: 5,855,574

: DECISION ON PETITION IN A MERGED REISSUE AND *EX PARTE* REEXAMINATION PROCEEDING

This is a decision on the January 4, 2011 patent owner petition, denominated "PETITION UNDER 37 CFR 1.183 CONCERNING MERGED REISSUE AND REEXAMINATION PROCEEDINGS," requesting the filing of a Request for Continued Reexamination (RCE) after final in a merged reissue-*ex parte* reexamination proceeding.

The petition is before the Office of Patent Legal Administration.

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

REVIEW OF THE FACTS

1. On January 5, 1999 the Office issued U.S. Patent No. 5,855,574 (the '574 patent) issued to Kling *et al.*

2. On September 24, 2003, a request for *ex parte* reexamination of all the claim of the '574 patent was filed by patent owner. The request was assigned control number 90/006,782 ("the '6782 proceeding).

3. On November 13, 2003, the Office issued an order granting reexamination in the '6782 proceeding of all the claims in the '574 patent. The Office action set a two-month period for filing a patent owner's statement.

4. On June 24, 2004, patent owner filed an application for reissue of the '574 patent, assigned application No. 10/875,090 (the '090 application).

5. On August 24, 2004, the Office published a notice of reissue of the '090 reissue application.

6. On July 21, 2005, the Office *sua sponte* issued a decision merging the '090 reissue application and the '6782 reexamination proceeding (the "merged proceeding").

7. Prosecution progressed to the point where, on September 14, 2010, the Office issued a final Office action allowing claims 1 and 16, but rejecting claims 3, 5, 10-24 and 26-29.

8. On November 14, 2010, the Office *sua sponte* issued a decision supplementing the July 21, 2005 merger decision stating that the filing of an RCE in a merged reissue-reexamination proceeding would result in the automatic severance of the merger and prosecution of the reissue application maybe suspended.

9. On November 30, 2010, patentee conducted an interview after final with the examiner of record.

10. On December 10, 2010, patentee filed an after final response, amending claims 3, 5, 18-24 and 28-29.

11. On December 17, 2010, the Office issued an advisory action indicating the December 10, 2010 after final response would not be entered as the amendments to the claims would require further search and/or consideration.

12. On January 4, 2011, patentee submitted the present petition denominated "PETITION UNDER 37 CFR 1.183 CONCERNING MERGED REISSUE AND REEXAMINATION PROCEEDINGS," requesting the filing of a RCE after final in a merged reissue-*ex parte* reexamination proceeding without the consequences set forth in the November 14, 2010 supplemental decision.

13. On February 16, 2011, patentee conducted a second interview after final with the examiner of record.

14. On February 18, 2011, patentee filed an after-final response consisting of a corrected supplemental reissue oath/declaration.

15. On February 23, 2011, the examiner of record entered the December 10, 2010 and February 18, 2011 after-final submissions.

16. On February 28, 2011, the Office issued a notice of allowance in the merged proceeding in response to the December 10, 2010 and February 18, 2011 after final submissions.

DECISION ON PETITION UNDER 37 CFR 1.183

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).

In the present petition, patentee requests that the Office suspend the consequences of filing an RCE in the present merged reissue-*ex parte* reexamination proceeding, which consequences were set forth in the November 14, 2010 supplemental merger decision. Patent owner asserts that the

issuance of the November 14, 2010 decision restricting the filing of RCEs in the present proceeding after the issuance of a final Office action is inequitable and creates an extraordinary situation where justice requires suspension of the rules.

Waiver of the rules under 37 CFR 1.183 may be suspended in an ***extraordinary situation when justice requires***.

As a result of the February 23, 2011 entry of the December 10, 2010 and February 18, 2011 after-final submissions, and the February 28, 2011 issuance of a notice of allowance in the merged proceeding (in response to the December 10, 2010 and February 18, 2011 after final submission), the specific facts and circumstances of the present proceeding do not present an ***extraordinary situation*** under 37 CFR 1.183, such that justice requires relief. There is no longer an outstanding final Office action (requiring response) in the merged proceeding, while the relief requested was based on the existence of an outstanding final Office action. Accordingly the present petition is DISMISSED.

CONCLUSION

1. The petition is **dismissed**.

2. Telephone inquiries related to this decision should be directed to Joseph F. Weiss, Jr., Legal Advisor, at (571) 272-7759, or in his absence Pinchus M. Laufer, Senior Legal Advisor, at 571-272-7726.

/Kenneth M. Schor/

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,868	11/17/2003	6481433	202170-0481	7381

1131 7590 11/05/2010

MICHAEL BEST & FRIEDRICH LLP
Two Prudential Plaza
180 North Stetson Avenue, Suite 2000
CHICAGO, IL 60601

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 11/05/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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P.O.Box 1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
JOHN S. MORTIMER
WOOD, PHILLIPS, KATZ, CLARK & MORTIMER
500 WEST MADISON STREET, SUITE 3800
CHICAGO, IL 60661-2511

Date: MAILED

NOV 05 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90006868 ; 10/991,326
PATENT NO. : 6481433
ART UNIT : 3993

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

JOHN S. MORTIMER
WOOD, PHILLIPS, KATZ, CLARK & MORTIMER
500 WEST MADISON STREET, SUITE 3800
CHICAGO, IL 60661-2511

Date:

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90006868 ; 10/991,326
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Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the ex parte reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

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Michael Best & Friedrich LLP
Two Prudential Plaza
180 North Stetson Avenue, Suite 2000
Chicago, IL 60601

(For Patent Owner)

MAILED

NOV 05 2010

CENTRAL REEXAMINATION UNIT

John S. Mortimer
Wood, Phillips, Katz, Clark & Mortimer
500 West Street, Suite 3800
Chicago, IL 60661/2511

(For Third Party Requester)

In re Reissue Application of
William S. Schjerven Sr. *et al.*
Application No.: 10/991,326
Filed: November 17, 2004
For: U.S. Patent No. 6,481,433

In re William S. Schjerven Sr. *et al.*
Reexamination Proceeding
Control No.: 90/006,868
Filed: November 17, 2003
For: U.S. Patent No.: 6,481,433

: SUPPLEMENT TO
: PRIOR DECISION
: TO MERGE
: REISSUE AND
: REEXAMINATION
: PROCEEDINGS

This decision is supplemental to the Office's prior merger decision mailed June 20, 2005, which *sua sponte* merged reissue application No.10/991,326 and reexamination control No. 90/006,868 into a single proceeding.

The above-identified prior merger decision continues to be in effect, and all further examination in the merged proceeding should continue to be conducted in accordance with the above-identified prior merger decision, except as it is supplemented by this decision – as follows:

If a request for continued examination (RCE) is filed under 37 CFR 1.114, as is permitted for the reissue application, then 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, a request for continued examination (RCE) is not available in the reexamination proceeding, and any response to the outstanding Office action (e.g., response to a final rejection) at that stage in the reexamination proceeding must be

made taking into account the non-availability of RCE practice. Any failure to timely respond would result in the termination of the prosecution pursuant to 37 CFR 1.550(d).

In addition, if a final Office action should be issued subsequent to the mail date of this decision in this merged proceeding, any request for extension for time (to respond to any such subsequent final action) 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 Office action issued in the present merged proceeding subsequent to the mail date of this decision.

The merged proceeding will otherwise continue as per the above-identified prior merger decision.

CONCLUSION

1. Reissue application No. 10/991,326 and reexamination control No. 90/006,868 remain merged as a single proceeding.

2. 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, a request for continued examination (RCE) is not available in the reexamination proceeding, and any response to the outstanding Office action (e.g., response to a final rejection) at that stage in the reexamination proceeding must be made taking into account the non-availability of RCE practice. Any failure to timely respond would result in the termination of the prosecution pursuant to per 37 CFR 1.550(d).

3. In addition, if a final Office action should be issued in this merged proceeding subsequent to the mail date of this decision, then any request for extension for time (to respond to any such subsequent action) 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 Office action issued subsequent to the mail date of this decision.

4. All further examination in the merged proceeding is to continue to be conducted in accordance with the above-identified prior merger decision.

5. Telephone inquiries related to this decision should be directed to Colleen Dunn at (571) 272-1170, or in her absence to Eric Keasel at (571) 272-4929 or to Mark Reinhart at (571) 272-1611.

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

11/04/10

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,953	02/27/2004	6455275		7971

7590 11/05/2010

EXAMINER	
ART UNIT	PAPER NUMBER

John P. White
Cooper & Dunham LLP
1185 Sixth Avenue
New York, NY 10036

DATE MAILED: 11/05/2010

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
Daniel B. Ravicher, Executive Director
Public Patent Foundation
1375 Broadway, Suite 600
New York, NY 10018

Date:
MAILED
NOV 05 2010
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90006953
PATENT NO. : 6455275
ART UNIT : 3900

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

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/870,229	06/18/2004	Richard Axel	17668-A7-B	1533

23432 7590 11/05/2010

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

EXAMINER
QIAN, CELINE X

ART UNIT	PAPER NUMBER
1636	

MAIL DATE	DELIVERY MODE
11/05/2010	PAPER

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

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

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John P. White
Cooper & Dunham LLP
30 Rockefeller Plaza
20th Floor
New York, NY 10112

(For Patent Owner)

MAILED

NOV 0 5 2010

CENTRAL REEXAMINATION UNIT

Daniel B. Ravicher
Public Patent Foundation, Inc.
1375 Broadway, Suite 600
New York, NY 10018

(For Third Party Requester)

In re Reissue Application of
Richard Axel, *et al.*
Application No.: 10/870,229
Filed: June 18, 2004
For: U.S. Patent No. 6,455,275

In re Richard Axel, *et al.*
Reexamination Proceeding
Control No.: 90/006,953
Filed: February 27, 2004
For: U.S. Patent No.: 6,455,275

: SUPPLEMENT TO
: PRIOR DECISION
: TO MERGE
: REISSUE AND
: REEXAMINATION
: PROCEEDINGS

This decision is supplemental to the Office's prior merger decision mailed January 12, 2005, which *sua sponte* merged reissue application No. 10/870,229 and reexamination control No. 90/006,953 into a single proceeding.

The above-identified prior merger decision continues to be in effect, and all further examination in the merged proceeding should continue to be conducted in accordance with the above-identified prior merger decision, except as it is supplemented by this decision – as follows:

If a request for continued examination (RCE) is filed under 37 CFR 1.114, as is permitted for the reissue application, then 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, a request for continued examination (RCE) is not available in the reexamination proceeding, and any response to the outstanding Office action (e.g.,

response to a final rejection) at that stage in the reexamination proceeding must be made taking into account the non-availability of RCE practice. Any failure to timely respond would result in the termination of the prosecution pursuant to 37 CFR 1.550(d).

In addition, if a final Office action should be issued subsequent to the mail date of this decision in this merged proceeding, any request for extension for time (to respond to any such subsequent final action) 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 Office action issued in the present merged proceeding subsequent to the mail date of this decision.

The merged proceeding will otherwise continue as per the above-identified prior merger decision.

CONCLUSION

1. Reissue application No. 10/870,229 and reexamination control No. 90/006,953 remain merged as a single proceeding.

2. 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, a request for continued examination (RCE) is not available in the reexamination proceeding, and any response to the outstanding Office action (e.g., response to a final rejection) at that stage in the reexamination proceeding must be made taking into account the non-availability of RCE practice. Any failure to timely respond would result in the termination of the prosecution pursuant to per 37 CFR 1.550(d).

3. In addition, if a final Office action should be issued in this merged proceeding subsequent to the mail date of this decision, then any request for extension for time (to respond to any such subsequent action) 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 Office action issued subsequent to the mail date of this decision.

4. All further examination in the merged proceeding is to continue to be conducted in accordance with the above-identified prior merger decision.

5. Telephone inquiries related to this decision should be directed to Colleen Dunn at (571) 272-1170, or in her absence to Eric Keasel at (571) 272-4929 or to Mark Reinhart at (571) 272-1611.

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.
90/006,984	03/29/2004	6202051	2043.566UX3	6698

49845 7590 09/28/2010

SCHWEGMAN, LUNDBERG & WOESSNER/EBAY
P.O. BOX 2938
MINNEAPOLIS, MN 55402

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 09/28/2010

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,362	04/03/2007	6,202,051	2043.566UX4	7252

49845 7590 09/28/2010

SCHWEGMAN, LUNDBERG & WOESSNER/EBAY
P.O. BOX 2938
MINNEAPOLIS, MN 55402

EXAMINER	
ART UNIT	PAPER NUMBER

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Schwegman, Kundberg & Woessner/EBAY
PO Box 2938
Minneapolis, MN 55402

(Requester, now Patent Owner)

MAILED

SEP 28 2010

CENTRAL REEXAMINATION UNIT

In re Woolston	:
Reexamination Proceeding	: DECISION *SUA SPONTE*
Control No. 90/006,984	: MERGING
Filed: March 29, 2004	: REEXAMINATION
For: U.S. Patent No. 6,202,051	: PROCEEDINGS
In re Woolston	:
Reexamination Proceeding	:
Control No. 90/008,362	:
Filed: April 7, 2007	:
For: U.S. Patent No. 6,202,051	:

The above identified *ex parte* reexamination files are before the Central Reexamination Unit for consideration of merger of proceedings under 37 CFR 1.565(c).

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,202,051 (hereinafter, the '051 patent), issued to Woolston, on March 13, 2001.

2. On March 29, 2004, a third party deposited a request for *ex parte* reexamination of the '051 patent. The reexamination proceeding was assigned Control No. 90/006,984 (hereinafter, the '6984 proceeding).

3. The Reexamination Order was granted in the '6984 proceeding on April 28, 2004 finding a substantial new question of patentability (SNQP) as to claims 1-52.

4. A Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) was mailed on August 31, 2007 (in the '6984 proceeding) confirming the patentability of claims 13, 33-35, and 52 (claims 1-12, 14-32, and 36-51 were cancelled).

5. On April 3, 2007, a third party requester deposited a Request for ex *parte* Reexamination of the '051 patent. The reexamination proceeding was assigned Control No. 90/008,362 (hereinafter, the '8362 proceeding).

6. The Reexamination Order was granted in the '8362 proceeding on June 28, 2007 finding a substantial new question of patentability (SNQP) as to claims 13, 33-35, and 52.

7. A NIRC was mailed on August 31, 2007 (in the '8362 proceeding) confirming the patentability of claims 13, 33-35, and 52 (claims 1-12, 14-32, and 36-51 were cancelled).

8. On December 18, 2009, Patent Owner filed a paper entitled "PETITION UNDER 37 C.F.R. §1.182" in the '6984 proceeding with an admission that claims 13 and 33-35 were unpatentable. The paper also included an amendment to claims 13 and 33 (claims 34 and 35 are dependent on claim 33).

9. On February 5, 2010, Patent Owner filed a paper entitled "PETITION UNDER 37 C.F.R. §1.182" in the '8362 proceeding with an admission that claims 13 and 33-35 were unpatentable. The paper also included an amendment to claims 13 and 33 (claims 34 and 35 are dependent on claim 33).

DECISION

Under 37 C.F.R. § 1.565(c):

> If *ex parte* reexamination is ordered while a prior *ex parte* reexamination proceeding is pending and prosecution in the prior *ex parte* reexamination has not been terminated, the *ex parte* reexamination proceedings will be consolidated and result in the issuance of a single certificate of a single certificate under § 1.570.

As noted in the above noted facts, reexamination has been ordered in both of the above-identified reexamination proceedings. Accordingly, merger of the proceedings under § 1.565(c) is appropriate.

I. Merger of Proceedings.

The NIRCs are withdrawn in the '6984 and '8362 proceedings.

In accordance with 37 C.F.R. § 1.565(c), the '6984 and '8362 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Proceedings.

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

III. Conduct of Merged Proceeding.

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

The amendments filed on December 18, 2009 in the '6984 proceeding and filed February 5, 2010 in the '8362 proceeding are entered. The merged proceeding is forwarded to the examiner for action not inconsistent with this decision.

CONCLUSION

1. Reexamination Control Nos. 90/006,984 and 90/008,362 are MERGED.

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

Eric Keasel
SPE, AU 3992

UNITED STATES PATENT AND TRADEMARK OFFICE

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Address: COMMISSIONER FOR PATENTS
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,984	03/29/2004	6202051	2043.566UX3	6698

49845 7590 09/28/2010

SCHWEGMAN, LUNDBERG & WOESSNER/EBAY
P.O. BOX 2938
MINNEAPOLIS, MN 55402

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 09/28/2010

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,362	04/03/2007	6,202,051	2043.566UX4	7252

49845 7590 09/28/2010

SCHWEGMAN, LUNDBERG & WOESSNER/EBAY
P.O. BOX 2938
MINNEAPOLIS, MN 55402

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 09/28/2010

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

Schwegman, Kundberg & Woessner/EBAY
PO Box 2938
Minneapolis, MN 55402

(Requester, now Patent Owner)

MAILED

SEP 2 8 2010

CENTRAL REEXAMINATION UNIT

In re Woolston
Reexamination Proceeding
Control No. 90/006,984
Filed: March 29, 2004
For: U.S. Patent No. 6,202,051

: DECISION
: ON § 1.182
: PETITIONS

In re Woolston
Reexamination Proceeding
Control No. 90/008,362
Filed: April 3, 2007
For: U.S. Patent No. 6,202,051

The above identified *ex parte* reexamination files are before the Office of Patent Legal Administration (OPLA) for consideration - a petition paper entitled "PETITION UNDER 37 C.F.R. § 1.182" in control number 90/006,984 and a petition paper entitled "PETITION UNDER 37 C.F.R. § 1.182" in control number 90/008,362.

The petitions are dismissed as moot. The petition is granted, however, to the extent that two proceedings will be addressed as a merged proceeding by the Central Reexamination Unit.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,202,051 (hereinafter, the '051 patent), issued to Woolston, on March 13, 2001.

2. On March 29, 2004, a third party filed a request for *ex parte* reexamination of the '051 patent. The reexamination proceeding was assigned Control No. 90/006,984 (hereinafter, the '6984 proceeding).

3. The reexamination request was granted for the '6984 proceeding on April 28, 2004, finding a substantial new question of patentability (SNQ) as to claims 1-52.

4. A Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) was mailed on August 31, 2007 (in the '6984 proceeding), confirming the patentability of claims 13, 33-35, and 52 (claims 1-12, 14-32, and 36-51 were cancelled).

5. On April 3, 2007, a third party requester deposited a Request for ex *parte* Reexamination of the '051 patent. The reexamination proceeding was assigned Control No. 90/008,362 (hereinafter, the '8362 proceeding).

6. The reexamination request was granted for the '8362 proceeding on June 28, 2007, finding a substantial new question of patentability (SNQ) as to claims 13, 33-35, and 52.

7. A NIRC was mailed on August 31, 2007 (in the '8362 proceeding), confirming the patentability of claims 13, 33-35, and 52 (claims 1-12, 14-32, and 36-51 were cancelled).

8. On December 18, 2009, Patent Owner filed a paper entitled "PETITION UNDER 37 C.F.R. §1.182" in the '6984 proceeding with an admission that claims 13 and 33-35 were unpatentable. The paper also included an amendment to claims 13 and 33 (claims 34 and 35 are dependent on claim 33).

9. On February 5, 2010, Patent Owner filed a paper entitled "PETITION UNDER 37 C.F.R. §1.182" in the '8362 proceeding with an admission that claims 13 and 33-35 were unpatentable. The paper also included an amendment to claims 13 and 33 (claims 34 and 35 are dependent on claim 33).

10. On September 28, 2010, the '6984 and '8362 proceedings were merged, the amendments filed on December 18, 2009, in the '6984 proceeding, and filed on February 5, 2010, in the '8362 proceeding, were entered, and an Office action was mailed.

DECISION

In view of the above merger, entry, and treatment of the amendments by the Central Reexamination Unit, the December 18, 2009 petition entitled "PETITION UNDER 37 C.F.R. §1.182" in the '6984 proceeding and the February 5, 2010 petition entitled "PETITION UNDER 37 C.F.R. §1.182" in the '8362 proceeding are dismissed as moot. The petition is granted, however, to the extent that two proceedings will be addressed as a merged proceeding by the Central Reexamination Unit.

CONCLUSION

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

/Kenneth M Schor/

Kenneth M Schor
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

9-28-10
Kenfinal+ACP –after it

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,984	03/29/2004	6202051	2043.566UX3	6698

49845 7590 09/28/2010

SCHWEGMAN, LUNDBERG & WOESSNER/EBAY
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MINNEAPOLIS, MN 55402

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,362	04/03/2007	6,202,051	2043.566UX4	7252

49845 7590 09/28/2010

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PO Box 2938
Minneapolis, MN 55402

(Requester, now Patent Owner)

MAILED

SEP 2 8 2010

CENTRAL REEXAMINATION UNIT

In re Woolston
Reexamination Proceeding
Control No. 90/006,984
Filed: March 29, 2004
For: U.S. Patent No. 6,202,051

: DECISION
: ON § 1.182
: PETITIONS

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The petitions are dismissed as moot. The petition is granted, however, to the extent that two proceedings will be addressed as a merged proceeding by the Central Reexamination Unit.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,202,051 (hereinafter, the '051 patent), issued to Woolston, on March 13, 2001.

2. On March 29, 2004, a third party filed a request for *ex parte* reexamination of the '051 patent. The reexamination proceeding was assigned Control No. 90/006,984 (hereinafter, the '6984 proceeding).

3. The reexamination request was granted for the '6984 proceeding on April 28, 2004, finding a substantial new question of patentability (SNQ) as to claims 1-52.

4. A Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) was mailed on August 31, 2007 (in the '6984 proceeding), confirming the patentability of claims 13, 33-35, and 52 (claims 1-12, 14-32, and 36-51 were cancelled).

5. On April 3, 2007, a third party requester deposited a Request for ex *parte* Reexamination of the '051 patent. The reexamination proceeding was assigned Control No. 90/008,362 (hereinafter, the '8362 proceeding).

6. The reexamination request was granted for the '8362 proceeding on June 28, 2007, finding a substantial new question of patentability (SNQ) as to claims 13, 33-35, and 52.

7. A NIRC was mailed on August 31, 2007 (in the '8362 proceeding), confirming the patentability of claims 13, 33-35, and 52 (claims 1-12, 14-32, and 36-51 were cancelled).

8. On December 18, 2009, Patent Owner filed a paper entitled "PETITION UNDER 37 C.F.R. §1.182" in the '6984 proceeding with an admission that claims 13 and 33-35 were unpatentable. The paper also included an amendment to claims 13 and 33 (claims 34 and 35 are dependent on claim 33).

9. On February 5, 2010, Patent Owner filed a paper entitled "PETITION UNDER 37 C.F.R. §1.182" in the '8362 proceeding with an admission that claims 13 and 33-35 were unpatentable. The paper also included an amendment to claims 13 and 33 (claims 34 and 35 are dependent on claim 33).

10. On September 28, 2010, the '6984 and '8362 proceedings were merged, the amendments filed on December 18, 2009, in the '6984 proceeding, and filed on February 5, 2010, in the '8362 proceeding, were entered, and an Office action was mailed.

DECISION

In view of the above merger, entry, and treatment of the amendments by the Central Reexamination Unit, the December 18, 2009 petition entitled "PETITION UNDER 37 C.F.R. §1.182" in the '6984 proceeding and the February 5, 2010 petition entitled "PETITION UNDER 37 C.F.R. §1.182" in the '8362 proceeding are dismissed as moot. The petition is granted, however, to the extent that two proceedings will be addressed as a merged proceeding by the Central Reexamination Unit.

CONCLUSION

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

/Kenneth M Schor/

Kenneth M Schor
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,233	10/04/2004	6422413	95255.2	5925

7590 02/25/2011

WILLIAM A. HALL
2174 LAKE YSABEL ROAD
TEMPLETON, CA 93465

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 02/25/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
Michael J. Colitz, III
Holland & Knight LLP
Suite 4100, 100 N. Tampa Street
Tampa, FL 33602-3644

Date: MAILED

FEB 25 2011

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90007233
PATENT NO. : 6422413
ART UNIT : 3900

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

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

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MAILED

FEB 25 2011

CENTRAL REEXAMINATION UNIT

William A. Hall
2174 Lake Ysabel Road
Templeton, CA 93465

(For Patent Owner)

Michael J. Colitz, III
Holland & Knight LLP
Suite 4100, 100 N. Tampa Street
Tampa, FL 33602-3644

(For Third Party Requester)

In re Hall et al.
Reexamination Proceeding
Control No. : 90/007,233
Filed: October 4, 2004
Patent No. 6,422,413

: **DECISION**
: **ON**
: **PETITION**
:
:

This is a decision addressing patent owner's petition, filed June 1, 2009, to reinstate an amendment dated October 8, 2008, which is being treated as a petition requesting supervisory review of the examiner's decision not to enter the amendment of October 8, 2008, as set forth in an advisory action mailed March 23, 2009.

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

SUMMARY

Patent owner's petition is DISMISSED as untimely for the reasons set forth below, without consideration of the merits.

BRIEF STATEMENT OF RELEVANT FACTS

1. Patent No. 6,422,413 (the '413 patent) issued on July 23, 2002.

2. A request for reexamination, assigned Control No. 90/007,233 (the '233 proceeding), was filed by a third party Requester on October 4, 2004.

3. Reexamination was ordered in the '233 reexamination proceeding on December 6, 2004.

4. A non-final Office action on the merits was mailed on September 19, 2005.

5. A second non-final Office was mailed on July 28, 2006.

6. A final Office action was mailed on October 20, 2006.

7. An advisory action was mailed on December 21, 2006.

8. Patent owner filed a notice of appeal on January 11, 2007. A first appeal brief was filed on March 8, 2007 and a second, replacement appeal brief was filed on October 24, 2007.

9. An examiner's answer was mailed on September 5, 2008.

10. On October 24, 2008, patent owner filed an amendment.

11. On November 3, 2008, patent owner filed a reply brief.

11. On March 23, 2009, a second advisory action was mailed. In the advisory action, the examiner stated that the amendment filed October 24, 2008 would not be entered because it was not limited to canceling claims or rewriting dependent claims into independent form pursuant to 37 CFR 41.33(b) and (c).

12. On May 20, 2009, the Board of Patent Appeal and Interferences (BPAI) returned the appeal to the examiner for correction. Specifically, the BPAI noted that the appeal brief filed October 24, 2007 1) did not separately map independent claim 53 to the specification and 2) contained a claims appendix that was not in proper format. The BPAI also noted that the examiner's answer mailed September 5, 2008 1) did not include the Jackson reference in the "Evidence Relied Upon" section and 2) lacked a "Related Proceedings Appendix." The BPAI also noted that the reply brief filed November 3, 2008 should not have been entered because it was signed by an attorney not authorized to sign it.

13. On June 1, 2009, patent owner filed the instant petition.

DISCUSSION

Patent owner requests supervisory review of the examiner's action in issuing the advisory action mailed March 23, 2009. The petitioner argues that the subject matter of the interview regarding claim limitations was and is incorporated in the amendment dated October 23, 2008.

The request to review the advisory action of March 23, 2009 is dismissed as untimely.

STATEMENT OF RELEVANT AUTHORITY

37 CFR 1.181(f) states:

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

DECISION

The petitioner brings before the Office a petition under 37 CFR § 1.181 to review the advisory action of March 23, 2009. The petitioner filed the petition on June 1, 2009. The action from which relief is requested is the advisory action which was mailed on March 23, 2009. Therefore, the petition was filed over **two** months from the mailing date of the action from which relief is requested. As quoted above, 37 CFR 1.181(f) requires petitions under that section be filed within **two** months from the mailing date of the action from which relief is requested and that such time period is not extendable.

Therefore, the petition is dismissed as untimely because it was not filed within the two month time period required by 37 CFR 1.181(f).

In other words, this petition is untimely to request relief from the examiner's actions in the advisory action. It is noted that even if this petition was deemed timely filed, the grounds of argument presented in the petition only address the merits of the examiner's determinations, which are appealable (and not petitionable) issues. See MPEP 1201 and 1002. Specifically, the issues of claim interpretation and application of the prior art to the claims are appealable issues, and therefore, cannot be addressed by petitions.

CONCLUSION

1. Patent Owner's petition under 37 CFR 1.181, filed June 1, 2009, is **dismissed** as untimely for the reasons discussed above.

2. The present *ex parte* reexamination proceeding is being forwarded to the examiner for further consideration on the merits.

3. Telephone inquiries related to this decision should be directed to Andy Kashnikow, Supervisory Patent Examiner, at (571) 272-4361.

Irem Yucel
Director
Technology Center 1600

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,383	01/18/2005	6622570		2869

34142 7590 02/17/2012

GALLAGHER & DAWSEY CO., L.P.A.
P.O. BOX 785
COLUMBUS, OH 43216

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 02/17/2012

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

Terry Jacobs
Ecoroll Corporation Tool Technology
502 Technecenter Dr., Suite C
Milford, OH 45150

Date: MAILED

FEB 17 2012

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90007383
PATENT NO. : 6622570
ART UNIT : 2800

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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FEB 17 2012

CENTRAL REEXAMINATION UNIT

Gallagher & Dawsey Co., L.P.A.
P.O. Box 785
Columbus, OH 43216

(For patent owner)

Terry Jacobs
Ecoroll Corporation Tool Technology
502 Technecenter Dr.
Suite C
Milford, OH 45150

(For third party requester)

In re Paul S. Prevey, III
Ex Parte Reexamination Proceeding
Control No. 90/007,383
Filed: January 18, 2005
For: U.S. Patent No. 6,622,570

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

This is a decision on the September 2, 2011 patent owner petition under 37 CFR 1.137(a) to accept an unavoidably delayed Notice of Appeal and revive the present terminated reexamination ("the September 2, 2011 patent owner petition to revive").

The September 2, 2011 patent owner petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The September 2, 2011 patent owner petition to revive is **dismissed**.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

35 U.S.C. 133 provides:

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

35 U.S.C. 305 provides, in pertinent part:

> After the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title.

37 CFR 1.137 provides, in pertinent part:

> (a) *Unavoidable.* If the delay in reply by ... patent owner was unavoidable, 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(l);
> (3) A showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable ....
>
> *****
>
> (d) *Terminal disclaimer.*
> (1) ***
> (2) ***
> (3) The provisions of paragraph (d)(1) of this section do not apply to ... reexamination proceedings.

37 CFR 1.550 provides, in pertinent part:

> (d) If the patent owner fails to file a timely and appropriate response to any Office action or any written statement of an interview required under § 1.560(b), the prosecution in the *ex parte* reexamination proceeding will be a terminated prosecution, and the Director will proceed to issue and publish a certificate concluding the reexamination proceeding under § 1.570 in accordance with the last action of the Office.
>
> (e) If a response by the patent owner is not timely filed in the Office,
> (1) The delay in filing such response may be excused if it is shown to the satisfaction of the Director that the delay was unavoidable; a petition to accept an unavoidably delayed response must be filed in compliance with § 1.137(a) ....

MPEP 2268 provides, in pertinent part:

> I. PETITION BASED ON UNAVOIDABLE DELAY
>
> The unavoidable delay provisions of 35 U.S.C. 133 are imported into, and are applicable to, *ex parte* reexamination proceedings by 35 U.S.C. 305. See *In re Katrapat*, 6 USPQ2d

1863 (Comm'r Pat. 1988). Accordingly, the Office will consider, in appropriate circumstances, a petition showing unavoidable delay under 37 CFR 1.137(a) where untimely papers are filed subsequent to the order for reexamination. Any such petition must provide an adequate showing of the cause of unavoidable delay, including the details of the circumstances surrounding the unavoidable delay and evidence to support the showing. Additionally, the petition must be accompanied by the petition fee set forth in 37 CFR 1.17(l) and a proposed response to continue prosecution (unless it has been previously filed).

*****

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(a) is Dismissed

Ex Parte Reexamination Certificate No. C1 6,622,570 issued for the present proceeding on September 16, 2008. The present petition under 37 CFR 1.137(a) to accept an unavoidably delayed Notice of Appeal and revive the present terminated reexamination was filed by patent owner on September 2, 2011.

37 CFR 1.181(f) states, in pertinent part:

> (f) ... Any petition under **this part** not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable. [Emphasis added.]

The time-frame in § 1.181(f) is not only applicable to matters that seek to invoke supervisory authority of the Director under § 1.181(a)(3), but is also inclusive of petitions § 1.137 for revival which are petitions under part 1 of Chapter I, Subchapter A, of Title 37 of the Code of Federal Regulations. Such petitions include § 1.137 petitions for unavoidable delay filed after issuance of reexamination certificates.

In view of the Office's mandate under 35 U.S.C. 305 for "special dispatch" in carrying out reexamination proceedings, Office practice is to insist that all petitions for unavoidable revival filed after issuance of a reexamination certificate be submitted within two months of the certificate, which certificate is the action from which relief is being requested – absent a grantable petition under 37 CFR 1.183 which must state the

details as to the delay in filing a revival petition that establish an extraordinary situation when justice requires waiver of the two-month period.

Under the time limit established by 37 CFR 1.181(f), any petition requesting relief from the September 16, 2008 certificate was due in the '7383 reexamination proceeding on or before November 16, 2008. The present petition was not filed in the '7383 reexamination proceeding until September 2, 2011, and was not accompanied by a grantable petition under 37 CFR 1.183 stating the details as to the delay in filing the petition that establish an extraordinary situation for which justice requires waiver of the two-month period. Therefore, the September 2, 2011 petition to revive is untimely.

Accordingly, the September 2, 2011 patent owner petition to accept an unavoidably delayed Notice of Appeal is **dismissed**.

LACK OF PROOF OF SERVICE

37 CFR 1.550(f) provides, in pertinent part:

> After filing of a request for *ex parte* reexamination by a third party requester, any document filed by either the patent owner or the third party requester must be served on the other party in the reexamination proceeding in the manner provided by § 1.248. **The document must reflect service or the document may be refused consideration by the Office.** [Emphasis added.]

A review of the instant petition shows that it was accompanied by the following papers: (i) a Transmittal Form, PTO/SB/21; (ii) a Fee Transmittal, PTO/SB/17; and (iii) a Notice of Appeal, PTO/SB/31. However, the requisite proof of service (of the instant petition) by the patent owner on the third party requester was not included with the present petition.

As pointed out in MPEP § 2266.03:

> Any paper filed with the Office, i.e., any submission made, in a third party requested reexamination by either the patent owner or the third party requester, must be served on every other party in the reexamination proceeding.
>
> **As proof of service, the party submitting the paper to the Office must attach a certificate of service to the paper.** It is required that the name and address of the party served, and the method of service be set forth in the certificate of service. Further, a copy of the certificate of service must be attached with the copy of the paper that is served on the other party. [Emphasis added.]

A certificate of service pursuant to MPEP § 2266.03 has not been found attached to the instant petition.

Accordingly, the copy of the petition submitted by the patent owner is being forwarded to the third party requester together with all attachments thereto. Any future communications filed by the patent owner in the present reexamination proceeding must include proof of service on the third party requester pursuant to 37 CFR 1.550(f).

CONCLUSION

1. The September 2, 2011 patent owner petition to revive under 37 CFR 1.137(a) is **dismissed**.

2. Any inquiry concerning this decision should be directed to the undersigned at (571) 272-7728.

Raul Tamayo
Legal Advisor
Office of Patent Legal Administration

02-16-2012

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,410	02/04/2005	5329619	286142000430	8873

26694 7590 06/06/2011

VENABLE LLP
P.O. BOX 34385
WASHINGTON, DC 20043-9998

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/06/2011

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
SCOTT W. DOYLE
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MCLEAN, VA 22102

Date:

MAILED
JUN 06 2011
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90007410
PATENT NO. : 5329619
ART UNIT : 3900

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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(For Patent Owner)

HOWREY LLP - East
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2941 FAIRVIEW PARK DR, SUITE 200
FALLS CHURCH VA 22042-2924

MAILED
JUN 06 2011
CENTRAL REEXAMINATION UNIT

(For Requester)

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MCLEAN, VA 22102

(Courtesy Copy)

VENABLE LLP
P.O. BOX 34385
WASHINGTON DC 20043-9998

In re Page *et al.*
Reexamination Proceeding
Control No. 90/007,410
Filing Date of Request: February 4, 2005
For: U.S. Patent No. 5,329,619

: DECISION
: VACATING
: *EX PARTE*
: REEXAMINATION
: CERTIFICATE

This is a decision on the August 7, 2009 paper entitled "PETITION UNDER 37 C.F.R. 1.182 AND ALTERNATIVELY 1.181(A)(3) OR 1.183".

This decision addresses the publication of an *ex parte* reexamination certificate for the present proceeding on January 6, 2009, after a petition to revive the terminated proceeding was granted on November 10, 2008.

The petition, and the proceeding as a whole, are before the Office of Patent Legal Administration.

The petition under 37 CFR 1.182 is dismissed for a lack of proper service of the petition.

For the reasons set forth below, the *ex parte* reexamination certificate published on January 6, 2009 is *sua sponte* **vacated**.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 5,329,619 (hereinafter, the '619 patent), issued to Page *et al.*, on July 12, 1994.

2. On February 4, 2005, a third party requester filed a request for *ex parte* reexamination of the '619 patent.

3. The reexamination proceeding was assigned Control No. 90/007,410 (hereinafter, the '7410 proceeding).

4. On April 4, 2006, the order granting the request for reexamination was mailed.

5. On September 23, 2008 a Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) was mailed.

6. On October 3, 2008, the '7410 proceeding was forwarded to the Office of Patent Publication.

7. On October 6, 2008, a petition to revive the unintentionally terminated proceeding was filed under 37 CFR 1.137(b).

8. On November 10, 2008, the decision granting the petition under 37 CFR 1.137(b) was granted. The decision withdrew the NIRC mailed September 23, 2008.

9. On January 6, 2009, Reexamination Certificate No. C1 5,329,619 was issued.

10. On August 7, 2009, a paper entitled. "PETITION UNDER 37 C.F.R. 1.182 AND ALTERNATIVELY 1.181(A)(3) OR 1.183" was filed. This petition paper was not served on requester.

11. Prosecution was reopened based on November 10, 2008 decision and, on November 30, 2010 a Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) was mailed.

DECISION

As to the August 7, 2009 petition, it is **refused consideration** under 37 CFR 1.550(f) as it has not been shown to have been served on the third party requester. Accordingly, the petition is dismissed.

However, the underlying issue of vacating the certificate is addressed *sua sponte* as follows:

The Reexamination Certificate issued for the present proceeding was issued in error. The Patent Owner timely filed a petition to revive the terminated proceeding and that petition was granted before the issuance of the reexamination certificate on January 6, 2009. The Office's failure to remove the '7410 proceeding from the publication cycle resulted in the erroneous issuance of the reexamination certificate. Federal agencies, including the Office, have broad authority to correct their prior errors. See *The Last Best Beef LLC v. Dudas*, 2007 WL 3087186, 84, USPQ2d 1699, C.A. 4 (Va.) Oct. 24, 2007 (No. 06-2219).

It is in the public's interest to be advised of the patent owner's response and permit the Office to have benefit of consideration of that response before issuing a reexamination certificate. Issuance of the reexamination certificate was premature, and the interests of the public are best served by vacating the reexamination certificate in order to allow the proceeding to resume and progress.

In view of the above, the NIRC issued September 23, 2008 remains withdrawn and Reexamination Certificate No. C1 5,329,619 that was issued January 6, 2009, in error is hereby **vacated**.

In due course, the following erratum will be published in the *Official Gazette*:

> All reference to Reexamination Certificate No. C1 5,329,619 to Page et al. of Darmstadt (DE) for COOPERATIVE PROCESSING INTERFACE AND COMMUNICATION BROKER FOR HETEROGENEOUS COMPUTING ENVIRONMENTS, appearing in the *Official Gazette* of January 6, 2009, should be deleted since the reexamination certificate has been vacated.

CONCLUSION

1) The petition under 37 CFR 1.182 is dismissed.

2) The *Ex Parte* Reexamination Certificate issued January 6, 2009 is *sua sponte* **vacated.**

3) The Office of Patent Publications will take action with respect to the 5,329,619 patent consistent with this decision.

5. In view of the November 30, 2010 issuance a a Notice of Intent to Issue Ex Parte Reexamination Certificate (NIRC) , the Central Reexamination Unit will process the present reexamination proceeding consistent with the procedure for processing a proceeding after a NIRC has been issued.

3) Telephone inquiries related to this decision should be directed to Eric Keasel, Supervisory Patent Examiner, AU 3992, at (571) 272-4929.

/ Kenneth M. Schor/

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,503	04/04/2005	6410516	74753/JPW/GJG	5583

23432 7590 11/22/2010

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 11/22/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patents and Trademark Office
P.O.Box 1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
Grantland G. Drutchas
McDonnell Boehnen Hulbert & Berghoff
300 S. Wacker Drive, Suite 3100
Chicago, IL 60606

Date:
MAILED

NOV 2 2 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90007503
PATENT NO. : 6410516
ART UNIT : 1600

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

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,828	12/02/2005	6410516	0207/74753/JPW/GJG	4525

23432 7590 11/22/2010

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 11/22/2010

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
BAWA BIOTECHNOLOGY CONSULTING LLP
21005 STARFLOWER WAY
ASHBURN, VA 20147

Date MAILED

NOV 2 2 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90007828
PATENT NO. : 6410516
ART UNIT : 3900

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

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

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Gary Gershik
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(for Patent Owner)

Grantland G. Drutchas
McDonnell Boehnen Hulbert & Berghoff
300 S. Wacker Drive, Suite 3100
Chicago, IL 60606

(for Third Party Requester)

MAILED

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CENTRAL REEXAMINATION UNIT

In re Baltimore et al
Reexamination Proceeding
Control No.: 90/007,503
Filed: April 4, 2005
For: U.S. Patent 6,410,516

Dr. Raj Bawa
Bawa Technology Consulting, LLC
21005 Starflower Way
Ashburn, VA 20147

(for Third Party Requester)

In re Baltimore et al
Reexamination Proceeding
Control No.: 90/007,828
Filed: December 2, 2005
For: U.S. Patent 6,410,516

DECISION ON PETITIONS

This is a decision addressing three (3) patent owner filed petitions, each titled "PETITION UNDER 37 CFR 1.59(b) AND 1.182 TO EXPUNGE INFORMATION SUBMITTED UNDER MPEP 724.02," submitted on February 25, 2008, May 21, 2008, and June 9, 2008.

The petition is before the Supervisory Patent Examiner of Art Unit 3991 in the Central Reexamination Unit for consideration.

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

Decision

The information submitted on February 25, 2008, May 21, 2008, and June 9, 2008 has been reviewed by the examiner and is not considered pertinent to the decision of patentability. Further, the information is no longer under protective order. Accordingly, all of the information submitted on February 25, 2008, May 21, 2008, and June 9, 2008 is of record in the electronic file and is open to the public.
In a telephone interview with Gary Gershik, counsel for Patent Owner, it was agreed that no further petitions to expunge this material will be filed and the proceeding may be forwarded to publications.

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

/Deborah Jones/
SPE 3991, Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,509	04/15/2005	6197287	0503-1110-1	5030

466 7590 03/27/2012

YOUNG & THOMPSON
209 Madison Street
Suite 500
Alexandria, VA 22314

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/27/2012

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,636	07/20/2005	6197287	0503-1110-2	3551

466 7590 03/27/2012

YOUNG & THOMPSON
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Alexandria, VA 22314

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ART UNIT	PAPER NUMBER

DATE MAILED: 03/27/2012

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MAILED

Date: MAR 27 2012

CENTRAL REEXAMINATION UN

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
ALANA M. FUIERER, Esq.
HESLIN ROTHENBERG FARLEY& MESITI, P.C.
5 COLUMBUS CIRCLE
ALBUNY, NY 12203

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90007509
PATENT NO. : 6197287
ART UNIT : 3900

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

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

ALANA M. FUIERER,Esq.
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ALBANY, NY 12203

Date:

MAILED

MAR 27 2012

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90007636
PATENT NO. : 6197287
ART UNIT : 3900

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

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(For Patent Owner)

MAILED

MAR 27 2012

CENTRAL REEXAMINATION UNIT

Alana M. Fuierer
HESLIN ROTHENBERG FARLEY & MESITI P.C.
5 Columbia Circle
Albany, NY 12203-5160

(For Third Party Requester)

In re: Mallo et al.
Ex Parte: Reexamination Proceeding
Control No.: 90/007,509 + 90/007,636
For: U.S. Patent No.: 6,616,909

DECISION ON PETITION UNDER 37 CFR 1.181

This is a decision on a petition filed by the Patent Owner filed on February 12, 2010, entitled "RULE 181 PETITION TO REINSTATE APPEAL IN REEXAM". In the petition, Patent Owner petitions to reinstate the appeal initiated May 28, 2008 and vacate the Notice to Issue Ex Parte Reexamination Certificate (NIRC) mailed January 2, 2010.

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

The petition is **denied**.

REVIEW OF RELEVANT FACTS

- A Final Rejection was mailed March 28, 2008.
- Patent Owner filed a Notice of Appeal on May 28, 2008.
- Patent Owner filed an Appeal Brief on July 28, 2008.
- A Notice of Non-Compliant Appeal Brief in *Ex Parte* Reexamination was mailed on March 9, 2009.
- Patent Owner filed a response to the non-compliant appeal brief on April 9, 2009.
- A Notice of Intent to Issue *Ex Parte* Reexamination Certificate was mailed on January 2, 2010.
- Patent Owner filed the present rule 1.181 petition on February 12, 2010.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 C.F.R. § 41.37 Appeal brief

(c) (1) The brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(i) through (c)(1)(x) of this section, except that a brief filed by an appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c)(1)(i) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section:

> (ix) Evidence appendix. An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See § 41.33 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner as to grounds of rejection to be reviewed on appeal. (Emphasis added)

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

MPEP 1205.03 Non-Compliant Appeal Brief and Amended Brief

The question of whether a brief complies with the rule is a matter within the jurisdiction of the examiner and the Board. The examiner will review the brief to ensure that the required items of the brief are present. Both the Board and the examiner will review the brief for compliance with the content requirements of the brief (37 CFR 41.37(c)). 37 CFR 41.37(d) provides that if a brief is filed which does not comply with all the requirements of paragraph (c), the appellant will be notified of the reasons for noncompliance. Appellant will be given 1 month or 30 days from the mailing of the notification of non-compliance, whichever is longer to file an amended brief. Extensions of time may be granted under 37 CFR 1.136(a) or 1.136(b). The Office may use the form paragraphs set forth below or form PTOL-462, "Notification of on-Compliant Appeal Brief (37 CFR 41.37) to notify appellant that the appeal brief is defective. The appeal will be dismissed if the appellant does not timely file an amended brief, or files an amended brief which does not overcome all the reasons for noncompliance of which the appellant was notified. (Emphasis added)

DECISION

On July 28, 2008, Patent Owner filed their Appeal Brief after initiating their appeal on May 28, 2008.

On March 9, 2009, the Office mailed a "Notification of Non-Compliant Appeal Brief (37 CFR 41.37) in Ex Parte Reexamination" which held the July 28, 2008 brief defective for failing to "contain, as an appendix thereto (37 CFR 41.37(c)(1)(ix)), copies of the evidence submitted under 37 CFR 1.130, 131, or 1.132 or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered by the examiner". In particular, the notice of non-compliant appeal brief set out several specific reasons why the brief was defective. First, the notice indicated that the brief's "evidence appendix fails to note that the Mallo declaration was entered and considered by the Examiner within the 03-28-08 Final Rejection". Second, the notice indicated that the arguments section of the brief made reference to the following evidence which was neither cited in the appendix, nor indicated as to where in the record the references had been entered: A) a CAS registry document, B) an EPA website, C) a Kirk Othmer dictionary reference, D) EP-B-0186361 and E) two other European applications.

On April 9, 2009, Patent Owner responded to the Notice of Non-Compliant Appeal brief submitting a replacement Evidence Appendix that included the statement as to where in the record the Mallo declaration was entered by the Examiner. However the replacement appendix did not include the citation to the additional evidence that the examiner stated was mentioned in the brief. Rather, Patent Owner simply argued that the "applied evidence need not be included in the evidence appendix". Regarding the EPA website, Patent Owner argued that the EPA website noted in the "brief merely provides background and context for the statements that already appear in the specification of the patent as filed" and is "not evidence that Appellant relies upon as to the impropriety of the rejections on appeal and thus is not governed by 37 CFR §41.37 (c)(1)(ix). Regarding the CAS Registry Document and the Kirk Othmer dictionary reference, Patent Owner argued that these references were cited by the Examiner and relied upon for the

rejections on appeal and thus need not be included in the evidence appendix. Regarding EP-B-0186361, Patent Owner argued that this reference "is referred to in the applied EP '853 reference for a description of how inverse emulsion polymerization of the applied reference is performed. EP '361 is thus incorporated by reference in the applied EP '853 as to this aspect of its disclosure, such that the provisions of Rule 41.37 (c)(1)(ix) likewise do not apply to it". Regarding the EPA website, Patent Owner argued that the EPA website noted in the "brief merely provides background and context for the statements that already appear in the specification of the patent as filed" and is "not evidence that Appellant relies upon as to the impropriety of the rejections on appeal and thus is not governed by 37 CFR §41.37 (c)(1)(ix). Regarding the citation of the two European applications, Patent Owner argues this merely refers to the same two European applications (i.e., EP '843 and EP '361).

On January 9, 2010, a Notice of Intent to Issue Ex Parte Reexamination Certificate (NIRC) was mailed cancelling finally rejected claims 1-4, 7-12, 14, 17-19 and 22-24 in view of Patent Owner's failure to file an appropriate response to the Notice of Non-Compliant Appeal Brief mailed March 9, 2009 (for failing to include the above identified references in the brief appendix).

On February 12, 2010, Patent Owner filed the present petition under rule 1.181 requesting that the Notice of Intent to Issues Ex Parte Reexamination Certificate (NIRC) be vacated and the appeal be reinstated. In the petition, Patent Owner petitioner reinstated the arguments from their April 9, 2009 response to the Notice of Non-Compliant Appeal brief as to why the CAS registry document, an EPA website, Kirk Othmer dictionary reference and EP-B-0186361 need not be include the brief's appendix.

A review of the record indicates that the EPA Website referred to in the March 9, 2009 Notice of Non-Compliant Appeal Brief, was cited in footnote 3 on page 7 of Patent Owner's brief. Footnote 3 states "Indeed, the EPA has now classified acrylamide as a Group B, probable human carcinogen. See – http://www.epa.gov/atw/hlthef/acrylami.html". Further, footnote 3 references the following paragraph bridging pages 6 and 7 of Patent Owner's brief on appeal.

> "As discussed at 1:34-45 of the present patent, the acrylamide/sodium AMPS copolymers described in EP '853 have the benefit of retaining an appreciable thickening capacity even at pH 4, but are attended by the significant disadvantage of having a monoacrylamide content that, although characterized as extremely low, was expected by the appellants to result in making them impossible to use in cosmetics in the near future, following changes in the European legislation on hazardous substances[3]" (See paragraph bridging pages 6 and 7 of Patent Owner's brief on appeal).

Thus, Patent Owner is clearly relying on the EPA website citation as evidence to support arguments as to the impropriety of the rejections over the EP '853 reference.

A further review of the record indicates that the EP-B-0186361 reference referred to in the March 9, 2009 Notice of Non-Compliant Appeal Brief, was cited in on page 27, lines 12-20 and page 41, lines 10-17 of Patent Owner's Brief on appeal. Contrary to Patent Owner's assertion,

EP-B-0186361 is not specifically incorporated-by-reference by the EP0503853A2 (EP '853) reference. Accordingly, it cannot be said that EP-B-0186361 was cited by the Examiner as a basis of the rejections under appeal, merely because the EP '853 reference mentions EP0186361.

Additionally, Patent Owner on page 27, lines 7-24 of their brief on appeal argues:

> "As to claim 12, the final rejection relies upon the disclosure in Example 1 of EP '853, page 6, lines 10-12 that 5% by weight of a mixture of 20% by weight antifoam and 80% weight of an ethoxylated higher alcohol surfactant having an HLB of 12.5 is added to the finished inverse emulsion.
>
> However, Example 1 of EP '853 states that the inverse emulsion polymerization is conducted according to Example 1 of an earlier European application, EP-B-0186361, which is not relied upon. Reference to that example of the earlier European application suggests that both W/O and O/W emulsifiers are already present in the reaction system at the time of polymerization; however, it is sufficiently difficult to correlate the disclosure of the respective Examples 1 of these two European applications, that it cannot be determined whether the recitation of claim 12 (or, for that matter, the recitations of claims 10 or 11) are met by EP '853". (See page 27, lines 7-24 of Patent Owner's brief on appeal").

Thus, Patent Owner affirmatively states that EP-B-0186361 was not relied upon by the Examiner in rejecting the claims and is clearly relying on the reference as evidence to support arguments as to the impropriety of the rejections over the EP '853 reference.

37 C.F.R. § 41.37 (c) (1) (ix) requires an appeal brief to have an "appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner."

The regulation further states that "un-entered evidence is not permitted in the brief".

Further, 37 C.F.R. § 41.37 (d) states that "[I]f a brief is filed which does not comply with all the requirements of paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and given a time period within which to file an amended brief. If appellant does not file an amended brief within the set time period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, the appeal will stand dismissed." (Emphasis added)

Accordingly, since the EP-B-0186361 reference and the EPA website (http:// www.epa.gov/atw/hlthef/acrylami.html) were cited by Patent Owner for the first time in their

brief on appeal filed July 28, 2008 and because Patent Owner relies on these reference in their brief to provide evidence to support their arguments as to the impropriety of the rejections over the EP '853 reference, 37 C.F.R. § 41.37 (c) (1) (ix) requires them to be listed in their appendix with copies and have a statement as to where in the record they were entered by the Examiner. If such evidence was not entered, it is not permitted in the brief.

Thus, because Patent Owner's response to the non-compliant appeal brief filed April 9, 2009 did not correct the appeal brief to either cite the EPA website and EP-B-0186361 in the appendix with a statement as to where in the record these references were entered by the Examiner or remove reference to the references from the body of the appeal brief, Patent Owner's amended brief did not overcome all the reasons for non-compliance.

Accordingly, Patent Owner's amended brief did not overcome all the reasons for non-compliance stated in the Notice of Non-Compliant Appeal Brief mailed March 9, 2009 and the appeal was properly dismissed in acordance with 37 C.F.R. § 41.37 (d) and MPEP 1205.03.

For the reasons set forth above, it is deemed that the examiner followed Office rules and procedures and did not abuse her discretion in deciding dismiss the appeal and issue a Notice of Intent to Issue *Ex Parte* Reexamination Certificate on January 2, 2010.

For these reasons, Patent Owner's February 12, 2010 petition is hereby denied.

CONCLUSION

1. The petition filed by Patent Owner on February 12, 2010, is **denied.**

2. Telephone inquiries related to this decision should be directed to Stephen Stein, Supervisory Patent Reexamination Specialist, at (571) 272-1544 or in his absence to the undersigned at (571) 272-0700.

Irem Yucel
Director, Central Reexamination Unit

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.:20110217

DATE : February 17, 2011

TO SPE OF : ART UNIT 3992

SUBJECT : Request for Certificate of Correction on Patent No.: 5,982,921 C1

A response is requested with respect to the accompanying request for a certificate of correction.

Please complete this form and return with file, within **7** days to:
Certificates of Correction Branch - PK 3-910
Palm location **7590** - Tel. No. 305-8201

With respect to the change(s) requested, correcting Office and/or Applicant's errors, should the patent read as shown in the certificate of correction? No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Thank You For Your Assistance **Certificates of Correction Branch**

The request for issuing the above-identified correction(s) is hereby:
Note your decision on the appropriate box.

☒ **Approved** **All** changes apply.

☐ **Approved in Part** Specify below which changes **do not** apply.

☐ **Denied** State the reasons for denial below.

Comments:

Eric Keasel

SPE: Eric Keasel **Art Unit** 3992

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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Dion M. Bregman
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2 Palo Alto Square
3000 El Camino Real, Suite 700
Pal Alto, CA 94306

(For Patent Owner)

MAILED

NOV 05 2010

CENTRAL REEXAMINATION UNIT

Kevin J. Carroll
Grossman, Tucker, Perreault & Pfleger PLLC
55 South Commercial Street
Manchester, NH 03101

(For Third Party Requester)

In re Reissue Application of
Belgacem Haba
Application No.: 11/398,458
Filed: April 4, 2006
For: U.S. Patent No. 6,833,984

In re Belgacem Haba
Reexamination Proceeding
Control No.: 90/007,681
Filed: August 19, 2004
For: U.S. Patent No.: 6,833,984

: SUPPLEMENT TO
: PRIOR DECISION
: TO MERGE
: REISSUE AND
: REEXAMINATION
: PROCEEDINGS

This decision is supplemental to the Office's prior merger decision mailed December 11, 2006, which *sua sponte* merged reissue application No. 11/398,458 and reexamination control No. 90/007,681 into a single proceeding.

The above-identified prior merger decision continues to be in effect, and all further examination in the merged proceeding should continue to be conducted in accordance with the above-identified prior merger decision, except as it is supplemented by this decision – as follows:

If a request for continued examination (RCE) is filed under 37 CFR 1.114, as is permitted for the reissue application, then 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, a request for continued examination (RCE) is not available in the reexamination proceeding, and any response to the outstanding Office action (e.g.,

response to a final rejection) at that stage in the reexamination proceeding must be made taking into account the non-availability of RCE practice. Any failure to timely respond would result in the termination of the prosecution pursuant to 37 CFR 1.550(d).

In addition, if a final Office action should be issued subsequent to the mail date of this decision in this merged proceeding, any request for extension for time (to respond to any such subsequent final action) 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 Office action issued in the present merged proceeding subsequent to the mail date of this decision.

The merged proceeding will otherwise continue as per the above-identified prior merger decision.

CONCLUSION

1. Reissue application No. 11/398,458 and reexamination control No. 90/007,681 remain merged as a single proceeding.

2. 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, a request for continued examination (RCE) is not available in the reexamination proceeding, and any response to the outstanding Office action (e.g., response to a final rejection) at that stage in the reexamination proceeding must be made taking into account the non-availability of RCE practice. Any failure to timely respond would result in the termination of the prosecution pursuant to per 37 CFR 1.550(d).

3. In addition, if a final Office action should be issued in this merged proceeding subsequent to the mail date of this decision, then any request for extension for time (to respond to any such subsequent action) 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 Office action issued subsequent to the mail date of this decision.

4. All further examination in the merged proceeding is to continue to be conducted in accordance with the above-identified prior merger decision.

5. Telephone inquiries related to this decision should be directed to Colleen Dunn at (571) 272-1170, or in her absence to Eric Keasel at (571) 272-4929 or to Mark Reinhart at (571) 272-1611.

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

11/04/10

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
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,684	08/22/2005	6024981	15514/40037	1442

21832 7590 05/02/2011

MCCARTER & ENGLISH, LLP HARTFORD
CITYPLACE I
185 ASYLUM STREET
HARTFORD, CT 06103

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 05/02/2011

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte CIMA LABORATORIES, INC.
Patent Owner

Appeal 2009-003071
Ex parte Reexamination Control 90/007,684 and 90/008,133
Patent 6,042,981
Technology Center 3900

DECISION ON PETITION

This is a decision on Patent Owner's "Petition Pursuant to 35 C.F.R. § 1.550(c)(M.P.E.P. 2265)," filed April 20, 2011 ("Petition"). The Petition "requests a one-month extension of time pursuant to 37 C.F.R. § 1.550(c) to extend the period for filing a reply to the Board of Patent Appeals and Interferences' new rejections, which were raised in the March 24, 2011 Request for Rehearing decision in the above-captioned reexamination." Petition, p. 1.

FINDINGS

1. On March 24, 2011, the Board of Patent Appeals and Interferences ("Board") entered a Decision on Appeal in this reexamination proceeding, including new grounds of rejection. Decision, pp. 10-11.

2. The Decision on Appeal, citing 37 C.F.R. § 41.50(b), notes that Appellant has two months from the date of the Decision to file a response to the new grounds of rejection.

3. In the Petition, Appellant contends that:

> [T]he preparation of [new] evidence and a complete response to the Board's new rejections will necessarily require more than the 60 day period set by 37 C.F.R. § 41.50(b).

Petition, p. 3.

RELEVANT AUTHORITY

In respect to the showing required for an extension of time to respond to a new ground of rejection under 37 C.F.R. § 41.50(b), 37 C.F.R. § 1.550(c) provides:

> The time for taking any action by a patent owner in an *ex 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).

ANALYSIS

Patent Owner has established that sufficient cause exists for extending by one month the time for Appellant to reopen prosecution in response to the new grounds of rejection.

DECISION

In view of the foregoing, the Petition is GRANTED. A response to the new grounds of rejection is due by June 24, 2011.

The petition fee has been charged to the deposit account of Patent Owner's attorney.

James T. Moore
Acting Chief Administrative Patent Judge

Counsel for Patent Owner:
Eric Grondahl
McCarter & English, LLP
Cityplace 1
185 Asylum Street
Hartford, CT 06103

Counsel for Third Party Requester:
Alan H. Norman
Thompson Coburn, LLP
One US Bank Plaza
St. Louis, MO 63101

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.
90/007,710	09/07/2005	5744980	13268/1	1827

7590 03/25/2011

ACTEL CORPORATION
2061 STIERLIN COURT
MOUNTAIN VIEW, CA 94043

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/25/2011

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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ACTEL CORPORATION : (For Patent Owner)
2061 STIERLIN COURT :
MOUNTAIN VIEW CA 94043 :

MAILED
MAR 25 2011
CENTRAL REEXAMINATION UNIT

KENYON & KENYON LLP : (For Third Party
1500 K STREET N.W. : Requester)
SUITE 700 :
WASHINGTON, DC 20005 :

In re: McGowan *et al.* :
Ex Parte Reexamination Proceeding : DECISION ON PETITION
Control No.: 90/007,710 : UNDER 37 CFR § 1.181
Deposited: 07 September 2005 :
For: U.S. Patent No.: 5,744,980 :

MAILED
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CENTRAL REEXAMINATION

This is a decision on the petition filed by the patent owner on 24 May 2010 2010, entitled "Petition Under 37 CFR § 1.181" [hereinafter "the petition"]. Petitioner seeks entry of claim amendments and reopening of prosecution.

The petition is dismissed-as-moot.

REVIEW OF RELEVANT FACTS

- U.S. Patent No. 5,744,980 issued on 28 April 1998.
- A request for *ex parte* reexamination was filed 07 September 2005 and assigned control no. 90/007,710.
- A Final action was mailed 134 February 2009.
- An amendment after Final was submitted with a petition for entry under 37 CFR 1.182 was submitted on 28 April 2010.
- The petition under 37 CFR 1.182 was granted on 01 July 2010 permitting entry of the amendment.
- A Notice of Intent to Issue Reexamination Certificate confirming original patent claims as well as newly added claims was mailed on 01 July 2010.
- The entry of the amendment and subsequent re-opening and confirmation of patent claims renders the instant petition as moot.

DECISION

The petitioner seeks entry of amendments to the claims and re-opening of prosecution under 37 CFR § 1.181 to invoke supervisory authority. The entry and re-opening of prosecution is moot in view of the granting olf the petition filed under 37 CFR § 1.182, entry of amendments and subsequent Notice of Intent to Issue Reexamination Certificate following confirmation of claims and patentability of newly added claims. Since there is no issue to be decided the instant petition is moot.

37 CFR § 1.181 **Petition to the Director.**
(a) Petition may be taken to the Director:
(1) From any action or requirement of any examiner in the ex parte prosecution of an application, or in ex parte or inter partes prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;

(2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and
(3) To invoke the supervisory authority of the Director in appropriate circumstances. For petitions involving action of the Board of Patent Appeals and Interferences, see § 41.3 of this title.
(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Briefs or memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declarations (and exhibits, if any) must accompany the petition.
(c) When a petition is taken from an action or requirement of an examiner in the ex parte prosecution of an application, or in the ex parte or inter partes prosecution of a reexamination proceeding, it may be required that there have been a proper request for reconsideration (§ 1.111) and a repeated action by the examiner. The examiner may be directed by the Director to furnish a written statement, within a specified time, setting forth the reasons for his or her decision upon the matters averred in the petition, supplying a copy to the petitioner.
(d) Where a fee is required for a petition to the Director the appropriate section of this part will so indicate. If any required fee does not accompany the petition, the petition will be dismissed.
(e) Oral hearing will not be granted except when considered necessary by the Director.
(f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.
(g) The Director may delegate to appropriate Patent and Trademark Office officials the determination of petitions.

Response to the Petition

The petition is dismissed as moot

CONCLUSION

1. Based on a *de novo* review of the record as a whole, the petition is dismissed-as-moot

2. Telephone inquiries related to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner, at (571) 272-1611 or in his absence to the undersigned at (571) 272-0700.

Irem Yucel
Director, Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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NOV 09 2010

CENTRAL REEXAMINATION UNIT

Oleg Sokolov
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Danbury, CT 06811

(For Patent Owner)

Christopher C. Dunham
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(For Third Party Requester)

In re Reissue Application of
Oleg Sokolov
Application No.: 11/895,784
Filed: August 27, 2007
For: U.S. Patent No. 5,970,118

In re Oleg Sokolov
Reexamination Proceeding
Control No.: 90/007,755
Filed: October 3, 2005
For: U.S. Patent No.: 5,970,118

: SUPPLEMENT TO
: PRIOR DECISION
: TO MERGE
: REISSUE AND
: REEXAMINATION
: PROCEEDINGS

This decision is supplemental to the Office's prior merger decision mailed February 18, 2009, which *sua sponte* merged reissue application No. 11/895,784 and reexamination control No. 90/007,755 into a single proceeding.

The above-identified prior merger decision continues to be in effect, and all further examination in the merged proceeding should continue to be conducted in accordance with the above-identified prior merger decision, except as it is supplemented by this decision – as follows:

If a request for continued examination (RCE) is filed under 37 CFR 1.114, as is permitted for the reissue application, then 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, a request for continued examination (RCE) is not available in the reexamination proceeding, and any response to the outstanding Office action (e.g., response to a final rejection) at that stage in the reexamination proceeding must be made taking into account the non-availability of RCE practice. Any failure to timely respond would result in the termination of the prosecution pursuant to 37 CFR 1.550(d).

In addition, if a final Office action should be issued subsequent to the mail date of this decision in this merged proceeding, any request for extension for time (to respond to any such subsequent final action) 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 Office action issued in the present merged proceeding subsequent to the mail date of this decision.

The merged proceeding will otherwise continue as per the above-identified prior merger decision.

CONCLUSION

1. Reissue application No. 11/895,784 and reexamination control No. 90/007,755 remain merged as a single proceeding.

2. 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, a request for continued examination (RCE) is not available in the reexamination proceeding, and any response to the outstanding Office action (e.g., response to a final rejection) at that stage in the reexamination proceeding must be made taking into account the non-availability of RCE practice. Any failure to timely respond would result in the termination of the prosecution pursuant to per 37 CFR 1.550(d).

3. In addition, if a final Office action should be issued in this merged proceeding subsequent to the mail date of this decision, then any request for extension for time (to respond to any such subsequent action) 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 Office action issued subsequent to the mail date of this decision.

4. All further examination in the merged proceeding is to continue to be conducted in accordance with the above-identified prior merger decision.

5. Telephone inquiries related to this decision should be directed to Colleen Dunn at (571) 272-1170, or in her absence to Eric Keasel at (571) 272-4929 or to Mark Reinhart at (571) 272-1611.

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

11/04/10

UNITED STATES PATENT AND TRADEMARK OFFICE

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Richard L. Treanor, Ph.D.
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Alexandria, VA 22314

(For Patent Owner)

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NOV 05 2010

CENTRAL REEXAMINATION UNIT

Gregory S. Rosenblatt
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(For First Third Party Requester)

Lawrence E. Laubscher, Jr.
Laubscher & Laubscher PC
1160 Spa Road, Suite 2B
Annapolis, MD 21403

(For Second Third Party Requester)

In re Reissue Application of
Seigo Yamamoto *et al.*
Application No.: 11/430,302
Filed: August 4, 2005
For: U.S. Patent No. 5,514,909

In re Seigo Yamamoto *et al.*
Reexamination Proceeding
Control No.: 90/007,822
Filed: November 28, 2005
For: U.S. Patent No.: 5,514,909

In re Seigo Yamamoto *et al.*
Reexamination Proceeding
Control No.: 90/007,883
Filed: January 20, 2006
For: U.S. Patent No.: 5,514,909

: SUPPLEMENT TO
: PRIOR DECISION
: TO MERGE
: REISSUE AND
: REEXAMINATION
: PROCEEDINGS

This decision is supplemental to the Office's prior merger decision mailed October 18,

2006, which *sua sponte* merged reissue application No. 11/430,302 and reexamination control Nos. 90/007,822 and 90/007,883 into a single proceeding.

The above-identified prior merger decision continues to be in effect, and all further examination in the merged proceeding should continue to be conducted in accordance with the above-identified prior merger decision, except as it is supplemented by this decision – as follows:

If a request for continued examination (RCE) is filed under 37 CFR 1.114, as is permitted for the reissue application, then 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, a request for continued examination (RCE) is not available in the reexamination proceeding, and any response to the outstanding Office action (e.g., response to a final rejection) at that stage in the reexamination proceeding must be made taking into account the non-availability of RCE practice. Any failure to timely respond would result in the termination of the prosecution pursuant to 37 CFR 1.550(d).

In addition, if a final Office action should be issued subsequent to the mail date of this decision in this merged proceeding, any request for extension for time (to respond to any such subsequent final action) 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 Office action issued in the present merged proceeding subsequent to the mail date of this decision.

The merged proceeding will otherwise continue as per the above-identified prior merger decision.

CONCLUSION

1. Reissue application No. 11/430,302 and reexamination control Nos. 90/007,822 and 90/007,883 remain merged as a single proceeding.

2. 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, a request for continued examination (RCE) is not available in the reexamination proceeding, and any response to the outstanding Office action (e.g., response to a final rejection) at that stage in the reexamination proceeding must be made taking into account the non-availability of RCE practice. Any failure to timely respond would result in the termination of the prosecution pursuant to per 37 CFR 1.550(d).

3. In addition, if a final Office action should be issued in this merged proceeding subsequent to the mail date of this decision, then any request for extension for time (to respond to any such subsequent action) 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 Office action issued subsequent to the mail date of this decision.

4. All further examination in the merged proceeding is to continue to be conducted in accordance with the above-identified prior merger decision.

5. Telephone inquiries related to this decision should be directed to Colleen Dunn at (571) 272-1170, or in her absence to Eric Keasel at (571) 272-4929 or to Mark Reinhart at (571) 272-1611.

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

11/04/10

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UNITED STATES DEPARTMENT OF COMMERCE
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Address: COMMISSIONER FOR PATENTS
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,824	11/28/2005	6033542	283161US0RX	9293

22850 7590 11/05/2010

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 11/05/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patents and Trademark Office
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
GREGORY S. ROSENBLATT
WIGGIN AND DANA LLP
ONE CENTURY TOWER, P.O. BOX 1832
NEW HAVEN, CT 06508

Date:

MAILED

NOV 0 5 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90007824
PATENT NO. : 6033542
ART UNIT : 3900

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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.
11/430,299	05/09/2006	Seigo Yamamoto	290192US0RE	5009

22850 7590 11/09/2010

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER	
MCDONALD, RODNEY GLENN	

ART UNIT	PAPER NUMBER
1724	

NOTIFICATION DATE	DELIVERY MODE
11/09/2010	ELECTRONIC

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

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

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

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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Richard L. Treanor (For Patent Owner)
Oblon, Spivak, McClelland, Maier & Neustadt, LLP
1940 Duke Street
Alexandria, VA 22314

MAILED

NOV 0 5 2010

CENTRAL REEXAMINATION UNIT

Gregory S. Rosenblatt (For Third Party Requester)
Wiggin & Dana LLP
One Century Tower, P. O. Box 1832
New Haven, CT 06508

In re Reissue Application of
Seigo Yamamoto *et al.*
Application No.: 11/430,299
Filed: May 9, 2006
For: U.S. Patent No. 6,033,542

In re Seigo Yamamoto *et al.*
Reexamination Proceeding
Control No.: 90/007,824
Filed: November 28, 2005
For: U.S. Patent No.: 6,033,542

: SUPPLEMENT TO
: PRIOR DECISION
: TO MERGE
: REISSUE AND
: REEXAMINATION
: PROCEEDINGS

This decision is supplemental to the Office's prior merger decision mailed October 13, 2006, which *sua sponte* merged reissue application No. 11/430,299 and reexamination control No. 90/007,824 into a single proceeding.

The above-identified prior merger decision continues to be in effect, and all further examination in the merged proceeding should continue to be conducted in accordance with the above-identified prior merger decision, except as it is supplemented by this decision – as follows:

If a request for continued examination (RCE) is filed under 37 CFR 1.114, as is permitted for the reissue application, then 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, a request for continued examination (RCE) is not available in the reexamination proceeding, and any response to the outstanding Office action (e.g., response to a final rejection) at that stage in the reexamination proceeding must be

made taking into account the non-availability of RCE practice. Any failure to timely respond would result in the termination of the prosecution pursuant to 37 CFR 1.550(d).

In addition, if a final Office action should be issued subsequent to the mail date of this decision in this merged proceeding, any request for extension for time (to respond to any such subsequent final action) 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 Office action issued in the present merged proceeding subsequent to the mail date of this decision.

The merged proceeding will otherwise continue as per the above-identified prior merger decision.

CONCLUSION

1. Reissue application No. 11/430,299 and reexamination control No. 90/007,824 remain merged as a single proceeding.

2. 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, a request for continued examination (RCE) is not available in the reexamination proceeding, and any response to the outstanding Office action (e.g., response to a final rejection) at that stage in the reexamination proceeding must be made taking into account the non-availability of RCE practice. Any failure to timely respond would result in the termination of the prosecution pursuant to per 37 CFR 1.550(d).

3. In addition, if a final Office action should be issued in this merged proceeding subsequent to the mail date of this decision, then any request for extension for time (to respond to any such subsequent action) 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 Office action issued subsequent to the mail date of this decision.

4. All further examination in the merged proceeding is to continue to be conducted in accordance with the above-identified prior merger decision.

5. Telephone inquiries related to this decision should be directed Colleen Dunn at (571) 272-1170, or in her absence to Eric Keasel at (571) 272-4929 or to Mark Reinhart at (571) 272-1611.

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

11/04/10

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,824	11/28/2005	6033542	283161US0RX	9293

22850 7590 03/01/2011

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER
MCDONALD, RODNEY GLENN

ART UNIT	PAPER NUMBER
1724	

MAIL DATE	DELIVERY MODE
03/01/2011	PAPER

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

Kobelco Research Institute, Inc.
Appellant and Patent Owner

Tosoh Corporation
Third Party Requester

Merged *Ex parte* Reexamination Control 90/007,824 and Reissue Application 11/430,299
Patent 6,033,542

DECISION ON PETITION

This is a Decision on Appellant's "Petition Under 37 CFR 41.3," filed February 22, 2011 ("Petition"). The Petition seeks a "stay [of] the final decision of the Board [of Patent Appeals and Interferences] on [the] Request for Rehearing Under 37 CFR 41.52 filed February 16, 2011." Petition, p. 1.

FINDINGS

1. On December 16, 2010, the Board of Patent Appeals and Interferences ("Board") issued a Decision on Appeal ("Decision") in this merged *ex parte* reexamination proceeding and reissue application.

2. In the Decision, the Board, *inter alia*, affirmed a rejection of all pending claims under 35 U.S.C. § 251 "as being based on a defective reissue declaration." Decision, p. 11.

3. In affirming the rejection under 35 U.S.C. § 251, the Board relied on the Board's decision in *Ex parte Tanaka*, 93 USPQ2d 1291 (BPAI 2009) (Precedential). Decision, pp. 4, 8-9.

4. The Board's decision in *Tanaka* presently is on appeal to the Federal Circuit Court of Appeals.

5. On February 16, 2011, Appellant filed a Request for Rehearing of the Board's Decision of December 16, 2010.

6. On February 22, 2011, Appellant filed the present Petition, including payment of the petition fee.

DICUSSION

In the Petition, Appellant argues that "the time, efforts, expenses, and efficiency of Appellant and the Board are best served by staying the Board's decision on the Request for Rehearing . . . until the Federal Circuit has decided *Tanaka*." Petition, p. 6. Since in the Decision in the present appeal, the Board relies on its earlier decision in *Tanaka* and the Federal Circuit presently is reviewing the Board's *Tanaka* decision, Appellant's request for a stay of a decision on the Request for Rehearing is reasonable.

Ex parte Reexamination Control 90/007,824
Reissue Application 11/430,299
Patent 6,033,542

DECISION

In view of the forgoing, the Petition is GRANTED to the extent that the Board will stay issuing a decision on the Request for Rehearing for at least 45 days or until the Federal Circuit issues a decision in *Tanaka*, whichever occurs first.

James T. Moore
Acting Chief Administrative Patent Judge

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UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,828	12/02/2005	6410516	0207/74753/JPW/GJG	4525

23432 7590 11/22/2010

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 11/22/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patents and Trademark Office
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Alexandria, VA 22313-1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
BAWA BIOTECHNOLOGY CONSULTING LLP
21005 STARFLOWER WAY
ASHBURN, VA 20147

Date: MAILED

NOV 2 2 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90007828
PATENT NO. : 6410516
ART UNIT : 3900

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

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

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United States Patent and Trademark Office
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P.O. Box 1450
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www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,503	04/04/2005	6410516	74753/JPW/GJG	5583

23432 7590 11/22/2010

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30 Rockefeller Plaza
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NEW YORK, NY 10112

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 11/22/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
Grantland G. Drutchas
McDonnell Boehnen Hulbert & Berghoff
300 S. Wacker Drive, Suite 3100
Chicago, IL 60606

Date:
MAILED

NOV 2 2 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90007503
PATENT NO. : 6410516
ART UNIT : 1600

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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MAILED

NOV 2 2 2010

CENTRAL REEXAMINATION UNIT

In re Baltimore et al
Reexamination Proceeding
Control No.: 90/007,503
Filed: April 4, 2005
For: U.S. Patent 6,410,516

Dr. Raj Bawa
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21005 Starflower Way
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(for Third Party Requester)

In re Baltimore et al
Reexamination Proceeding
Control No.: 90/007,828
Filed: December 2, 2005
For: U.S. Patent 6,410,516

DECISION ON PETITIONS

This is a decision addressing three (3) patent owner filed petitions, each titled "PETITION UNDER 37 CFR 1.59(b) AND 1.182 TO EXPUNGE INFORMATION SUBMITTED UNDER MPEP 724.02," submitted on February 25, 2008, May 21, 2008, and June 9, 2008.

The petition is before the Supervisory Patent Examiner of Art Unit 3991 in the Central Reexamination Unit for consideration.

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

Decision

The information submitted on February 25, 2008, May 21, 2008, and June 9, 2008 has been reviewed by the examiner and is not considered pertinent to the decision of patentability. Further, the information is no longer under protective order. Accordingly, all of the information submitted on February 25, 2008, May 21, 2008, and June 9, 2008 is of record in the electronic file and is open to the public.
In a telephone interview with Gary Gershik, counsel for Patent Owner, it was agreed that no further petitions to expunge this material will be filed and the proceeding may be forwarded to publications.

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

/Deborah Jones/
SPE 3991, Central Reexamination Unit

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CENTRAL REEXAMINATION UNIT

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Irvine, CA 92614

Bradley J. Olson (For Third Party Requester)
Dickstein Shapiro Morin & Oshinsky LLP
1825 Eye Street NW
Washington DC 20006-5403

In re Reissue Application of Peter S. Wohrle Application No.: 10/366,531 Filed: February 12, 2003 For: U.S. Patent No. 6,283,754	: SUPPLEMENT TO : PRIOR DECISION : TO MERGE : REISSUE AND : REEXAMINATION
In re Peter S. Wohrle Reexamination Proceeding Control No.: 90/007,836 Filed: December 2, 2005 For: U.S. Patent No.: 6,283,754	: PROCEEDINGS

This decision is supplemental to the Office's prior merger decision mailed June 15, 2006, which *sua sponte* merged reissue application No. 10/366,531 and reexamination control No. 90/007,836 into a single proceeding.

The above-identified prior merger decision continues to be in effect, and all further examination in the merged proceeding should continue to be conducted in accordance with the above-identified prior merger decision, except as it is supplemented by this decision – as follows:

If a request for continued examination (RCE) is filed under 37 CFR 1.114, as is permitted for the reissue application, then 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, a request for continued examination (RCE) is not available in the reexamination proceeding, and any response to the outstanding Office action (e.g.,

response to a final rejection) at that stage in the reexamination proceeding must be made taking into account the non-availability of RCE practice. Any failure to timely respond would result in the termination of the prosecution pursuant to 37 CFR 1.550(d).

In addition, if a final Office action should be issued subsequent to the mail date of this decision in this merged proceeding, any request for extension for time (to respond to any such subsequent final action) 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 Office action issued in the present merged proceeding subsequent to the mail date of this decision.

The merged proceeding will otherwise continue as per the above-identified prior merger decision.

CONCLUSION

1. Reissue application No. 10/366,531 and reexamination control No. 90/007,836 remain merged as a single proceeding.

2. 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, a request for continued examination (RCE) is not available in the reexamination proceeding, and any response to the outstanding Office action (e.g., response to a final rejection) at that stage in the reexamination proceeding must be made taking into account the non-availability of RCE practice. Any failure to timely respond would result in the termination of the prosecution pursuant to per 37 CFR 1.550(d).

3. In addition, if a final Office action should be issued in this merged proceeding subsequent to the mail date of this decision, then any request for extension for time (to respond to any such subsequent action) 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 Office action issued subsequent to the mail date of this decision.

4. All further examination in the merged proceeding is to continue to be conducted in accordance with the above-identified prior merger decision.

5. Telephone inquiries related to this decision should be directed to Colleen Dunn at (571) 272-1170, or in her absence to Eric Keasel at (571) 272-4929 or to Mark Reinhart at (571) 272-1611.

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

11/04/10

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,839	12/07/2005	5734961	866093	1585

40401 7590 12/13/2010

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

EXAMINER	
FOSTER, ROLAND G	
ART UNIT	PAPER NUMBER
3992	

MAIL DATE	DELIVERY MODE
12/13/2010	PAPER

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANTOR MEDIA CORPORATION

Appeal 2010-007531
Reexamination Control 90/007,839; 90/007,936; 90/007,942;
90/007,957; and 90/009,261
Technology Center 3900

DECISION ON PETITION

This is a decision on the "Petition Under 37 CFR 1.550(c) for Extension of Time to Request Rehearing of Board Decision" filed on December 6, 2010. In this Petition, directed to the Chief Judge of the Board of Patent Appeals and Interferences, the Appellant seeks a two month extension of time to request rehearing of the Decision on Appeal, which was mailed on October 21, 2010.

In support of the Petition, the Appellant's representative states that "In November, 2010" the patent owner and previous counsel agreed to terminate the representation. (Petition at 2). As no specific date is stated in the Petition, a logical conclusion is that this agreement was reached as early as November 1, about 10 days after the Decision was rendered. Read in this light, the Petition states that approximately 40 days prior to the filing of the instant Petition, the Appellant knew that it was going to seek new representation in these merged reexamination proceedings. The Petition does not indicate that any steps were taken to ensure compliance with approaching deadlines. This fact weighs against granting the Petition.

On November 29, about 40 days after the Decision, the petitioner states that the Appellant chose new representation. (Petition at 2). No reason for this period of delay is provided. This fact likewise weighs against granting the Petition.

The petitioner further states that the issues and prosecution history associated with the Decision are extensive. In support of this statement, the Appellant lists the Decision as being 27 pages long, the Examiner's Answer as being 231 pages long, and the Appeal Brief as being 90 pages long. (Petition at 2). However, in a request for rehearing a requestor must "state

with particularity the points believed to have been misapprehended or overlooked by the Board." 37 C.F.R. § 41.52(a)(1). In other words, the page lengths of the Briefing and Answer are not significantly relevant. On the other hand, the Board decision is concise at 27 pages and the issues, while complex, are not extraordinarily so. This fact likewise weighs against granting the Petition.

The petitioner further states that the patent attorney assigned to the case "is scheduled to spend 9 days out of the country in December" (Petition at 2.) However, the Petition does not state that no one else at the representative's offices is available to work on the case. Nor does the Petition state the gravity of the reason the patent attorney is out of the country, or whether the trip is optional and could be rescheduled. This fact weighs against granting the Petition.

The petitioner further states that the underlying patent, 5,734,961 is directed to complex telecommunications methods and systems, and requires extensive technical analysis and comparison against similarly complex applied art. (Petition at 2.) The posture of this case at this time is that the issues are developed, the analysis has been performed, and a decision has been rendered. Any issues to be raised in the context of a rehearing request are circumscribed by that decision and analysis, and we presume the Appellant's representative to be technologically capable. As a consequence, this fact likewise weighs against granting the Petition.

The Appellant's representative states that he "believes no fee is due with this petition." (Petition at 3). The Appellant's representative is directed to 37 C.F.R. § 41.52(b) which, with respect to extensions of time

for filing a request for rehearing in an ex parte reexamination proceeding appeal, states: "See . . . § 1.550(c) of this title for extensions of time to reply for ex parte reexamination proceedings." 37 C.F.R. § 1.550(c) in turn provides that "any action by a patent owner in an ex parte reexamination proceeding will be extended only for sufficient cause" and further that "[a]ny request for such extension must be accompanied by the petition fee set forth in § 1.17(g)." 37 C.F.R. § 1.17(g) specifies a $200 fee for a patent owner filing a request for extension of time in an ex parte reexamination proceeding.

Thus the appropriate fee of $200 shall be debited to the Appellant's representative's account.

DECISION

For the foregoing reasons, and in the absence of a showing of sufficient cause, the petition is hereby DENIED.

DENIED

James T. Moore
Acting Chief Administrative Patent Judge

Appeal 2010-007531
Reexamination Control 90/007,839; 90/007,936; 90/007,942; 90/007,957 and 90/009,261

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,839	12/07/2005	5734961	866093	1585

40401 7590 12/22/2010

Hershkovitz & Associates, LLC
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EXAMINER	
FOSTER, ROLAND G	
ART UNIT	PAPER NUMBER
3992	

MAIL DATE	DELIVERY MODE
12/22/2010	PAPER

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte ANTOR MEDIA CORPORATION

Appeal 2010-007531
Ex parte Reexamination Control 90/007,839; 90/007,936; 90/007,942; 90/007,957; 90/009,261
Patent 5,734,961
Technology Center 3900

DECISION ON PETITION

This is a decision on Patent Owner's "Request for Reconsideration of Decision Under 37 CFR 1.550(c) for Extension of Time to Request Rehearing of Board Decision," filed December 16, 2010 ("Request for Reconsideration"). In the Request for Reconsideration, Patent Owner seeks to have the Decision on Petition entered December 13, 2010 reversed and an extension of two months to file a request for rehearing of the Board Decision on Appeal of October 21, 2010.

FINDINGS

1. On December 13, 2010, the Acting Chief Administrative Patent Judge issued a Decision on Petition denying Patent Owner's "Petition Under 37 CFR 1.550(c) for Extension of Time to Request Rehearing of Board Decision," filed December 6, 2010.

2. In the present Request for Reconsideration, Patent Owner argues that, following the Decision on Appeal, it experienced difficulty in obtaining new representation and that time will be required for a new representative to become familiar with the issues relevant to patentability. Request for Reconsideration, pp. 3-4.

3. Although not discussed in either the initial Petition or the Request for Reconsideration, a review of the record in these merged reexamination proceedings reveals that Abraham Hershkovitz of Hershkovitz & Associates, LLC, Patent Owner's current representative, was among the prior representation appointed by Patent Owner in a Revocation of Powers of Attorney With New Powers of Attorney, filed November 5, 2007.

4. Although not discussed in either the initial Petition or the Request for Reconsideration, a review of the record in these merged reexamination proceedings further reveals Mr. Hershkovitz personally participated in interviews with USPTO personnel and representatives of Patent Owner during prosecution of the merged reexamination proceedings. See Ex Parte Reexamination Interview Summaries of January 29, 2008, September 9, 2008 and February 9, 2009.

ANALYSIS

As indicated by the forgoing, the record in these merged reexamination proceedings establishes that Mr. Hershkovitz previously participated in these proceedings as a representative for Patent Owner. While Mr. Hershkovitz was associated with a different firm at the time of his

initial representation of Patent Owner, i.e., Fulbright & Jaworski L.L.P., Mr. Hershkovitz is not "new" to the proceedings at this juncture.

In view of the foregoing, the representations made in Patent Owner's Request for Reconsideration concerning Mr. Hershkovtiz's status as Patent Owner's newly appointed representative are inconsistent with the underlying facts.

DECISION

For the forgoing reason, the Request for Reconsideration is DENIED.

James T. Moore
Acting Chief Administrative Patent Judge

Ex parte Reexamination Control 90/007,839; 90/007,936; 90/007,942; 90/007,957; 90/009,261
Patent 5,734,961

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(For Patent Owner)

MAILED

NOV 05 2010

CENTRAL REEXAMINATION UNIT

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(For Second Third Party Requester)

In re Reissue Application of
Seigo Yamamoto *et al.*
Application No.: 11/430,302
Filed: August 4, 2005
For: U.S. Patent No. 5,514,909

In re Seigo Yamamoto *et al.*
Reexamination Proceeding
Control No.: 90/007,822
Filed: November 28, 2005
For: U.S. Patent No.: 5,514,909

In re Seigo Yamamoto *et al.*
Reexamination Proceeding
Control No.: 90/007,883
Filed: January 20, 2006
For: U.S. Patent No.: 5,514,909

: SUPPLEMENT TO
: PRIOR DECISION
: TO MERGE
: REISSUE AND
: REEXAMINATION
: PROCEEDINGS

This decision is supplemental to the Office's prior merger decision mailed October 18,

2006, which *sua sponte* merged reissue application No. 11/430,302 and reexamination control Nos. 90/007,822 and 90/007,883 into a single proceeding.

The above-identified prior merger decision continues to be in effect, and all further examination in the merged proceeding should continue to be conducted in accordance with the above-identified prior merger decision, except as it is supplemented by this decision – as follows:

If a request for continued examination (RCE) is filed under 37 CFR 1.114, as is permitted for the reissue application, then 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, a request for continued examination (RCE) is not available in the reexamination proceeding, and any response to the outstanding Office action (e.g., response to a final rejection) at that stage in the reexamination proceeding must be made taking into account the non-availability of RCE practice. Any failure to timely respond would result in the termination of the prosecution pursuant to 37 CFR 1.550(d).

In addition, if a final Office action should be issued subsequent to the mail date of this decision in this merged proceeding, any request for extension for time (to respond to any such subsequent final action) 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 Office action issued in the present merged proceeding subsequent to the mail date of this decision.

The merged proceeding will otherwise continue as per the above-identified prior merger decision.

CONCLUSION

1. Reissue application No. 11/430,302 and reexamination control Nos. 90/007,822 and 90/007,883 remain merged as a single proceeding.

2. 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, a request for continued examination (RCE) is not available in the reexamination proceeding, and any response to the outstanding Office action (e.g., response to a final rejection) at that stage in the reexamination proceeding must be made taking into account the non-availability of RCE practice. Any failure to timely respond would result in the termination of the prosecution pursuant to per 37 CFR 1.550(d).

3. In addition, if a final Office action should be issued in this merged proceeding subsequent to the mail date of this decision, then any request for extension for time (to respond to any such subsequent action) 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 Office action issued subsequent to the mail date of this decision.

4. All further examination in the merged proceeding is to continue to be conducted in accordance with the above-identified prior merger decision.

5. Telephone inquiries related to this decision should be directed to Colleen Dunn at (571) 272-1170, or in her absence to Eric Keasel at (571) 272-4929 or to Mark Reinhart at (571) 272-1611.

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

11/04/10

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,936	02/17/2006	5734961	18768-002LL1	7819

40401 7590 12/13/2010

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EXAMINER	
FOSTER, ROLAND G	
ART UNIT	PAPER NUMBER
3992	

MAIL DATE	DELIVERY MODE
12/13/2010	PAPER

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANTOR MEDIA CORPORATION

Appeal 2010-007531
Reexamination Control 90/007,839; 90/007,936; 90/007,942;
90/007,957; and 90/009,261
Technology Center 3900

DECISION ON PETITION

This is a decision on the "Petition Under 37 CFR 1.550(c) for Extension of Time to Request Rehearing of Board Decision" filed on December 6, 2010. In this Petition, directed to the Chief Judge of the Board of Patent Appeals and Interferences, the Appellant seeks a two month extension of time to request rehearing of the Decision on Appeal, which was mailed on October 21, 2010.

In support of the Petition, the Appellant's representative states that "In November, 2010" the patent owner and previous counsel agreed to terminate the representation. (Petition at 2). As no specific date is stated in the Petition, a logical conclusion is that this agreement was reached as early as November 1, about 10 days after the Decision was rendered. Read in this light, the Petition states that approximately 40 days prior to the filing of the instant Petition, the Appellant knew that it was going to seek new representation in these merged reexamination proceedings. The Petition does not indicate that any steps were taken to ensure compliance with approaching deadlines. This fact weighs against granting the Petition.

On November 29, about 40 days after the Decision, the petitioner states that the Appellant chose new representation. (Petition at 2). No reason for this period of delay is provided. This fact likewise weighs against granting the Petition.

The petitioner further states that the issues and prosecution history associated with the Decision are extensive. In support of this statement, the Appellant lists the Decision as being 27 pages long, the Examiner's Answer as being 231 pages long, and the Appeal Brief as being 90 pages long. (Petition at 2). However, in a request for rehearing a requestor must "state

with particularity the points believed to have been misapprehended or overlooked by the Board." 37 C.F.R. § 41.52(a)(1). In other words, the page lengths of the Briefing and Answer are not significantly relevant. On the other hand, the Board decision is concise at 27 pages and the issues, while complex, are not extraordinarily so. This fact likewise weighs against granting the Petition.

The petitioner further states that the patent attorney assigned to the case "is scheduled to spend 9 days out of the country in December" (Petition at 2.) However, the Petition does not state that no one else at the representative's offices is available to work on the case. Nor does the Petition state the gravity of the reason the patent attorney is out of the country, or whether the trip is optional and could be rescheduled. This fact weighs against granting the Petition.

The petitioner further states that the underlying patent, 5,734,961 is directed to complex telecommunications methods and systems, and requires extensive technical analysis and comparison against similarly complex applied art. (Petition at 2.) The posture of this case at this time is that the issues are developed, the analysis has been performed, and a decision has been rendered. Any issues to be raised in the context of a rehearing request are circumscribed by that decision and analysis, and we presume the Appellant's representative to be technologically capable. As a consequence, this fact likewise weighs against granting the Petition.

The Appellant's representative states that he "believes no fee is due with this petition." (Petition at 3). The Appellant's representative is directed to 37 C.F.R. § 41.52(b) which, with respect to extensions of time

for filing a request for rehearing in an ex parte reexamination proceeding appeal, states: "See . . . § 1.550(c) of this title for extensions of time to reply for ex parte reexamination proceedings." 37 C.F.R. § 1.550(c) in turn provides that "any action by a patent owner in an ex parte reexamination proceeding will be extended only for sufficient cause" and further that "[a]ny request for such extension must be accompanied by the petition fee set forth in § 1.17(g)." 37 C.F.R. § 1.17(g) specifies a $200 fee for a patent owner filing a request for extension of time in an ex parte reexamination proceeding.

Thus the appropriate fee of $200 shall be debited to the Appellant's representative's account.

DECISION

For the foregoing reasons, and in the absence of a showing of sufficient cause, the petition is hereby DENIED.

DENIED

James T. Moore
Acting Chief Administrative Patent Judge

Appeal 2010-007531
Reexamination Control 90/007,839; 90/007,936; 90/007,942; 90/007,957 and 90/009,261

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UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,936	02/17/2006	5734961	18768-002LL1	7819

40401 7590 12/22/2010

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EXAMINER	
FOSTER, ROLAND G	
ART UNIT	PAPER NUMBER
3992	

MAIL DATE	DELIVERY MODE
12/22/2010	PAPER

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte ANTOR MEDIA CORPORATION

Appeal 2010-007531
Ex parte Reexamination Control 90/007,839; 90/007,936; 90/007,942; 90/007,957; 90/009,261
Patent 5,734,961
Technology Center 3900

DECISION ON PETITION

This is a decision on Patent Owner's "Request for Reconsideration of Decision Under 37 CFR 1.550(c) for Extension of Time to Request Rehearing of Board Decision," filed December 16, 2010 ("Request for Reconsideration"). In the Request for Reconsideration, Patent Owner seeks to have the Decision on Petition entered December 13, 2010 reversed and an extension of two months to file a request for rehearing of the Board Decision on Appeal of October 21, 2010.

FINDINGS

1. On December 13, 2010, the Acting Chief Administrative Patent Judge issued a Decision on Petition denying Patent Owner's "Petition Under 37 CFR 1.550(c) for Extension of Time to Request Rehearing of Board Decision," filed December 6, 2010.

2. In the present Request for Reconsideration, Patent Owner argues that, following the Decision on Appeal, it experienced difficulty in obtaining new representation and that time will be required for a new representative to become familiar with the issues relevant to patentability. Request for Reconsideration, pp. 3-4.

3. Although not discussed in either the initial Petition or the Request for Reconsideration, a review of the record in these merged reexamination proceedings reveals that Abraham Hershkovitz of Hershkovitz & Associates, LLC, Patent Owner's current representative, was among the prior representation appointed by Patent Owner in a Revocation of Powers of Attorney With New Powers of Attorney, filed November 5, 2007.

4. Although not discussed in either the initial Petition or the Request for Reconsideration, a review of the record in these merged reexamination proceedings further reveals Mr. Hershkovitz personally participated in interviews with USPTO personnel and representatives of Patent Owner during prosecution of the merged reexamination proceedings. See Ex Parte Reexamination Interview Summaries of January 29, 2008, September 9, 2008 and February 9, 2009.

ANALYSIS

As indicated by the forgoing, the record in these merged reexamination proceedings establishes that Mr. Hershkovitz previously participated in these proceedings as a representative for Patent Owner. While Mr. Hershkovitz was associated with a different firm at the time of his

initial representation of Patent Owner, i.e., Fulbright & Jaworski L.L.P., Mr. Hershkovitz is not "new" to the proceedings at this juncture.

In view of the foregoing, the representations made in Patent Owner's Request for Reconsideration concerning Mr. Hershkovtiz's status as Patent Owner's newly appointed representative are inconsistent with the underlying facts.

DECISION

For the forgoing reason, the Request for Reconsideration is DENIED.

James T. Moore
Acting Chief Administrative Patent Judge

Ex parte Reexamination Control 90/007,839; 90/007,936; 90/007,942; 90/007,957; 90/009,261
Patent 5,734,961

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,940	02/16/2006	5506587	1553-1008-2	9570

466 7590 02/11/2011

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 02/11/2011

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Commissioner for Patents
United States Patents and Trademark Office
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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Date: MAILED
DEC 12 2001
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90007940
PATENT NO. : 5506587
ART UNIT : 3900

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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YOUNG & THOMPSON
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(For Patent Owner)

MAILED

MAR 11 2011

CENTRAL REEXAMINATION UNIT

MALIN HALEY DIMAGGIO BOWEN
& LHOTA, P.A.
1936 S ANDREWS AVENUE
FORT LAUDERDALE, FL 33316

(For Third Party Requester)

In re Hakan Lans.
Ex Parte Reexamination
Control Nos. 90/007,940
Filed: 16 February 2006
For: U.S. Patent 5,506,587

DECISION
DISMISSING
PETITION

This is a decision on the patent owner petition, filed 19 March 2010, denominated "Rule 181 Petition to Reinstate Appeal in Reexam" requesting vacature of the Notice of Intent to Issue Reexamination Certificate and reinstate the Appeal brief.

The proceeding and the petition are before the Central Reexamination Unit

The request for vacature and reinstatement under 37 CFR § 1.181 are **dismissed**, because the Office lacks jurisdiction over U.S. Patent 5,506,587, since reexamination proceeding Control No. 90/007,940 have now been concluded by the issuance and publication of a reexamination certificate.

REVIEW OF SALIENT FACTS

1. U.S. Patent No. 5,506,587 (hereinafter the '587 patent) issued on 09 April 1996 to Hakan Lans.
2. On 16 February 1006, a request for *ex parte* reexamination was filed by a third party and was assigned control No. 90/007,940 (hereinafter the '7,940 proceeding).
3. On 10 May 2006, reexamination was ordered in the '7,940 proceeding of the '587 patent.
4. On 28 December 2007, a non Final Office action was mailed in the '7,940 proceeding of the '587 patent.
5. On 05 September 2008, a Final Office action was mailed in the '7,940 proceeding of the '587 patent.

6. On 23 February 2009 a second Final Office action was mailed in the '7,940 proceeding of the '587 patent. .

7. On 23 April 2009 the Notice of Appeal was received in the '7,940 proceeding of the '587 patent.

8. On 15 September 2009, a Notification of Non-Compliant Appeal was mailed in the '7,940 proceeding of the '587 patent.

9. On 15 January 2010, a Notice to Issue Reexamination Certificate was mailed in the '7,940 proceeding of the '587 patent. The Notice of Intent to Issue Reexamination Certificate was mailed for failure to fully comply with the requirements of the Notification of Non-Compliance mailed on 15 September 2009.

10. On 19 March 2010 the instant petition was received in the '7,940 proceeding of the '587 patent.

11. On 30 March 2010 the Certificate was mailed in the '7,940 proceeding of the '587 patent.

DECISION

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

MPEP 1305 states in part:

> Once a patent has been granted, the U.S. Patent and Trademark Office can take no action concerning it, except as provided in 35 U.S.C. 135, 35 U.S.C. 251 through 256, 35 U.S.C. 302 through 307 and 35 U.S.C. 311 through 316.

§ 1.181 Petition to the Director.

> (a) Petition may be taken to the Director:
>
> (1) From any action or requirement of any examiner in the *ex parte* prosecution of an application, or in *ex parte* or *inter partes* prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;
>
> (2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and
>
> (3) To invoke the supervisory authority of the Director in appropriate circumstances. For petitions involving action of the Board of Patent Appeals and Interferences, see § **41.3** of this title.
>
> (b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Briefs or memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declarations (and exhibits, if any) must accompany the petition.
>
> (c) When a petition is taken from an action or requirement of an examiner in the *ex parte* prosecution of an application, or in the *ex parte* or *inter partes* prosecution of a reexamination proceeding, it may be required that there have been a proper request for reconsideration (§ **1.111**) and a repeated action by the examiner.

The examiner may be directed by the Director to furnish a written statement, within a specified time, setting forth the reasons for his or her decision upon the matters averred in the petition, supplying a copy to the petitioner.

(d) Where a fee is required for a petition to the Director the appropriate section of this part will so indicate. If any required fee does not accompany the petition, the petition will be dismissed.

(e) Oral hearing will not be granted except when considered necessary by the Director.

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

(g) The Director may delegate to appropriate Patent and Trademark Office officials the determination of petitions.

§ 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).

§ 1.183 Suspension of rules.

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

ANALYSIS AND FINDINGS

Once a patent has been granted, the U.S. Patent and Trademark Office can take no action concerning it, except as provided in 35 U.S.C. 135, 35 U.S.C. 251 through 256, 35 U.S.C. 302 through 307 and 35 U.S.C. 311 through 316. See MPEP 1305. The Office does not have jurisdiction to act on a petition matter in a reexamination proceeding after the reexamination certificate has issued and published, because the Office lacks jurisdiction over the patent that was reexamined, once the reexamination proceeding has been concluded by the issuance and publication of a reexamination certificate.

In this case, the Notice of Intent to Issue the Reexamination Certificate was issued on 19 January 2010. Two full months after the Notice was issued, the patent owner filed a petition on Friday, 19 March 2010, which permitted only eleven business days to process and act on the petition before the reexamination certificate issued and published on its scheduled date for issuance and publication. Although the petition states that, the patent owner believed that they had fully complied with the Notification of Non-Compliant Appeal Brief - the situation remains that the petition was not filed with sufficient time to permit the Office to process the paper and withdraw

the proceeding from the printing process prior to issuance and publication of the certificate. As a result, the Office now lacks jurisdiction to render a decision on the petition. Accordingly, the petition is dismissed.

CONCLUSION

1. For the reasons set forth above, the Request for Vacature and Reinstatement of the Appeal pursuant to 37 CFR § 1.181 is **dismissed** for lack of jurisdiction.

2. The reexamination proceedings have concluded, and the *Ex Parte* Reexamination Certificate U.S. 5,506,587 has issued on 30 March 2010.

3. Any inquiry concerning this communication should be directed to Mark Reinhart, Supervisory Patent Examiner in Art Unit 3992, Central Reexamination Unit, at (571) 272-1611.

Irem Yucel
Director
Central Reexamination UNit

MJR/09 Feb 2010

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,940	02/16/2006	5506587	1553-1008-2	9570

466 7590 10/20/2011

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 10/20/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
BARRY L. HALEY, ESQ. MALIN, HALEY, &
DiMAGGIO, P.A.
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FORT LAUDERDALE, FL 33316

Date:
MAILED
OCT 20 2011
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90007940
PATENT NO. : 5506587
ART UNIT : 3900

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
P.O. Box 1450
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YOUNG & THOMPSON
209 Madison Street
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(For Patent Owner)

MAILED

OCT 20 2011

CENTRAL REEXAMINATION UNIT

MALIN HALEY DIMAGGIO BOWEN
& LHOTA, P.A.
1936 S ANDREWS AVENUE
FORT LAUDERDALE, FL 33316

(For Third Party Requester)

In re: Lans.
Ex Parte Reexamination
Control Nos. 90/007,940
Filed: 16 February 2006
For: U.S. Patent 5,506,587

DECISION
DISMISSING
PETITION

This is a decision on the patent owner petition, filed 25 March 2011, denominated "Petition to Reconsider Decision on Petition to Reinstate Appeal in *Ex Parte* Reexamination" requesting reconsideration of the decision mailed 11 February 2011 to reinstate the Appeal the in instant reexamination proceeding .

The petition is before the Central Reexamination Unit.

The request for reconsideration is **dismissed**, because the Office lacks jurisdiction over U.S. Patent 5,506,587, since reexamination proceeding Control No. 90/007,940 have now been concluded by the issuance and publication of a reexamination certificate.

REVIEW OF SALIENT FACTS

- U.S. Patent No. 5,506,587 (hereinafter the '587 patent) issued on 09 April 1996 to Håkam Lans.
- On 16 February 2006, a request for *ex parte* reexamination was filed by a third party and was assigned control No. 90/007,940 (hereinafter the '7,940 proceeding).
- On 10 May 2006, reexamination was ordered in the '7,940 proceeding of the '587 patent.
- On 20 March 2010 a Notice of Intent to Issue Reexamination Certificate was mailed due to improper response from the patent owner to the previously mailed Office action in the '7,940 proceeding.
- On 19 March 2010 a petition and declaration were submitted under 37 CFR 1.181 to the '7,940 proceeding.
- On 30 March 2010 the Certificate was mailed in the '7,940 proceeding of the '587 patent.
- On 11 February 2011 a decision dismissing the 19 March 2010 petition was mailed.
- On 25 March 2011 the instant petition for reconsideration was filed.

DECISION

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

MPEP 1305 states in part:

> Once a patent has been granted, the U.S. Patent and Trademark Office can take no action concerning it, except as provided in 35 U.S.C. 135, 35 U.S.C. 251 through 256, 35 U.S.C. 302 through 307 and 35 U.S.C. 311 through 316.

37 CFR § 1.181 Petition to the Director.

(a) Petition may be taken to the Director:

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

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

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

(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Briefs or memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declarations (and exhibits, if any) must accompany the petition.

(c) When a petition is taken from an action or requirement of an examiner in the ex parte prosecution of an application, or in the ex parte or inter partes prosecution of a reexamination proceeding, it may be required that there have been a proper request for reconsideration (§ 1.111) and a repeated action by the examiner. The examiner may be directed by the Director to furnish a written statement, within a specified time, setting forth the reasons for his or her decision upon the matters averred in the petition, supplying a copy to the petitioner.

(d) Where a fee is required for a petition to the Director the appropriate section of this part will so indicate. If any required fee does not accompany the petition, the petition will be dismissed.

(e) Oral hearing will not be granted except when considered necessary by the Director.

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

(g) The Director may delegate to appropriate Patent and Trademark Office officials the determination of petitions.

ANALYSIS AND FINDINGS

Once a patent has been granted, the U.S. Patent and Trademark Office can take no action concerning it, except as provided in 35 U.S.C. 135, 35 U.S.C. 251 through 256, 35 U.S.C. 302 through 307 and 35 U.S.C. 311 through 316. See MPEP 1305. The Office does not have jurisdiction to act on a petition matter in a reexamination proceeding after the reexamination certificate has issued and published, because the Office lacks jurisdiction over the patent that was reexamined, once the reexamination proceeding has been concluded by the issuance and publication of a reexamination certificate.

In this case, the Reexamination Certificate was issued on 30 March 2010. The petition was filed 25 March 2011 nearly one year following the issuance of the certificate on 30 March 2010. Since the certificate has issued the Office lacks jurisdiction over the patent at this time.

As a result, the Office now lacks jurisdiction to render a decision on the petition. Accordingly, the petition is dismissed.

CONCLUSION

1. For the reasons set forth above, the Request for Reconsideration of Petition to Reinstate Appeal in *Ex Parte* Reexamination pursuant to 37 CFR § 1.181 is **dismissed** for lack of jurisdiction.

2. The reexamination proceedings have concluded, and the *Ex Parte* Reexamination Certificate U.S. 5,506,587 has issued on 30 March 2010.

3. Any inquiry concerning this communication should be directed to Mark Reinhart, Supervisory Patent Examiner in Art Unit 3992, Central Reexamination Unit, at (571) 272-1611.

Irem Yucel
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.
90/007,942	02/17/2006	5734961	62797/P0001RE/10616216	2496

40401 7590 12/13/2010

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EXAMINER	
FOSTER, ROLAND G	
ART UNIT	PAPER NUMBER
3992	

MAIL DATE	DELIVERY MODE
12/13/2010	PAPER

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANTOR MEDIA CORPORATION

Appeal 2010-007531
Reexamination Control 90/007,839; 90/007,936; 90/007,942;
90/007,957; and 90/009,261
Technology Center 3900

DECISION ON PETITION

This is a decision on the "Petition Under 37 CFR 1.550(c) for Extension of Time to Request Rehearing of Board Decision" filed on December 6, 2010. In this Petition, directed to the Chief Judge of the Board of Patent Appeals and Interferences, the Appellant seeks a two month extension of time to request rehearing of the Decision on Appeal, which was mailed on October 21, 2010.

In support of the Petition, the Appellant's representative states that "In November, 2010" the patent owner and previous counsel agreed to terminate the representation. (Petition at 2). As no specific date is stated in the Petition, a logical conclusion is that this agreement was reached as early as November 1, about 10 days after the Decision was rendered. Read in this light, the Petition states that approximately 40 days prior to the filing of the instant Petition, the Appellant knew that it was going to seek new representation in these merged reexamination proceedings. The Petition does not indicate that any steps were taken to ensure compliance with approaching deadlines. This fact weighs against granting the Petition.

On November 29, about 40 days after the Decision, the petitioner states that the Appellant chose new representation. (Petition at 2). No reason for this period of delay is provided. This fact likewise weighs against granting the Petition.

The petitioner further states that the issues and prosecution history associated with the Decision are extensive. In support of this statement, the Appellant lists the Decision as being 27 pages long, the Examiner's Answer as being 231 pages long, and the Appeal Brief as being 90 pages long. (Petition at 2). However, in a request for rehearing a requestor must "state

with particularity the points believed to have been misapprehended or overlooked by the Board." 37 C.F.R. § 41.52(a)(1). In other words, the page lengths of the Briefing and Answer are not significantly relevant. On the other hand, the Board decision is concise at 27 pages and the issues, while complex, are not extraordinarily so. This fact likewise weighs against granting the Petition.

The petitioner further states that the patent attorney assigned to the case "is scheduled to spend 9 days out of the country in December" (Petition at 2.) However, the Petition does not state that no one else at the representative's offices is available to work on the case. Nor does the Petition state the gravity of the reason the patent attorney is out of the country, or whether the trip is optional and could be rescheduled. This fact weighs against granting the Petition.

The petitioner further states that the underlying patent, 5,734,961 is directed to complex telecommunications methods and systems, and requires extensive technical analysis and comparison against similarly complex applied art. (Petition at 2.) The posture of this case at this time is that the issues are developed, the analysis has been performed, and a decision has been rendered. Any issues to be raised in the context of a rehearing request are circumscribed by that decision and analysis, and we presume the Appellant's representative to be technologically capable. As a consequence, this fact likewise weighs against granting the Petition.

The Appellant's representative states that he "believes no fee is due with this petition." (Petition at 3). The Appellant's representative is directed to 37 C.F.R. § 41.52(b) which, with respect to extensions of time

for filing a request for rehearing in an ex parte reexamination proceeding appeal, states: "See . . . § 1.550(c) of this title for extensions of time to reply for ex parte reexamination proceedings." 37 C.F.R. § 1.550(c) in turn provides that "any action by a patent owner in an ex parte reexamination proceeding will be extended only for sufficient cause" and further that "[a]ny request for such extension must be accompanied by the petition fee set forth in § 1.17(g)." 37 C.F.R. § 1.17(g) specifies a $200 fee for a patent owner filing a request for extension of time in an ex parte reexamination proceeding.

Thus the appropriate fee of $200 shall be debited to the Appellant's representative's account.

DECISION

For the foregoing reasons, and in the absence of a showing of sufficient cause, the petition is hereby DENIED.

DENIED

James T. Moore
Acting Chief Administrative Patent Judge

Appeal 2010-007531
Reexamination Control 90/007,839; 90/007,936; 90/007,942; 90/007,957 and 90/009,261

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,942	02/17/2006	5734961	62797/P0001RE/10616216	2496

40401 7590 12/22/2010

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EXAMINER	
FOSTER, ROLAND G	
ART UNIT	PAPER NUMBER
3992	

MAIL DATE	DELIVERY MODE
12/22/2010	PAPER

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte ANTOR MEDIA CORPORATION

Appeal 2010-007531
Ex parte Reexamination Control 90/007,839; 90/007,936; 90/007,942; 90/007,957; 90/009,261
Patent 5,734,961
Technology Center 3900

DECISION ON PETITION

This is a decision on Patent Owner's "Request for Reconsideration of Decision Under 37 CFR 1.550(c) for Extension of Time to Request Rehearing of Board Decision," filed December 16, 2010 ("Request for Reconsideration"). In the Request for Reconsideration, Patent Owner seeks to have the Decision on Petition entered December 13, 2010 reversed and an extension of two months to file a request for rehearing of the Board Decision on Appeal of October 21, 2010.

FINDINGS

1. On December 13, 2010, the Acting Chief Administrative Patent Judge issued a Decision on Petition denying Patent Owner's "Petition Under 37 CFR 1.550(c) for Extension of Time to Request Rehearing of Board Decision," filed December 6, 2010.

2. In the present Request for Reconsideration, Patent Owner argues that, following the Decision on Appeal, it experienced difficulty in obtaining new representation and that time will be required for a new representative to become familiar with the issues relevant to patentability. Request for Reconsideration, pp. 3-4.

3. Although not discussed in either the initial Petition or the Request for Reconsideration, a review of the record in these merged reexamination proceedings reveals that Abraham Hershkovitz of Hershkovitz & Associates, LLC, Patent Owner's current representative, was among the prior representation appointed by Patent Owner in a Revocation of Powers of Attorney With New Powers of Attorney, filed November 5, 2007.

4. Although not discussed in either the initial Petition or the Request for Reconsideration, a review of the record in these merged reexamination proceedings further reveals Mr. Hershkovitz personally participated in interviews with USPTO personnel and representatives of Patent Owner during prosecution of the merged reexamination proceedings. See Ex Parte Reexamination Interview Summaries of January 29, 2008, September 9, 2008 and February 9, 2009.

ANALYSIS

As indicated by the forgoing, the record in these merged reexamination proceedings establishes that Mr. Hershkovitz previously participated in these proceedings as a representative for Patent Owner. While Mr. Hershkovitz was associated with a different firm at the time of his

initial representation of Patent Owner, i.e., Fulbright & Jaworski L.L.P., Mr. Hershkovitz is not "new" to the proceedings at this juncture.

In view of the foregoing, the representations made in Patent Owner's Request for Reconsideration concerning Mr. Hershkovtiz's status as Patent Owner's newly appointed representative are inconsistent with the underlying facts.

DECISION

For the forgoing reason, the Request for Reconsideration is DENIED.

James T. Moore
Acting Chief Administrative Patent Judge

Ex parte Reexamination Control 90/007,839; 90/007,936; 90/007,942; 90/007,957; 90/009,261
Patent 5,734,961

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,957	03/03/2006	5734961	04395.0003.000000	9567

40401 7590 12/13/2010

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FOSTER, ROLAND G	
ART UNIT	PAPER NUMBER
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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANTOR MEDIA CORPORATION

Appeal 2010-007531
Reexamination Control 90/007,839; 90/007,936; 90/007,942;
90/007,957; and 90/009,261
Technology Center 3900

DECISION ON PETITION

This is a decision on the "Petition Under 37 CFR 1.550(c) for Extension of Time to Request Rehearing of Board Decision" filed on December 6, 2010. In this Petition, directed to the Chief Judge of the Board of Patent Appeals and Interferences, the Appellant seeks a two month extension of time to request rehearing of the Decision on Appeal, which was mailed on October 21, 2010.

In support of the Petition, the Appellant's representative states that "In November, 2010" the patent owner and previous counsel agreed to terminate the representation. (Petition at 2). As no specific date is stated in the Petition, a logical conclusion is that this agreement was reached as early as November 1, about 10 days after the Decision was rendered. Read in this light, the Petition states that approximately 40 days prior to the filing of the instant Petition, the Appellant knew that it was going to seek new representation in these merged reexamination proceedings. The Petition does not indicate that any steps were taken to ensure compliance with approaching deadlines. This fact weighs against granting the Petition.

On November 29, about 40 days after the Decision, the petitioner states that the Appellant chose new representation. (Petition at 2). No reason for this period of delay is provided. This fact likewise weighs against granting the Petition.

The petitioner further states that the issues and prosecution history associated with the Decision are extensive. In support of this statement, the Appellant lists the Decision as being 27 pages long, the Examiner's Answer as being 231 pages long, and the Appeal Brief as being 90 pages long. (Petition at 2). However, in a request for rehearing a requestor must "state

with particularity the points believed to have been misapprehended or overlooked by the Board." 37 C.F.R. § 41.52(a)(1). In other words, the page lengths of the Briefing and Answer are not significantly relevant. On the other hand, the Board decision is concise at 27 pages and the issues, while complex, are not extraordinarily so. This fact likewise weighs against granting the Petition.

The petitioner further states that the patent attorney assigned to the case "is scheduled to spend 9 days out of the country in December" (Petition at 2.) However, the Petition does not state that no one else at the representative's offices is available to work on the case. Nor does the Petition state the gravity of the reason the patent attorney is out of the country, or whether the trip is optional and could be rescheduled. This fact weighs against granting the Petition.

The petitioner further states that the underlying patent, 5,734,961 is directed to complex telecommunications methods and systems, and requires extensive technical analysis and comparison against similarly complex applied art. (Petition at 2.) The posture of this case at this time is that the issues are developed, the analysis has been performed, and a decision has been rendered. Any issues to be raised in the context of a rehearing request are circumscribed by that decision and analysis, and we presume the Appellant's representative to be technologically capable. As a consequence, this fact likewise weighs against granting the Petition.

The Appellant's representative states that he "believes no fee is due with this petition." (Petition at 3). The Appellant's representative is directed to 37 C.F.R. § 41.52(b) which, with respect to extensions of time

for filing a request for rehearing in an ex parte reexamination proceeding appeal, states: "See . . . § 1.550(c) of this title for extensions of time to reply for ex parte reexamination proceedings." 37 C.F.R. § 1.550(c) in turn provides that "any action by a patent owner in an ex parte reexamination proceeding will be extended only for sufficient cause" and further that "[a]ny request for such extension must be accompanied by the petition fee set forth in § 1.17(g)." 37 C.F.R. § 1.17(g) specifies a $200 fee for a patent owner filing a request for extension of time in an ex parte reexamination proceeding.

Thus the appropriate fee of $200 shall be debited to the Appellant's representative's account.

DECISION

For the foregoing reasons, and in the absence of a showing of sufficient cause, the petition is hereby DENIED.

DENIED

James T. Moore
Acting Chief Administrative Patent Judge

Appeal 2010-007531
Reexamination Control 90/007,839; 90/007,936; 90/007,942; 90/007,957 and 90/009,261

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,957	03/03/2006	5734961	04395.0003.000000	9567

40401 7590 12/22/2010

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Ex parte ANTOR MEDIA CORPORATION

Appeal 2010-007531
Ex parte Reexamination Control 90/007,839; 90/007,936; 90/007,942; 90/007,957; 90/009,261
Patent 5,734,961
Technology Center 3900

DECISION ON PETITION

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As indicated by the forgoing, the record in these merged reexamination proceedings establishes that Mr. Hershkovitz previously participated in these proceedings as a representative for Patent Owner. While Mr. Hershkovitz was associated with a different firm at the time of his

initial representation of Patent Owner, i.e., Fulbright & Jaworski L.L.P., Mr. Hershkovitz is not "new" to the proceedings at this juncture.

In view of the foregoing, the representations made in Patent Owner's Request for Reconsideration concerning Mr. Hershkovtiz's status as Patent Owner's newly appointed representative are inconsistent with the underlying facts.

DECISION

For the forgoing reason, the Request for Reconsideration is DENIED.

James T. Moore
Acting Chief Administrative Patent Judge

Ex parte Reexamination Control 90/007,839; 90/007,936; 90/007,942; 90/007,957; 90/009,261
Patent 5,734,961

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,004	06/29/2006	6966259	MSM0001	4056

7590 01/21/2011

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 01/21/2011

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MICHAEL S. MARCUS, ESQ.
DICKSTEIN SHAPIRO LLP
1825 EYE STREET, NW
WASHINGTON, DC 2006-5403

Date:

MAILED

JAN 21 2011

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008004
PATENT NO. : 6966259
ART UNIT : 3900

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
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MAILED

JAN 21 2011

CENTRAL REEXAMINATION UNIT

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Michael S. Marcus, Esq. : (For Third-Party Requester)
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WASHINGTON DC 2006-5403 :

In re KANGA *et alia* : DECISION ON
Reexamination Proceeding : PETITION UNDER
Control No. 90 / 008,004 : 37 CFR 1.181
Request Deposited: April 12, 2006 : FOR ENTRY OF REPLY BRIEF
For: U.S. Patent No. 6,966,259 :

This is a decision on patent owner's petition for consideration of the previously filed Reply Brief, or, in the alternative, for entry of the substitute Reply Brief filled concurrently with petition filed on December 23, 2008. The petition is before the Central Reexamination Unit for consideration. It is noted the petition is filed under 37 CFR 1.181 or in the alternative under 37 CFR 1.183. Noting 37 CFR 1.4(c), presentation of petitions under alternative rules is prohibited. Rather than dismiss the petition as improperly presented, the petition is being construed and considered under 37 CFR 1.181. The petition appears timely filed and no fee is due.

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

REVIEW OF RELEVANT FACTS

1. Reexamination of U.S. Patent No. 6,966,259 was ordered in the Determination mailed August 25, 2006.

2. Prosecution was closed with the final rejection mailed March 30, 2009.

3. Appeal was undertaken by patent Owner with the Notice of Appeal filed May 29, 2009 and subsequent Brief of July 28, 2009.

4. An examiner's answer was mailed by the Office on September 18, 2009.

5. A reply Brief was submitted by Owner on November 11, 2009. This reply Brief was denied entry in the Notice of December 9, 2009.

6. This instant petition, with proposed substitute reply Brief, was filed December 23, 2009.

The delay in consideration of the instant petition is regretted.

DECISION

Petitioner contends the examiner's refusal to enter the November 11, 2009 reply brief was in error. Petitioner seeks relief in the grant of entry of the reply brief at issue. Alternatively, petitioner seeks relief of a substitute/replacement reply brief filed concurrently with the instant petition.

The examiner refused entry of the November 11, 2009 reply brief as it allegedly contained new evidence and owner had not provided a showing of good and sufficient reasons why the evidence was necessary and was not earlier presented. Specifically, the examiner objected to the reply brief containing references to the evidence presented in the Feinberg and Fryd patents. These patents were explicitly discussed for the first time in the proceeding in the reply brief. Reply brief page 15. Additionally, the examiner objected to the citation of the dictionary definition as owner had not provided a showing of good and sufficient reasons why the evidence was not earlier presented.

The petition argues the Feinberg and Fryd patents are incorporated by reference in the applied Fan '142 patent. Petitioner notes MPEP 2163.07(b) and concludes that the discussions of Feinberg and Fryd are not newly presented evidence but simply explain in greater detail examples of suitable Fan '142 compositions. While this statement may be true, and while the cited MPEP guidance proscribes incorporation by reference precludes a later assertion the subject matter is "new" to the specification which references, this is within the context of examination of patent applications and the question of new matter. That subject matter can be incorporated does not address the context of argument and whether or not the argued evidence is new to the record of argument in the proceeding. The prohibition of entry of new evidence late in a proceeding is premised on the need for the record to be fixed so that a meaningful and efficient appeal may be taken. To allow argument to be supplemented after brief and answer by pointing to evidence never before asserted to the record, regardless of its inclusion in the record, frustrates the fixed record. Accordingly, petitioners arguments are not well taken and the examiner's position on this point appears well founded. Having reached this conclusion, denial of entry of the reply brief appears proper and consideration of the second issue/argument need not occur.

Turning to petitioner's alternative requested relief, the substitute reply brief filed December 23, 2009 omits reference to the offending evidence found in the Feinberg and Fryd patents. Further petitioner presents reasoning why the dictionary definitions were not earlier presented in the petition, pages 2 -3. It appears fair that this substitute brief be allowed entry.

CONCLUSION

1. Petitioner's request is granted –in - part . Petitioners request for entry of the originally submitted reply brief is denied while petitioner's request for entry of the substitute reply brief is granted.

2. The file is being forwarded to the examiner for notation of consideration of the substitute reply brief and will be forwarded to the Board of Patent Appeals and Interferences in due course.

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

Irem Yucel
Director, Technology Center 1600

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(For Patent Owner)

MAILED

JAN 21 2011

IP Group of DLA Piper LLP (US)
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Philadelphia, PA 19103

(For Requester)

CENTRAL REEXAMINATION UNIT

In re Brownrigg et al
Ex Parte Reexamination Proceeding
Control No. 90/008,011
Filed: July 24, 2006
For: U.S. Patent No. 6,044,062

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

This is a decision on the August 26, 2010 patent owner petition under 37 CFR 1.182, entitled "Second Petition Under 37 CFR § 1.182 and PTO Official Gazette of March 1, 2005 to Consider Declaration and Reply Brief" (the August 26, 2010 patent owner petition).

The August 26, 2010 patent owner petition and the record as a whole are before the Office of Patent Legal Administration for consideration.

DECISION

The August 26, 2010 petition requests entry of evidence prior to a decision by the Board of Patent Appeals and Interferences (BPAI). It is **dismissed as moot** in view of the November 10, 2010 BPAI decision, which affirmed-in-part the examiner's rejections, and in view of patent owner's December 9, 2010 response to the BPAI decision, which cancelled all of the rejected claims, and requested an early issuance of a Notice of Intent to Issue a Reexamination Certificate (NIRC) indicating the patentability and/or confirmation of the allowed claims.

CONCLUSION

- The August 26, 2010 patent owner petition is **dismissed as moot**.

- 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

1/20/2011

UNITED STATES PATENT AND TRADEMARK OFFICE

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(For patent owner)

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(For third party requester)

MAILED
OCT 20 2010
CENTRAL REEXAMINATION UNIT

In re Ronald A. Katz
Ex Parte Reexamination Proceeding
Control No. 90/008,051
Filed: June 2, 2006
For: U.S. Patent No. 6,434,223

: **DECISION**
: **GRANTING PETITION**
: **UNDER 37 CFR 1.137(b)**
: **AND VACATING**
: **CERTIFICATE**

This is a decision on the July 26, 2010 patent owner petition under 37 CFR 1.137(b) to accept an unintentionally delayed Appeal Brief and revive the present terminated reexamination ("the July 26, 2010 patent owner petition to revive").

The July 26, 2010 patent owner petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The July 26, 2010 patent owner petition to revive is **granted**.

Reexamination Certificate No. C1 6,434,223 issued May 25, 2010, for the present proceeding, and the January 21, 2010 Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) for the present proceeding, are hereby **vacated**.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

35 U.S.C. 41(a)(7) provides, in pertinent part:

> REVIVAL FEES. — On filing each petition ... for an unintentionally delayed response by the patent owner in any reexamination proceeding ...

35 U.S.C. 133 provides:

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

35 U.S.C. 305 provides, in pertinent part:

> After the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title.

37 CFR 1.113 provides, in pertinent part:

> (a) On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon ... for *ex parte* reexaminations filed under § 1.510, patent owner's reply is limited to appeal in the case of rejection of any claim (§ 41.31 of this title), or to amendment as specified in § 1.114 or § 1.116.
> *
> *
> (c) Reply to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the reply to a final rejection or action must comply with any requirements or objections as to form.

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 1.550 provides, in pertinent part:

> (d) If the patent owner fails to file a timely and appropriate response to any Office action or any written statement of an interview required under § 1.560(b), the prosecution in the *ex parte* reexamination proceeding will be a terminated prosecution, and the Director will proceed to issue and publish a certificate concluding the reexamination proceeding under § 1.570 in accordance with the last action of the Office.
>
> (e) If a response by the patent owner is not timely filed in the Office,
>
> *
>
> *
>
> (2) The response may nevertheless be accepted if the delay was unintentional; a petition to accept an unintentionally delayed response must be filed in compliance with § 1.137(b).

37 CFR 41.33 provides, in pertinent part:

> (a) Amendments filed after the date of filing an appeal pursuant to § 41.31(a)(1) through (a)(3) and prior to the date a brief is filed pursuant to § 41.37 may be admitted as provided in § 1.116 of this title.

37 CFR 41.37 provides, in pertinent part:

> (a)(1) Appellant must file a brief under this section within two months from the date of filing the notice of appeal under § 41.31.

MPEP 2268 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, all *ex parte* reexamination proceedings by section 4605 of the American Inventors Protection Act of 1999. The unintentional delay provisions of 35 U.S.C. 41(a)(7) became effective in reexamination proceedings on November 29, 2000. Accordingly, the Office will consider, in appropriate circumstances, a petition showing unintentional delay under 37 CFR 1.137(b) where untimely papers are filed 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 set forth in 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).

MPEP 2274 provides, in pertinent part:

> I. AMENDMENT
>
> Where the appeal brief is not filed, but within the period allowed for filing the brief an amendment is presented which places the claims of the patent under reexamination in a patentable condition, the amendment may be entered.
> *
> *
> IV. FAILURE TO TIMELY FILE APPEAL BRIEF
>
> Failure to file the brief and/or the appeal brief fee within the permissible time will result in dismissal of the appeal. ... The reexamination prosecution is then terminated, and a Notice of Intent to Issue Ex Parte Reexamination Certificate (NIRC) (see MPEP § 2287) will subsequently be issued indicating the status of the claims at the time of appeal.

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), the instant reexamination proceeding was terminated due to the failure to timely submit a proper response, within the meaning of 37 CFR 1.113, to the March 19, 2009 final Office action. Although patent owner timely filed a Notice of Appeal on July 27, 2009, patent owner's September 28, 2009 appeal brief was non-compliant, and patent owner failed to timely file a compliant appeal brief in response to the November 13, 2009 Notification of Non-Compliant Appeal Brief.

Patent owner submitted a supplemental appeal brief on July 26, 2010. The July 26, 2010 appeal brief has been found to be in compliance with the regulations. Further, patent owner was charged the $540.00 37 CFR 41.20(b)(2) fee for filing a brief in support of an appeal on September 29, 2009. Item (1) has thus been satisfied.

A petition fee of $1,620.00 and a proper statement under 37 CFR 1.137(b)(3) were submitted as part of the July 26, 2010 patent owner petition to revive, which satisfy items (2) and (3), respectively.

Accordingly, the July 26, 2010 patent owner petition to revive is **granted**.

In this instance, Reexamination Certificate No. C1 6,434,223 issued for the present proceeding on May 25, 2010. Based on the granting of the petition to revive, both the Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) issued on January 21, 2010, and the reexamination certificate are hereby **vacated**.

In due course, the following *erratum* will be published in the *Official Gazette*:

> All reference to Reexamination Certificate No. C1 6,434,223 to Ronald A. Katz of Los Angeles, CA (US) for TELEPHONE INTERFACE CALL PROCESSING SYSTEM WITH CALL SELECTIVITY, appearing in the *Official Gazette* of May 25, 2010, should be deleted, since the reexamination certificate has been vacated.

CONCLUSION

1. The July 26, 2010 patent owner petition to revive under 37 CFR 1.137(b) is **granted**.

2. The termination of prosecution noted in the January 21, 2010 NIRC, and the NIRC itself, are **vacated**.

3. The *Ex Parte* Reexamination Certificate issued May 25, 2010, is **vacated**.

4. The Office of Patent Publications will take action with respect to the 6,434,223 patent consistent with this decision.

5. Art Unit 3992 of the Central Reexamination Unit will process the July 26, 2010 supplemental appeal brief in the 90/008,051 reexamination proceeding, after which the examiner will proceed to issue an examiner's answer under 37 CFR 41.39 or take other appropriate action.

6. Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Erik Kielin, of CRU Art Unit 3992, at (571) 272-1693.

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

/Kenneth M. Schor/

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

10-19-2010
kenpetWD.../

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

RONALD A. KATZ TECHNOLOGY LICENSING L.P.
Patent Owner

JOHN L. WELSH
Third Party Requester

Ex parte Reexamination Control 90/008,051
Patent 6,434,223

DECISION ON PETITION

This is a decision on Patent Owner's "Petition Under 37 C.F.R. § 41.3," filed October 7, 2010 ("Present Petition"). In the Petition, Patent Owner seeks an oral hearing before the Chief Administrative Patent Judge "to address the merits of Petitioner's Petition Under 37 C.F.R. § 1.137(b) to Revive Unintentionally Terminated Reexamination Prosecution ...." Present Petition, p. 1.

FINDINGS

1. On July 26, 2010, Patent Owner filed a Petition Under 37 C.F.R. § 1.137(b) to Revive Unintentionally Terminated Reexamination Prosecution ("Petition to Revive").

2. On October 7, 2010, Patent Owner filed the Present Petition seeking an oral hearing on the Petition to Revive.

3. On October 20, 2010, the Office of Patent Legal Administration entered a Decision Granting Petition Under 37 CFR 1.137(b) [Petition to Revive] and Vacating Certificate ("Decision").

ANALYSIS

As indicated by the forgoing sequence of events, the Petition to Revive was granted by the Decision entered October 20, 2010. Thus, the Present Petition is now moot.

DECISION

For the forgoing reasons, the Present Petition is DISMISSED as moot.

James T. Moore
Acting Chief Administrative Patent Judge

Ex parte Reexamination Control 90/008,051
Patent 6,434,223

Counsel for Patent Owner:
Reena A. Kuyper
Berry & Associates P.C.
9229 Sunset Boulevard, Suite 630
Los Angeles, CA 90069

Counsel for Third Party Requester:
John L. Welsh
Welsh & Flaxman LLC
2000 Duke Street, Suite 100
Alexandria, VA 22314

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,055	06/26/2006	6967479	GEMS8081.209-REEX	8866

27061 7590 03/25/2011

ZIOLKOWSKI PATENT SOLUTIONS GROUP, SC (GEMS)
136 S WISCONSIN ST
PORT WASHINGTON, WI 53074

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/25/2011

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

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United States Patent and Trademark Office
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MAR 25 2011

CENTRAL REEXAMINATION UNIT

(For Patent Owner)

ZIOLKOWSKI PATENT SOLUTIONS GROUP, SC (GEMS)
136 S WISCONSIN ST
PORT WASHINGTON WI 53074

In re: Polzon *et alia* :
Reexamination Proceeding :
Control No. 90/008,055 :
Request Deposited: June 26, 2006 :
For: U.S. Patent No. 6,967,479 :

This is a decision on the August 18, 2009 paper entitled "PETITION UNDER 37 C.F.R. §1.181 REQUESTING CORRECTION OF EX PARTE REEXAMINATION CERTIFICATE ISSUED JULY 21, 2009"

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

Initially, it is noted that filing a petition under 37 CFR 1.181 is not warranted in this instance. Patent Owner is respectfully directed to MPEP chapter 1400 for Certificate of Correction practice.

It is strongly advised that the text of the correction requested be submitted on a Certificate of Correction form, PTO/SB/44 (also referred to as PTO 1050). Submission of this form in duplicate is not necessary. The location of the error in the printed patent should be identified on form PTO/SB/44 by column and line number or claim and line number. See MPEP § 1485 for a discussion of the preparation and submission of a request for a Certificate of Correction.

As to the merits of the request, it is noted that claim 38 is a new claim that was added and determined to be patentable. Accordingly, the request to designate it as a confirmed claim and also list it as an original claim with only the word --and-- added is not approved.

CONCLUSION

1. The patent owner's request for correction is **dismissed**.

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

Eric Keasel
SPE, Central Reexamination Unit

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.:20110413

DATE : April 17, 2011

TO SPE OF : ART UNIT 3992

SUBJECT : Request for Certificate of Correction on Patent No.: 6,967,479 C1

A response is requested with respect to the accompanying request for a certificate of correction.

Please complete this form and return with file, within **7** days to:
Certificates of Correction Branch - PK 3-910
Palm location **7590** - Tel. No. 305-8201

With respect to the change(s) requested, correcting Office and/or Applicant's errors, should the patent read as shown in the certificate of correction? No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Thank You For Your Assistance **Certificates of Correction Branch**

The request for issuing the above-identified correction(s) is hereby:
Note your decision on the appropriate box.

☒ **Approved** **All** changes apply.

☐ **Approved in Part** Specify below which changes **do not** apply.

☐ **Denied** State the reasons for denial below.

Comments:

The corrections to the reexam certificate are approved

SPE: /Eric Keasel/ **Art Unit** 3992

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.:20110413

DATE : April 13, 2011

TO SPE OF : ART UNIT 3992

SUBJECT : Request for Certificate of Correction on Patent No.: 6,967,479 C1

A response is requested with respect to the accompanying request for a certificate of correction.

Please complete this form and return with file, within **7** days to:
Certificates of Correction Branch - PK 3-910
Palm location **7590** - Tel. No. 305-8201

With respect to the change(s) requested, correcting Office and/or Applicant's errors, should the patent read as shown in the certificate of correction? No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Thank You For Your Assistance **Certificates of Correction Branch**

The request for issuing the above-identified correction(s) is hereby:
Note your decision on the appropriate box.

☒ **Approved** **All** changes apply.

☐ **Approved in Part** Specify below which changes **do not** apply.

☐ **Denied** State the reasons for denial below.

Comments:

The corrections to the reexam certificate are approved

Eric Keasel

SPE: Eric Keasel **Art Unit** 3992

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.:20110417

DATE : April 17, 2011

TO SPE OF : ART UNIT 3992

SUBJECT : Request for Certificate of Correction on Patent No.: 6,707,300 C1

A response is requested with respect to the accompanying request for a certificate of correction.

Please complete this form and return with file, within **7** days to:
Certificates of Correction Branch - PK 3-910
Palm location **7590** - Tel. No. 305-8201

With respect to the change(s) requested, correcting Office and/or Applicant's errors, should the patent read as shown in the certificate of correction? No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Thank You For Your Assistance **Certificates of Correction Branch**

The request for issuing the above-identified correction(s) is hereby:
Note your decision on the appropriate box.

☒ **Approved** **All** changes apply.

☐ **Approved in Part** Specify below which changes **do not** apply.

☐ **Denied** State the reasons for denial below.

Comments:

The corrections of the reexam certificate are approved

SPE: /Eric Keasel/ **Art Unit** 3992

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,056	06/26/2006	6707300	GEMS8081.127-REEX	9307

27061 7590 04/19/2011

ZIOLKOWSKI PATENT SOLUTIONS GROUP, SC (GEMS)
136 S WISCONSIN ST
PORT WASHINGTON, WI 53074

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/19/2011

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CENTRAL REEXAMINATION UNIT

(For Patent Owner)

ZIOLKOWSKI PATENT SOLUTIONS GROUP, SC (GEMS)
136 S WISCONSIN ST
PORT WASHINGTON WI 53074

In re: Polzon *et alia*
Reexamination Proceeding
Control No. 90/008,056
Request Deposited: June 26, 2006
For: U.S. Patent No. 6,707,300

This is a decision on the August 18, 2009 paper entitled "PETITION UNDER 37 C.F.R. §1.181 REQUESTING CORRECTION OF EX PARTE REEXAMINATION CERTIFICATE ISSUED JULY 21, 2009"

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

Initially, it is noted that filing a petition under 37 CFR 1.181 is not warranted in this instance. Patent Owner is respectfully directed to MPEP chapter 1400 for Certificate of Correction practice.

The Office separately prepared the Certificate of Correction form, PTO/SB/44 (also referred to as PTO 1050).

Accordingly, the petition is dismissed as moot.

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

Eric Keasel
SPE, 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.
90/008,063	08/07/2006	6480710	027952-001701US	8900

33717 7590 09/29/2010

GREENBERG TRAURIG LLP (LA)
2450 COLORADO AVENUE, SUITE 400E
INTELLECTUAL PROPERTY DEPARTMENT
SANTA MONICA, CA 90404

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 09/29/2010

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

JEFFERY L. CAMERON
BROOKS & CAMERON PLLC
1221 NICOLLET AVENUE, SUITE 500
MINNEAPOLIS, MN 55403

Date:

MAILED

SEP 2 9 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008063
PATENT NO. : 6480710
ART UNIT : 3900

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O. Box 1450
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(For Patent Owner)

GREENBERG TRAURIG LLP (LA)
2450 COLORADO AVENUE, SUITE 400E
INTELLECTUAL PROPERTY DEPARTMENT
SANTA MONICA CA 90404

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SEP 2 9 2010

CENTRAL REEXAMINATION UNIT

(For Requester)

Brooks & Cameron, PLLC
1221 Nicollet Avenue, Suite 500
Minneapolis, MN 55403

In re Laybourn *et alia*	:	
Reexamination Proceeding	:	**DECISION**
Control No. 90/008,063	:	**ON**
Corrected Request Deposited: August 7, 2006	:	**PETITION**
For: U.S. Patent No. 6,480,710	:	

This is a decision on the August 24, 2010 paper entitled "REQUEST FOR RECONSIDERATION OF DECISION DATED JUNE 24, 2010 DISMISSING PETITION TO DIRECTOR UNDER 37 C.F.R. § 1.181" requesting reconsideration of the decision dismissing a request for entry of an after-final amendment previously requested in a petition filed October 28, 2009 entitled "PETITION TO DIRECTOR UNDER 37 CFR §1.181" requesting "to enter the Amendment filed May 5, 2009".

The *ex parte* reexamination is before the Director of the Central Reexamination Unit for reconsideration the June 24, 2010 decision.

The request for reconsideration is granted to the extent the request is reconsidered; however, the arguments are found unpersuasive and the petition of October 28, 2009 remains **DISMISSED** as untimely for the reasons set forth below.

BACKGROUND and DECISION

After non-final rejection, Patent Owner (PO) did not amend the claims.

The examiner issued a final rejection on March 5, 2009.

An interview was conducted on April 22, 2009.

PO proposed an amendment to the claims in an after-final response filed May 5, 2009.

The examiner did not enter the proposed amendment in the advisory action of June 4, 2009.

PO filed a Notice of Appeal on July 1, 2009.

Another interview was conducted on August 28, 2009.

An appeal brief was filed on September 1, 2009.

Another interview was held on September 11, 2009.

A Notice of non-compliant appeal brief was September 24, 2009.

An amended appeal brief was filed on October 26, 2009.

A petition was filed on October 28, 2009. Said petition requested entry of the proposed amendment of May 5, 2009 that was not entered in the advisory action mailed June 4, 2009.

A decision dismissing the October 28, 2009 as untimely was mailed on June 24, 2010. An examiner's answer was also mailed on June 24, 2010.

A reply brief was filed on August 24, 2010. A petition requesting reconsideration of the June 24, 2010 decision was also filed on August 24, 2010.

The reply brief was entered and the proceeding was forwarded to the Board of Patent Appeals and Interferences on August 27, 2010.

The appeal was docketed at the Board on September 3, 2010.

The appeal was remanded on September 7, 2010 for consideration of the petition requesting reconsideration of the June 24, 2010 decision.

37 CFR 1.181(f) states, in part:

> Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

Since the advisory action of June 4, 2009 was the action from which relief is requested, the petition of October 28, 2009 is untimely.

Petitioner points to 37 CFR 1.181(c) to explain the belatedness of the petition:

"When a petition is taken from an action or requirement of an examiner in the *ex parte* prosecution of an application, or in the *ex parte* or *inter partes* prosecution of a reexamination proceeding, it may be required that there have been a proper request for reconsideration (§ 1.111) and a repeated action by the examiner."

However, Petitioner did not file a reply under 37 CFR 1.111 requesting reconsideration; therefore, the argument is unpersuasive.

Petitioner argues that the request to schedule an interview could be considered a reply under 37 CFR 1.111.

37 CFR 1.111 states, in part:

> In order to be entitled to reconsideration or further examination, the applicant or patent owner must reply to the Office action. The reply by the applicant or patent owner must be reduced to a writing which distinctly and specifically points out the supposed errors in the examiner's action and must reply to every ground of objection and rejection in the prior Office action.

A request to schedule an interview is not a reply to an Office action. Therefore, the argument is unpersuasive.

The request to reconsider the decision mailed June 24, 2010 is found unpersuasive and the petition of October 28, 2009 remains **DISMISSED** as untimely.

CONCLUSION

1. Petitioner's request for reconsideration has been considered, but is found unpersuasive and the petition remains **dismissed** as untimely.

2. The proceeding is forwarded to the Board of Patent Appeals and Interferences for decision.

3. Inquiries regarding this decision may be directed to the undersigned, or, in the alternative to Eric Keasel, Supervisory Patent Examiner, at (571) 272-4929.

4. This decision is not a final agency decision and is without prejudice to request reconsideration or higher-level review.

Gregory A. Morse
Director, Central Reexamination Unit

Additional Discussion

Arguendo, had the petition to review non-entry of the after-final amendment been timely filed, the petition would have been dismissed on the merits. Petitioner argues the proposed change of cancelling dependent claims 14 and 23 and adding a variation of the language of those claims in independent claims 1 and 21 does not require further consideration. It is unclear why patent owner presented a variation of the language of the dependent claims when proposing an amendment to the independent claims. However, it is clear that such an amendment would significantly change the scope of dependent claims 2-13, 15-18, 22, and 24-37, which would require further consideration and introduce new issues at appeal. Furthermore, the proposed amendment that was denied entry presented additional proposed amendments to claims 6 and 33 that would require further consideration.

UNITED STATES PATENT AND TRADEMARK OFFICE

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SEP 30 2010

CENTRAL REEXAMINATION UNIT

Commissioner for Patents
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(For Patent Owner)

GREENBERG TRAURIG LLP (LA)
2450 COLORADO AVENUE, SUITE 400E
INTELLECTUAL PROPERTY DEPARTMENT
SANTA MONICA CA 90404

(For Requester)

Brooks & Cameron, PLLC
1221 Nicollet Avenue, Suite 500
Minneapolis, MN 55403

In re Laybourn *et alia* :
Reexamination Proceeding : **DECISION**
Control No. 90/008,065 : **ON**
Corrected Request Deposited: August 7, 2006 : **PETITION**
For: U.S. Patent No. 6,625439 :

This is a decision on the August 24, 2010 paper entitled "REQUEST FOR RECONSIDERATION OF DECISION DATED JUNE 24, 2010 DISMISSING PETITION TO DIRECTOR UNDER 37 C.F.R. § 1.181" requesting reconsideration of the decision dismissing a request for entry of an after-final amendment previously requested in a petition filed October 28, 2009 entitled "PETITION TO DIRECTOR UNDER 37 CFR §1.181" requesting "to enter the Amendment filed May 5, 2009".

The *ex parte* reexamination is before the Director of the Central Reexamination Unit for reconsideration the June 24, 2010 decision.

The request for reconsideration is granted to the extent the request is reconsidered; however, the arguments are found unpersuasive and the petition of October 28, 2009 remains **DISMISSED** as untimely for the reasons set forth below.

BACKGROUND and DECISION

After non-final rejection, Patent Owner (PO) did not amend the claims.

The examiner issued a final rejection on March 5, 2009.

An interview was conducted on April 22, 2009.

PO proposed an amendment to the claims in an after-final response filed May 5, 2009.

The examiner did not enter the proposed amendment in the advisory action of June 4, 2009.

PO filed a Notice of Appeal on July 1, 2009.

An appeal brief was filed on September 1, 2009.

Another interview was held on September 11, 2009.

A Notice of non-compliant appeal brief was September 24, 2009.

An amended appeal brief was filed on October 26, 2009.

A petition was filed on October 28, 2009. Said petition requested entry of the proposed amendment of May 5, 2009 that was not entered in the advisory action mailed June 4, 2009.

A decision dismissing the October 28, 2009 as untimely was mailed on June 24, 2010. An examiner's answer was also mailed on June 24, 2010.

A reply brief was filed on August 24, 2010. A petition requesting reconsideration of the June 24, 2010 decision was also filed on August 24, 2010.

The reply brief was entered and the proceeding was forwarded to the Board of Patent Appeals and Interferences on August 27, 2010.

The appeal was docketed at the Board on September 3, 2010.

The appeal was remanded on September 7, 2010 for consideration of the petition requesting reconsideration of the June 24, 2010 decision.

37 CFR 1.181(f) states, in part:

> Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

Since the advisory action of June 4, 2009 was the action from which relief is requested, the petition of October 28, 2009 is untimely.

Petitioner points to 37 CFR 1.181(c) to explain the belatedness of the petition:

"When a petition is taken from an action or requirement of an examiner in the *ex parte* prosecution of an application, or in the *ex parte* or *inter partes* prosecution of a reexamination proceeding, it may be required that there have been a proper request for reconsideration (§ 1.111) and a repeated action by the examiner."

However, Petitioner did not file a reply under 37 CFR 1.111 requesting reconsideration; therefore, the argument is unpersuasive.

Petitioner argues that the request to schedule an interview could be considered a reply under 37 CFR 1.111.

37 CFR 1.111 states, in part:

> In order to be entitled to reconsideration or further examination, the applicant or patent owner must reply to the Office action. The reply by the applicant or patent owner must be reduced to a writing which distinctly and specifically points out the supposed errors in the examiner's action and must reply to every ground of objection and rejection in the prior Office action.

A request to schedule an interview is not a reply to an Office action. Therefore, the argument is unpersuasive.

The request to reconsider the decision mailed June 24, 2010 is found unpersuasive and the petition of October 28, 2009 remains **DISMISSED** as untimely.

CONCLUSION

1. Petitioner's request for reconsideration has been considered, but is found unpersuasive and the petition remains **dismissed** as untimely.

2. The proceeding is forwarded to the Board of Patent Appeals and Interferences for decision.

3. Inquiries regarding this decision may be directed to the undersigned, or, in the alternative to Eric Keasel, Supervisory Patent Examiner, at (571) 272-4929.

4. This decision is not a final agency decision and is without prejudice to request reconsideration or higher-level review.

Gregory A. Morse
Director, Central Reexamination Unit

Additional Discussion

Arguendo, had the petition to review non-entry of the after-final amendment been timely filed, the petition would have been dismissed on the merits. Petitioner argues the proposed change of cancelling dependent claim 3 and adding a variation of the language of those claims in independent claim 1 does not require further consideration. It is unclear why patent owner presented a variation of the language of the dependent claims when proposing an amendment to the independent claims. However, it is clear that such an amendment would significantly change the scope of dependent claim 4, which would require further consideration and introduce new issues at appeal.

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,104	09/15/2006	6023683	EPL-001REX	2837

70813 7590 06/24/2011

GOODWIN PROCTER LLP
901 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20001

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/24/2011

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte ePlus, Inc.
Appellant and Assignee

Appeal 2010-007804
Reexamination Control No. 90/008,104
Patent 6,023,683
Technology Center 3900

DECISION ON PETITION

This is a decision on Patent Owner's "Petition under 37 C.F.R. § 41.3," ("present petition") of May 18, 2011. In the petition, patent owner requests that the "Statement of Status of Concurrent Litigation," filed by third party requester on May 12, 2011, be expunged. The petition fee of $400 in accordance with 37 C.F.R. § 41.20(a) was charged to patent owner's deposit account on May 18, 2011.

FINDINGS

1. On September 15, 2006, third party requester filed a request for *ex parte* reexamination of U.S. Patent No. 6,023,683, which was assigned Control No. 90/008,104.

2. On October 28, 2006, reexamination was ordered and a non-final Office action was mailed on February 29, 2008.

3. Prosecution was conducted and on January 8, 2009, a Final Office Action was mailed.

4. Patent owner filed a Notice of Appeal on March 6, 2009, and an appeal brief on May 6, 2009.

5. Patent owner filed a respondent brief on January 29, 2010.

6. On February 26, 2010, an examiner's answer was mailed.

7. Requester filed a reply brief and a request for oral hearing on April 26, 2010.

8. On May 19, 2010, an Appeal Docketing Notice was mailed.

9. On May 18, 2011, a BPAI Decision on Appeal was mailed.

10. Patent owner filed the present petition on May 18, 2011.

RELEVANT AUTHORITY

37 CFR § 41.3 provides:

(a) Deciding official. Petitions must be addressed to the Chief Administrative Patent Judge. A panel or an administrative patent judge may certify a question of policy to the Chief Administrative Patent Judge for decision. The Chief Administrative Patent Judge may delegate authority to decide petitions.

(b) Scope. This section covers petitions on matters pending before the Board (§§ 41.35, 41.64, 41.103, and 41.205); otherwise, see §§ 1.181 to 1.183 of this title. The following matters are not subject to petition:

(1) Issues committed by statute to a panel, and
(2) In pending contested cases, procedural issues. See § 41.121(a) (3) and § 41.125(c).

(c) Petition fee. The fee set in § 41.20(a) must accompany any petition under this section except no fee is required for a petition under this section seeking supervisory review.

(d) Effect on proceeding. The filing of a petition does not stay the time for any other action in a Board proceeding.

(e) Time for action.
(1) Except as otherwise provided in this part or as the Board may authorize in writing, a party may:
(i) File the petition within 14 days from the date of the action from which the party is requesting relief, and
(ii) File any request for reconsideration of a petition decision within 14 days of the decision on petition or such other time as the Board may set.
(2) A party may not file an opposition or a reply to a petition without Board authorization.

37 CFR 1.565(a) provides:

In an ex parte reexamination proceeding before the Office, the patent owner must inform the Office of any prior or concurrent proceedings in which the patent is or was involved such as interferences, reissues, ex parte reexaminations, inter partes reexaminations, or litigation and the results of such proceedings. See § 1.985 for notification of prior or concurrent proceedings in an inter partes reexamination proceeding.

MPEP 2282 provides in part:

It is important for the Office to be aware of any prior or concurrent proceedings in which a patent undergoing ex parte reexamination is or was involved, such as interferences, reissues, inter partes reexaminations, other ex parte reexaminations or litigations, and any results of such proceedings. . . . Ordinarily, no submissions of any kind by third parties filed after the date of the order are entered into the reexamination or patent file while the reexamination proceeding is pending. However, in order to ensure a complete file, with updated status information regarding prior or concurrent proceedings regarding the patent under reexamination, the Office will, at any time, accept from any parties, for entry into the reexamination file, copies of notices of suits and other proceedings involving the patent and copies of decisions or papers filed in the court from litigations or other proceedings involving the patent. >Such decisions include final court decisions (even if the decision is still appealable), decisions to vacate, decisions to remand, and decisions as to the merits of the patent claims. Non-merit decisions on motions such as for a new venue, a new trial/discovery date, or sanctions will not be entered into the patent file, and will be expunged from the patent file by closing the appropriate paper if they were entered before discovery of their nature. Further, papers filed in the court from litigations

or other proceedings involving the patent will not be entered into the record (and will be expunged if already entered) if they provide a party's arguments, such as a memorandum in support of summary judgment. If the argument has an entry right in the reexamination proceeding, it must be submitted via the vehicle (provision(s) of the rules) that provides for that entry right. It is not required nor is it permitted that parties submit copies of copending reexamination proceedings and applications (which copies can be mistaken for a new request/filing); rather, submitters may provide a notice identifying the application/proceeding number and its status. Any submission that is not permitted entry will be returned, expunged, or discarded, at the sole discretion of the Office.< It is to be noted that if the Office, in its sole discretion, deems the volume of the papers filed from litigations or other proceedings to be too extensive/lengthy, the Office may return >, expunge or discard, at its sole discretion,< all or part of the submission. In such an instance, a party may limit the submission in accordance with what is deemed relevant, and resubmit the papers. Persons making such submissions must limit the submissions to the notification, and must not include further arguments or information. **Where a submission is not limited to bare notice of the prior or concurrent proceedings (in which a patent undergoing reexamination is or was involved), the submission will be returned by the Office.** It is to be understood that highlighting of certain text by underlining, fluorescent marker, etc., goes beyond bare notice of the prior or concurrent proceedings. (emphasis added)

DISCUSSION

In the petition, patent owner requests that the "Statement of Status of Concurrent Litigation," filed by third party requester on May 12, 2011, be expunged. Patent owner asserts that the statement goes beyond bare notice of the concurrent litigation. A review of the record reveals that the statement is not limited to bare notice of the concurrent litigation pursuant to MPEP 2282. Therefore, the submission is improper. The present petition is **granted**.

DECISION

In view of the foregoing, the present petition is GRANTED.

The requester's submission of May 12, 2011, will be closed from the Office's Image File Wrapper (IFW) system and made non-viewable.

James Donald Smith
Chief Administrative Patent Judge

Counsel for Patent Owner:
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Counsel for Third Party Requester:
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UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,104	09/15/2006	6023683	EPL-001REX	2837

70813 7590 09/29/2011

GOODWIN PROCTER LLP
901 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20001

EXAMINER	
POKRZYWA, JOSEPH R	

ART UNIT	PAPER NUMBER
3992	

MAIL DATE	DELIVERY MODE
09/29/2011	PAPER

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ePlus, Inc.[1]

Appeal 2010-007804
Reexamination Control 90/008,104
Patent 6,023,683[2]
Technology Center 3900

DECISION ON PETITION

This is a decision on the "PETITION UNDER 37 C.F.R. § 41.3 and 37 C.F.R. § 1.183 TO ENTER NEW EVIDENCE," filed July 13, 2011 ("Petition"). The Petition requests "that the new evidence presented herein be entered," and "an opportunity to fully address the new evidence presented in connection with the Patent Owner's Request for Rehearing" or alternatively, "that the Board consider the Patent Owner's Revised Request for Rehearing." Petition 4.

---

[1] ePlus, Inc. is the assignee of the subject patent and the real party in interest.
[2] Issued February 8, 2000, to James M. Johnson et al.

FINDINGS

1) On March 6, 2009, Appellants filed a Notice of Appeal.

2) On May 6, 2009, Appellants filed an Appeal Brief.

3) On February 26, 2010, an Examiner's Answer was mailed to Appellants.

4) On April 26, 2010, Appellants filed a Reply Brief and a Request For Oral Hearing.

5) On May 12, 2010, the Examiner acknowledgement to the Reply Brief was entered and considered.

6) On May 19, 2010, an Appeal Docketing Notice was mailed to Appellants.

7) On July 14, 2010, Appellants filed a Confirmation of Hearing.

8) On October 20, 2010, Appellants presented arguments at Oral Hearing.

9) On May 18, 2011, a Decision On Appeal, affirming the Examiner, was mailed to the Appellants.

10) On July 13, 2011, Appellants filed the instant Petition, along with both a Request for Rehearing and a Revised Request for Rehearing.

11) Attached to the Petition are excerpts of deposition transcripts given by Laurene Fielder McEneny and by Jesus Ramos and a Revised Request For Rehearing Under 37 C.F.R. § 41.79 Following Board Decision On Appeal.

12) The Appellants state the following as facts in their petition:

> 10)The '683 Patent was asserted in three federal district court cases, namely: (1) *ePlus, Inc.* v. *Ariba, Inc.*, C.A. No. 1:04-cv-612 (E.D. Va. 2004); (2) *ePlus, Inc.* v. *SAP America, Inc. and SAP AG,* C.A. No. 3:05-cv-281 (E.D. Va. 2005), and, most recently, (3) *ePlus Inc. v. Lawson Software, Inc.* Civil Action No. 3:09CV620 (E.D.Va. 2010).

11) The Ariba litigation resulted in a jury verdict for the Patent Owner and defendant Ariba taking a license.

12) The SAP litigation was concluded through a settlement between the parties.

13) In the *Lawson Software* litigation, on January 27,2011, the jury returned a verdict finding that claims 26, 28, and 29 are not anticipated or rendered obvious by prior art. In addition, the jury found that Lawson Software infringed claims 26, 28, and 29.

14) During the *Lawson Software* litigation, the authors of the P.O. Writer Plus and Gateway/2000 Manuals, Ms. Fielder McEneny and Mr. Ramos, testified under oath with respect to the teachings and public accessibility of the manuals.

15) Ms. McEneny's deposition took place on June 10, 2010.

16) Mr. Ramos's deposition took place on May 24, 2010.

Petition 2-3.

RELEVANT AUTHORITY

37 C.F.R. § 1.183 states:

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

37 C.F.R. § 41.33 states:

> (a) Amendments filed after the date of filing an appeal pursuant to § 41.31(a)(1) through (a)(3) and prior to the date a brief is filed pursuant to § 41.37 may be admitted as provided in § 1.116 of this title.
>
> (b) Amendments filed on or after the date of filing a brief pursuant to § 41.37 may be admitted:
>
> (1) To cancel claims, where such cancellation does not affect the scope of any other pending claim in the proceeding, or

(2) To rewrite dependent claims into independent form.

(c) All other amendments filed after the date of filing an appeal pursuant to § 41.31(a)(1) through (a)(3) will not be admitted except as permitted by §§ 41.39(b)(1), 41.50(a)(2)(i), 41.50(b)(1) and 41.50(c).

(d)(1) An affidavit or other evidence filed after the date of filing an appeal pursuant to § 41.31(a)(1) through (a)(3) and prior to the date of filing a brief pursuant to § 41.37 may be admitted if the examiner determines that the affidavit or other evidence overcomes all rejections under appeal and that a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented has been made.

(2) All other affidavits or other evidence filed after the date of filing an appeal pursuant to § 41.31(a)(1) through (a)(3) will not be admitted except as permitted by §§ 41.39(b)(1), 41.50(a)(2)(i) and 41.50(b)(1).

37 C.F.R. § 41.39(b) states:

(b) If an examiner's answer contains a rejection designated as a new ground of rejection, appellant must within two months from the date of the examiner's answer exercise one of the following two options to avoid sua sponte dismissal of the appeal as to the claims subject to the new ground of rejection:

(1) Reopen prosecution. Request that prosecution be reopened before the primary examiner by filing a reply under § 1.111 of this title with or without amendment or submission of affidavits (§§ 1.130, 1.131 or 1.132 of this title) or other evidence. Any amendment or submission of affidavits or other evidence must be relevant to the new ground of rejection. A request that complies with this paragraph will be entered and the application or the patent under ex parte reexamination will be reconsidered by the examiner under the provisions of § 1.112 of this title. Any request that prosecution be reopened under this paragraph will be treated as a request to withdraw the appeal.

(2) Maintain appeal. Request that the appeal be maintained by filing a reply brief as set forth in § 41.41. Such a reply brief must address each new ground of rejection as set forth in § 41.37(c)(1)(vii)

and should follow the other requirements of a brief as set forth in § 41.37(c). A reply brief may not be accompanied by any amendment, affidavit (§§ 1.130, 1.131 or 1.132 of this title) or other evidence. If a reply brief filed pursuant to this section is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under paragraph (b)(1) of this section..

37 C.F.R. § 41.50(a)(2)(i) states:

(2) If a supplemental examiner's answer is written in response to a remand by the Board for further consideration of a rejection pursuant to paragraph (a)(1) of this section, the appellant must within two months from the date of the supplemental examiner's answer exercise one of the following two options to avoid sua sponte dismissal of the appeal as to the claims subject to the rejection for which the Board has remanded the proceeding:

(i) Reopen prosecution. Request that prosecution be reopened before the examiner by filing a reply under § 1.111 of this title with or without amendment or submission of affidavits (§§ 1.130, 1.131 or 1.132 of this title) or other evidence. Any amendment or submission of affidavits or other evidence must be relevant to the issues set forth in the remand or raised in the supplemental examiner's answer. A request that complies with this paragraph will be entered and the application or the patent under ex parte reexamination will be reconsidered by the examiner under the provisions of § 1.112 of this title. Any request that prosecution be reopened under this paragraph will be treated as a request to withdraw the appeal.

37 C.F.R. § 41.50(b)(1) states:

(b) Should the Board have knowledge of any grounds not involved in the appeal for rejecting any pending claim, it may include in its opinion a statement to that effect with its reasons for so holding, which statement constitutes a new ground of rejection of the claim. A new ground of rejection pursuant to this paragraph shall not be considered final for judicial review. When the Board makes a new ground of rejection, the appellant, within two months from the date of the decision, must exercise one of the following two options with

respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. The new ground of rejection is binding upon the examiner unless an amendment or new evidence not previously of record is made which, in the opinion of the examiner, overcomes the new ground of rejection stated in the decision. Should the examiner reject the claims, appellant may again appeal to the Board pursuant to this subpart.

37 C.F.R. § 41.52(a)(1) states:

(a)(1) Appellant may file a single request for rehearing within two months of the date of the original decision of the Board. No request for rehearing from a decision on rehearing will be permitted, unless the rehearing decision so modified the original decision as to become, in effect, a new decision, and the Board states that a second request for rehearing would be permitted. The request for rehearing must state with particularity the points believed to have been misapprehended or overlooked by the Board. Arguments not raised in the briefs before the Board and evidence not previously relied upon in the brief and any reply brief(s) are not permitted in the request for rehearing except as permitted by paragraphs (a)(2) and (a)(3) of this section. When a request for rehearing is made, the Board shall render a decision on the request for rehearing. The decision on the request for rehearing is deemed to incorporate the earlier opinion reflecting its decision for appeal, except for those portions specifically withdrawn on rehearing, and is final for the purpose of judicial review, except when noted otherwise in the decision on rehearing.

ARGUMENTS

Appellants, in the current Petition, argue:

[t]he evidence that the Patent Owner seeks to have entered – evidence unavailable to the Patent Owner at the time of the Appeal and the Board at the time of its Decision – directly contradicts these factual findings made by the Board. In fact, the evidence shows that the

> authors of the manuals took steps to maintain them as confidential and would not license the software to their competitors, who are likely to comprise the vast majority of those skilled in art.

Petition 5.

Appellants argue that this evidence shows that the references that formed the basis of the prior art rejection would not have been sold to competitors. Petition 7. Appellants also argue that this evidence further shows the obligations customers were under to not divulge the contents of the references. Petition 7-9.

DISCUSSION

Rule 37 C.F.R. § 41.33 specifies that evidence submitted after the filing of an appeal brief "will not be admitted except as permitted by §§ 41.39(b)(1), 41.50(a)(2)(i) and 41.50(b)(1)." None of these provisions apply in the instant case, and Appellants have not contended that any do apply. Thus, Appellants are petitioning for extraordinary relief under 37 C.F.R. § 1.183.

Appellants' contention rests on the assertion that the proffered evidence contradicts the panel's basis for affirming the rejections, and that the evidence only came into Appellants' possession after the appeal was filed. The Petition indicates that the proffered evidence in the form of depositions from *ePlus Inc. v. Lawson Software, Inc.* were taken on May 24, 2010, and June 10, 2010. Both dates are after Appellants filed their Reply Brief, on April 26, 2010. The Petition further indicates that the jury in that case returned a verdict finding that claims 26, 28, and 29 are not anticipated or rendered obvious by prior art.

Because this evidence was not submitted in a timely manner because the evidence did not come into being until after the filing of the Appeal Brief; the evidence is asserted to contradict the basis for the panel's conclusions; and the

verdict in the parallel litigation is at least probative of the evidence's potential capacity for persuasion, the panel will consider the evidence along with the Request for Rehearing. This consideration of both the evidence and the Appellants' Rehearing Request will provide the requested "opportunity to fully address the new evidence presented in connection with the Patent Owner's Request for Rehearing."

The Revised Request for Rehearing, as distinguished from the Request for Rehearing, is only provided as an alternative should this petition be denied, and so the Revised Request is dismissed as moot.

DECISION

For the reasons set forth above, the Petition is GRANTED.

James Donald Smith
Chief Administrative Patent Judge

nlk

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,113	09/07/2006	6711615	18033-0005RX1	2543

26181 7590 08/19/2010

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 08/19/2010

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

RENEE D. BROWN

DAY,CASEBERR,MADRID & BATCHELDER LLP

20300 STEVENS CREEK BLVD. SUITE400

CUPERTINO, CA 95014

MAILED

AUG 19 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/008113

PATENT NO. 6,711,615

ART UNI 3993

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Renee DuBoard Brown
Howrey LLP
4th Floor
1950 University Avenue
East Palo Alto, CA 94303-2281

MAILED

AUG 19 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/008113

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CENTRAL REEXAMINATION UNIT

DAY CASEBEER MADRID & BATCHELDER LLP
20300 STEVENS CREEK BOULEVARD
SUITE 400
CUPERTINO, CA 95014

(For Requester)

In re Porras *et alia*
Reexamination Proceeding
Control No. 90/008,113
For: U.S. Patent No. 6,484,203

: DECISION DISMISSING
: PETITIONS UNDER
: 37 CFR 1.116 AND
: 37 CFR 1.550(c)

In re Porras *et alia*
Reexamination Proceeding
Control No. 90/009,127
For: U.S. Patent No. 6,484,203

This is a decision on the March 2, 2009 "RENEWED PETITION FOR ADMISSION OF EVIDENCE UNDER 37 C.F.R. §1.116" requesting that appendices of evidence submitted on March 2, 2009 be entered and the April 29, 2009 "PETITION FOR AN EXTENSION OF TIME UNDER 37 C.F.R. §1.550(C)"

The petitions are before the Director of the Central Reexamination Unit for consideration.

The petitions are **dismissed as moot** for the reasons set forth below.

DECISION

Petitioner's attention is respectfully directed to the petition decision of December 4, 2008, which addressed the same issue as the admission of evidence under 37 CFR 1.116.

It is premature to petition for the entry of the evidence when the examiner has not yet made a determination to not enter the evidence. It is also noted that the examiner did enter the evidence as noted in the advisory action mailed May 14, 2009.

Therefore, the petition "for admission of evidence" is **dismissed as moot**.

The petition for extension of time is **dismissed as moot** in view of the timely filed appeal brief on May 4, 2009.

CONCLUSION

1. Petitioner's requests are **dismissed as moot**.

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 Eric Keasel, at (571) 272-4929, or Mark Reinhart, at (571) 272-1611.

Eric Keasel
SPE, Art Unit 3992

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,123	07/07/2006	6321338	18033-0003RX1	3409

26181 7590 08/19/2010

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 08/19/2010

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

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East Palo Alto, CA 94303-2281

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AUG 19 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/008,123*.

PATENT NO. *6321338*.

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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Howrey LLP
4th Floor
1950 University Avenue
East Palo Alto, CA 94303-2281

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/008,123*.

PATENT NO. *6321338*.

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)).

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AUG 19 2010

CENTRAL REEXAMINATION UNIT

DAY CASEBEER MADRID & BATCHELDER LLP
20300 STEVENS CREEK BOULEVARD
SUITE 400
CUPERTINO, CA 95014

(For Requester)

In re Porras *et alia*
Reexamination Proceeding
Control No. 90/008,123
For: U.S. Patent No. 6,321,338

: DECISION DISMISSING
: PETITION UNDER
: 37 CFR 1.116
:

This is a decision on the March 9, 2009 "RENEWED PETITION FOR ADMISSION OF EVIDENCE UNDER 37 C.F.R. §1.116" requesting that appendices of evidence submitted on March 9, 2009 be entered.

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

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

DECISION

Petitioner's attention is respectfully directed to the petition decision of December 4, 2008, which addressed the same issue.

It is premature to petition for the entry of the evidence when the examiner has not yet made a determination to not enter the evidence. It is also noted that the examiner did enter the evidence submitted on March 9, 2009 as noted in the advisory action mailed May 14, 2009.

Therefore, the petition is **dismissed as moot**.

CONCLUSION

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

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
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Central Reexamination Unit

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

Eric Keasel
SPE, Art Unit 3992

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AUG 20 2010

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(For Patent Owner)

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East Palo Alto, CA 94303-2281

(For Requester)

In re Porras *et alia*
Reexamination Proceeding
Control No. 90/008,125
For: U.S. Patent No. 6,484,203

: DECISION DISMISSING
: PETITION UNDER
: 37 CFR 1.116

In re Porras *et alia*
Reexamination Proceeding
Control No. 90/009,126
For: U.S. Patent No. 6,484,203

This is a decision on the February 24, 2009 "PETITION FOR ADMISSION OF EVIDENCE UNDER 37 C.F.R. §1.116" requesting that appendices of evidence submitted on February 24, 2009 be entered.

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

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

DECISION

Petitioner's attention is respectfully directed to the petition decision of December 3, 2008, which addressed the same issue.

It is premature to petition for the entry of the evidence when the examiner has not yet made a determination to not enter the evidence. It is also noted that the examiner did enter the evidence as noted in the advisory action mailed May 14, 2009.

Therefore, the petition is **dismissed as moot**.

CONCLUSION

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

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 Eric Keasel, at (571) 272-4929, or Mark Reinhart, at (571) 272-1611.

Eric Keasel
SPE, Art Unit 3992

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.
90/008,133	09/07/2006	6024981	15514/40037	9856

21832 7590 05/02/2011

MCCARTER & ENGLISH, LLP HARTFORD
CITYPLACE I
185 ASYLUM STREET
HARTFORD, CT 06103

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 05/02/2011

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte CIMA LABORATORIES, INC.
Patent Owner

Appeal 2009-003071
Ex parte Reexamination Control 90/007,684 and 90/008,133
Patent 6,042,981
Technology Center 3900

DECISION ON PETITION

This is a decision on Patent Owner's "Petition Pursuant to 35 C.F.R. § 1.550(c)(M.P.E.P. 2265)," filed April 20, 2011 ("Petition"). The Petition "requests a one-month extension of time pursuant to 37 C.F.R. § 1.550(c) to extend the period for filing a reply to the Board of Patent Appeals and Interferences' new rejections, which were raised in the March 24, 2011 Request for Rehearing decision in the above-captioned reexamination." Petition, p. 1.

FINDINGS

1. On March 24, 2011, the Board of Patent Appeals and Interferences ("Board") entered a Decision on Appeal in this reexamination proceeding, including new grounds of rejection. Decision, pp. 10-11.

2. The Decision on Appeal, citing 37 C.F.R. § 41.50(b), notes that Appellant has two months from the date of the Decision to file a response to the new grounds of rejection.

3. In the Petition, Appellant contends that:

> [T]he preparation of [new] evidence and a complete response to the Board's new rejections will necessarily require more than the 60 day period set by 37 C.F.R. § 41.50(b).

Petition, p. 3.

RELEVANT AUTHORITY

In respect to the showing required for an extension of time to respond to a new ground of rejection under 37 C.F.R. § 41.50(b), 37 C.F.R. § 1.550(c) provides:

> The time for taking any action by a patent owner in an *ex 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).

ANALYSIS

Patent Owner has established that sufficient cause exists for extending by one month the time for Appellant to reopen prosecution in response to the new grounds of rejection.

DECISION

In view of the foregoing, the Petition is GRANTED. A response to the new grounds of rejection is due by June 24, 2011.

The petition fee has been charged to the deposit account of Patent Owner's attorney.

James T. Moore
Acting Chief Administrative Patent Judge

Counsel for Patent Owner:
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Counsel for Third Party Requester:
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Thompson Coburn, LLP
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St. Louis, MO 63101

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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FEB 10 2011

CENTRAL REEXAMINATION UNIT

RATNERPRESTIA
P.O. Box 980
Valley Forge, PA 19482

For Patent Owner

Wilmer Cutler Pinkering
Hale and Dorr, LLP
1875 Pennsylvia Ave. NW
Washington, DC 20004

For Requester

Ex Parte Reexamination Proceeding
Control No. 90/008,142
Filed: September 6. 2006
For: US Patent No. 6,440,457 B1

DECISION ON
PETITION UNDER
37 CFR 1.181

This is a decision addressing the petition filed May 14, 2010 under 37 CFR 1.181 requesting review on the non-entry of the reply brief.

The petition is before the Director of Technology Center 1600, who oversees the Central Reexamination Unit, for consideration.

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

BACKGROUND

On November 30, 2009, Patent Owner filed a Reply Brief. The examiner did not consider the document to be in compliance with 37 CFR 41.41(a) and refused entry. Review of the file reveals the proceeding has been forwarded to the Board of Patent Appeals and Interferences where a decision was rendered on December 10, 2010 reversing the Examiner.

Accordingly, Patent Owner's petition is DISMISSED as moot.

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

Irem Yucel
Director, Technology Center 1600

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,142	09/06/2006	6440457	0002717-00264	6540

EXAMINER

ART UNIT	PAPER NUMBER

23122 7590 02/11/2011

RATNERPRESTIA
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VALLEY FORGE, PA 19482

DATE MAILED: 02/11/2011

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Date: FEB 11 2011

CENTRAL REEXAMINATION UNIT

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
WILMER CUTLER PICKERING HALE AND DORR LLP
1875 PENNSYLVANIA AVE., NW
WASHINGTON, DC 20004

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008142
PATENT NO. : 6440457
ART UNIT : 3900

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

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

Decision Granting 37 CFR 1.59 Petition in Reexamination	Control No.:90/008,142

1. The petition under 37 CFR 1.59 to expunge proprietary, protective order and/or trade secret documents under 37 CFR 1.59 filed July 23, 2007, July 24, 2007, and October 24, 2007 _____ is granted.

2. The Patent owner's representative requests expungement of document(s) that have been filed under MPEP 724.02. The examiner has determined that the information in such document(s) presented under seal are not material to patentability in the instant reexamination proceeding. Further, the petitioner has complied with all of the requirements of MPEP 724.05.

   A. ☒ Since the petition does not specify otherwise, the documents have been:
      i. ☐ Destroyed.
      ii. ☒ Expunged.

   B. ☐ Other/Comment:

      _____

3. CONCLUSION

   Telephone inquiries with regard to this decision should be directed to Deborah Jones _____ at 571-272-1535_____, _____. In his/her absence, calls may be directed to _____, _____ in the Central Reexamination Unit.

   [Signature]

   Deborah D. Jones
   (Printed)
   Supervisory Patent Examiner
   CRU - Art Unit 3991

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(For Patent Owner)

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(For Third Party Requester)

In re Edgren et al.
Reexamination Proceeding
Control No.: 90/008,142
Filing Date: September 6, 2006
For: U.S. Patent No.: 6,440,457

: DECISION
: DISMSSING
: PETITION

The above reexamination proceeding is before the Director of Technology Center 1600, who oversees the Central Reexamination Unit, after receipt of a May 19, 2010 patent owner petition, entitled "Petition to the Director under 37 C.F.R. § 1.181 to Review Non-Entry by Examiner of References Cited in an Information Disclosure Statement" requesting that the references cited in the February 6, 2008, December 4, 2008, January 13, 2009, and September 23, 2009 information disclosure statements (IDSs) be entered into the proceeding record. This petition is being treated as a petition under 37 CFR 1.181 invoking supervisory review.

The patent owner's petition is dismissed as moot.

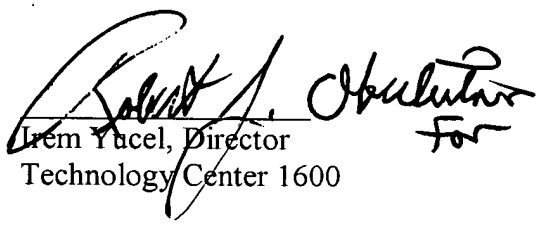
DECISION

As pointed out, the patent owner filed a May 19, 2010 petition, which is a petition requesting that the references cited in the February 6, 2008, December 4, 2008, January 13, 2009, and September 23, 2009 IDSs be entered into the proceeding record. On February 11, 2011, the Office mailed an action that clarified that the references cited in the February 6, 2008, December 4, 2008, January 13, 2009, and September 23, 2009 IDSs are entered into the proceeding record. See the continuation sheet of the interview summary, which is attached to the Notice of Intent to Issue *Ex Parte* Reexamination Certificate mailed February 11, 20100. Therefore, the relief requested by the May 19, 2010 petition has already been given by the February 11, 2011 Office action. Thus, the patent owner's May 19, 2010 petition is moot, and hereby, dismissed.

CONCLUSION

1. The May 19, 2010 patent owner's petition is dismissed as moot.

2. Telephone inquiries related to this decision should be directed Deborah Jones, Supervisory Patent Examiner, at (571) 272-1535.



Irem Yucel, Director
Technology Center 1600

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OCT 20 2010

CENTRAL REEXAMINATION UNIT

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(For patent owner)

John L. Welsh
Welsh & Flaxman LLC
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Alexandria, VA 22314

(For third party requester)

In re Ronald A. Katz
Ex Parte Reexamination Proceeding
Control No. 90/008,155
Filed: August 7, 2006
For: U.S. Patent No. 5,828,734

: **DECISION**
: **GRANTING PETITION**
: **UNDER 37 CFR 1.137(b)**
: **AND VACATING**
: **CERTIFICATE**

This is a decision on the July 26, 2010 patent owner petition under 37 CFR 1.137(b) to accept an unintentionally delayed Appeal Brief and revive the present terminated reexamination ("the July 26, 2010 patent owner petition to revive").

The July 26, 2010 patent owner petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The July 26, 2010 patent owner petition to revive is **granted**.

Reexamination Certificate No. C1 5,828,734 issued May 25, 2010, for the present proceeding, and the January 22, 2010 Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) for the present proceeding, are hereby **vacated**.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

35 U.S.C. 41(a)(7) provides, in pertinent part:

> REVIVAL FEES. — On filing each petition ... for an unintentionally delayed response by the patent owner in any reexamination proceeding ...

35 U.S.C. 133 provides:

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

35 U.S.C. 305 provides, in pertinent part:

> After the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title.

37 CFR 1.113 provides, in pertinent part:

> (a) On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon ... for *ex parte* reexaminations filed under § 1.510, patent owner's reply is limited to appeal in the case of rejection of any claim (§ 41.31 of this title), or to amendment as specified in § 1.114 or § 1.116.
> *
> *
> (c) Reply to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the reply to a final rejection or action must comply with any requirements or objections as to form.

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 1.550 provides, in pertinent part:

(d) If the patent owner fails to file a timely and appropriate response to any Office action or any written statement of an interview required under § 1.560(b), the prosecution in the *ex parte* reexamination proceeding will be a terminated prosecution, and the Director will proceed to issue and publish a certificate concluding the reexamination proceeding under § 1.570 in accordance with the last action of the Office.

(e) If a response by the patent owner is not timely filed in the Office,

*

*

(2) The response may nevertheless be accepted if the delay was unintentional; a petition to accept an unintentionally delayed response must be filed in compliance with § 1.137(b).

37 CFR 41.33 provides, in pertinent part:

(a) Amendments filed after the date of filing an appeal pursuant to § 41.31(a)(1) through (a)(3) and prior to the date a brief is filed pursuant to § 41.37 may be admitted as provided in § 1.116 of this title.

37 CFR 41.37 provides, in pertinent part:

(a)(1) Appellant must file a brief under this section within two months from the date of filing the notice of appeal under § 41.31.

MPEP 2268 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, all *ex parte* reexamination proceedings by section 4605 of the American Inventors Protection Act of 1999. The unintentional delay provisions of 35 U.S.C. 41(a)(7) became effective in reexamination proceedings on November 29, 2000. Accordingly, the Office will consider, in appropriate circumstances, a petition showing unintentional delay under 37 CFR 1.137(b) where untimely papers are filed 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 set forth in 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).

MPEP 2274 provides, in pertinent part:

> I. AMENDMENT
>
> Where the appeal brief is not filed, but within the period allowed for filing the brief an amendment is presented which places the claims of the patent under reexamination in a patentable condition, the amendment may be entered.
> *
> *
> IV. FAILURE TO TIMELY FILE APPEAL BRIEF
>
> Failure to file the brief and/or the appeal brief fee within the permissible time will result in dismissal of the appeal. ... The reexamination prosecution is then terminated, and a Notice of Intent to Issue Ex Parte Reexamination Certificate (NIRC) (see MPEP § 2287) will subsequently be issued indicating the status of the claims at the time of appeal.

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), the instant reexamination proceeding was terminated due to the failure to timely submit a proper response, within the meaning of 37 CFR 1.113, to the March 19, 2009 final Office action. Although patent owner timely filed a Notice of Appeal on July 27, 2009, patent owner's September 28, 2009 appeal brief was non-compliant, and patent owner failed to timely file a compliant appeal brief in response to the November 13, 2009 Notification of Non-Compliant Appeal Brief.

Patent owner submitted a supplemental appeal brief on July 26, 2010. The July 26, 2010 appeal brief has been found to be in compliance with the regulations. Further, patent owner was charged the $540.00 37 CFR 41.20(b)(2) fee for filing a brief in support of an appeal on September 29, 2009. Item (1) has thus been satisfied.

A petition fee of $1,620.00 and a proper statement under 37 CFR 1.137(b)(3) were submitted as part of the July 26, 2010 patent owner petition to revive, which satisfy items (2) and (3), respectively.

Accordingly, the July 26, 2010 patent owner petition to revive is **granted**.

In this instance, Reexamination Certificate No. C1 5,828,734 issued for the present proceeding on May 25, 2010. Based on the granting of the petition to revive, both the Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) issued on January 22, 2010, and the reexamination certificate are hereby **vacated**.

In due course, the following *erratum* will be published in the *Official Gazette*:

> All reference to Reexamination Certificate No. C1 5,828,734 to Ronald A. Katz of Los Angeles, CA (US) for TELEPHONE INTERFACE CALL PROCESSING SYSTEM WITH CALL SELECTIVITY, appearing in the *Official Gazette* of May 25, 2010, should be deleted, since the reexamination certificate has been vacated.

CONCLUSION

1. The July 26, 2010 patent owner petition to revive under 37 CFR 1.137(b) is **granted**.

2. The termination of prosecution noted in the January 22, 2010 NIRC, and the NIRC itself, are **vacated**.

3. The *Ex Parte* Reexamination Certificate issued May 25, 2010, is **vacated**.

4. The Office of Patent Publications will take action with respect to the 5,828,734 patent consistent with this decision.

5. Art Unit 3992 of the Central Reexamination Unit will process the July 26, 2010 supplemental appeal brief in the 90/008,155 reexamination proceeding, after which the examiner will proceed to issue an examiner's answer under 37 CFR 41.39 or take other appropriate action.

6. Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Erik Kielin, of CRU Art Unit 3992, at (571) 272-1693.

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

/Kenneth M. Schor/

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

10-19-2010
kenpetWD.../

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,155	08/07/2006	5828734	6646-240	5577

35554 7590 03/01/2011

REENA KUYPER, ESQ.
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EXAMINER	
KIELIN, ERIK J	

ART UNIT	PAPER NUMBER
3992	

MAIL DATE	DELIVERY MODE
03/01/2011	PAPER

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

RONALD A. KATZ TECHNOLOGY LICENSING L.P.
Patent Owner

JOHN L. WELSH
Third Party Requester

Ex parte Reexamination Control 90/008,155
Patent 5,828,734

DECISION ON PETITION

This is a decision on Patent Owner's "Petition Under 37 C.F.R. § 41.3," filed October 7, 2010 ("Present Petition"). In the Petition, Patent Owner seeks an oral hearing before the Chief Administrative Patent Judge "to address the merits of Petitioner's Petition Under 37 C.F.R. § 1.137(b) to Revive Unintentionally Terminated Reexamination Prosecution ...." Present Petition, p. 1.

FINDINGS

1. On July 26, 2010, Patent Owner filed a Petition Under 37 C.F.R. § 1.137(b) to Revive Unintentionally Terminated Reexamination Prosecution ("Petition to Revive").

2. On October 7, 2010, Patent Owner filed the Present Petition seeking an oral hearing on the Petition to Revive.

3. On October 20, 2010, the Office of Patent Legal Administration entered a Decision Granting Petition Under 37 CFR 1.137(b) [Petition to Revive] and Vacating Certificate ("Decision").

ANALYSIS

As indicated by the forgoing sequence of events, the Petition to Revive was granted by the Decision entered October 20, 2010. Thus, the Present Petition is now moot.

DECISION

For the forgoing reasons, the Present Petition is DISMISSED as moot.

James T. Moore
Acting Chief Administrative Patent Judge

Ex parte Reexamination Control 90/008,155
Patent 5,828,734

Counsel for Patent Owner:
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Berry & Associates P.C.
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Los Angeles, CA 90069

Counsel for Third Party Requester:
John L. Welsh
Welsh & Flaxman LLC
2000 Duke Street, Suite 100
Alexandria, VA 22314

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 08-23-2010

TO SPE OF : ART UNIT ~~1638~~ 3992

SUBJECT : Request for Certificate of Correction for Appl. No:90008178 Patent No: 6308317 C1

Please respond to this request for a certificate of correction within 7 days.

FOR IFW FILES:

Please review the requested changes/corrections as shown in the **COCIN** document(s) in the IFW application image. No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Please complete the response (see below) and forward the completed response to scanning using document code **COCX**.

FOR PAPER FILES:

Please review the requested changes/corrections as shown in the attached certificate of correction. Please complete this form (see below) and forward it with the file to:

Certificates of Correction Branch (Co f C)
Randolph Square – 9D10-A
Palm Location 7580

Discrependency with the claims

Eva James
Certificates of Correction Branch
703-756-1583 _____

Thank You For Your Assistance

The request for issuing the above-identified correction(s) is hereby:

Note your decision on the appropriate box.

☐ **Approved**	All changes apply.
☐ **Approved in Part**	Specify below which changes **do not** apply.
☒ **Denied**	State the reasons for denial below.

The requested changes are not of a clerical nature, a typographical error, or a mistake of minor character

ERIC S. KEASEL
CRU SPE-AU 3992

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

1-7-2011

Patent No. : 6,308,317 C1
Serial No. : 90/008,178
Inventor(s) : Timothy J. Wilkinson, et. al.
Issued : December 2, 2008

Re: Request for Certificate of Correction

Consideration has been given your request for the issuance of a certificate of correction for the above-identified patent under the provisions of Rule(s) 1.322.

Respecting the alleged errors in the claims of the Reexamination Certificate should not be entered because the requested changes are not of a clerical nature, a typographical (error, or a mistake of minor character) per examiner

In view of the foregoing, your request is hereby denied.

Further correspondence concerning this matter should be filed and directed to Decisions and Certificates of Correction Branch. Any response must be filed within a four week period with the sum of $100.00

Eva James
For Mary Diggs
Decisions & Certificate
of Correction Branch
(571-272-3422 or 703-756-1580)

Pehr Jansson
3616 Far West Blvd#117-314
Austin TX 78731

ej

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,305	10/23/2006	4940658	466992801100	9384

22334 7590 01/31/2012

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 01/31/2012

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

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Date: 1-31-12

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008305
PATENT NO. : 4940658
ART UNIT : 3900

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Peter F. Weinberg
Gibson Dunn & Crutcher LLP
Suite 4200
1801 California Street
Denver, CO 80202

MAILED

JAN 31 2012

CENTRAL REEXAMINATION UNIT

(For Patent Owner)

Morrison & Foerster LLP
12531 High Bluff Drive
Suite 100
San Diego, CA 92130-2040

(For Third Party Requester)

In re Competitive Technologies, Inc.
and The Trustees of Columbia University
Ex Parte Reexamination Proceeding
Control No.: 90/008,305
Request Deposited: October 23, 2006
For: U.S. Patent No.: 4,940,658

DECISION ON PETITION

This is a decision on the August 2, 2011, petition Patent Owners Competitive Technologies, Inc. and The Trustees of Columbia University ("Patent Owners" or "Petitioners") filed entitled PETITION TO THE DIRECTOR under 37 C.F.R. §§ 1.181 and 1.182. The instant petition has been forwarded to the undersigned for decision.

The petition asks the Director to (1) withdraw the Renewed Request for Rehearing; (2) issue a Notice of Intent to Issue Ex Parte Reexamination Certificate ("NIRC") within two weeks of the decision on the petition; and (3) issue the Reexamination Certificate within two weeks of the NIRC.[1]

The petition to withdraw the Renewed Request for Rehearing is **GRANTED**.

The petition to issue a Notice of Intent to Issue Ex Parte Reexamination Certificate ("NIRC") within two weeks of the decision on the petition and issue the Reexamination Certificate within two weeks of the NIRC is **DENIED**.

[1] Alternatively, Patent Owners ask that, if the foregoing relief is denied, the Director (1) directly supervise any work of the Office to ensure that the reexamination is treated with special dispatch; (2) directly supervise any further work such that any action is taken within specific time frames; and (3) instruct the Chief APJ to accomplish any work at the Board of Patent Appeals and Interferences ("Board") within two months of any event triggering its duty to take action. These additional requests are moot in view of the withdrawal the Renewed Request for Rehearing.

FEES

This petition is treated in accordance with the provisions of 37 C.F.R. § 1.182. Hence, the requisite petition fee for a petition under 37 C.F.R. § 1.182 is $400.00 pursuant to 37 C.F.R. § 1.17(f), and the $400.00 fee has been charged to Petitioners' deposit account.

REVIEW OF FACTS

1. U.S. Patent No. 4,940,658 (the '658 patent) was granted to Robert H. Allen et al. on July 7, 1990, based on an application for patent filed on November 20, 1986. The patent is assigned to Competitive Technologies, Inc. and The Trustees of Columbia University.

2. On October 23, 2006, third party requester, General Atomics, Diazyme Laboratories Division ("third party requester"), filed an original request for *ex parte* reexamination of the '658 patent, which request was assigned reexamination control no. 90/008,305 ("the '8305 proceeding").

3. On December 14, 2006, *ex parte* reexamination of the '658 patent was ordered.

4. On February 16, 2007, Patent Owners timely filed a statement pursuant to 37 C.F.R. § 1.530.

5. On April 12, 2007, third party requester timely submitted a reply to Patent Owner's statement pursuant to 37 C.F.R. § 1.535.

6. On May 16, 2007, the examiner issued a non-final Office Action.

7. On July 18, 2007, Patent Owners responded to the Office Action..

8. On December 27, 2007, the examiner issued a final rejection.

9. On March 3, 2008, Patent Owners filed a Notice of Appeal.

10. On March 17, 2008, the examiner issued an Advisory Action.

11. On April 30, 2008, Patent Owners filed an Appeal Brief.

12. On September 24, 2008, the examiner issued an Examiner's Answer.

13. On November 26, 2008, Patent Owners filed a Reply Brief.

14. On July 30, 2009, the Board reversed the examiner.

15. On September 29, 2009, the examiner requested reconsideration of the July 30, 2009, decision by an expanded panel of the Board.

16. On December 13, 2010, the original Board panel issued an opinion maintaining the reversal of the examiner as per the July 30, 2009, decision.

17. On June 29, 2011, the examiner requested reconsideration of the July 30, 2009, and December 13, 2010, decisions by an expanded panel of the Board.

RELEVANT STATUTES, REGULATIONS AND PROCEDURES

35 U.S.C. § 132 states:

(a) Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. No amendment shall introduce new matter into the disclosure of the invention.

(b) The Director shall prescribe regulations to provide for the continued examination of applications for patent at the request of the applicant. The Director may establish appropriate fees for such continued examination and shall provide a 50 percent reduction in such fees for small entities that qualify for reduced fees under section 41(h)(1) of this title.

35 U.S.C. § 305 states: "After the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title. In any reexamination proceeding under this chapter, the patent owner will be permitted to propose any amendment to his patent and a new claim or claims thereto, in order to distinguish the invention as claimed from the prior art cited under the provisions of section 301 of this title, or in response to a decision adverse to the patentability of a claim of a patent. No proposed amended or new claim enlarging the scope of a claim of the patent will be permitted in a reexamination proceeding under this chapter. All reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office."

35 U.S.C. § 307 states:

(a) In a reexamination proceeding under this chapter, when the time for appeal has expired or any appeal proceeding has terminated, the Director will issue and publish a certificate canceling any claim of the patent finally determined to be unpatentable, confirming any claim of the patent determined to be patentable, and incorporating in the patent any proposed amended or new claim determined to be patentable.

(b) Any proposed amended or new claim determined to be patentable and incorporated into a patent following a reexamination proceeding will have the same effect as that specified in section 252 of this title for reissued patents on the right of any person who made, purchased, or used within the United States, or imported into the United States, anything patented by such proposed amended or new claim, or who made substantial preparation for the same, prior to issuance of a certificate under the provisions of subsection (a) of this section.

37 C.F.R. § 1.182 states: "All situations not specifically provided for in the regulations of this

part will be decided in accordance with the merits of each situation by or under the authority of the Director, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f)."

37 C.F.R. § 41.1(b) states: "*Construction.* The provisions of Part 41 shall be construed to secure the just, speedy, and inexpensive resolution of every proceeding before the Board."

37 C.F.R. § 41.52(a)(1) states: "Appellant may file a single request for rehearing within two months of the date of the original decision of the Board. No request for rehearing from a decision on rehearing will be permitted, unless the rehearing decision so modified the original decision as to become, in effect, a new decision, and the Board states that a second request for rehearing would be permitted. The request for rehearing must state with particularity the points believed to have been misapprehended or overlooked by the Board."

MPEP 1214.04 states (in relevant part):

The examiner may request rehearing of the Board decision. Such a request should normally be made within 2 months of the receipt of the Board decision in the TC. The TC Director's secretary should therefore date stamp all Board decisions upon receipt in the TC.

All requests by the examiner to the Board for rehearing of a decision must be approved by the TC Director and must also be forwarded to the Office of the Deputy Commissioner for Patent Examination Policy for approval before mailing.

The request for rehearing must state with particularity the points believed to have been misapprehended or overlooked by the Board. Arguments not raised in the answers before the Board and evidence not previously relied upon in the answers are not permitted in the request for rehearing except upon a showing of good cause, the examiner may present a new argument based upon a recent relevant decision of either the Board or a Federal Court.

The request should set a period of 2 months for the appellant to file a reply.

If the request for rehearing is approved by the Office of the Deputy Commissioner for Patent Examination Policy, the TC will mail a copy of the request for rehearing to the appellant. After the period set for appellant to file a reply (plus mailing time) has expired, the application file will be forwarded to the Board."

DECISION

The petition is **granted** for withdrawal of the renewed request for rehearing, and issuance of a NIRC and reexamination certificate and **denied** with regard to Patent Owners' request that the Office issue a NIRC and reexamination certificate within specified time frames, for the reasons as explained below. Although the examiner acted within her authority in submitting the renewed request for rehearing to the Board, the renewed request for rehearing is nevertheless

withdrawn in view of the circumstances in this proceeding. The NIRC[2] and Reexamination Certificate will be issued in the ordinary course of business in a reexamination proceeding and consistent with the "special dispatch" requirement of 35 U.S.C. § 305, but not on the expedited schedule requested by Patent Owners.

I. A Renewed Request For Rehearing Is Not *Ultra Vires*

Patent Owners assert that submitting a renewed rehearing request to the Board is *ultra vires*. Petition at 4. To establish that seeking a renewed request for rehearing at the Board is *ultra vires*, Patent Owners must establish that the USPTO acted in "brazen defiance" of its statutory authority. *See Heinl v. Godici*, 143 F. Supp. 2d 593, 601 (E.D. Va. 2001) (holding that only "when an agency acts in 'brazen defiance' of its statutory authorization, courts need not await the conclusion of the underlying proceeding") (citing *Philip Morris, Inc. v. Block*, 755 F.2d 368, 370 (4th Cir. 1985)). That is not the case here.

Agency action is not *ultra vires* even if the action is incorrect; rather, agency action is *ultra vires* when the agency patently misconstrues a statute, disregards a specific and unambiguous statutory directive, or violates a specific command of a statute. *See Hunter v. FERC*, 527 F. Supp. 2d 9 (D.D.C. 2007) (citing *Griffith v. FLRA*, 842 F.2d 487, 493 (D.C. Cir. 1988)); *see also Leedom v. Kyne*, 358 U.S. 184 (1958) (holding that the narrow exception for judicial review before a final agency decision applies only when the agency had acted "contrary to a specific prohibition in the Act" that was "clear and mandatory"); *Physicians Nat'l House Staff v. Fanning*, 642 F.2d 492, 496 (D.C. Cir. 1980) (holding that, to invoke judicial review before a final agency action, "an error of fact or law is insufficient; the [agency] must have acted without statutory authority"). Here, as discussed below, there is no law, rule or guidance that clearly prohibits the examiner from seeking a renewed request for rehearing. Accordingly, Patent Owners cannot show that the USPTO "clearly 'exceeded its statutory authority'" in submitting a renewed request for rehearing. *Heinl*, 143 F. Supp. 2d at 601 (quoting *Philip Morris*, 755 F.2d at 370).

II. Neither The MPEP Nor The Code Of Federal Regulations Prohibits The Examiner From Seeking Renewed Rehearing

Patent Owners first argue that the renewed request for rehearing cites to MPEP 1214.04, but fails to rely on any specific provision therein. Petition at 4. Patent Owners state that they "are unaware of any law, rule, or other source of authority that authorizes such a filing." *Id.* MPEP 1214.04 applies to examiner requests for rehearing. The recited section does not limit examiner requests for rehearing to a single request. To the contrary, MPEP 1214.04 refers to "[a]ll requests by the examiner to the Board for rehearing of a decision," specifically contemplating that multiple "requests" can be filed for rehearing of "a decision."

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[2] It is fully expected that the next action in this reexamination proceeding will be a NIRC. *See* MPEP 12014.04. However, the Office does not "direct" primary examiners to allow or reject the claims in a patent application or patent under reexamination. Thus, this decision should not be viewed as precluding the examiner from taking further action, not inconsistent with the BPAI panel decision of December 13, 2010, and subject if the subject to the requirements of MPEP 1214.07, if there is a valid basis for reopening prosecution in this reexamination proceeding.

The renewed request for rehearing otherwise complied with MPEP 1214.04. It was both "approved by the TC Director" and "forwarded to the Office of the Deputy Commissioner for Patent Examination Policy for approval before mailing." This level of review occurred here. Furthermore, the request specifically states why the examiner renewed her rehearing request. Although MPEP 1214.04 indicates that "a request should normally be made within 2 months of the receipt of the Board decision in the TC," it does not require that all such requests be filed within that two-month period.

Patent Owners next point to 37 C.F.R. § 41.52 and assert that this rule contemplates at most a single request for rehearing. Petition at 4. But § 41.52 is limited to requests for rehearing by an "[a]ppellant" (Patent Owners here), not by an examiner. Foremost, the first sentence of § 41.52(a)(1) provides that only an "[a]ppellant" is limited to "fil[ing] a single request for rehearing within two months of the date of the original decision of the Board." Although the word "appellant" does not appear in the language quoted by Patent Owners, the remainder of the subsection makes clear that it applies only to appellants, providing that "[a]rguments not raised in the briefs before the Board and evidence not previously relied upon in the brief and any reply brief(s) are not permitted in the request for rehearing." Only appellants file "briefs," a "brief," or "any reply brief(s)," *see* 37 C.F.R. §§ 41.37, 41.41; examiners file an "examiner's answer" and may file a "supplemental examiner's answer responding to a reply brief," *see* 37 C.F.R. §§ 41.39, 41.43. Thus, § 41.52 does not govern conduct by the examiner; rather, it governs only conduct by an appellant.

III. A Decision By The Board Does Not Preclude Further Consideration Of Issues Of Patentability By The Examiner

Patent Owners appear to equate a Board decision reversing the examiner with a determination that the claims are in condition for patentability that binds the examiner. Contrary to this understanding, the USPTO is free to conduct further proceedings pursuant to 35 U.S.C. §§ 132 and 305. The Board has no authority to mandate confirmation of patentability of claims under reexamination. The Board does not examine applications or "allow claims," but merely reviews (i.e., sustains or reverses) rejections of claims. *See Ex parte Alpha Industries Inc.*, 22 USPQ2d 1851, 1857 (BPAI 1992); *see also* 35 U.S.C. § 307(a); *cf. In re Alappat*, 33 F.3d 1526, 1535 (Fed. Cir. 1994) (en banc). It is well established that the USPTO may "tak[e] extraordinary action to withdraw a patent from issue when a responsible [US]PTO official reasonably believes that the subject matter may be unpatentable and that the application may have been allowed in error." *BlackLight Power, Inc. v. Rogan*, 295 F.3d 1269, 1273 (Fed. Cir. 2002). Indeed, the Director "has an obligation to refuse to grant a patent if he believes that doing so would be contrary to law." *Alappat*, 33 F.3d at 1535; *see also In re Drawbaugh*, 9 App. D.C. 219, 240 (D.C. Cir 1896). Therefore, the Director has the authority under 35 U.S.C. § 307(a) to resolve any substantial new question of whether the pending claims in the present reexamination are patentable under 35 U.S.C. § 103 before issuing a NIRC in the present reexamination and subsequently issuing a reexamination certificate, regardless of the Board's patentability determination.

It is also well established that a court decision reversing a rejection does not preclude further proceedings in the USPTO or operate as a mandate to issue the application as a patent. *See Jeffrey Mfg. Co. v. Kingsland*, 179 F.2d 35, 36 (D.C. Cir. 1949); *see also Gould v. Quigg*, 822

F.2d 1074, 1079 (Fed. Cir. 1987) (holding that, while the district court properly reversed a rejection, the district court erred in directing, rather than authorizing, the issuance of a patent); *In re Gould*, 673 F.2d 1385, 1386 (CCPA 1982) (holding that the USPTO can always reopen prosecution in an application under an ex parte court appeal once it regains jurisdiction over the application); *In re Arkley*, 455 F.2d 586, 589 (CCPA 1972) (holding that the USPTO is free to make such other rejections as it considers appropriate subsequent to a court decision reversing a rejection); *In re Fisher*, 448 F.2d 1406, 1407 (CCPA 1971) (holding that a reversal of a rejection does not mandate issuance of a patent); *In re Ruschig*, 379 F.2d 990, 993 (CCPA 1967) (holding that, subsequent to a court decision reversing a rejection, the USPTO may reopen prosecution and reconsider previously withdrawn rejections that are not inconsistent with the decision reversing the rejection); *In re Citron*, 326 F.2d 418, 419 (CCPA 1964) (holding that, following decision reversing a rejection of claims, the USPTO has not only the right but the duty to reject claims deemed unpatentable over new references); *Hull v. Commissioner*, 9 D.C. (2 MacArth.) 90 (D.C. 1875) (denying mandamus to issue a patent, notwithstanding that the Commissioner withdrew an application from issue after favorable decision by the board of examiners-in-chief and after payment of the issue fee). Thus, a Board decision reversing an examiner's rejection does not operate as a mandate to the examiner to issue the application as a patent or in this case, issue a Notice of Intent to Issue a Reexamination Certificate (and henceforth issue the reexamination certificate).

IV. Until A Reexamination Certificate Issues, The USPTO Retains Jurisdiction To Review The Matter

Jurisdiction for action in a reexamination proceeding does not end until the reexamination certificate issues. *See* 35 U.S.C. § 307(a). As stated by the Federal Circuit, "[a] reexamination is complete upon the statutorily mandated issuance of a reexamination certificate, 35 U.S.C. § 307(a); the NIRC merely notifies the applicant of the USPTO's intent to issue a certificate. A NIRC does not wrest jurisdiction from the USPTO precluding further review of the matter." *In re Bass*, 314 F.3d 575, 577 (Fed. Cir. 2002). Thus, the USPTO has the authorization to conduct further proceedings to determine patentability following an examiner's reversal by the Board. *See In re Borkowski*, 505 F.2d 713, 718 (CCPA 1974) (holding that, until a matter has been completed, the USPTO must have the flexibility to reconsider and correct prior decisions). The renewed rehearing request therefore was appropriate.

V. The Renewed Rehearing Request Is Withdrawn

Even though a renewed rehearing request can be proper, upon reconsideration, prudence counsels in favor of not seeking further reconsideration of the original Board panel's decision in this reexamination proceeding. The renewed rehearing request repeats arguments already made and twice rejected by the original Board panel. In addition, the instant proceeding concerns the reexamination of a patent that has already been issued by the Office, thus taking extraordinary steps as would be warranted in a pending application to ensure the issuance of a valid patent is not as compelling in this situation. *Cf. BlackLight Power, Inc.*, 295 F.3d at 1274. Moreover, the patent that is the subject of this reexamination proceeding is now expired, limiting any public policy justification for seeking further reconsideration of the original Board panel's decision in this reexamination proceeding. For these reasons, it is considered appropriate upon reconsideration to withdraw the Renewed Request for Rehearing.

VI. Imposing The Particular Deadlines Requested By Patent Owner Is Unwarranted

Patent Owners request that the Director specify certain deadlines for issuing a NIRC and a reexamination certificate. Such relief is unwarranted. As discussed above, Patent Owners have not established that either the examiner or the Board has acted improperly, much less that they require such additional supervision. The USPTO will not impose arbitrary deadlines that have no basis in the statutory requirement of "special dispatch." The NIRC and reexamination certificate will issue in the ordinary course of business in a reexamination proceeding.

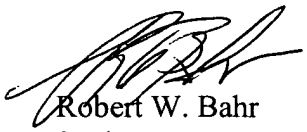
Patent Owners also request in the alternative that, if the renewed rehearing request is not withdrawn, the Director "directly supervise any further work of the Office" and ensure that various actions occur within various specified time frames. This alternative request is moot because the renewed rehearing request is withdrawn.

CONCLUSION

1. Patent Owners' petition filed August 2, 2011, for withdrawal of the renewed request for rehearing, and issuance of a NIRC and reexamination certificate is **granted**. The renewed request for rehearing mailed on June 29, 2011, is hereby **WITHDRAWN**.

2. Patent Owners' request that the Office issue a NIRC and reexamination certificate within specified time frames is **denied**. The NIRC and reexamination certificate will be issued consistent with the special dispatch requirement of 35 U.S.C. § 305 in the ordinary course of business in a reexamination proceeding.

3. Patent Owners' petition in the alternative filed on August 2, 2011, for the Director to "directly supervise any further work of the Office" and set certain deadlines for USPTO actions is **dismissed as moot**.



Robert W. Bahr
Senior Patent Counsel
Office of the Associate Commissioner
for Patent Examination Policy

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.
90/008,325	11/13/2006	5128984	6646-210A	2812

35554 7590 04/22/2011

REENA KUYPER, ESQ.
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9229 SUNSET BOULEVARD
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LOS ANGELES, CA 90069

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/22/2011

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

WELSH & FLAXMAN LLC

2000 DUKE STREET, SUITE 100

ALEXANDRIA, VA 22314

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/008,325*.

PATENT NO. *5128984*.

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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APR 22 2011

CENTRAL REEXAMINATION UNIT

REENA KUYPER, ESQ. : (For Patent Owner)
BYARD NILSSON, ESQ. :
9229 SUNSET BOULEVARD :
SUITE 630 :
LOS ANGELES, CA 90069 :

WELSH & FLAXMAN LLC : (For Third Party
2000 DUKE STREET : Requester)
SUITE 100 :
ALEXANDRIA, VA 22314 :

In re: Katz
Ex Parte Reexamination Proceeding : DECISION ON PETITION
Control No.: 90/008,325 : UNDER 37 CFR §§ 1.181,
Deposited: November 13, 2006 : 1.182 AND 1.183
For: U.S. Patent No.: 5,128,984 :

This is a decision on a petition filed by the patent owner on April 29, 2010, entitled "PETITION TO THE DIRECTOR UNDER 37 CFR §§ 1.181, 1.182 AND 1.183" [hereinafter "the petition"].

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

The petition is dismissed.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 CFR § 1.4 Nature of correspondence and signature requirements (in part):

(c) Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects.

DECISION

The petition raises multiple issues which are distinct inquiries addressed by different branches of the Office, therefore this is an improper paper not in compliance with 37 CFR § 1.4(c). For example, petitions filed under 37 CFR § 1.181 are decided by the Central Reexamination Unit, but petitions filed under 37 CFR §§ 1.182 and 1.183 are decided by the Office of Patent Legal Administration. As the petition purports to be filed under all of these rules, therefore combining multiple distinct subjects in a single paper, the petition is dismissed under 37 CFR § 1.4(c).

CONCLUSION

1. The above named petition filed April 29, 2010 is hereby dismissed.

2. Telephone inquiries related to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner, at (571) 272-1611 or in his absence to the undersigned at (571) 272-0700.

Irem Yucel
Director, Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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REENA KUYPER, ESQ. : (For Patent Owner)
BYARD NILSSON, ESQ. :
9229 SUNSET BOULEVARD :
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LOS ANGELES, CA 90069 :

MAILED

OCT 25 2011

WELSH & FLAXMAN LLC : (For Third Party
2000 DUKE STREET : Requester)
SUITE 100 :
ALEXANDRIA, VA 22314 :

CENTRAL REEXAMINATION UNIT

In re: Katz
Ex Parte Reexamination Proceeding : DECISION ON PETITION
Control No.: 90/008,325 : UNDER 37 CFR §§ 1.181,
Deposited: November 13, 2006 :
For: U.S. Patent No.: 5,128,984 :

This is a decision on a petition filed by the patent owner on May 23, 2011, entitled "PETITION TO THE DIRECTOR UNDER 37 CFR § 1.181" [hereinafter "the petition"]. The petition is a request to the Director to exercise his discretion to review the examiner's denial of entry of patent owner's reply brief and amended reply brief.

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

The petition is denied.

REVIEW OF RELEVANT FACTS

- U.S. Patent No. 5,128,984 issued on July 7, 1992.
- A request for *ex parte* reexamination was filed on November 13, 2006 and assigned control no. 90/008,325.
- *Ex parte* reexamination was ordered and prosecution progressed until the appeal stage. An examiner's answer was mailed by the Office on December 17, 2009.
- On February 24, 2010 patent owner filed a reply brief.
- On March 10, 2010 patent owner filed an amended reply brief.
- On March 12, 2010 the examiner issued an advisory action denying entry of the original reply brief under 37 CFR § 41.41(a)(2) and (b) as including new evidence.
- On March 26, 2010 the examiner issued an advisory action denying entry of the amended reply brief as being untimely.
- On April 29, 2010 patent owner filed a petition under 37 CFR §§ 1.181, 1.182 & 1.183 requesting entry of the reply briefs.
- On April 22, 2011 the Office dismissed the petition on procedural grounds.
- On May 23, 2011 patent owner filed the instant petition.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 CFR § 41.41 Reply Brief:

(a)

(1) Appellant may file a reply brief to an examiner's answer within two months from the date of the examiner's answer.

(2) A reply brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence. See § 1.116 of this title for amendments,

affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.33 for amendments, affidavits or other evidence filed after the date of filing the appeal.

(b) A reply brief that is not in compliance with paragraph (a) of this section will not be considered. Appellant will be notified if a reply brief is not in compliance with paragraph (a) of this section.

(c) Extensions of time under § 1.136 (a) of this title for patent applications are not applicable to the time period set forth in this section. See § 1.136 (b) of this title for extensions of time to reply for patent applications and § 1.550 (c) of this title for extensions of time to reply for *ex parte* reexamination proceedings.

37 CFR § 1.565 Concurrent Office Proceedings Which Include an Ex Parte Reexamination Proceeding (in part):

(a) In an *ex parte* reexamination proceeding before the Office, the patent owner must inform the Office of any prior or concurrent proceedings in which the patent is or was involved such as interferences, reissues, *ex parte* reexaminations, *inter partes* reexaminations, or litigation and the results of such proceedings. See § 1.985 for notification of prior or concurrent proceedings in an *inter partes* reexamination proceeding.

DECISION

Patent owner ["petitioner"] requests supervisory review of the examiner's denial of entry of the reply brief and the amended reply brief. The examiner denied entry of the reply brief for failing to comply with 37 CFR § 41.41(a)(2) because it included new evidence, and denied entry of the amended reply brief for being untimely, i.e. failing to comply with 37 CFR § 41.41(a)(1).

The Original Reply Brief

Petitioner argues that the original reply brief did not include new evidence, as the documents were submitted not as evidence but as part of its duty to inform the Board of related proceedings. Petitioner argues it did not rely on the materials, a Request for Reconsideration of a Board Decision and a Brief filed with the Court of Appeals for the Federal Circuit in related reexamination and litigation proceedings. Petitioner states they were merely attached for informational purposes and submitted as a part of its duty to keep the Board apprised of related proceedings under 37 CFR § 41.37(c)(1)(ii).

Petitioner's argument that the materials were not relied upon is without merit. Petitioner references the Request for Reconsideration at pp. 3-4 of the reply brief, and then lists as points 1. and a.-d. the very headings that it used in the Request for Reconsideration. It is apparent that petitioner intended to utilize its arguments from the Request for Reconsideration to buttress its arguments in the reply brief.

In light of this, petitioner's arguments that the materials do not fall within the definition of "evidence" is also without merit. As stated by petitioner, evidence is broadly any perceptible thing that tends to establish or disprove a fact. The examiner relied heavily on a previous Board decision concerning the related '707 patent, and the Request for Reconsideration concerns that decision. The Request purports to show why the Board acted incorrectly in its decision, and therefore why it should now decide in favor of petitioner. The Request is evidence of the fact that petitioner has made these arguments before the Board, and therefore is evidence furthering its position that the examiner erred in his claim construction. It is apparently intended to support the notion that the prior Board panel was incorrect and therefore the examiner or the later Board panel need not follow their decision.

Furthermore, even if the materials were attached merely for informational purposes, they go beyond what is permissible as far as notice of related proceedings. For example, MPEP § 2282 discusses a patent owner's duty to apprise the Office of related proceedings under 37 CFR § 1.565(a). It is apparent that the duty extends to materials such as notice of suit or decisions of a court, but does not extend to documents that are a party's arguments. "[P]apers filed in the court from litigations or other proceedings involving the patent will not be entered into the record (and will be expunged if already entered) if they provide a party's arguments, such as a memorandum in support of summary judgment." MPEP § 2282 (emphasis added). Likewise, 37 CFR § 41.37(c)(1)(ii) requires a statement identifying related proceedings, but it does not require filing of materials such as those that were submitted. In fact, it states that "Copies of any decisions rendered by a court or the Board in any proceeding identified under this paragraph must be included in an appendix . . . ." 37 CFR § 41.37(c)(1)(ii) (emphasis added). It is clear that the information sought by the Office is either bare notice of a proceeding or an actual decision by a tribunal, not the necessarily interested slant provided in a brief by the parties.

The submissions are a brief and a request for reconsideration, and are clearly drawn to patent owner's arguments in those proceedings. They therefore go beyond the information required by the Office under 37 CFR §§ 1.565(a) and 41.37(c)(1)(ii), and in fact are the very type of information the Office *does not* wish to be submitted. Thus, even if the materials were merely submitted for informational purposes, such submission was improper. Additionally, at least a part of the submissions were referenced in the reply brief and relied upon to buttress patent owner's argument in said reply brief. In that sense they can fairly be considered evidence. Accordingly, the examiner's refusal to enter the reply brief including such new evidence was not improper.

The Amended Reply Brief

37 CFR § 41.41(a)(1) requires that a reply brief be filed within two months of the answer. The amended reply brief was filed outside that period. Accordingly, the amended reply brief was not timely and is not subject to entry or consideration.

Petitioner argues that the amended reply brief was not untimely because it was filed promptly, was a *bona fide* attempt to respond to potential problems, and the original was timely. Petition pp. 5-6. Factors such as these are not in any way mentioned in nor implied by the regulations and therefore cannot overcome the explicit timeliness requirement. Such factors may have influenced the ability to obtain an extension of time under 37 CFR §§ 41.41(c) & 1.550(c), but none was requested.

Petitioner argues that when an appeal brief is non-compliant with the rules, the appellant is given an opportunity to correct. Likewise, when a rebuttal brief in an *inter partes* reexamination is non-compliant, an opportunity to correct is given. Be that as it may, the rules do not provide for correction of a reply brief in *ex parte* proceedings. The fact that correction is explicitly permitted for other types of filings does not weigh in favor of permitting correction here where it was not provided for. Indeed this weighs against permitting correction, as it shows the Office was aware of the ability to provide for a time to correct yet declined to do so.

Additionally, the present situation differs from those mentioned. As to an appeal brief, if there were no opportunity to correct then a procedural defect would lead to a dismissal of the appeal, so fairness in permitting a correction comes into play. That is not an issue here, as the appeal goes forward and will be heard regardless of the filing of a reply brief. As to a rebuttal brief, the adversarial *inter partes* nature raises the importance of a rebuttal brief, as an appellant would typically be responding not only to an examiner's answer, but also to a respondent brief of the other party. The Office is aware of such differences in *ex parte* and *inter partes* proceedings, and the fact that it declined to provide for correction as to *ex parte* reply briefs is telling.

Accordingly, as the Office has provided no mechanism for the correction of a defective reply brief, or for the filing of any supplemental reply brief, the examiner did not act improperly in refusing to enter the amended reply brief based on its untimeliness.

Due Process Argument

Petitioner argues that refusing entry of the reply briefs denies it of due process and amounts to an unjustified forfeiture of property rights, analogizing the situation to that found in *Enzo Therapeutics Inc. v. Yeda Research & Development Co.*, 477 F. Supp. 2d 699 (E.D. Va. 2007). Any comparison to *Enzo* is irrelevant in light of the nature of the so-called "forfeiture" here.

Enzo arose from an interference proceeding, and a key part of that proceeding was that Enzo's application was not co-pending with its parent, defeating a priority claim. Accordingly, Enzo filed a petition to revive the parent, which the Board held as insufficient. This essentially defeated Enzo's case, as it could not claim benefit to the parent. The Board further did not permit Enzo to file additional evidence as to its petition. Ultimately, the court held that Enzo must be permitted to present new evidence relating to its petition to revive, and remanded to the Board for consideration of such evidence. The court held that refusing Enzo the opportunity to file new evidence was an unjustifiable forfeiture of Enzo's property and that justice required an opportunity to amend/correct the petition.

Accordingly, the principles of equity were far different in *Enzo* than they are here. In *Enzo* (as well as in the unjustifiable forfeiture cases cited by the court, which mostly related to pleadings, 477 F. Supp. 2d at 718) a party essentially would have lost its case due to its procedural failings, and equity prefers that a just cause be heard on its merits. Here, petitioner has lost nothing of the sort. Its case will still be heard by the Board, and it has already had a full and fair opportunity to present its case. A reply brief is not even required, and the case has not been lost due to the procedural failings. The right to file a reply brief is not a "property right;" it is a procedural right to argue further, a right that is accorded by regulation *so long as the regulations are complied with.* Here, they were not. Accordingly, neither the principles of equity nor due process require leave to file or correct a reply brief.

Accordingly, the examiner's actions in refusing to enter either reply brief were not improper and did not deny patent owner due process. The petition is denied.

CONCLUSION

1. The petition filed May 23, 2011 is denied.

2. As no reply brief has been properly filed, the proceeding will be forwarded to the Board for decision on the appeal.

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) 272-0700.

Irem Yucel
Director, Central Reexamination Unit

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UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,326	11/09/2006	6249876	10414-25	7651

7590 10/11/2011

EXAMINER

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ART UNIT	PAPER NUMBER

DATE MAILED: 10/11/2011

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EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/008,326*.

PATENT NO. *6249876*.

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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OCT 11 2011

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In re: Balakrishnan *et alia*
Reexamination Proceeding
Control No. 90/008,326
Request Deposited: November 9, 2006
For: U.S. Patent No. 6,249,876

: DECISION
: WITHDRAWING
: NIRC

A review of the record reveals that the BPAI decision of December 22, 2010 affirmed the examiner's rejection of claims 1 and 17-19.

Patent Owner requested rehearing on February 22, 2011.

The BPAI denied the request for rehearing in the decision of May 11, 2011.

The examiner issued a Notice of Intent to Issue *Ex Parte* Reexamination Certificate on July 21, 2011.

On July 27, 2011, Patent Owner entered a paper in control number 90/008,326 entitled NOTIFICATION OF PRIOR AND CONCURRENT PROCEEDINGS UNDER 37 CFR §

1.565(a) informing the Office of concurrent litigation ("the Fairchild Delaware action" currently on appeal to the CAFC, "the Fairchild II action" in the United States District Court, District of Delaware, and POWER INTEGRATIONS, INC. v. HONORABLE DAVID KAPPOS, Case No. 1:11-cv-01254, United States District Court for the District of Columbia).

In view of the July 27, 2011 notification, the Notice of Intent to Issue *Ex Parte* Reexamination Certificate of July 21, 2011 is **withdrawn**.

In view of the above, the paper entitled "PETITION UNDER 37 C.F.R. § 1.182 TO WITHDRAW NOTIC OF INTENT TO ISSUE *EX PARTE* REEXAMINATION CERTIFICATE" is **dismissed as moot**.

CONCLUSION

1. The NIRC is withdrawn.

2. The petition of July 25, 2011 is **dismissed**.

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

Eric Keasel
SPE, Central Reexamination Unit

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OCT 19 2011

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In re Lowery et al.
Reexamination Proceeding
Control No.: 90/008,342
Filed: November 27, 2006
Control No.: 90/008,562
Filed: March 29, 2007
Control No.: 90/008,574
Filed: April 3, 2007
for: U.S. Patent 5,894,554

: DECISION ON PETITIONS
: UNDER 37 CFR 1.181

This is a decision on the petition filed August 23, 2009 for entry of the amendments presented in the response submitted on June 29, 2009 to a Final Office action issued April 29, 2009. This decision also addresses the six petitions, filed on January 14, 2010, which request entry of the amendments pursuant to 37 CFR 41. 33(a) that were filed on October 29 and 30, 2009 after receipt of a Notice of Appeal but prior to filing the Appeal Brief.

The petition is before the Director of Technology Center 1600, who oversees the Central Reexamination Unit, for decision.

The petition of August 23, 2009 is GRANTED for the reasons set forth below.

The six petitions of January 14, 2010 are DISMISSED for the reasons set forth below.

Review of Facts

1. On November 27, 2006, a first request for reexamination of USPN 5,894,554 was filed and assigned control number 90/008,342.

2. On January 25, 2007, reexamination was ordered in the 90/008,342 proceeding.

3. On March 29, 2007, a second request for reexamination of USPN 5,894,554 was filed and assigned control number 90/008,562.

4. On April 3, 2007, a third request for reexamination of USPN 5,894,554 was filed and assigned control number 90/008,574.

5. On May 4, 2007, reexamination was ordered in the 90/008,562 proceeding and 90/008,574 proceeding.

6. On May 13, 2008, the three proceedings were merged.

7. On June 30, 2008, a non-final Office action was mailed in the merged proceedings.

8. On September 2, 2008, a timely response to the non-final Office action was submitted and added proposed new claims 12-281.

9. On October 3, 2008, a Notice of Defective Paper was issued.

10. On November 3, 2008, a corrected response was submitted.

11. On April 29, 2009, a Final Office action was mailed.

12. On June 29, 2009, an after-final response was submitted. The response proposed to cancel claims 9, 10, 39, 40, 69, 70, 99, 100, and 121-200 and amend numerous claims, e.g., claims 21, 22, 51, 52, 61, 71, 81, 82, 91, 101, 111, 112, 210, 211, 230, 231, 250, 251, 270, 271, and 281, to address the rejections under 35 USC 112.

13. On July 9, 2009, an Advisory action was mailed indicating the amendment of June 29, 2009 would not be entered because it raised new issues requiring further consideration and search, contained new matter, and did not place the proceeding in better form for appeal.

14. On August 23, 2009, Patent Owner filed this petition requesting entry of the amendment of June 29, 2009.

15. On August 31, 2009, Patent Owner filed a Notice of Appeal.

16. On October 29, 2009, Patent Owner filed First, Second, and Third amendments.

17. On October 30, 2009, Patent Owner filed Fourth, Fifth, and Sixth amendments.

18. On November 2, 2009, Patent Owner filed an Appeal Brief.

19. On November 14, 2009, an Advisory action was mailed indicating the six amendments, filed on October 29 and 30, 2009, are not entered because the amendments fail to put the proceeding in better form for appeal.

20. On December 14, 2009, a Notice of Defective Brief was mailed.

21. On December 18, 2009, another Notice of Defective Brief was mailed.

22. On December 30, 2009, Patent Owner filed an amendment that proposed to cancel claim 281.

23. On January 14, 2010, Patent Owner filed six petitions requesting entry of each of the six amendments filed on October 29-30, 2009.

24. On January 15, 2010, a replacement Appeal Brief was submitted.

Decision

37 CFR 1.116 provides, in part:

> (b) After a final rejection or other final action (§ 1.113) in an application or in an *ex parte* reexamination filed under § 1.510, .., but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title):
>
> (1) An amendment may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action;
>
> (2) An amendment presenting rejected claims in better form for consideration on appeal may be admitted; or
>
> (e) An affidavit or other evidence submitted after a final rejection or other final action (§ 1.113) ... in an *ex parte* reexamination filed under § 1.510 ... may be admitted upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented.

37 CFR 1.550(a) provides:

> All *ex parte* reexamination proceedings, including any appeals to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office. After issuance of the *ex parte* reexamination order and expiration of the time for submitting any responses, the examination will be conducted in accordance with §§ 1.104 through 1.116 and will result in the issuance of an *ex parte* reexamination certificate under § 1.570.

MPEP 2271 provides, in part:

> Before a final action is in order, a clear issue should be developed between the examiner and the patent owner. To bring the prosecution to a speedy conclusion and at the same time deal justly with the patent owner and the public, the examiner will twice provide the patent owner with such information and references as may be useful in defining the position of the Office as to unpatentability before the action is made final. Initially, the decision ordering reexamination of the patent will contain an identification of the new questions of patentability that the examiner considers to be raised by the prior art considered. In addition, the first Office action will reflect the consideration of any arguments and/or amendments contained in the request, the owner's statement filed pursuant to 37 CFR 1.530, and any reply thereto by the requester, and should fully apply all relevant grounds of rejection to the claims. ...
>
> It is intended that the second Office action in the reexamination proceeding following the decision ordering reexamination will be made final in accordance with the guidelines set forth in MPEP § 706.07(a).

The patent owner (petitioner) states that the examiner erred in deciding not to enter the June 29, 2009 proposed amendment. The petitioner explained his attempts to schedule an interview for the merged reexamination proceedings prior to the Final Office action and how he filed amendments to address the issues raised in the Final Office action. See pages 2-3 of the petition. Specifically, the patent owner presented reasons why the June 29, 2009 amendment was necessary and not earlier presented. See pages 4-6.

In response to patent owner's arguments that the examiner erred in deciding not to enter the June 29, 2009 proposed amendment, the director finds there is a good and sufficient reason to enter the amendment. Turning to the specific facts of this merged proceeding, the director finds that the June 29, 2009 amendment, on balance, significantly reduces or simplifies the issues for appeal. Specifically, the June 29, 2009 amendment proposed to cancel claims 9, 10, 39, 40, 69, 70, 99, 100, and 121-200 and amend numerous other claims to reduce issues under 35 U.S.C. 112. As outlined in detail below, entry of the amendment would eliminate numerous issues (e.g., issues II. A & B on page 47, III.A. 1-12 & 19-42 on pages 47-59, and III. B. 1 & 3 on pages 60-61 of the June 29, 2009 response) and reduce other issues (e.g., issues III. A. 13-15 on pages 50-53, III. B. 2 on page 61, and V.A., B., F., and G. on pages 63-77 and 85-92 of the June 29, 2009 response). Therefore, in light of the facts and circumstances of the present situation, the entry of the amendment of June 29, 2009 is considered the best course to further prosecution.

Accordingly, good and sufficient reasons to enter the June 29, 2009 amendment in the merged reexamination proceedings have been provided. In view of the above, the petition, dated August 23, 2009, is GRANTED.

The six petitions dated January 14, 2010 request entry of amendments filed on either October 29 or 30, 2009. Upon review of the record, these six amendments, *en total*, appear to present substantially similar amendments to the June 29, 2009 amendment. Patent owner filed the six separate amendments, after the June 29, 2009 amendment was denied entry, because of the Office's policy that amendments are not entered-in-part. See, e.g., page 4 of the January 14,

2010 petition requesting entry of the sixth amendment. Accordingly, it is deemed that entry of the June 29, 2009 amendment renders the October 29 and 30, 2009 amendments as duplicative amendment submissions. Therefore, the six petitions of January 14, 2010 are DISMISSED as moot in light of the relief granted for the August 23, 2009 petition.

In summary, the amendment of June 29, 2009 is entered. In addition, the proposed amendment of December 30, 2009, which cancelled independent claim 281, is entered. In view of the complexity of the action/issues, it is further determined that the best course of action at this point is to return this proceeding to the examiner for issuance of a new Final Office action.

Conclusion

1. The Patent Owner's petition, dated August 23, 2009, for entry of the amendments presented in the response submitted on June 29, 2009 is GRANTED.

2. The six petitions filed on January 14, 2010 are dismissed as moot in light of the relief provided in granting the petition of August 23, 2009.

3. The proceeding is returned to the examiner for issuance of a Final Office action.

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

Irem Yucel, Director
Technology Center 1600

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,343	11/27/2006	6415335		3417

7590 02/02/2012

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 02/02/2012

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
Public Patent Foundation
1375 Broadway, Suite 600
New York, NY 10018

Date: MAILED

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CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008343
PATENT NO. : 6415335
ART UNIT : 3900

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,343	11/27/2006	6415335		3417

7590 02/02/2012

EXAMINER	
ART UNIT	PAPER NUMBER

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Dallas, TX 75201-2980

DATE MAILED: 02/02/2012

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CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008568
PATENT NO. : 6415335
ART UNIT : 3900

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,584	04/03/2007	6415335	FRIENDFINDER.RX2	3276

7590 02/02/2012

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 02/02/2012

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CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008584
PATENT NO. : 6415335
ART UNIT : 3900

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In re Lowery et al.
Reexamination Proceeding
Control No.: 90/008,343
Filed: November 27, 2006
Control No.: 90/008,568 : DECISION ON PETITIONS
Filed: March 29, 2007 : UNDER 37 CFR 1.181
Control No.: 90/008,584
Filed: April 3, 2007
for: U.S. Patent 6,415,335

This is a decision on the petition filed August 23, 2009 for reconsideration of the petition decision rendered August 13, 2009 for entry of the amendments presented in the response submitted on June 19, 2009 to a Final Office action issued March 30, 2009. This decision also addresses the seven petitions, filed on December 22, 2009, which request entry of the after-final amendments pursuant to 37 CFR 41. 33(a) that were filed on August 27, 28 and 30, 2009 after receipt of a Notice of Appeal but prior to filing the Appeal Brief.

The petitions are before the Director of the Central Reexamination Unit, for decision.

The petition of August 23, 2009 is granted for the reasons set forth below.

The seven petitions of December 22, 2009 are dismissed for the reasons set forth below.

Review of Facts

1. On March 30, 2009, a Final Office action was mailed.

2. On April 20, 2009, a personal interview was conducted with Charles Fish (for Patent Owner), M. Steelman (examiner), F. Ferris (examiner) and Eric Keasal (supervisor).

3. On April 30, 2009, a first after-Final amendment was submitted that proposed amending claims 1, 2, 15, 16, and 29 and added new claims 30-184. This submission also included a Statement of the Interview (see page 35 of the response).

4. On May 28, 2009, an Advisory action was mailed denying entry of the After-final amendment.

5 On June 19, 2009, a second after-final response was submitted. The response proposed essentially the same amendments that were proposed on April 30, 2009. The editorial difference in claim 29 did not change the meaning of that claim and it was not in compliance with 37 CFR 1.530(f).

6. On June 30, 2009, a Notice of Appeal was filed.

7. On June 30, 2009, a petition under 37 CFR 1.181 was filed requesting entry of the amendment filed June 19, 2009.

8 On July 1, 2009, an Advisory action was mailed indicating the amendment of June 19, 2009 would not be entered because it raised new issues requiring further consideration and search, contained new matter, and did not place the proceeding in better form for appeal.

9. On August 13, 2009, the petition under 37 CFR 1.181, filed June 30, 2009, was dismissed.

10. On August 23, 2009, a petition under 37 CFR 1.181(a)(3) was filed requesting the decision of August 13, 2009 be overturned.

11. On August 23, 2009, Patent Owner also filed an amendment pursuant to 37 CFR 41.33(a).

12. On August 27, 2009, Patent Owner filed Second, Third, Fourth, Fifth and Sixth amendments pursuant to 37 CFR 41.33(a).

13. On August 28, 2009, Patent Owner filed Seventh and Eighth amendments pursuant to 37 CFR 41.33(a).

14. On August 30, 2009, Patent Owner filed a supplement to the Sixth after-final amendment.

15. On August 31, 2009, Patent Owner filed an Appeal Brief.

16. On October 16, 2009, a Notice of Defective Appeal Brief was mailed.

17. On October 23, 2009, an Advisory action was mailed indicating the amendments filed on August 27, 28, and 30, 2009, are not entered because the amendments fail to put the proceeding in better form for appeal

18. On November 16, 2009, an Appeal Brief was filed.

19. On December 22, 2009, seven Petitions under 37 CFR 1.181 were filed for entry of each of the amendments filed August 28, 28, and 30, 2009,

Decision

37 CFR 1.116 provides, in part:

> (b) After a final rejection or other final action (§ 1.113) in an application or in an *ex parte* reexamination filed under § 1.510, .., but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title):
>
> (1) An amendment may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action;
>
> (2) An amendment presenting rejected claims in better form for consideration on appeal may be admitted; or
>
> (e) An affidavit or other evidence submitted after a final rejection or other final action (§ 1.113) ... in an *ex parte* reexamination filed under § 1.510 ... may be admitted upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented.

MPEP 2271 provides, in part:

> Before a final action is in order, a clear issue should be developed between the examiner and the patent owner. To bring the prosecution to a speedy conclusion and at the same time deal justly with the patent owner and the public, the examiner will twice provide the patent owner with such information and references as may be useful in defining the position of the Office as to unpatentability before the action is made final. Initially, the decision ordering reexamination of the patent will contain an identification of the new questions of patentability that the examiner considers to be raised by the prior art considered. In addition, the first Office action will reflect the consideration of any arguments and/or amendments contained in the request, the owner's statement filed pursuant to 37 CFR 1.530, and any reply thereto by the requester, and should fully apply all relevant grounds of rejection to the claims. ...

It is intended that the second Office action in the reexamination proceeding following the decision ordering reexamination will be made final in accordance with the guidelines set forth in MPEP § 706.07(a).

The patent owner (petitioner) states that the examiner erred in deciding not to enter the June 19, 2009 proposed amendment. The petitioner explained his attempts to submit the amendments suggested at the interview held on April 20, 2009 to address the issues raised in the Final Office action. See page 5 of the petition. Specifically, the patent owner presented reasons why the June 19, 2009 amendment was necessary and not earlier presented. See pages 6-7.

In response to patent owner's arguments that the examiner erred in deciding not to enter the June 19, 2009 proposed amendment, the director finds there is a good and sufficient reason to enter the amendment. Turning to the specific facts of this merged proceeding, the director finds that the June 19, 2009 amendment, on balance, significantly reduces or simplifies the issues for appeal. Specifically, the June 19, 2009 submission proposed amendments that would eliminate numerous issues under 35 USC 112 that were discussed at the interview conducted on April 20, 2009. Therefore, in light of the facts and circumstances of the present situation, the entry of the amendment of June 19, 2009 is considered the best course to further prosecution.

Accordingly, good and sufficient reasons to enter the June 19, 2009 amendment in the merged reexamination proceedings have been provided. In view of the above, the petition, dated August 23, 2009, is GRANTED.

The seven petitions dated December 22, 2009 request entry of amendments filed on August 27, 28 and 30, 2009. Upon review of the record, these amendments, *en total*, are present in the amendment of June 19, 2009 and are considered redundant. Therefore, the seven petitions of December 23, 2009 are DISMISSED.

In summary, the amendment of June 19, 2009 is entered. In view of the complexity of the action/issues, it is further determined that the best course of action at this point is to return this proceeding to the examiner for issuance of a new Final office action.

Conclusion

1. The Patent Owner's petition, dated August 23, 2009, for reconsideration of the decision rendered August 13, 2009 for entry of the amendments presented in the response submitted on June 19, 2009 is GRANTED.

2. The amendment filed June 19, 2009 is entered.

3. The seven petitions filed on December 23, 2009 are DISMISSED as moot in light of the relief provided ingranting the petition of August 23, 2009. 4. The amendment filed August 23, 2009 is entered and considered the most current edition of the claims in this proceeding.

5. The proceeding is returned to the examiner for issuance of a Final office action based of the claims as amended on June 19, 2009.

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

Irem Yucel, Director
Technology Center 1600

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 3/4/2011

TO SPE OF : ART UNIT 3993 Kashnikow Andres (Spe)

SUBJECT : Request for Certificate of Correction for Appl. No.: 96/008352 Patent No.: 6712387

CofC mailroom date: 11/15/2011

Please respond to this request for a certificate of correction within 7 days.

FOR IFW FILES:

Please review the requested changes/corrections as shown in the **COCIN** document(s) in the IFW application image. No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Please complete the response (see below) and forward the completed response to scanning using document code **COCX**.

FOR PAPER FILES:

Please review the requested changes/corrections as shown in the attached certificate of correction. Please complete this form (see below) and forward it with the file to:

Certificates of Correction Branch (CofC)
Randolph Square – 9D10-A
Palm Location 7580

Certificates of Correction Branch

703-756-1571 _____

Thank You For Your Assistance

The request for issuing the above-identified correction(s) is hereby:

Note your decision on the appropriate box.

- [X] **Approved** — All changes apply.
- [ ] **Approved in Part** — Specify below which changes **do not** apply.
- [ ] **Denied** — State the reasons for denial below:

Comments: _____

SPE

3993
Art Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,357	12/01/2006	6694660	20020/10093	8443

29370 7590 09/28/2010

ROBERT A. PARSONS
4000 N. CENTRAL AVENUE, SUITE 1220
PHOENIX, AZ 85012

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 09/28/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
HANLEY, FLIGHT & ZIMMERMAN, LLC
150 SOUTH WACKER DRIVE
SUITE 2100
CHICAGO, IL 60606

Date:
MAILED
SEP 2 8 2010
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008357
PATENT NO. : 6694660
ART UNIT : 3993

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

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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150 SOUTH WACKER DRIVE, SUITE 2100
CHICAGO, IL 60606

Date:

MAILED

SEP 2 8 2010

CENTRAL REEXAMINATION UNIT

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
11/361,036	02/23/2006	Robert Bruce Davies	4151-A7R	3022

29370 7590 09/28/2010

ROBERT A. PARSONS
4000 N. CENTRAL AVENUE, SUITE 1220
PHOENIX, AZ 85012

EXAMINER	
CHAMBERS, TROY	
ART UNIT	PAPER NUMBER
3641	
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09/28/2010	PAPER

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

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Robert A. Parsons (For Patent Owner)
PARSONS & GOLTRY
4000 N. Central Avenue, Suite 1220
Phoenix, Arizona 85012

MAILED

SEP 2 8 2010

CENTRAL REEXAMINATION UNIT

Keith R. Jarosik
Hanley, Flight & Zimmerman, LLC (For Requester)
USPTO Customer Number 34431
150 S. Wacker Drive, Suite 2100
Chicago, Illinois 60606

Hanley, Flight & Zimmerman, LLC (For Petitioner)
150 S. Wacker Drive, Suite 2100
Chicago, Illinois 60606

In re Reissue Application of :
Robert Bruce Davies :
Application No. 11/361,036 : DECISION DISMISSING PETITIONS
Filed: February 23, 2006 : UNDER 37 CFR 1.182, AND
For: U.S. Patent No. 6,694,660 : DISMISSING PETITION
: UNDER 37 CFR 1.292 FOR
In re Robert Bruce Davies : THE INSTITUTION OF
Ex Parte Reexamination Proceeding : *INTER PARTES* PUBLIC USE
Control No: 90/008,357 : PROCEEDINGS
Filed: December 1, 2006 :
For: U.S. Patent No. 6,694,660 :

This is a decision on the petition under 37 CFR 1.182 and the petition under 37 CFR 1.292 for the institution of *inter partes* public use proceedings, concurrently filed on July 20, 2010, and on the petition under 37 CFR 1.182 filed on August 2, 2010, requesting entry of the accompanying supplemental submission to the petition under 37 CFR 1.292. It is noted that the petitioner who filed these petitions has the same correspondence address as the third party requester of the reexamination proceeding.

For the reasons set forth below, the petition under 37 CFR 1.182 for entry of the accompanying petition under 37 CFR 1.292 and the petition under 37 CFR 1.182 for entry of the supplemental submission are dismissed.

Accordingly, the petition under 37 CFR 1.292 for institution of public use proceedings, including the supplemental submission, is dismissed as untimely.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,694,660 (the '660 patent) issued on February 24, 2004, with 18 claims.

2. On February 23, 2006, an application for reissue of the '660 patent, assigned application No. 11/361,036 (the '036 reissue application), was filed by the patent owner.

3. On September 12, 2006, the filing of the '036 reissue application was announced in the *Official Gazette*. The two-month time period for members of the public to submit pertinent information to the Office before the examiner's action expired on November 12, 2006. *See* Manual of Patent Examining Procedure (MPEP) §§ 1441 and 720.

4. On December 1, 2006, a request for *ex parte* reexamination of the '660 patent was filed by a third party requester, and was assigned control No. 90/008,357 (the '8357 proceeding).

5. Reexamination was ordered for the '8357 proceeding on January 8, 2007.

6. A decision merging the '036 reissue application and '8357 reexamination proceeding was mailed on May 23, 2007.

7. On May 13, 2010, a final Office action was mailed, closing the prosecution in the merged proceeding.

8. On July 12, 2010, a proposed after-final amendment was filed.

9. On July 20, 2010, petitioner filed: (1) a petition under 37 CFR 1.182 for entry of a petition under 37 CFR 1.292, accompanied by a check in the amount of $400.00 for the payment of the fee required under 37 CFR 1.17(f); (2) a petition under 37 CFR 1.292 for institution of public use proceedings, accompanied by new evidence, accompanied by a check in the amount of $1,510.00 for the payment of the fee required under 37 CFR 1.17(j); and (3) certificates of service under 37 CFR 1.248 that a copy of the petitions and all accompanying papers have been served on the patent owner. These petitions are the subject of this decision.

10. On July 21, 2010, an advisory action was mailed, denying the entry of the proposed after-final amendment filed on July 12, 2010. On the same day, patent owner filed another proposed after-final amendment.

11. On August 2, 2010, petitioner filed: (1) a petition under 37 CFR 1.182 for entry of the accompanying supplement to the petition under 37 CFR 1.292 filed on July 20, 2010; (2) a supplement to the petition under 37 CFR 1.292 filed on July 20, 2010, accompanied by new evidence including affidavits; and (3) certificates of service under 37 CFR 1.248 that a copy of the petitions and all accompanying papers have been served on the patent owner. The $400.00 petition fee for the petition under 37 CFR 1.182 has been charged to petitioner's deposit account as authorized in the petition.

REGULATIONS AND EXAMINING PROCEDURE

37 CFR 1.292 provides in pertinent part as follows:

> (a) When a petition for the institution of public use proceedings, supported by affidavits or declarations is found, on reference to the examiner, to make a prima facie showing that the invention claimed in an application believed to be on file had been in public use or on sale more than one year before the filing of the application, a hearing may be had before the Director to determine whether a public use proceeding should be instituted. If instituted, the Director may designate an appropriate official to conduct the public use proceeding, including the setting of times for taking testimony, which shall be taken as provided by part 41, subpart D, of this title. The petitioner will be heard in the proceedings but after decision therein will not be heard further in the prosecution of the application for patent.
>
> (b) The petition and accompanying papers, or a notice that such a petition has been filed, shall be entered in the application file if:
>
> (1) The petition is accompanied by the fee set forth in § 1.17(j);
>
> (2) The petition is served on the applicant in accordance with § 1.248, or filed with the Office in duplicate in the event service is not possible; and
>
> (3) The petition is submitted prior to the date the application was published or the mailing of a notice of allowance under § 1.311, whichever occurs first.

37 CFR 1.176 provides in pertinent part as follows:

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

MPEP § 1441 provides in pertinent part that:

> 37 CFR 1.176 provides that reissue applications will be acted on by the examiner in advance of other applications, i.e., "special." Generally, a reissue application will not be acted on sooner than 2 months after announcement of the filing of the reissue has appeared in the *Official Gazette*. The 2-month delay is provided in order that members of the public may have time to review the reissue application and submit pertinent information to the Office before the examiner's action.

MPEP § 720 provides in pertinent part as follows:

> A petition filed after final rejection will be considered if the application has not been published and is still pending when the petition and application are provided to the member of the OPLA staff. However, prosecution will not ordinarily be reopened after final rejection if the subject matter alleged in the petition to have been in "public use" or "on sale" is merely cumulative of the prior art cited in the final rejection. If a petition is filed after the date the application was published or the mailing of a notice of allowance under 37 CFR 1.311, it will be dismissed as untimely.
>
> A petition with regard to a reissue application should be filed within the 2-month period following announcement of the filing of the reissue application in the *Official Gazette*. If, for some reason, the petition cannot be filed within the 2-month period provided by 37 CFR 1.176, the petition can be submitted at a later time, but petitioner must be aware that reissue applications are "special" and a later filed petition may be received after action by the examiner. Any request by a petitioner in a reissue application for an extension of the 2-month period following the announcement in the *Official Gazette* will be considered only if filed in the form of a petition under 37 CFR 1.182 and accompanied by the petition fee set forth in 37 CFR 1.17(f). The petition must explain why the additional time is necessary and the nature of the allegations to be made in the petition. A copy of such petition must be served upon applicant in accordance with 37 CFR 1.248. The petition should be directed to the appropriate Technology Center (TC). Any such petition will be critically reviewed as to demonstrated need before being granted since the delay of examination of a reissue application of another party is being requested. Accordingly, the requests should be made only where necessary, for the minimum period required, and with a justification establishing the necessity for the extension.

DISCUSSION

As noted above, the two-month time period for members of the public to submit pertinent information to the Office before the examiner's action expired on November 12, 2006. Furthermore, a final Office action was mailed on May 13, 2010, closing the prosecution in the above-identified merged proceeding. As set forth in MPEP § 720, any request by a petitioner in a reissue application for an extension of the two-month period following the announcement in the *Official Gazette* will be considered only if filed in the form of a petition under 37 CFR 1.182. The petition must explain why the additional time is necessary and the nature of the allegations to be made in the petition. In addition, the petition will be critically reviewed as to demonstrated need before being granted since the delay of examination of a reissue application of another party is being requested.

In the 37 CFR 1.182 petition filed July 20, 2010, petitioner states that the petition under 37 CFR 1.292 for institution of public use proceedings could not have been presented earlier. For support, the petitioner contends that the new claim limitation ("at least one repeatably removable

and refastenable fastener removably securing the handguard in position") introduced by the proposed after-final amendment filed on July 12, 2010, implicated the new evidence submitted in the petition under 37 CFR 1.292. The petitioner further alleges that the proposed after-final amendment made the new evidence highly material, anticipatory, and non-cumulative to the claims in the proceeding.

However, the proposed after-final amendment filed on July 12, 2010 has been denied entry by the examiner in the advisory action mailed on July 21, 2010. Furthermore, the patent owner subsequently filed another proposed after-final amendment on July 21, 2010, that did not contain this new claim limitation. Therefore, the pending claims in the above-identified merged proceeding have not been amended by the proposed after-final amendment filed on July 12, 2010, to include the new claim limitation, which petitioner has alleged has implicated the new evidence. Accordingly, the petitioner's reasons for presenting the new evidence more than two months (i.e., nearly four years) after the announcement of the filing of the reissue application in the *Official Gazette* and after prosecution has been closed are insufficient.

In the 37 CFR 1.182 petition filed August 2, 2010, petitioner states reasons why the supplemental submission to the petition under 37 CFR 1.292 could not have been presented earlier. This 37 CFR 1.182 petition, however, does not set forth any additional reasons why the 37 CFR 1.292 petition could not have been submitted earlier.

In view of the above, the petition under 37 CFR 1.182 for entry of the accompanying petition under 37 CFR 1.292 and the petition under 37 CFR 1.182 for entry of the supplemental submission to the 37 CFR 1.292 petition are dismissed. Accordingly, the petition under 37 CFR 1.292 for institution of public use proceedings, including the supplemental submission, is dismissed as untimely.

As noted above, the 37 CFR 1.292 petition, the supplemental submission to the 37 CFR 1.292 petition, and the 37 CFR 1.182 petitions each include an indication of service under 37 CFR 1.248 on the patent owner. Therefore, the original petition under 37 CFR 1.292, including the accompanying evidence, filed July 20, 2010 is being discarded. The supplemental submission to the 37 CFR 1.292 petition, including the accompanying evidence, filed August 2, 2010 was incorporated into the Image File Wrapper (IFW) for the present proceeding before it was reviewed for entry into the file. Therefore, the supplemental submission will be expunged from the file by marking it "closed" in the IFW rendering it unavailable for viewing by the public.

In addition, the petitions under 37 CFR 1.182 include a discussion of the nature of how the evidence could be applied to the claims (e.g., see pages 2-3 of the petition under 37 CFR 1.182 filed on July 20, 2010). This amounts to a protest in itself. Accordingly, the original petition under 37 CFR 1.182 filed July 20, 2010 is being discarded and the original petition under 37 CFR 1.182 filed August 2, 2010 (which was incorporated into the IFW for the present proceeding before it was reviewed for entry into the file) will be expunged from the file by marking it as "closed" in the IFW rendering it unavailable for viewing by the public.

CONCLUSION

1. The petition under 37 CFR 1.182 filed on July 20, 2010 and the petition under 37 CFR 1.182 filed on August 2, 2010 are dismissed.

2. The petition under 37 CFR 1.292 filed on July 20, 2010, including the supplemental submission filed on August 2, 2010, is dismissed as untimely.

3. The original petition under 37 CFR 1.292, including the accompanying evidence, and the original petition under 37 CFR 1.182 filed July 20, 2010 are being discarded. The petition under 37 CFR 1.182 and the supplemental submission, including the accompanying evidence, filed on August 2, 2010, is being expunged from the file by marking them as "closed" in the IFW rendering them unavailable for viewing by the public.

4. Telephone inquiries with respect to this matter should be directed to the undersigned at (571) 272-7727.

Eugenia A. Jones

Eugenia A. Jones
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Associate Commissioner
for Patent Examination Policy

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,357	12/01/2006	6694660	20020/10093	8443

29370 7590 11/05/2010

ROBERT A. PARSONS
4000 N. CENTRAL AVENUE, SUITE 1220
PHOENIX, AZ 85012

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90/008,357	12/01/2006	6694660	20020/10093	8443

29370 7590 11/05/2010

EXAMINER

HANLEY, FLIGHT, & ZIMMERMAN, LLC
150 South Wacker Drive
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Chicago, Illinois 60606

ART UNIT	PAPER NUMBER

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Robert A. Parsons
4000 N. Central Avenue, Suite 1220
Phoenix, AZ 85012

(For Patent Owner)

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NOV 05 2010

CENTRAL REEXAMINATION UNIT

Hanley, Flight & Zimmerman, LLC
150 South Wacker Drive
Suite 2100
Chicago, IL 60606

(For Third Party Requester)

In re Reissue Application of
Robert Davies Bruce
Application No.: 11/361,036
Filed: February 23, 2006
For: U.S. Patent No. 6,694,660

In re Robert Davies Bruce
Reexamination Proceeding
Control No.: 90/008,357
Filed: December 1, 2006
For: U.S. Patent No.: 6,694,660

: SUPPLEMENT TO
: PRIOR DECISION
: TO MERGE
: REISSUE AND
: REEXAMINATION
: PROCEEDINGS

This decision is supplemental to the Office's prior merger decision mailed May 23, 2007, which *sua sponte* merged reissue application No. 11/361,036 and reexamination control No. 90/008,357 into a single proceeding.

The above-identified prior merger decision continues to be in effect, and all further examination in the merged proceeding should continue to be conducted in accordance with the above-identified prior merger decision, except as it is supplemented by this decision – as follows:

If a request for continued examination (RCE) is filed under 37 CFR 1.114, as is permitted for the reissue application, then 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, a request for continued examination (RCE) is not available in the reexamination proceeding, and any response to the outstanding Office action (e.g., response to a final rejection) at that stage in the reexamination proceeding must be made taking into account the non-availability of RCE practice. Any failure to timely respond would result in the termination of the prosecution pursuant to 37 CFR 1.550(d).

In addition, if a final Office action should be issued subsequent to the mail date of this decision in this merged proceeding, any request for extension for time (to respond to any such subsequent final action) 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 Office action issued in the present merged proceeding subsequent to the mail date of this decision.

The merged proceeding will otherwise continue as per the above-identified prior merger decision.

CONCLUSION

1. Reissue application No. 11/361,036 and reexamination control No. 90/008,357 remain merged as a single proceeding.

2. 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, a request for continued examination (RCE) is not available in the reexamination proceeding, and any response to the outstanding Office action (e.g., response to a final rejection) at that stage in the reexamination proceeding must be made taking into account the non-availability of RCE practice. Any failure to timely respond would result in the termination of the prosecution pursuant to per 37 CFR 1.550(d).

3. In addition, if a final Office action should be issued in this merged proceeding subsequent to the mail date of this decision, then any request for extension for time (to respond to any such subsequent action) 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 Office action issued subsequent to the mail date of this decision.

4. All further examination in the merged proceeding is to continue to be conducted in accordance with the above-identified prior merger decision.

5. Telephone inquiries related to this decision should be directed to Colleen Dunn at (571) 272-1170, or in her absence to Eric Keasel at (571) 272-4929 or to Mark Reinhart at (571) 272-1611.

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

11/04/10

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PHOENIX, AZ 85012

EXAMINER	
ART UNIT	PAPER NUMBER

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Date:
MAILED
JAN 28 2011
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008357
PATENT NO. : 6694660
ART UNIT : 3993

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

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

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MAILED

JAN 28 2011

CENTRAL REEXAMINATION UNIT

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USPTO Customer Number 34431
150 S. Wacker Drive, Suite 2100
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In re Reissue Application of :
Robert Bruce Davies :
Application No. 11/361,036 : DECISION GRANTING PETITION
Filed: February 23, 2006 : UNDER 37 CFR 1.182
For: U.S. Patent No. 6,694,660 :
:
In re Robert Bruce Davies :
Ex Parte Reexamination Proceeding :
Control No: 90/008,357 :
Filed: December 1, 2006 :
For: U.S. Patent No. 6,694,660 :

This is a decision on the petition under 37 CFR 1.182 filed on October 12, 2010, requesting entry of the accompanying petition under 37 CFR 1.292 entitled "Supplement to the Petition Under 37 C.F.R. § 1.292 for the Institution of *Inter Partes* Public Use Proceedings". It is noted that the petitioner who filed these petitions has the same correspondence address as the third party requester of the reexamination proceeding.

The "supplement" is being treated as a second petition under 37 CFR 1.292 since the prior petition was discarded, as stated in the September 28, 2010 decision.

The petition under 37 CFR 1.182 filed October 12, 2010 is granted. Accordingly, the petition under 37 CFR 1.292 for institution of public use proceedings filed October 12, 2010, including the accompanying papers, has been entered in the record of the above-identified merged proceeding.

In accordance with MPEP 720.02, the 37 CFR 1.292 petition, including the accompanying papers, is being forwarded to the examiner for a determination of whether a *prima facie* case of public use or sale in this country of the claimed subject matter is established by the petition.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,694,660 (the '660 patent) issued on February 24, 2004, with 18 claims.

2. On February 23, 2006, an application for reissue of the '660 patent, assigned application No. 11/361,036 (the '036 reissue application), was filed by the patent owner.

3. On September 12, 2006, the filing of the '036 reissue application was announced in the *Official Gazette*. The two-month time period for members of the public to submit pertinent information to the Office before the examiner's action expired on November 12, 2006. *See* Manual of Patent Examining Procedure (MPEP) §§ 1441 and 720.

4. On December 1, 2006, a request for *ex parte* reexamination of the '660 patent was filed by a third party requester, and was assigned control No. 90/008,357 (the '8357 proceeding).

5. Reexamination was ordered for the '8357 proceeding on January 8, 2007.

6. A decision merging the '036 reissue application and '8357 reexamination proceeding was mailed on May 23, 2007.

7. On May 13, 2010, a final Office action was mailed, closing the prosecution in the merged proceeding.

8. On July 12, 2010, a proposed after-final amendment was filed.

9. On July 20, 2010, petitioner filed: (1) a petition under 37 CFR 1.182 for entry of a petition under 37 CFR 1.292, accompanied by a check in the amount of $400.00 for the payment of the fee required under 37 CFR 1.17(f); (2) a petition under 37 CFR 1.292 for institution of public use proceedings, accompanied by new evidence, accompanied by a check in the amount of $1,510.00 for the payment of the fee required under 37 CFR 1.17(j); and (3) certificates of service under 37 CFR 1.248 that a copy of the petitions and all accompanying papers have been served on the patent owner.

10. On July 21, 2010, an advisory action was mailed, denying the entry of the proposed after-final amendment filed on July 12, 2010. On the same day, patent owner filed another proposed after-final amendment.

11. On August 2, 2010, petitioner filed: (1) a petition under 37 CFR 1.182 for entry of the accompanying supplement to the petition under 37 CFR 1.292 filed on July 20, 2010; (2) a supplement to the petition under 37 CFR 1.292 filed on July 20, 2010, accompanied by new

evidence including affidavits; and (3) certificates of service under 37 CFR 1.248 that a copy of the petitions and all accompanying papers have been served on the patent owner.

12. On September 28, 2010, a decision dismissing the petitions under 37 CFR 1.182 and 1.292 filed July 20, 2010 and August 2, 2010 was mailed.

13. On October 12, 2010, petitioner filed the instant petition under 37 CFR 1.182, accompanied by the $400.00 petition fee, and the instant petition under 37 CFR 1.292. The petitions included certificates of service under 37 CFR 1.248.

14. Additional proposed amendments were filed on October 13, 2010, and November 12, 2010.

REGULATIONS AND EXAMINING PROCEDURE

37 CFR 1.292 provides in pertinent part as follows:

> (a) When a petition for the institution of public use proceedings, supported by affidavits or declarations is found, on reference to the examiner, to make a prima facie showing that the invention claimed in an application believed to be on file had been in public use or on sale more than one year before the filing of the application, a hearing may be had before the Director to determine whether a public use proceeding should be instituted. If instituted, the Director may designate an appropriate official to conduct the public use proceeding, including the setting of times for taking testimony, which shall be taken as provided by part 41, subpart D, of this title. The petitioner will be heard in the proceedings but after decision therein will not be heard further in the prosecution of the application for patent.
>
> (b) The petition and accompanying papers, or a notice that such a petition has been filed, shall be entered in the application file if:
>
> (1) The petition is accompanied by the fee set forth in § 1.17(j);
>
> (2) The petition is served on the applicant in accordance with § 1.248, or filed with the Office in duplicate in the event service is not possible; and
>
> (3) The petition is submitted prior to the date the application was published or the mailing of a notice of allowance under § 1.311, whichever occurs first.

37 CFR 1.176 provides in pertinent part as follows:

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

MPEP § 1441 provides in pertinent part that:

> 37 CFR 1.176 provides that reissue applications will be acted on by the examiner in advance of other applications, i.e., "special." Generally, a reissue application will not be acted on sooner than 2 months after announcement of the filing of the reissue has appeared in the *Official Gazette*. The 2-month delay is provided in order that members of the public may have time to review the reissue application and submit pertinent information to the Office before the examiner's action.

MPEP § 720 provides in pertinent part as follows:

> A petition filed after final rejection will be considered if the application has not been published and is still pending when the petition and application are provided to the member of the OPLA staff. However, prosecution will not ordinarily be reopened after final rejection if the subject matter alleged in the petition to have been in "public use" or "on sale" is merely cumulative of the prior art cited in the final rejection. If a petition is filed after the date the application was published or the mailing of a notice of allowance under 37 CFR 1.311, it will be dismissed as untimely.
>
> A petition with regard to a reissue application should be filed within the 2-month period following announcement of the filing of the reissue application in the *Official Gazette*. If, for some reason, the petition cannot be filed within the 2-month period provided by 37 CFR 1.176, the petition can be submitted at a later time, but petitioner must be aware that reissue applications are "special" and a later filed petition may be received after action by the examiner. Any request by a petitioner in a reissue application for an extension of the 2-month period following the announcement in the *Official Gazette* will be considered only if filed in the form of a petition under 37 CFR 1.182 and accompanied by the petition fee set forth in 37 CFR 1.17(f). The petition must explain why the additional time is necessary and the nature of the allegations to be made in the petition. A copy of such petition must be served upon applicant in accordance with 37 CFR 1.248. The petition should be directed to the appropriate Technology Center (TC). Any such petition will be critically reviewed as to demonstrated need before being granted since the delay of examination of a reissue application of another party is being requested. Accordingly, the requests should be made only where necessary, for the minimum period required, and with a justification establishing the necessity for the extension.

DISCUSSION

As noted previously, the two-month time period for members of the public to submit pertinent information to the Office before the examiner's action expired on November 12, 2006, and a final Office action was mailed on May 13, 2010, closing the prosecution in the above-identified

merged proceeding. As set forth in MPEP § 720, any request by a petitioner in a reissue application for an extension of the two-month period following the announcement in the *Official Gazette* will be considered only if filed in the form of a petition under 37 CFR 1.182. The petition must explain why the additional time is necessary and the nature of the allegations to be made in the petition. In addition, the petition will be critically reviewed as to demonstrated need before being granted since the delay of examination of a reissue application of another party is being requested.

The petitions under 37 CFR 1.182 filed July 20, 2010 and August 10, 2010 were dismissed because petitioner's reasons for presenting the new evidence more than two months after the announcement of the filing of the reissue application in the *Official Gazette* and after prosecution was closed were found to be insufficient.

In the 37 CFR 1.182 petition filed October 12, 2010, petitioner requests reconsideration of the dismissal of the petitions based on a clarification of the facts. Petitioner states that it was the July 12, 2010 amendment of claims 1 and 9 that prompted the petitioners to contact their competitor to seek evidence of the prior public use and that prior to that time claims 1 and 9 had been properly rejected by the examiner over the art of record. Petitioner also alleges that the evidence was difficult to find due to the fact that it pertains to internal structures that were not shown in printed publications of the particular handguards that were offered for sale. Petitioner further states that the petition with the documentary evidence was filed on August 2, 2010, the same day that the documentary evidence was obtained.

In view of the particular circumstances in this case, the petition under 37 CFR 1.182 is granted.

After mailing of this decision, the $1510.00 petition fee for the 37 CFR 1.292 petition filed October 12, 2010 will be charged to deposit account 50-2455, as authorized in the petition.

Accordingly, the 37 CFR 1.292 petition filed October 12, 2010 has been entered in the record of the merged proceeding. In accordance with MPEP 720.02, the 37 CFR 1.292 petition, including the accompanying papers, is being forwarded to the examiner for a determination of whether a *prima facie* case of public use or sale in this country of the claimed subject matter is established by the petition.

CONCLUSION

1. The petition under 37 CFR 1.182 filed on October 12, 2010 is granted.

2. The petition under 37 CFR 1.292, including the accompanying papers, filed on October 12, 2010 has been entered in the record of the merged proceeding. The petition under 37 CFR 1.292, including the accompanying papers, filed October 12, 2010 is being forwarded to the examiner for a determination of whether a *prima facie* case of public use or sale in this country of the claimed subject matter is established by the petition.

3. Telephone inquiries with respect to this matter should be directed to the undersigned at (571) 272-7727.

Eugenia A. Jones

Eugenia A. Jones
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Associate Commissioner
for Patent Examination Policy

01/28/2011 RBELL1 00000001 502455 90008357
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,357	12/01/2006	6694660	20020/10093	8443

29370 7590 12/19/2011

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 12/19/2011

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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CHICAGO, IL 60606

Date:

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DEC 19 2011

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008357
PATENT NO. : 6694660
ART UNIT : 3993

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

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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.
11/361,036	02/23/2006	Robert Bruce Davies	4151-A7R	3022

29370 7590 12/21/2011

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EXAMINER	
CHAMBERS, TROY	

ART UNIT	PAPER NUMBER
3641	

NOTIFICATION DATE	DELIVERY MODE
12/21/2011	ELECTRONIC

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

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

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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MAILED

DEC 19 2011

CENTRAL REEXAMINATION UNIT

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(For Petitioner)

In re Reissue Application of
Robert Bruce Davies
Application No. 11/361,036
Filed: February 23, 2006
For: U.S. Patent No. 6,694,660

In re Robert Bruce Davies
Ex Parte Reexamination Proceeding
Control No: 90/008,357
Filed: December 1, 2006
For: U.S. Patent No. 6,694,660

: DECISION GRANTING PETITION
: UNDER 37 CFR 1.292

This is a decision on the petition under 37 CFR 1.292 filed on October 12, 2010, to institute public use proceedings against the claims of the above-identified merged proceeding.

The petition under 37 CFR 1.292 filed October 12, 2010 is granted.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,694,660 (the '660 patent) issued on February 24, 2004, with 18 claims.

2. On February 23, 2006, an application for reissue of the '660 patent, assigned application No. 11/361,036 (the '036 reissue application), was filed by the patent owner.

3. On September 12, 2006, the filing of the '036 reissue application was announced in the *Official Gazette*. The two-month time period for members of the public to submit pertinent information to the Office before the examiner's action expired on November 12, 2006. *See* Manual of Patent Examining Procedure (MPEP) §§ 1441 and 720.

4. On December 1, 2006, a request for *ex parte* reexamination of the '660 patent was filed by a third party requester, and was assigned control No. 90/008,357 (the '8357 proceeding).

5. Reexamination was ordered for the '8357 proceeding on January 8, 2007.

6. A decision merging the '036 reissue application and '8357 reexamination proceeding was mailed on May 23, 2007.

7. On May 13, 2010, a final Office action was mailed, closing the prosecution in the merged proceeding.

8. On July 12, 2010, a proposed after-final amendment was filed.

9. On July 20, 2010, petitioner filed: (1) a petition under 37 CFR 1.182 for entry of a petition under 37 CFR 1.292, accompanied by a check in the amount of $400.00 for the payment of the fee required under 37 CFR 1.17(f); (2) a petition under 37 CFR 1.292 for institution of public use proceedings, accompanied by new evidence, accompanied by a check in the amount of $1,510.00 for the payment of the fee required under 37 CFR 1.17(j); and (3) certificates of service under 37 CFR 1.248 that a copy of the petitions and all accompanying papers have been served on the patent owner.

10. On July 21, 2010, an advisory action was mailed, denying the entry of the proposed after-final amendment filed on July 12, 2010. On the same day, patent owner filed another proposed after-final amendment.

11. On August 2, 2010, petitioner filed: (1) a petition under 37 CFR 1.182 for entry of the accompanying supplement to the petition under 37 CFR 1.292 filed on July 20, 2010; (2) a supplement to the petition under 37 CFR 1.292 filed on July 20, 2010, accompanied by new evidence including affidavits; and (3) certificates of service under 37 CFR 1.248 that a copy of the petitions and all accompanying papers have been served on the patent owner.

12. On September 28, 2010, a decision dismissing the petitions under 37 CFR 1.182 and 1.292 filed July 20, 2010 and August 2, 2010 was mailed.

13. On October 12, 2010, petitioner filed a second petition under 37 CFR 1.182, accompanied by the $400.00 petition fee, and a second petition under 37 CFR 1.292. The petitions included certificates of service under 37 CFR 1.248.

14. Additional proposed amendments were filed on October 13, 2010, and November 12, 2010.

15. On January 28, 2011, a decision granting the petition under 37 CFR 1.182 filed on October 12, 2010 was mailed.

16. On July 8, 2011, a notice regarding the petition to institute public use proceedings was mailed informing the parties of the examiner's conclusion that a *prima facie* showing had been made and setting a preliminary hearing for August 11, 2011.

17. On August 11, 2011, a preliminary hearing was held.

18. On August 25, 2011, applicant filed papers entitled "Admission of Applicant" and "Submission by Reissue Applicant Regarding Preliminary Hearing on Whether to Institute a Public Use Proceeding", with exhibits. Petitioner filed a paper entitled "Summary of August 11, 2011 Preliminary Hearing for the Institution of Public Use Proceedings" with exhibits.

DISCUSSION

At the preliminary hearing on August 11, 2011, and in the written arguments filed August 25, 2011, applicant made several arguments as to why a public use proceeding should not be instituted. Applicant's arguments have been considered, but have not been found persuasive.

Applicant's first, second, and third reasons to deny institution of a public use proceeding relate to the timeliness of the petition. In sum, applicant argues that the reissue application has had a thorough examination on the merits, the petition was belatedly filed without sufficient cause, and petitioner has engaged in piecemeal prosecution. Petitioner filed a petition under 37 CFR 1.182 on October 12, 2010, and provided sufficient reasons for the delay in presenting the evidence. Accordingly, the 37 CFR 1.182 petition was granted in a decision mailed on January 28, 2011. Thereafter, the examiner made a determination that a *prima facie* case of public use or sale has been established by the petition under 37 CFR 1.292. It would not be appropriate to now disregard what appears to be highly pertinent factual evidence and withdraw the previous decision granting the 37 CFR 1.182 petition. Applicant has not provided sufficient reasons that would warrant doing so, particularly at this late stage.

Regarding applicant's argument that the reissue applicant has not been accorded fundamental and substantive due process required by the Administrative Procedures Act, this is simply not the case. Applicant argues that he has not been permitted to present substantive arguments to traverse the examiner's determination that a *prima facie* case of unpatentability based on public use or sale exists. It is important to note that the examiner has not yet made any rejections in this application based on public use or sale. MPEP § 720.02 states, in part, that "[a] *prima facie* is established by the petition if the examiner finds that the facts asserted in the affidavit(s) or declaration(s), as supported by the exhibits, if later proved true by testimony taken in the public use proceeding, would result in a statutory bar to the claims under 35 U.S.C. 102(b) alone or in combination under 35 U.S.C. 103." Furthermore, MPEP § 720.04 states, in part, that "[t]he fact that the affidavits or declarations and exhibits presented with the petition...have been held to make out a *prima facie* case does not mean that the statutory bar has been conclusively

established." The statutory bar can only be established after the taking of testimony in the public use proceeding. If, after the conclusion of the public use proceedings, a rejection is ultimately made, applicant will have the ability to traverse any such rejection made by the examiner in the same manner as in any other application. See MPEP § 720.05.

In addition, applicant argues that the Director should appoint a representative other than the examiner to review the examiner's determination that a *prima facie* showing has been established after the applicant has an opportunity to formally traverse the determination. Applicant requests that the Director require the examiner and the Director's representative to conduct a personal interview with the applicant, prior to deciding whether to institute a public use proceeding, to address the merits of whether or not a public use and/or on sale bar exists regarding applicant's claims. However, having a personal interview with the applicant at this point in time would be clearly inconsistent with the well-established procedure set forth in MPEP §§ 720-720.05 for public use proceedings. As noted above, applicant will have the ability to traverse any rejection that might be made after the conclusion of the public use proceedings. Furthermore, the examiner's determination appears to be reasonable and supported by the evidence, and the examiner's report was also signed by the Technology Center Director. Applicant has not provided any reasons why it is necessary for someone else to substantively review the primary examiner's determination at this point in time.

Lastly, applicant argues that the rules of practice governing proceedings in contested cases are contradictory and need to be amended before a public use proceeding can be instituted. Applicant argues that contested cases must be conducted by a member of the Board of Patent Appeals and Interferences. However, a public use proceeding is not a contested case under 37 CFR 41.100 et seq. A contested case is defined in 37 CFR 41.2 as "a Board proceeding other than an appeal under 35 U.S.C. 134 or a petition under § 41.3. An appeal in an *inter partes* reexamination is not a contested case." MPEP § 720.04 merely states that "[t]he procedure for taking testimony is similar to that for taking testimony in an interference." Furthermore, 37 CFR 1.292 provides for the Director to designate an appropriate official to conduct the public use proceeding and MPEP § 720.04 provides for the examiner to conduct the proceeding. Thus, there is no contradiction between the rules and the MPEP.

Applicant's admission regarding certain exhibits is acknowledged. However, applicant has not admitted that all the exhibits that relate to the subject matter petitioner alleges to be in public use or on sale is prior art. For example, applicant has not admitted that the M15 Rifle is prior art. The examiner has found that a *prima facie* showing of public use or sale has been established with respect to certain pending claims based on the M15 Rifle alone or in combination with other references. Thus, issues remain as to what was on sale or in public use and when, which it is appropriate to resolve in a public use proceeding.

Applicant requests that the examiner be required to make a new determination of whether a *prima facie* case of public use and/or sale exists with respect to the claims based on the prior art of record along with the admitted prior art shown in Exhibits B-G. The examiner has already concluded that a *prima facie* showing of public use or sale has been established by the petition. It appears that nothing would be gained by having the examiner review the same evidence again

to determine whether a *prima facie* showing has been made. It would only further delay prosecution of this application.

The showing made in the petition filed October 12, 2010, is sufficient to justify the institution of public use proceedings. A public use proceeding is the proper forum for resolving the public use or on sale issues raised in this application. As set forth in MPEP § 720.04, testimony in all public use proceedings will be limited to the issues of public use or on sale, i.e., facts establishing what was in "public use or on sale" and facts establishing when and where the "public use or sale" occurred. The application is accordingly referred to the Examiner of Technology Center Art Unit 3641 who will set a schedule of times for taking testimony and conduct the proceedings. See MPEP §§ 720.04 and 720.05. This should be done within ONE MONTH of the date of this decision. Prosecution in this application is otherwise suspended.

It is noted that the amendment filed July 21, 2010, overcame the rejections made in the final rejection mailed May 13, 2010, as is evident from the prosecution history, and thus tolled the time period that was running from the final rejection. Another Office action will be issued by the examiner in due course after conclusion of the public use proceedings.

CONCLUSION

1. The petition under 37 CFR 1.292 filed on October 12, 2010 is granted.

2. Telephone inquiries with respect to this matter should be directed to the undersigned at (571) 272-7727.

Eugenia A. Jones

Eugenia A. Jones
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Associate Commissioner
for Patent Examination Policy

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,357	12/01/2006	6694660	20020/10093	8443

29370 7590 02/14/2012

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 02/14/2012

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

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FEB 14 2012

CENTRAL REEXAMINATION

Keith R. Jarosik
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150 S. Wacker Drive, Suite 2100
Chicago, Illinois 60606

In re Reissue Application of :
Robert Bruce Davies :
Application No. 11/361,036 : DECISION DISMISSING REQUEST
Filed: February 23, 2006 : FOR RECONSIDERATION
For: U.S. Patent No. 6,694,660 :
:
In re Robert Bruce Davies :
Ex Parte Reexamination Proceeding :
Control No: 90/008,357 :
Filed: December 1, 2006 :
For: U.S. Patent No. 6,694,660 :

This is a decision on the request for reconsideration filed January 5, 2012, requesting reconsideration of the decision granting the petition under 37 CFR 1.292, to institute public use proceedings against the claims of the above-identified merged proceeding.

The request for reconsideration filed January 5, 2012, is granted to the extent that reconsideration has been given, but dismissed to the extent that the request for withdrawal of the decision is dismissed.

BACKGROUND

On December 19, 2011[1], a decision granting the petition under 37 CFR 1.292 was mailed.

On January 5, 2012, applicant filed the instant request for reconsideration, and a paper titled "Contingent Petition To the Director of Decision Granting Petition Under 37 CFR § 1.292."

On January 6, 2012, the examiner mailed a letter setting a schedule of times for taking testimony and for filing and serving copies of records and briefs.

On January 11, 2012, applicant filed a "Request To Stay Schedule For Testimony & For Filing And Serving Copies Of Record And Briefs."

DISCUSSION

Applicant argues that the decision granting the petition for public use proceedings mailed December 19, 2011, is improper and denies the applicant fundamental and substantive due process, and requests that the decision be withdrawn. Applicant's arguments have been considered, but have not been found persuasive. Contrary to applicant's assertion, applicant has not been denied fundamental or substantive due process. Accordingly, the decision mailed December 19, 2011, will not be withdrawn.

Applicant alleges that the decision fails to identify any evidence that has been established as prior art relied upon by the primary examiner in "his June 29, 2011 Decision Regarding Petition to Institute Public Use Proceeding," stating that it must be prior art only to the extent that it has been in public use or on sale more than one year prior to the filing date of U.S. Patent No. 6,694,660.

The "June 29, 2011 Decision" is the Examiner's Report mailed as an attachment to the notice regarding preliminary hearing mailed on July 8, 2011. Initially, it is pointed out that the purpose of the Examiner's Report is for the examiner to state the examiner's findings as to whether a *prima facie* showing has been established by the petition (taking the allegations as true) in order for the Office of Patent Legal Administration staff member to determine the appropriate next step (e.g., dismissal of the petition or scheduling of a preliminary hearing). The examiner does not need to identify and explain all possible rejections that could be made if the allegations in the petition were later proved true in a public use proceeding. The examiner only needs to compare at least one claim with what is alleged to be in public use or on sale. See MPEP § 720.02. As stated in the previous decision, the examiner has not yet made any rejections in this application based on public use or sale. As pointed out in the previous decision, MPEP § 720.02 states, in part, that "[a] *prima facie* case is established by the petition if the examiner finds that the facts asserted in the affidavit(s) or declaration(s), as supported by the exhibits, if later proved true by

[1] The decision was mailed on December 19, 2011, although notification of the decision was also sent electronically on December 21, 2011, since the reissue applicant is a participant in the e-Office action program.

testimony taken in the public use proceeding, would result in a statutory bar to the claims under 35 U.S.C. 102(b) alone or in combination under 35 U.S.C. 103." (Emphasis added.) Furthermore, MPEP § 720.04 states, in part, that "[t]he fact that the affidavits or declarations and exhibits presented with the petition...have been held to make out a *prima facie* case does not mean that the statutory bar has been conclusively established." As pointed out in the previous decision, the statutory bar can only be established after the taking of testimony in the public use proceeding. Accordingly, at this point, nothing has been established as prior art based on public use or sale. Furthermore, if, after the conclusion of the public use proceedings, a rejection is ultimately made, applicant will have the ability to traverse any such rejection made by the examiner in the same manner as in any other application. See MPEP § 720.05. Thus, there has been no denial of due process.

Applicant also alleges that the decision mailed December 19, 2011, fails to specify what evidence petitioner will be permitted to introduce during the public use proceeding "that has not already been shown to be prior art by means other than it being in public use or on sale."

The previous decision pointed out that testimony is limited to the issues of public use or sale, citing MPEP § 720.04. Testimony will only be received on what petitioner has alleged in the petition to be in public use or on sale. This is the case for any public use proceeding. Thus, no testimony will be taken on references that have been established as prior art on the basis of something other than public use or on sale. There is no need for the petition decision to specify what the petitioner has alleged is in public use or on sale. Applicant's argument is unclear since it is not known if applicant is referring to applicant's admission of prior art, the references that are issued U.S. patents that the examiner relied on in his finding that a *prima facie* showing had been established by the petition, or something else. Applicant's admission of prior art and the secondary references are discussed below in connection with applicant's other arguments. It is noted here, however, that petitioner may introduce evidence regarding the EU0067 Handguard Assembly in the public use proceeding even though there has been a partial admission with respect to the EU0067 Handguard Assembly. Additionally, if applicant believes that there is anything else in the petition that has been established as prior art on the basis of something other than public use or sale, then applicant should state this in an admission.

In addition, applicant alleges that, in the "June 29, 2011 Decision" by the primary examiner (the Examiner's Report), the examiner's proposed prior art rejections under 35 USC 102(b) are based on three separate references[2], and the proposed rejections under 35 USC 103(a) use one of those three primary references and secondary references that are issued U.S. Patents, but the petition decision mailed December 19, 2011, fails to identify which of these references need to qualify as prior art based solely on their being in public use or on sale for more than one year prior to the filing date of U.S. Patent No. 6,694,660. Thus, applicant alleges that the petition decision fails to identify with specificity which of the references need to be proven as being "in public use" or "on sale" prior art.

[2] Namely, (1) the EU0067 Handguard Assembly; (2) the M15 Rifle; or (3) the Dutch AR-1 Rifle, as evidenced by the Dutch AR-10 Parts List or the AR-10 Manual.

It is what petitioner has alleged in the petition to be in public use or on sale that would need to be proven as being "in public use" or "on sale." The secondary references that are issued U.S. patents do not need to be proven as being "in public use" or "on sale." Thus, it is the "primary references" that petitioner has alleged were in public use or on sale that will need to be proven as prior art based on being in public use or on sale more than one year prior to the filing date of U.S. Patent No. 6,694,660.

Next, applicant asserts that with respect to the EU0067 Handguard Assembly, applicant Davies admitted on the record on August 25, 2011, that the EU0067 Handguard Assembly, as evidenced by petitioner's Exhibits A1-A6, were publicly available and/or on sale before March 25, 2011, and are prior art under 35 USC 102(b) to U.S. Patent No. 6,694,660.

Applicant's admission with respect to the EU0067 Handguard Assembly in the "Admission of Applicant" filed August 25, 2011, as evidenced by petitioner's Exhibits A1-A6, is acknowledged. However, as explained in the previous petition decision, the "Admission of Applicant" is not sufficient to eliminate the need for a public use proceeding since petitioner has made other allegations of public use or sale in the petition that applicant has not admitted to as being prior art. Thus, as pointed out in the previous petition decision, issues remain as to what was in public use or on sale, which is precisely what a public use proceeding is intended to resolve. A public use proceeding will bring the needed resolution to these issues. In fact, absent a clear admission by the applicant, there is no other way to resolve these issues in the application. Withdrawing the petition decision, as applicant requests, would not resolve these issues.

With respect to the M15 Rifle and the Dutch AR-1 Rifle, applicant alleges in the request for reconsideration to have "never denied that certain embodiments" of the rifles are available as prior art under 35 USC 102(b) to U.S. Patent No. 6,694,660. Applicant further alleges to have "not denied" that the M15 Rifle is prior art to U.S. Patent No. 6,694,660 and admits that "certain versions" of the M15 Rifle and the Dutch AR-1 rifle are prior art to U.S. Patent No. 6,694,660.

The "Admission of Applicant" filed August 25, 2011, identified to the Office what documents applicant admitted to be prior art. Anything that was not identified in the "Admission of Applicant" as being admitted prior art could not be taken as admitted prior art. A review of petitioner's paper titled "Summary of the August 11, 2011, Preliminary Hearing For The Institution of Public Use Proceedings," filed August 25, 2011, shows that applicant was given the opportunity to provide an admission to what petitioner has alleged was in public use or on sale, which would have eliminated the need for a public use proceeding. However, applicant did not make such an admission. Instead, the "Admission of Applicant" was limited to the EU0067 Handguard Assembly, to the extent illustrated in Exhibit B attached to the admission (petitioner's exhibits A1-A6), and "Technical Note 9", attached as Exhibit G to the admission. Some statements were also made in the "Admission of Applicant" with respect to the Handguard Assembly EU0073, but those statements fell short of an admission of prior art with respect to the Handguard Assembly EU0073. Thus, it is unclear how the "Admission of Applicant" was somehow supposed to be construed by the Office as an admission of prior art with respect to the M15 Rifle or the Dutch AR-1 Rifle when the admission was silent with respect to the M15 Rifle and the Dutch AR-1 Rifle. While applicant now alleges in the request for reconsideration to

have "never denied" that "certain versions" of the rifles are prior art to U.S. Patent No. 6,694,660, these ambiguous statements as to "certain embodiments" or "certain versions" of the rifles cannot be taken as an admission of prior art. Any admission of prior art must be clear and unambiguous.

Finally, applicant asserts that the failure to withdraw the decision will subject the applicant to harassment, delay and increased expense in arguing with petitioner what evidence will be proper to be relied upon by the examiner.

As pointed out previously, testimony in all public use proceedings will be limited to the issues of public use or on sale, i.e., facts establishing what was in "public use or on sale" and facts establishing when and where the "public use or sale" occurred. No testimony will be taken on whether the claimed subject matter would have been obvious over subject matter asserted to be in public use or on sale. See MPEP § 720.04. The public use proceeding is to give applicant an opportunity to cross-examine the petitioner's affiants and present rebuttal evidence, and for the Office to thoroughly investigate the public use or on sale allegations and make a determination as to whether or not a statutory bar has been established based on public use or sale. The Office encourages the parties to reach an agreement as to the issues of public use or sale in order to eliminate any delay and expense that may result from a public use proceeding, but, if they cannot do so, the public use proceeding needs to go forward so the issues can be resolved.

CONCLUSION

1. The request for reconsideration filed on January 5, 2012, is granted to the extent that reconsideration has been given, but dismissed to the extent that the request for withdrawal of the decision is dismissed.

2. Telephone inquiries with respect to this matter should be directed to the undersigned at (571) 272-7727.

Eugenia A. Jones
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Associate Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,357	12/01/2006	6694660	20020/10093	8443

29370 7590 02/15/2012

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 02/15/2012

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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Date:
MAILED
FEB 15 2012
CENTRAL REEXAMINATION

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008357
PATENT NO. : 6694660
ART UNIT : 3993

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

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

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MAILED
FEB 15 2012
CENTRAL REEXAMINATIO

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In re Reissue Application of :
Robert Bruce Davies :
Application No. 11/361,036 : DECISION DISMISSING PETITION
Filed: February 23, 2006 : UNDER 37 CFR 1.181
For: U.S. Patent No. 6,694,660 : AND
: DISMISSING REQUEST
In re Robert Bruce Davies : TO STAY
Ex Parte Reexamination Proceeding :
Control No: 90/008,357 :
Filed: December 1, 2006 :
For: U.S. Patent No. 6,694,660 :

This is a decision on the "Contingent Petition To the Director of Decision Granting Petition Under 37 CFR § 1.292" filed January 5, 2012, requesting supervisory review under 37 CFR 1.181 of the decision granting the petition under 37 CFR 1.292, to institute public use proceedings against the claims of the above-identified merged proceeding. The "Contingent Petition" is being treated as a petition under 37 CFR 1.181.

The petition under 37 CFR 1.181 filed January 5, 2012, is granted to the extent that supervisory review has been given, but dismissed to the extent that the request for reversal of the decision is dismissed.

In view of the dismissal of the request for reconsideration and the dismissal of the petition under 37 CFR 1.181, the request to stay filed January 11, 2012, is dismissed.

BACKGROUND

On December 19, 2011, a decision granting the petition under 37 CFR 1.292 was mailed.

On January 5, 2012, applicant filed a request for reconsideration, and the instant petition titled "Contingent Petition To the Director of Decision Granting Petition Under 37 CFR § 1.292." The request for reconsideration has been dismissed in a separate decision.

On January 6, 2012, the examiner mailed a letter setting a schedule of times for taking testimony and for filing and serving copies of records and briefs.

On January 11, 2012, applicant filed a "Request To Stay Schedule For Testimony & For Filing And Serving Copies Of Record And Briefs," which is also being treated in this decision.

DISCUSSION

Applicant argues that the decision granting the petition for public use proceedings mailed December 19, 2011, constitutes both clear error and an abuse of discretion. Applicant's arguments have been considered, but have not been found persuasive. Contrary to applicant's assertion, the decision mailed December 19, 2011, does not constitute clear error or an abuse of discretion. Applicant alleges that the December 19, 2011 decision is both clear error and an abuse of discretion for (1) the reasons presented in the request for reconsideration, and (2) the additional reasons presented in the petition under 37 CFR 1.181.

Reasons in the Request for Reconsideration

Applicant alleges that the December 19, 2011 decision was both clear error and an abuse of discretion for the reasons presented in the request for reconsideration filed on January 5, 2012. Applicant incorporates by reference the reasons presented in the request for reconsideration. The request for reconsideration and the decision dismissing the request for reconsideration have been reviewed. The reasons in the request for reconsideration do not support a finding of clear error or an abuse of discretion. The reasons presented in the request for reconsideration, and the responses in the decision dismissing the request for reconsideration, are briefly summarized below. A more detailed response to applicant's arguments was provided in the decision dismissing the request for reconsideration.

In the request for reconsideration, applicant alleged that the decision fails to identify any evidence that has been established as prior art relied upon by the primary examiner in "his June 29, 2011 Decision Regarding Petition to Institute Public Use Proceeding." The decision on the request for reconsideration stated that the examiner has not yet made any rejections in this application based on public use or sale and cited MPEP § 720.02 and 720.04. Thus, the decision concluded that, at this point, nothing has been established as prior art based on public use or sale.

In the request for reconsideration, applicant also alleged that the decision mailed December 19, 2011, failed to specify what evidence petitioner will be permitted to introduce during the public use proceeding "that has not already been shown to be prior art by means other than it being in public use or on sale." The decision on the request for reconsideration reiterated that testimony is limited to the issues of public use or sale (MPEP § 720.04) and that testimony will only be received on what petitioner has alleged in the petition to be in public use or on sale, which is the case for any public use proceeding. The decision stated that no testimony will be taken on references that have been established as prior art on the basis of something other than public use or on sale. Applicant was advised that if applicant believes that there is anything else in the petition that has been established as prior art on the basis of something other than public use or sale, then applicant should state this in an admission.

In the request for reconsideration, applicant alleged that, in the "June 29, 2011 Decision" by the primary examiner (the Examiner's Report), the examiner's proposed prior art rejections under 35 USC 102(b) are based on three separate references[1], and the proposed rejections under 35 USC 103(a) use one of those three primary references and secondary references that are issued U.S. Patents, but the petition decision mailed December 19, 2011, fails to identify which of these references need to qualify as prior art based solely on their being in public use or on sale for more than one year prior to the filing date of U.S. Patent No. 6,694,660. The request for reconsideration explained that it is what petitioner has alleged in the petition to be in public use or on sale that would need to be proven as being "in public use" or "on sale" and that secondary references that are issued U.S. patents do not need to be proven as being "in public use" or "on sale."

In the request for reconsideration, applicant asserted that with respect to the EU0067 Handguard Assembly, applicant Davies admitted on the record on August 25, 2011, that the EU0067 Handguard Assembly, as evidenced by petitioner's Exhibits A1-A6, were publicly available and/or on sale before March 25, 2011, and are prior art under 35 USC 102(b) to U.S. Patent No. 6,694,660. The request for reconsideration again reiterated that the "Admission of Applicant" is not sufficient to eliminate the need for a public use proceeding since petitioner has made other allegations of public use or sale in the petition that applicant has not admitted to as being prior art and thus, issues remain as to what was in public use or on sale, which is precisely what a public use proceeding is intended to resolve.

In the request for reconsideration, applicant alleged that, with respect to the M15 Rifle and the Dutch AR-1 Rifle, to have "never denied that certain embodiments" of the rifles are available as prior art under 35 USC 102(b) to U.S. Patent No. 6,694,660. Applicant further alleged to have "not denied" that the M15 Rifle is prior art to U.S. Patent No. 6,694,660 and admits that "certain versions" of the M15 Rifle and the Dutch AR-1 rifle are prior art to U.S. Patent No. 6,694,660. The decision dismissing the request for reconsideration explained that anything that was not identified in the "Admission of Applicant" as being admitted prior art could not be taken as admitted prior art and pointed out that the "Admission of Applicant" was limited to the EU0067 Handguard Assembly, to the extent illustrated in Exhibit B attached to the admission

[1] Namely, (1) the EU0067 Handguard Assembly; (2) the M15 Rifle; or (3) the Dutch AR-1 Rifle, as evidenced by the Dutch AR-10 Parts List or the AR-10 Manual.

(petitioner's exhibits A1-A6), and "Technical Note 9", attached as Exhibit G to the admission. Thus, those statements could not be construed by the Office as an admission of prior art with respect to the M15 Rifle or the Dutch AR-1 Rifle since the admission was silent with respect to the M15 Rifle and the Dutch AR-1 Rifle. Furthermore, the allegations in the request for reconsideration in which applicant alleged to have "never denied" that "certain versions" of the rifles are prior art to U.S. Patent No. 6,694,660 cannot be taken as an admission of prior art since any admission of prior art must be clear and unambiguous.

In the request for reconsideration, applicant asserted that the failure to withdraw the decision will subject the applicant to harassment, delay and increased expense in arguing with petitioner what evidence will be proper to be relied upon by the examiner. The decision dismissing the request for reconsideration again pointed out that testimony in all public use proceedings will be limited to the issues of public use or on sale, i.e., facts establishing what was in "public use or on sale" and facts establishing when and where the "public use or sale" occurred. It was also pointed out that the public use proceeding is to give applicant an opportunity to cross-examine the petitioner's affiants and present rebuttal evidence, and for the Office to thoroughly investigate the public use or on sale allegations and make a determination as to whether or not a statutory bar has been established based on public use or sale.

Thus, the reasons set forth in the request for reconsideration do not show any clear error or abuse of discretion on the part of the Office.

Additional Reasons in the Petition under 37 CFR 1.181

Applicant also alleges that the December 19, 2011 decision was both clear error and an abuse of discretion for the additional reasons presented in the petition under 37 CFR 1.181. It is noted that these additional reasons are the same reasons that applicant made in the "Submission by Reissue Applicant Regarding Preliminary Hearing" filed August 25, 2011, which were addressed in the petition decision mailed December 19, 2011, along with additional arguments being made to address the responses that were included in the December 19, 2011 decision. This decision reiterates applicant's previous arguments and the Office's responses thereto, and addresses applicant's additional arguments made in the petition under 37 CFR 1.181.

Applicant's first reason to not institute a public use proceeding is because "(1) this reissue application has had a thorough examination on the merits; (2) a number of the pending claims have been allowed; and (3) only allowed claims remain in the reissue application." Applicant's second reason is that "the petition to institute public use proceedings was belatedly filed without sufficient cause presented to justify the belatedness in filing the petition." Applicant's third reason is that "the institution of a public use proceeding...is a prime example of piecemeal prosecution that the USPTO has consistently refused to permit and those refusals have been consistently approved by the federal courts."

These three reasons to deny institution of a public use proceeding all relate to the timeliness of the petition. The December 19, 2011 decision responded to these reasons by pointing out that the petitioner filed a petition under 37 CFR 1.182 on October 12, 2010, and provided sufficient reasons for the delay in presenting the evidence; the 37 CFR 1.182 petition was granted in a

decision mailed on January 28, 2011; and the examiner made a determination that a *prima facie* case of public use or sale has been established by the petition under 37 CFR 1.292. The December 19, 2011 decision concluded that it would not be appropriate to disregard what appears to be highly pertinent factual evidence and withdraw the previous decision granting the 37 CFR 1.182 petition, and that applicant has not provided sufficient reasons that would warrant doing so. Furthermore, a notice of allowance has not been mailed in this application. Thus, the 37 CFR 1.292 petition was timely filed.

In the 37 CFR 1.181 petition, applicant alleges that the December 19, 2011 decision "(1) never explains what the allegedly highly pertinent evidence is and (2) never explains why that evidence is not available as prior art to reissue applicant other than as 'public use bar' or 'on sale bar' evidence; and (3) continues to engage in 'piecemeal prosecution' of this Reissue Application." It is clear that the highly pertinent evidence referred to in the December 19, 2011 decision is the public use or on sale evidence that the examiner concluded in the Examiner's Report established a *prima facie* case. Furthermore, the decision dismissing the request for reconsideration reiterated that testimony is limited to the issues of public use or sale (MPEP § 720.04), that testimony will only be received on what petitioner has alleged in the petition to be in public use or on sale, which is the case for any public use proceeding, and also advised the applicant that if applicant believes that there is anything else in the petition that has been established as prior art on the basis of something other than public use or sale, then applicant should state this in an admission. In addition, applicant's argument with respect to "piecemeal prosecution" is not well-taken. The December 19, 2011 decision is not "impermissible 'piecemeal' prosecution" as alleged by applicant. The decision treated the petition under 37 CFR 1.292 in accordance with the well-established procedures set forth in the MPEP for handling such petition, as the Office was required to do. It is not understood how treatment of a petition in accordance with Office rules and procedures is somehow prohibited by the policy against "piecemeal examination" or "piecemeal prosecution." The fact that the decision did not result in conclusion of the prosecution of this application, or the outcome that applicant may have liked, does not make it "impermissible 'piecemeal' prosecution."

In the 37 CFR 1.181 petition, applicant also alleges that the decision did not address the issue of "piecemeal prosecution" and that this constitutes "a tacit admission that this ground to deny institution of a public use proceeding is proper" and it also constitutes "a complete failure to comply with the Office's duty to address the substance of reissue applicant's arguments." Contrary to applicant's argument, the December 19, 2011 decision did address applicant's argument regarding "piecemeal prosecution." The decision explained that this argument about "piecemeal prosecution" was an argument about the timeliness of the petition and thus the decision addressed this argument together with applicant's other arguments that also related to the timeliness of the petition. The decision pointed out the 37 CFR 1.182 petition was granted in the decision mailed January 28, 2011. The decision granting the 37 CFR 1.182 petition concluded that petitioner's arguments for presenting the evidence in this merged proceeding more than 2 months after the announcement of the filing of the reissue application in the *Official Gazette* were sufficient and discussed why. Applicant did not provide sufficient reasons in the written arguments filed August 25, 2011, for reversing the decision granting the 37 CFR 1.182 petition. This was particularly the case due to the fact that the examiner had already found that a *prima facie* showing had been established by the 37 CFR 1.292 petition. Furthermore, it is noted

that MPEP § 707.07(g) states that "[p]iecemeal examination should be avoided as much as possible." There is no policy that prohibits an examiner from considering references or other evidence in an application that could render one or more claims unpatentable simply because the applicant has already received one or more Office actions in the application. Applicant's argument regarding "piecemeal prosecution" is simply not a basis for not considering relevant evidence (i.e., the public use or on sale evidence).

In the 37 CFR 1.181, applicant next alleges that the reissue applicant has not been accorded fundamental and substantive due process required by the Administrative Procedures Act. The December 19, 2011 decision stated that this was not the case. The decision stated that applicant argues that he has not been permitted to present substantive arguments to traverse the examiner's determination that a *prima facie* case of unpatentability based on public use or sale exists; noted that the examiner has not yet made any rejections in this application based on public use or sale; cited MPEP § 720.02, which states, in part, that "[a] *prima facie* is established by the petition if the examiner finds that the facts asserted in the affidavit(s) or declaration(s), as supported by the exhibits, if later proved true by testimony taken in the public use proceeding, would result in a statutory bar to the claims under 35 U.S.C. 102(b) alone or in combination under 35 U.S.C. 103;" cited MPEP § 720.04 states, in part, that "[t]he fact that the affidavits or declarations and exhibits presented with the petition...have been held to make out a *prima facie* case does not mean that the statutory bar has been conclusively established;" and stated that the statutory bar can only be established after the taking of testimony in the public use proceeding. The decision also pointed out that, if, after the conclusion of the public use proceedings, a rejection is ultimately made, applicant will have the ability to traverse any such rejection made by the examiner in the same manner as in any other application. See MPEP § 720.05.

In the 37 CFR 1.181 petition, applicant states that the arguments in the decision "completely overlook the fact that there is no final review of an Examiner's decision in the Public Use Proceeding...which means that Reissue Applicant has to endure the expense of another protracted inter partes proceeding within the Office without being able to present any meaningful input to the Examiner concerning the merit (or lack thereof) of a rejection." This is not the time for discussing the merits of a rejection since no rejection has yet been made in this application based on public use or sale. While there is no final review of the examiner's decision in the public use proceeding, there is review of any rejection that might ultimately be made by the examiner based on the public use or sale evidence, which review is the same as in any other application. It appears that applicant misunderstands the purpose of a public use proceeding. A public use proceeding is to give applicant an opportunity to cross-examine the petitioner's affiants and present rebuttal evidence, and for the Office to thoroughly investigate the public use or on sale allegations and make a determination as to whether or not a statutory bar has been established based on public use or sale. Furthermore, testimony in all public use proceedings will be limited to the issues of public use or on sale, i.e., facts establishing what was in "public use or on sale" and facts establishing when and where the "public use or sale" occurred.

In the 37 CFR 1.181 petition, applicant alleges that the Director should appoint a representative other than the examiner to review the examiner's determination that a *prima facie* showing has been established after the applicant has an opportunity to formally traverse the determination, and requests that the Director require the examiner and the Director's representative to conduct a

personal interview with the applicant, prior to deciding whether to institute a public use proceeding, to address the merits of whether or not a public use and/or on sale bar exists regarding applicant's claims. In the December 19, 2011 decision, it was stated that having a personal interview with the applicant at this point in time would be clearly inconsistent with the well-established procedure set forth in MPEP §§ 720-720.05 for public use proceedings; that applicant will have the ability to traverse any rejection that might be made after the conclusion of the public use proceedings; that the examiner's determination appears to be reasonable and supported by the evidence, and the examiner's report was also signed by the Technology Center Director; and that applicant has not provided any reasons why it is necessary for someone else to substantively review the primary examiner's determination at this point in time.

In the 37 CFR 1.181 petition, applicant argues that the decision merely addresses this issue in terms of inconsistency with the MPEP, and fails to address applicant's argument that there is precedent for the Director to have an independent review "which means that the Director acknowledges that an Applicant should have an opportunity to have an independent review of the Primary Examiner's decision by the Director take place before a public use proceeding is instituted." No such acknowledgement was made in the December 19, 2011 decision. The precedent cited by applicant, Svenson v. Coe, 39 USPQ 532 (D.C. Cir. 1938), held that the decision to hold or not hold public use proceedings is within the discretion of the Commissioner of Patents. It did not hold that an applicant is entitled to an independent review of the examiner's conclusion that *a prima facie* showing has been established by the petition. In addition, as explained in the December 19, 2011 decision, the examiner's report was reviewed to the extent that it appeared to be supported by the evidence, and it was signed by the Technology Center Director. Accordingly, an independent review of the examiner's conclusion that a *prima facie* showing has been established, before a public use proceeding is instituted, is not warranted.

In the 37 CFR 1.181 petition, applicant argues that the rules of practice governing proceedings in contested cases are contradictory and need to be amended before a public use proceeding can be instituted. Applicant argues that contested cases must be conducted by a member of the Board of Patent Appeals and Interferences. The December 19, 2011 decision stated that a public use proceeding is not a contested case under 37 CFR 41.100 et seq; a contested case is defined in 37 CFR 41.2 as "a Board proceeding other than an appeal under 35 U.S.C. 134 or a petition under § 41.3. An appeal in an *inter partes* reexamination is not a contested case;" cited MPEP § 720.04 which merely states that "[t]he procedure for taking testimony is similar to that for taking testimony in an interference;" pointed out that 37 CFR 1.292 provides for the Director to designate an appropriate official to conduct the public use proceeding and MPEP § 720.04 provides for the examiner to conduct the proceeding; and concluded that there is no contradiction between the rules and the MPEP.

In the 37 CFR 1.181 petition, applicant argues that because 37 CFR 41.2 "does not exclude *inter partes* public use proceedings from being contested cases but does exclude *inter partes* reexamination proceedings from contested cases...it is clear that *inter partes* public use proceedings, because they involve the Rules of Practice governing trial testimony, are considered contested cases." Contrary to applicant's argument, it is clear from 37 CFR 41.2 that an appeal in an *inter partes* reexamination proceeding is just an example of what is not a contested case. The rule is in no way limited to the exclusion of appeals in *inter partes* reexamination

proceedings from contested cases. Instead, the rule illustrates that that just because two parties are involved does not make it a contested case. Public use proceedings are extremely rare so it is not surprising that it was not specifically listed in 37 CFR 41.2 as something that is not a contested case. A public use proceeding is not a Board proceeding.

The Request to Stay

In view of the dismissal of the request for reconsideration and the dismissal of the petition under 37 CFR 1.181, the request to stay filed January 11, 2012, is dismissed. There is no basis for staying the schedule for testimony and for filing and serving copies of record and briefs. There is no change in terms of what petitioner is permitted to rely on.

CONCLUSION

1. The petition under 37 CFR 1.181 filed on January 5, 2012, is granted to the extent that supervisory review has been given, but dismissed to the extent that the request for reversal of the decision is dismissed.

2. The request for stay filed January 11, 2012, is dismissed.

3. Telephone inquiries with respect to this matter should be directed to the undersigned at (571) 272-5047.

Brian E. Hanlon

Brian E. Hanlon
Director
Office of Patent Legal Administration
Office of the Associate Commissioner
for Patent Examination 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
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,357	12/01/2006	6694660	20020/10093	8443

29370 7590 03/07/2012

ROBERT A. PARSONS
4000 N. CENTRAL AVENUE, SUITE 1220
PHOENIX, AZ 85012

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/07/2012

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
HANLEY, FLIGHT & ZIMMERMAN, LLC
150 SOUTH WACKER DRIVE
SUITE 2100
CHICAGO, IL 60606

Date:
MAILED
MAR 07 2012
CENTRAL REEXAMINATION U.

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008357
PATENT NO. : 6694660
ART UNIT : 3993

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

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

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Robert A. Parsons (For Patent Owner)
4000 N. Central Avenue, Suite 1220
Phoenix, Arizona 85012

MAILED

MAR 07 2012

CENTRAL REEXAMINATION U

Keith R. Jarosik
Hanley, Flight & Zimmerman, LLC (For Requester)
USPTO Customer Number 34431
150 S. Wacker Drive, Suite 2100
Chicago, Illinois 60606

Hanley, Flight & Zimmerman, LLC (For Petitioner)
150 S. Wacker Drive, Suite 2100
Chicago, Illinois 60606

In re Reissue Application of Robert Bruce Davies Application No. 11/361,036 Filed: February 23, 2006 For: U.S. Patent No. 6,694,660	DECISION DISMISSING REQUEST TO TERMINATE PUBLIC USE PROCEEDING
In re Robert Bruce Davies *Ex Parte* Reexamination Proceeding Control No: 90/008,357 Filed: December 1, 2006 For: U.S. Patent No. 6,694,660	

This is a decision on the request to terminate public use proceeding filed February 27, 2012.

The request filed February 27, 2012, is dismissed.

Reissue applicant argues that the public use petitioner failed to take any testimony during the testimony period, which expired on February 20, 2012. Reissue applicant argues that any affidavit evidence cannot be relied upon unless it was taken during the testimony period set in the Order dated January 6, 2012. Therefore, reissue applicant requests that the public use proceeding be terminated on its merits with prejudice to the public use petitioner.

February 20, 2012 was a Federal holiday within the District of Columbia. 35 U.S.C. 21(b) and 37 CFR 1.7(a) permit any action due on a Federal holiday to be taken on the next succeeding

business day. See also MPEP 710.05. Thus, public use petitioner's submission filed on February 21, 2012 is considered timely.

Furthermore, as stated in MPEP 720.04, 37 CFR 41.157(a) limits noncompelled direct testimony to affidavits. Petitioner may submit the affidavits that were submitted with the 37 CFR 1.292 petition as part of petitioner's testimony. MPEP 720.04 states, in part, that "[t]he affidavits or declarations are not to be considered part of the testimony and in no case can they be used as evidence on behalf of the party submitting them unless the affidavits or declarations are submitted as part of the petitioner's testimony." (Emphasis added.) Therefore, the public use petitioner's submission including affidavits filed on February 21, 2012 is acceptable as petitioner's testimony.

Telephone inquiries with respect to this matter should be directed to the undersigned at (571) 272-7727.

Eugenia A. Jones

Eugenia A. Jones
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Associate Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,984	03/29/2004	6202051	2043.566UX3	6698

49845 7590 09/28/2010

SCHWEGMAN, LUNDBERG & WOESSNER/EBAY
P.O. BOX 2938
MINNEAPOLIS, MN 55402

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 09/28/2010

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,362	04/03/2007	6,202,051	2043.566UX4	7252

49845 7590 09/28/2010

SCHWEGMAN, LUNDBERG & WOESSNER/EBAY
P.O. BOX 2938
MINNEAPOLIS, MN 55402

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ART UNIT	PAPER NUMBER

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Schwegman, Kundberg & Woessner/EBAY
PO Box 2938
Minneapolis, MN 55402

(Requester, now Patent Owner)

MAILED

SEP 2 8 2010

CENTRAL REEXAMINATION UNIT

In re Woolston
Reexamination Proceeding
Control No. 90/006,984
Filed: March 29, 2004
For: U.S. Patent No. 6,202,051

: DECISION
: ON § 1.182
: PETITIONS

In re Woolston
Reexamination Proceeding
Control No. 90/008,362
Filed: April 3, 2007
For: U.S. Patent No. 6,202,051

The above identified *ex parte* reexamination files are before the Office of Patent Legal Administration (OPLA) for consideration - a petition paper entitled "PETITION UNDER 37 C.F.R. § 1.182" in control number 90/006,984 and a petition paper entitled "PETITION UNDER 37 C.F.R. § 1.182" in control number 90/008,362.

The petitions are dismissed as moot. The petition is granted, however, to the extent that two proceedings will be addressed as a merged proceeding by the Central Reexamination Unit.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,202,051 (hereinafter, the '051 patent), issued to Woolston, on March 13, 2001.

2. On March 29, 2004, a third party filed a request for *ex parte* reexamination of the '051 patent. The reexamination proceeding was assigned Control No. 90/006,984 (hereinafter, the '6984 proceeding).

3. The reexamination request was granted for the '6984 proceeding on April 28, 2004, finding a substantial new question of patentability (SNQ) as to claims 1-52.

4. A Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) was mailed on August 31, 2007 (in the '6984 proceeding), confirming the patentability of claims 13, 33-35, and 52 (claims 1-12, 14-32, and 36-51 were cancelled).

5. On April 3, 2007, a third party requester deposited a Request for *ex parte* Reexamination of the '051 patent. The reexamination proceeding was assigned Control No. 90/008,362 (hereinafter, the '8362 proceeding).

6. The reexamination request was granted for the '8362 proceeding on June 28, 2007, finding a substantial new question of patentability (SNQ) as to claims 13, 33-35, and 52.

7. A NIRC was mailed on August 31, 2007 (in the '8362 proceeding), confirming the patentability of claims 13, 33-35, and 52 (claims 1-12, 14-32, and 36-51 were cancelled).

8. On December 18, 2009, Patent Owner filed a paper entitled "PETITION UNDER 37 C.F.R. §1.182" in the '6984 proceeding with an admission that claims 13 and 33-35 were unpatentable. The paper also included an amendment to claims 13 and 33 (claims 34 and 35 are dependent on claim 33).

9. On February 5, 2010, Patent Owner filed a paper entitled "PETITION UNDER 37 C.F.R. §1.182" in the '8362 proceeding with an admission that claims 13 and 33-35 were unpatentable. The paper also included an amendment to claims 13 and 33 (claims 34 and 35 are dependent on claim 33).

10. On September 28, 2010, the '6984 and '8362 proceedings were merged, the amendments filed on December 18, 2009, in the '6984 proceeding, and filed on February 5, 2010, in the '8362 proceeding, were entered, and an Office action was mailed.

DECISION

In view of the above merger, entry, and treatment of the amendments by the Central Reexamination Unit, the December 18, 2009 petition entitled "PETITION UNDER 37 C.F.R. §1.182" in the '6984 proceeding and the February 5, 2010 petition entitled "PETITION UNDER 37 C.F.R. §1.182" in the '8362 proceeding are dismissed as moot. The petition is granted, however, to the extent that two proceedings will be addressed as a merged proceeding by the Central Reexamination Unit.

CONCLUSION

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

/Kenneth M Schor/

Kenneth M Schor
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

9-28-10
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/006,984	03/29/2004	6202051	2043.566UX3	6698

49845 7590 09/28/2010

SCHWEGMAN, LUNDBERG & WOESSNER/EBAY
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MINNEAPOLIS, MN 55402

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 09/28/2010

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,362	04/03/2007	6,202,051	2043.566UX4	7252

49845 7590 09/28/2010

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(Requester, now Patent Owner)

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CENTRAL REEXAMINATION UNIT

In re Woolston
Reexamination Proceeding
Control No. 90/006,984
Filed: March 29, 2004
For: U.S. Patent No. 6,202,051

: DECISION
: ON § 1.182
: PETITIONS

In re Woolston
Reexamination Proceeding
Control No. 90/008,362
Filed: April 3, 2007
For: U.S. Patent No. 6,202,051

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2. On March 29, 2004, a third party filed a request for *ex parte* reexamination of the '051 patent. The reexamination proceeding was assigned Control No. 90/006,984 (hereinafter, the '6984 proceeding).

3. The reexamination request was granted for the '6984 proceeding on April 28, 2004, finding a substantial new question of patentability (SNQ) as to claims 1-52.

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10. On September 28, 2010, the '6984 and '8362 proceedings were merged, the amendments filed on December 18, 2009, in the '6984 proceeding, and filed on February 5, 2010, in the '8362 proceeding, were entered, and an Office action was mailed.

DECISION

In view of the above merger, entry, and treatment of the amendments by the Central Reexamination Unit, the December 18, 2009 petition entitled "PETITION UNDER 37 C.F.R. §1.182" in the '6984 proceeding and the February 5, 2010 petition entitled "PETITION UNDER 37 C.F.R. §1.182" in the '8362 proceeding are dismissed as moot. The petition is granted, however, to the extent that two proceedings will be addressed as a merged proceeding by the Central Reexamination Unit.

CONCLUSION

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

/Kenneth M Schor/

Kenneth M Schor
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,386	12/21/2006	6504103	RTC-2007-0245	1550

34456 7590 04/19/2011

LARSON NEWMAN, LLP
5914 WEST COURTYARD DRIVE
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AUSTIN, TX 78730

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/19/2011

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Kevin W. Jakel
Kaye Scholer LLP
901 Fifteenth Street NW, Suite 1100
Washington, DC 20005

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/008,386*.

PATENT NO. *6504103*.

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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CENTRAL REEXAMINATION UNIT

LARSON NEWMAN ABEL & POLANSKY, LLP (For Patent Owner)
5914 WEST COURTYARD DRIVE
SUITE 200
AUSTIN TX 78730

Kevin W. Jakel (For Requester)
Kaye Scholer LLP
901 Fifteenth Street, NW, Suite 1000
Washington, DC 20005

In re: Meyer *et alia*
Reexamination Proceeding
Control No. 90/008,386
Request Deposited: December 21, 2006
For: U.S. Patent No. 6,504,103

DECISION
DISMISSING
PETITIONS

The *ex parte* reexamination is before the Central Reexamination Unit for consideration of the petitions filed June 29, 2009 entitled "PETITION UNDER 37 C.F.R. 1.181 TO ENTER AND CONSIDER SUPPLEMENTAL REPLY" [hereinafter, the "CONSIDER SUPPLEMENTAL REPLY petition"] and "PETITION UNDER 37 C.F.R. §1.181 TO REOPEN PROSECUTION" [hereinafter, the "REOPEN PROSECUTION petition"]. The decision also addresses the petition filed February 24, 2010 entitled "PETITION TO STRIKE PORTIONS OF EXAMINER'S ANSWER".

The petitions are **DISMISSED** for the reasons set forth below.

DECISION

As the requested relief in the June 29, 2009 petitions overlap in scope, these petitions will be decided together.

The petitions are directed to the question of whether a reference (i.e. the 1974 Sales Brochure) used in the rejection of claims is a printed publication and, thus, is available as prior art in this reexamination proceeding. Such an argument was put forward in a supplemental response filed on March 4, 2009. The supplemental response of March 4, 2009 was not entered by the examiner in the final rejection of March 25, 2009 (citing 37 CFR 1.111(a)(2)). The supplemental

response was limited to arguments and did not contain any declarations or affidavits for the examiner to consider for entry or non-entry.

Petitioner argues that entry of the supplemental response is permitted under "36 C.F.R. § 1.111(a)(2)(F) [sic, presumably 37 C.F.R. § 1.111(a)(2)(F)]" as argued in the "CONSIDER SUPPLEMENTAL REPLY petition", page 3:

"The USPTO may enter a supplemental reply if the supplemental reply is clearly limited to simplification of issues for appeal. 36 C.F.R. § 1.111(a)(2)(F) [sic, presumably 37 C.F.R. § 1.111(a)(2)(F)]. Because the Sales Brochure does not qualify as a printed publication, issues on appeal are more than simplified by entry of the March Supplement Reply; the issue is entirely dispositive for all rejections, thus completely obviating the need for an appeal."

Petitioner essentially argues that entry of their March 2009 arguments should convince the examiner that the rejection should be withdrawn, thus simplifying the appeal.

37 CFR 1.181 states, in part:

(a) Petition may be taken to the Director:

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

(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.

As the availability of a reference as prior art is squarely related to the merits of the rejection, which is appealable to the Board of Patent Appeals and Interferences, the availability of the 1974 Sales Brochure is not a petitionable item under 37 CFR 1.181.

Furthermore, it is noted that petitioner has appealed the rejection based on the 1974 Sales Brochure and presented the arguments related to the availability of the 1974 Sales Brochure as prior art in the appeal brief.

Accordingly, the "CONSIDER SUPPLEMENTAL REPLY petition" is **dismissed** as improper under 37 CFR 1.181 as the proper forum to question the availability of a reference as prior art is appeal.

Furthermore, the examiner took this action in the non-final office action mailed April 15, 2008. Therefore, the request of June 29, 2009 to review an action taken by the examiner on April 15, 2008 is **dismissed** as untimely.

The "REOPEN PROSECUTION petition" similarly requests that prosecution be reopened to "determine which documents in the present reexamination are actually printed publications". For similar reasons as outlined above, the "REOPEN PROSECUTION petition" is **dismissed** as improper under 37 CFR 1.181 as the proper forum to question the availability of a reference as prior art is appeal and also **dismissed** as untimely as the examiner first took this action on April 15, 2008.

The February 24, 2010 petition requests that portions of the examiner's answer be striken because they refer to declarations. However, these declarations were submitted with the initial request and were addressed extensively in the final office action mailed March 25, 2009. Since the declarations have been used and relied on throughout prosecution, petitioner's late traversal is **dismissed** as untimely.

CONCLUSION

1. Petitioner's requests are **dismissed**.

2. Inquiries regarding this decision may be directed to Eric Keasel, Supervisory Patent Examiner, at (571) 272-4929.

3. This decision is not a final agency decision and is without prejudice to request reconsideration or higher-level review.

Irem Yucel
Director
Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,386	12/21/2006	6504103	RTC-2007-0245	1550

13897 7590 01/10/2012

Abel Law Group, LLP
7300 FM 2222
Bldg 1, Ste 210
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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 01/10/2012

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Kevin W. Jakel
Kaye Scholer LLP
901 Fifteenth Street NW, Suite 1100
Washington DC 20005

Date: MAILED

JAN 10 2012

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008386
PATENT NO. : 6504103
ART UNIT : 3900

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O. Box 1450
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George R. Meyer : (For Patent Owner)
ABEL LAW GROUP, LLP :
7300 FM 2222 :
Building 1, Suite 210 :
Austin, TX. 78730 :

Kevin W. Jakel :
KAYE SCHOLER, LLP : (For Third Party
901 15th Street, N.W., Suite 1100 : Requester)
Washington, D.C. 20005 :

MAILED

JAN 10 2012

CENTRAL REEXAMINATION UNIT

In re: Meyer et al. :
Ex Parte Reexamination Proceeding : DECISION ON PETITION
Control No.: 90/008,386 :
For: U.S. Patent No.: 6,504,103 :

This is a decision on a petition filed by the Patent Owner: a petition filed on June 2, 2009, entitled "PETITION TO EXPUNGE UNDER 37 C.F.R. § 1.59(b)".

The petition is before the Director of the Central Reexamination Unit. The decision on the petition will be **held in abeyance** until the issuance of the Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) is mailed.

REVIEW OF RELEVANT FACTS

- U.S. Patent No. 6,504,103 issued on January 7, 2003.
- A request for *Ex parte* reexamination was December 21, 2006 and assigned control no. 90/008,386.
- *Ex parte* reexamination was ordered on March 16, 2007.
- A Non-Final Office Action was mailed on April 15, 2008.
- The Patent Owner filed a Petition under 37 C.F.R. § 1.59(b) "petition" on June 2, 2009.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 C.F.R. § 1.59 Expungement of information or copy of papers in application file.

(b) An applicant may request that the Office expunge information, other than what is excluded by paragraph (a)(2) of this section, by filing a petition under this paragraph. Any petition to expunge information from an application must include the fee set forth in § 1.17(g) and establish to the satisfaction of the Director that the expungement of the information is appropriate in which case a notice granting the petition for expungement will be provided.

MPEP § 724.05 Petition To Expunge Information or Copy of Papers in Application File

A petition under 37 CFR 1.59(b) to expunge information submitted under MPEP § 724.02, or that should have been submitted under MPEP § 724.02 (as where proprietary information is submitted in an information disclosure statement but inadvertently not submitted in a sealed envelope as discussed in MPEP § 724.02) will be entertained only if the petition fee (37 CFR 1.17(g)) is filed and the information has been found not to be material to patentability. If the information is found to be material to patentability, any petition to expunge the information will be denied. Any such petition to expunge information submitted under MPEP § 724.02 should be submitted at the time of filing the information under MPEP § 724.02 and directed to the Technology Center (TC) to which the application is assigned.

DECISION

The Patent Owner ("Petitioner") requests that material (Information Disclosure Statement (IDS)) that is subject to a protective order, submitted in a sealed envelope on May 29, 2009, be expunged from the file of the above referenced reexamination proceeding if found not to be material to patentability. The request purports to have been filed in compliance with the requirements of MPEP § 724.02.

As outlined in section 724.05 of the MPEP, material submitted under MPEP § 724.02 will be expunged, **if it is found not to be material to patentability** and the petition seeking to have the material expunged contains: (A) a clear identification of the information to be expunged without disclosure of the details thereof; (B) a clear statement that the information to be expunged is trade secret material, proprietary

material and/or subject to a protective order, and that the information has not been otherwise made public; (C) a commitment on the part of the petitioner to retain such information for the period of any patent with regard to which such information has been submitted; (D) a statement that the petition to expunge is being submitted by, or on behalf of, the party in interest who originally submitted the information; and (E) the fee as set forth in 37 CFR 1.17(g) for a petition under 37 CFR 1.59(b). All the above-identified items have been provided.

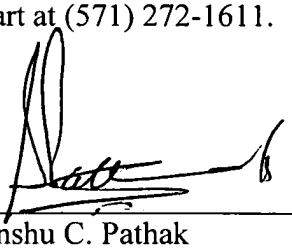
Per the guidelines set forth in section 724.04(c), a final decision on whether the information in question is "material to patentability" in the instant reexamination proceeding will be made prior to the mailing of a Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC). The submitted information will be maintained separate from the reexamination file and will not be publicly available until a final determination is made as to whether or not the information is material to patentability.

The petition is premature because the prosecution in the present proceeding has not been terminated, and, a final determination has not yet been made as to whether or not the information requested to be expunged is "material," with "materiality" being defined as any information which the examiner considers as being important to a determination of patentability of the claims. Thus, the petition to expunge must be dismissed at this time. Therefore, based on the above determination the decision on the petition will be **held in abeyance** until the issuance of the Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) is mailed.

CONCLUSION

1. The petition filed June 2, 2009, is **held in abeyance**.

3. Telephone inquiries related to this decision should be directed to Sudhanshu C. Pathak, Supervisory Patent Reexamination Examiner, at (571) 272-5509 or in his absence to Mark J. Reinhart at (571) 272-1611.



Sudhanshu C. Pathak
SPRS, CRU

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,410	01/05/2007	6597990		9576

22907 7590 11/09/2010

BANNER & WITCOFF, LTD.
1100 13th STREET, N.W.
SUITE 1200
WASHINGTON, DC 20005-4051

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 11/09/2010

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

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NOV 0 9 2010

CENTRAL REEXAMINATION UNIT

Evan M. Clark
Banner & Witcoff, LTD
1100 13th Street, NW
Suite 1200
Washington, DC 20005

(For Patent Owner)

Daniel E. Valencia
Berenato, White & Stavish, LLC
6550 Rock Spring Drive
Suite 240
Bethesda, MD 20817

(For Third Party Requester)

In re Reissue Application of
Anthony Brown
Application No.: 11/186,013
Filed: July 21, 2005
For: U.S. Patent No. 6.597.990

In re Anthony Brown
Reexamination Proceeding
Control No.: 90/008,410
Filed: January 5, 2007
For: U.S. Patent No.: 6.597.990

: SUPPLEMENT TO
: PRIOR DECISION
: TO MERGE
: REISSUE AND
: REEXAMINATION
: PROCEEDINGS

This decision is supplemental to the Office's prior merger decision mailed October 29, 2007, which *sua sponte* merged reissue application No. 11/186,013 and reexamination control No. 90/008,410 into a single proceeding.

The above-identified prior merger decision continues to be in effect, and all further examination in the merged proceeding should continue to be conducted in accordance with the above-identified prior merger decision, except as it is supplemented by this decision – as follows:

If a request for continued examination (RCE) is filed under 37 CFR 1.114, as is permitted for the reissue application, then 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, a request for continued examination (RCE) is not available in

the reexamination proceeding, and any response to the outstanding Office action (e.g., response to a final rejection) at that stage in the reexamination proceeding must be made taking into account the non-availability of RCE practice. Any failure to timely respond would result in the termination of the prosecution pursuant to 37 CFR 1.550(d).

In addition, if a final Office action should be issued subsequent to the mail date of this decision in this merged proceeding, any request for extension for time (to respond to any such subsequent final action) 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 Office action issued in the present merged proceeding subsequent to the mail date of this decision.

The merged proceeding will otherwise continue as per the above-identified prior merger decision.

CONCLUSION

1. Reissue application No. 11/186,013 and reexamination control No. 90/008,410 remain merged as a single proceeding.

2. 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, a request for continued examination (RCE) is not available in the reexamination proceeding, and any response to the outstanding Office action (e.g., response to a final rejection) at that stage in the reexamination proceeding must be made taking into account the non-availability of RCE practice. Any failure to timely respond would result in the termination of the prosecution pursuant to per 37 CFR 1.550(d).

3. In addition, if a final Office action should be issued in this merged proceeding subsequent to the mail date of this decision, then any request for extension for time (to respond to any such subsequent action) 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 Office action issued subsequent to the mail date of this decision.

4. All further examination in the merged proceeding is to continue to be conducted in accordance with the above-identified prior merger decision.

5. Telephone inquiries related to this decision should be directed to Colleen Dunn at (571) 272-1170, or in her absence to Eric Keasel at (571) 272-4929 or to Mark Reinhart at (571) 272-1611.

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

11/04/10

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

DATE : 09/27/11

TO SPE OF : ART UNIT 3992

SUBJECT : Request for Certificate of Correction for Appl. No.: 90008414 Patent No.: 6924891

CofC mailroom date: 09/12/11

Please respond to this request for a certificate of correction within 7 days.

FOR IFW FILES:

Please review the requested changes/corrections as shown in the **COCIN** document(s) in the IFW application image. No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Please complete the response (see below) and forward the completed response to scanning using document code **COCX**.

FOR PAPER FILES:

Please review the requested changes/corrections as shown in the attached certificate of correction. Please complete this form (see below) and forward it with the file to:

Certificates of Correction Branch (CofC)
Randolph Square – 9D10-A
Palm Location 7580
You can fax the Directors/SPE response to 571-273-3421

Note: **Should the changes in the claims and the inventor last name be approved?**

Lamonte Newsome

Certificates of Correction Branch

571-272-3421

Thank You For Your Assistance

The request for issuing the above-identified correction(s) is hereby:
Note your decision on the appropriate box.

☐ **Approved**	**All** changes apply.
☑ **Approved in Part**	Specify below which changes **do not** apply.
☐ **Denied**	State the reasons for denial below.

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Comments: Do not correct inventorship. Inventorship must be done in underlying patent

Changes to claims accepted and approved

3992

MARK J. REINHART
SPRE-AU 3992
CENTRAL REEXAMINATION UNIT

SPE Art Unit

Staple Here Only

UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT NO.	: 6,924,891 C1
APPLICATION NO	: 90/008,414
DATED	: MAY 10, 2011
INVENTOR(S)	: AVNER KARPOL, SILVIU REINHORN, EMANUEL ELYASAF, SHIMON YALOV, AND BOAZ KENAN

It is certified that an error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

Do not enter

First page Column 1 (Inventors), Line 3 – delete "Elysaf," and insert - - Elyasaf, - -, therefor.

OK to enter

Claim 20, Column 2, Line 26, before "using" insert - - defect - -.

Claim 22, Column 2, Line 11, delete "reptitively" and insert - - repetitively - - therefor.

Claim 37, Column 4, Line 23, delete "inputs" and insert - - inputs - - therefor.

Claim 78, Column 6, Line 51, delete "beams." and insert - - beam. - - therefor.

MARK J. REINHART
CRU SPE-AU 3992

MAILING ADDRESS OF SENDER:

David J. Goren
Fish & Richardson P.C.
P.O. Box 1022
Minneapolis, Minnesota 55440-1022

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

DATE : 5-11-11 Paper No.: _____

TO SPE OF : ART UNIT 3991

SUBJECT : Request for Certificate of Correction for Appl. No.: 90/008,482 Patent No.: 5236583

CofC mailroom date: 5-6-11

Please respond to this request for a certificate of correction within 7 days.

FOR IFW FILES: Check claims

Please review the requested changes/corrections as shown in the **COCIN** document(s) in the IFW application image. No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Please complete the response (see below) and forward the completed response to scanning using document code **COCX**.

FOR PAPER FILES:

Please review the requested changes/corrections as shown in the attached certificate of correction. Please complete this form (see below) and forward it with the file to:

Certificates of Correction Branch (CofC)
Randolph Square – 9D10-A
Palm Location 7580

Ennis Young
Certificates of Correction Branch
703-756-1814 _____

Thank You For Your Assistance

The request for issuing the above-identified correction(s) is hereby:
Note your decision on the appropriate box.

- ☒ **Approved** — **All** changes apply.
- ☐ **Approved in Part** — Specify below which changes **do not** apply.
- ☐ **Denied** — State the reasons for denial below.

Comments: _____

Deborah Jones
SPE

3991
Art Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE OF CORRECTION

EX PARTE REEXAMINATION CERTIFICATE NO.	:	5,236,503 C1
CONTROL NO.	:	90/008,482
ISSUE DATE	:	April 19, 2011
INVENTOR(S)	:	David M. Jones

It is certified that an error appears or errors appear in the above-identified reexamination certificate and that said Ex Parte Reexamination Certificate is hereby corrected as shown below:

Col. 2, line 4: "The patentability of claims 5 and 8 is confirmed" should read

-- The patentability of claim 5 is confirmed.

Claim 8 is determined to be patentable as amended.

8. [In a fluidized bed processor having a fluidizing gas source and a discharging spray nozzle within said processor, the improvement comprising shielding means adjacent said spray nozzle for shielding the initial spray pattern developed by said nozzle against the entrance of particles moving through the fluidized bed,] *The processor of claim 5* wherein said shielding means comprises a cylindrical [partition] *shield* surrounding said spray nozzle, one end of said cylindrical [partition] *shield* disposed at a level substantially adjacent the outermost extremity of said spray nozzle. --

MAILING ADDRESS OF SENDER (Please do not use customer number below):
Marcus J. Millet
LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK, LLP
600 South Avenue West
Westfield, New Jersey 07090

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,526	04/20/2007	6265196	02240-243505	5511

26694 7590 10/04/2010

VENABLE LLP
P.O. BOX 34385
WASHINGTON, DC 20043-9998

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 10/04/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
OBLON, SPIVAK, MCCLELLAND, MAIER &
NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

Date:
MAILED
OCT 04 2010
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008526
PATENT NO. : 6265196
ART UNIT : 3900

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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Venable LLP
P.O. Box 34385
Washington, DC 20043-9998

(For Patent Owner)

MAILED

OCT 04 2010

Oblon, Spivak, McClelland,
Maier & Neustadt, P.C.
1940 Duke Street
Alexandria, VA 22314

(For Requester)

CENTRAL REEXAMINATION UNIT

In re Srinivasan Chandrasegaran :
Ex Parte Reexamination Proceeding : **DECISION GRANTING**
Control No. 90/008,526 : **PETITION UNDER**
Filed: April 20, 2007 : **37 CFR 1.137(b)**
For: U.S. Patent No. 6,265,196 :

This is a decision on the August 26, 2010 patent owner petition under 37 CFR 1.137(b) to accept an unintentionally delayed Interview Summary and revive the present terminated reexamination prosecution ("the August 26, 2010 petition to revive").[1]

The August 26, 2010 petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The August 26, 2010 petition to revive is **granted**.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

35 U.S.C. 41(a)(7) provides, in pertinent part:

> REVIVAL FEES. — On filing each petition ... for an unintentionally delayed response by the patent owner in any reexamination proceeding ...

35 U.S.C. 133 provides:

> Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such

[1] Although a Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) has not been mailed to set forth the termination of the prosecution in this instance, the prosecution was "terminated" within the meaning of 37 CFR 1.550(d) for failure of the patent owner to timely file the written statement of interview required under 37 CFR 1.560(b) for the interview of July 22, 2010.

shorter time, not less than thirty days, as fixed by the Director in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Director that such delay was unavoidable.

35 U.S.C. 305 provides, in pertinent part:

After the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title.

37 CFR 1.137 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 1.550 provides, in pertinent part:

(d) If the patent owner fails to file a timely and appropriate response to any Office action or any written statement of an interview required under § 1.560(b), the prosecution in the *ex parte* reexamination proceeding will be a terminated prosecution, and the Director will proceed to issue and publish a certificate concluding the reexamination proceeding under § 1.570 in accordance with the last action of the Office.

(e) If a response by the patent owner is not timely filed in the Office,

*
*

(2) The response may nevertheless be accepted if the delay was unintentional; a petition to accept an unintentionally delayed response must be filed in compliance with § 1.137(b).

37 CFR 1.560(b) provides:

> 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.

MPEP 2268 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, all *ex parte* reexamination proceedings by section 4605 of the American Inventors Protection Act of 1999. The unintentional delay provisions of 35 U.S.C. 41(a)(7) became effective in reexamination proceedings on November 29, 2000. Accordingly, the Office will consider, in appropriate circumstances, a petition showing unintentional delay under 37 CFR 1.137(b) where untimely papers are filed 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 set forth in 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. The present proceeding is a reexamination proceeding; thus, the petition does not require a terminal disclaimer.[2]

---

[2] *See*: 37 CFR 1.137(d)(3).

Regarding item (1), this reexamination proceeding was terminated due to the failure to timely submit a statement of the substance of the July 22, 2010 interview pursuant to 37 CFR 1.560(b). 37 CFR 1.560(b) requires the submission of the statement as a separate part of a response to an Office action outstanding at the time of the interview, or as a separate paper filed within one month from the date of the interview. A statement under 37 CFR 1.560(b) was not filed until August 26, 2010, which was untimely. However, for the purpose of evaluating whether the August 26, 2010 petition to revive is a grantable petition, the August 26, 2010 Examiner Interview Summary satisfies item (1).

The appropriate petition fee of $1,620.00 set forth in 37 CFR 1.17(m) for the August 26, 2010 petition to revive has been paid, which satisfies item (2).

Regarding item (3), the statement provided in the August 26, 2010 petition to revive ("[i]t is confirmed that the entire delay was unintentional") does 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 statement contained in the August 26, 2010 petition to revive is being so construed, thereby satisfying item (3). Patent owner **must** notify the Office if the Office has misconstrued the statement provided in the August 26, 2010 petition to revive.

Accordingly, the August 26, 2010 patent owner petition to revive is **granted**. Prosecution in the above-identified reexamination proceeding will be resumed.

CONCLUSION

1. The August 26, 2010 patent owner petition under 37 CFR 1.137(b) is **granted**.

2. Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Sharon Turner, of Art Unit 3991, at (571) 272-0894.

3. Any inquiry concerning this decision should be directed to the undersigned at (571) 272-7728.

Raul Tamayo
Legal Advisor
Office of Patent Legal Administration

October 4, 2010

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.
90/008,526	04/20/2007	6265196	02240-243505	5511

26694 7590 11/01/2010

VENABLE LLP
P.O. BOX 34385
WASHINGTON, DC 20043-9998

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 11/01/2010

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UNITED STATES PATENT AND TRADEMARK OFFICE

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Venable LLP
P.O. Box 34385
Washington, DC 20043-9998

(For Patent Owner)

Oblon, Spivak, McClelland,
Maier & Neustadt, P.C.
1940 Duke Street
Alexandria, VA 22314

(For Requester)

MAILED

NOV 0 1 2010

CENTRAL REEXAMINATION UNIT

In re Srinivasan Chandrasegaran
Ex Parte Reexamination Proceeding
Control No. 90/008,526
Filed: April 20, 2007
For: U.S. Patent No. 6,265,196

CORRECTED DECISION GRANTING PETITION UNDER 37 CFR 1.137(b)

This is a decision correcting the decision issued on October 4, 2010, which was a decision on the August 26, 2010 patent owner petition under 37 CFR 1.137(b) to accept an unintentionally delayed Interview Summary and revive the present terminated reexamination prosecution ("the August 26, 2010 petition to revive").[1]

The August 26, 2010 petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The August 26, 2010 petition to revive is **granted**.

The October 4, 2010 decision is **vacated**.

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 *Ex Parte* 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 1.550(d) for failure of the patent owner to timely file the written statement of interview required under 37 CFR 1.560(b) for the interview of July 21, 2010.

35 U.S.C. 133 provides:

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

35 U.S.C. 305 provides, in pertinent part:

> After the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title.

37 CFR 1.137 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 1.550 provides, in pertinent part:

> (d) If the patent owner fails to file a timely and appropriate response to any Office action or any written statement of an interview required under § 1.560(b), the prosecution in the *ex parte* reexamination proceeding will be a terminated prosecution, and the Director will proceed to issue and publish a certificate concluding the reexamination proceeding under § 1.570 in accordance with the last action of the Office.
>
> (e) If a response by the patent owner is not timely filed in the Office,
> *
> *

(2) The response may nevertheless be accepted if the delay was unintentional; a petition to accept an unintentionally delayed response must be filed in compliance with § 1.137(b).

37 CFR 1.560(b) provides:

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.

MPEP 2268 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, all *ex parte* reexamination proceedings by section 4605 of the American Inventors Protection Act of 1999. The unintentional delay provisions of 35 U.S.C. 41(a)(7) became effective in reexamination proceedings on November 29, 2000. Accordingly, the Office will consider, in appropriate circumstances, a petition showing unintentional delay under 37 CFR 1.137(b) where untimely papers are filed 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 set forth in 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. The present proceeding is a reexamination proceeding; thus, the petition does not require a terminal disclaimer.[2] Regarding item (1), this reexamination proceeding was terminated due to the failure to timely submit a statement of the substance of the July 21, 2010 interview pursuant to 37 CFR 1.560(b). 37 CFR 1.560(b) requires the submission of the statement as a separate part of a response to an Office action outstanding at the time of the interview, or as a separate paper filed within one month from the date of the interview. A statement under 37 CFR 1.560(b) was not filed until August 26, 2010, which was untimely. However, for the purpose of evaluating whether the August 26, 2010 petition to revive is a grantable petition, the August 26, 2010 Examiner Interview Summary satisfies item (1).

The appropriate petition fee of $1,620.00 set forth in 37 CFR 1.17(m) for the August 26, 2010 petition to revive has been paid, which satisfies item (2).

Regarding item (3), the statement provided in the August 26, 2010 petition to revive ("[i]t is confirmed that the entire delay was unintentional") does 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 statement contained in the August 26, 2010 petition to revive is being so construed, thereby satisfying item (3). Patent owner **must** notify the Office if the Office has misconstrued the statement provided in the August 26, 2010 petition to revive.

Accordingly, the August 26, 2010 patent owner petition to revive is **granted**. Prosecution in the above-identified reexamination proceeding will be resumed.

PERIOD FOR RESPONSE IS EXTENDED

The following facts are noted:

1. A final rejection Office action issued on May 5, 2010. The May 5, 2010 Office action set a two-month period for response.

2. Patent owner timely filed a response to the May 5, 2010 action on July 6, 2010.

3. On July 21, 2010, patent owner's counsel participated in an examiner interview regarding the instant reexamination proceeding.

4. The Office issued an Advisory Action on July 23, 2010. The July 23, 2010 action stated that patent owner's July 6, 2010 response failed to overcome all of the rejections in the May 5, 2010 action. The July 23, 2010 action extended the period for response to run four months from May 5, 2010.

---

[2] *See*: 37 CFR 1.137(d)(3).

5. Although patent owner submitted on August 26, 2010, the instant petition and Examiner Interview Summary, patent owner has yet to file an appeal or take other appropriate action in view of the May 5 and July 23, 2010 actions.

Although a Notice of Intent to Issue Ex Parte Reexamination Certificate (NIRC) was not mailed to set forth the termination of the prosecution in this instance, the prosecution was "terminated" within the meaning of 37 CFR 1.550(d) for failure of the patent owner to timely file the written statement of interview required under 37 CFR 1.560(b) for the interview of July 21, 2010. Patent owner could not have filed an appeal or taken other appropriate action in response to the May 5, 2010 action while the instant reexamination proceeding was not pending.

In view of the fact that the instant decision is granting the August 26, 2010 patent owner petition to revive and that prosecution in the instant reexamination proceeding is being resumed, the time period for filing a Notice of Appeal, or to take other appropriate action to overcome all of the rejections in the May 5, 2010 action, is set to expire **SIX MONTHS** from the mailing date of the May 5, 2010 action, i.e., November 5, 2010. This time period is **not** extendable.

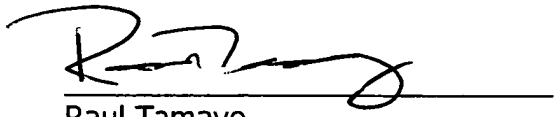
CONCLUSION

1. The August 26, 2010 patent owner petition under 37 CFR 1.137(b) is **granted**.

2. The time period for filing a Notice of Appeal, or to take other appropriate action to overcome all of the rejections in the May 5, 2010 action, is set to expire **SIX MONTHS** from the mailing date of the May 5, 2010 action, i.e., November 5, 2010. This time period is **not** extendable.

3. Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Sharon Turner, of Art Unit 3991, at (571) 272-0894.

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

November 1, 2010

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,526	04/20/2007	6265196	02240-243505	5511

26694 7590 01/05/2011

VENABLE LLP
P.O. BOX 34385
WASHINGTON, DC 20043-9998

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 01/05/2011

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
OBLON, SPIVAK, MCCLELLAND, MAIER &
NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

Date:

MAILED

JAN 05 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008526
PATENT NO. : 6265196
ART UNIT : 3900

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

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

Decision on Petition for Extension of Time in Reexamination	Control No.:90/008,526

1. THIS IS A DECISION ON THE PETITION FILED December 28, 2010.

2. THIS DECISION IS ISSUED PURSUANT TO:
   - A. ☒ 37 CFR 1.550(c) – The time for taking any action by a patent owner in an *ex parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
   - B. ☐ 37 CFR 1.956 – 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.

   The petition is before the Central Reexamination Unit for consideration.

3. FORMAL MATTERS
   Patent owner requests that the period for responding to the Office action mailed on _____, which sets a _____ period for filing a response thereto, be extended by _____.

   - A. ☒ Petition fee per 37 CFR §1.17(g)):
     - i. ☒ Petition includes authorization to debit a deposit account.
     - ii. ☐ Petition includes authorization to charge a credit card account.
     - iii. ☐ Other: _____.
   - B. ☒ Proper certificate of service was provided. (Not required in reexamination where patent owner is requester.)
   - C. ☒ Petition was timely filed.
   - D. ☒ Petition properly signed.

4. DECISION (See MPEP 2265 and 2665)
   - A. ☒ Granted or ☐ Granted-in-part for _____, because petitioner provided a factual accounting that established sufficient cause. (See 37 CFR 1.550(c) and 37 CFR 1.956).
     - ☐ Other/comment: _____.
   - B. ☐ Dismissed because:
     - i. ☐ Formal matters (See unchecked box(es) (A, B, C and/or D) in section 4 above).
     - ii. ☐ Petitioner failed to 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.
     - iii. ☐ Petitioner failed to explain why, in spite of the action taken thus far, the requested additional time is needed.
     - iv. ☐ The statements provided fail to establish sufficient cause to warrant extension of the time for taking action (See attached).
     - v. ☐ The petition is moot.
     - vi. ☐ Other/comment: _____.

5. CONCLUSION Appeal brief is due February 5, 2011

Telephone inquiries with regard to this decision should be directed to Deborah Jones_____ at ___571-272-1535_____, _____. In his/her absence, calls may be directed to _____, _____ in the Central Reexamination Unit.

[*Signature*] (Title) Deborah D. Jones Supervisory Patent Examiner CSU - Art Unit 3994

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,547	04/26/2007	6047530	26.03.3.235/A	8225

27572 7590 06/30/2011

HARNESS, DICKEY & PIERCE, P.L.C.
P.O. BOX 828
BLOOMFIELD HILLS, MI 48303

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/30/2011

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

James W. Miller
Suite 1960 Rand Tower
527 Marquette Avenue
Minneapolis, MN 55402

Date:

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008547
PATENT NO. : 6047530
ART UNIT : 3900

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

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

Decision Granting 37 CFR 1.59 Petition in Reexamination	Control No.: 90/008,547

1. The petition under 37 CFR 1.59 to expunge proprietary, protective order and/or trade secret documents under 37 CFR 1.59 filed February 29, 2008 is granted.

2. The Patent owner's representative requests expungement of document(s) that have been filed under MPEP 724.02. The examiner has determined that the information in such document(s) presented under seal are not material to patentability in the instant reexamination proceeding. Further, the petitioner has complied with all of the requirements of MPEP 724.05.

   A. ☒ Since the petition does not specify otherwise, the documents have been:
      i. ☒ Destroyed.
      ii. ☐ Expunged.

   B. ☐ Other/Comment:

      _____

3. CONCLUSION

   Telephone inquiries with regard to this decision should be directed to Andres Kashnikow at 571-272-4361. In his/her absence, calls may be directed to _____, _____ in the Central Reexamination Unit

Andres Kashnikow
[*Signature*]

SPE, CRU 3993
(Title)

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 2/25/11

TO SPE OF : ART UNIT 3991

SUBJECT : Request for Certificate of Correction for Appl. No.: 90/008,549 Patent No. 6,043,230

CofC mailroom date 9/3/10

Please respond to this request for a certificate of correction within 7 days.

FOR IFW FILES:

Please review the requested changes/corrections as shown in the **COCIN** document(s) in the IFW application image. No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Please complete the response (see below) and forward the completed response to scanning using document code **COCX**.

FOR PAPER FILES:

Please review the requested changes/corrections as shown in the attached certificate of correction. Please complete this form (see below) and forward it with the file to:

Certificates of Correction Branch (CofC)
Randolph Square – 9D10-A
Palm Location 7580

Ernest C. White, LIE

Certificates of Correction Branch

703-756-1814 _____

Thank You For Your Assistance

The request for issuing the above-identified correction(s) is hereby:

Note your decision on the appropriate box.

☒ **Approved**	**All** changes apply.
☐ **Approved in Part**	Specify below which changes **do not** apply.
☐ **Denied**	State the reasons for denial below.

Comments: _____

_____

_____

_____

Deborah Jones — **SPE**

3991 — **Art Unit**

Attorney Docket No. GILE-014/02US PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patentee: Arimilli *et al.* Confirmation No.: 8392

Patent No.: 6,043,230 C1 Group Art Unit: 3991

(Reexamination Request No. 90/008,549) Examiner: Kunz, Gary L.

Filed: April 30, 2007

For: **ANTIVIRAL PHOSPHONOMETHYOXY NUCLEOTIDE ANALOGS HAVING INCREASED ORAL BIOAVAILABILITY**

Commissioner for Patents
Office of Patent Publications
ATTN: Certificate of Corrections Branch
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Alexandria, VA 22314-1450

REQUEST FOR CERTIFICATE OF CORRECTION

This is a request for the issuance of a Certificate of Correction under 37 C.F.R. § 1.323 in the above-identified patent's Reexamination Certificate. Applicants respectfully submit that the mistakes resulted from typographical errors on the part of the Applicants, and correction under 37 C.F.R. § 1.323 is requested. The mistakes do not involve a change that would constitute new matter or require reexamination. A completed Certificate of Correction Form PTO/SB/44 is enclosed herein.

Amendments to the Claims begin on page 2.

Remarks begin on page 3.

AMENDMENTS TO THE CLAIMS

Clerical / Typographical Errors Attributable to the Applicant:

At claim 2, column 24, line 8 of the Reexamination Certificate, please **replace** "–$OC(R^2)OC(O)X(R)_a$" **with** -- –$OC(R^2)_2OC(O)X(R)_a$--.

At claim 2, column 24, line 9 of the Reexamination Certificate, please **replace** "–$OC(R^2)OC(O)X(R)_a$" **with** -- –$OC(R^2)_2OC(O)X(R)_a$--.

The chemical formula filed with the claim amendments during reexamination contained an inadvertent typographical error resulting in the incorrect chemical formula. The correct formula appears in the original claim 1 of the patent and reexamination certificate.

REMARKS

Applicants hereby state that the two separate statutory requirements have been met for the issuance of a Certificate of Correction in that the errors are of a clerical or typographical nature and do not constitute new matter. Therefore, Applicants respectfully request that a Certificate of Correction be issued.

Please charge the required $100 fee under 37 C.F.R. §1.20(a) to Deposit Account No. 50-1283. Although Applicants do not believe any additional fees are required, if there are any additional fees due in connection with the filing of this Request, the Commissioner is hereby authorized to charge the same to Deposit Account No. 50-1283.

Dated: September 3, 2010

Respectfully submitted,
COOLEY LLP

By: Erich E. Veitenheimer

Erich E. Veitenheimer
Reg. No. 40,420

USPTO Customer No. 58249

COOLEY LLP
ATTN: Patent Group
777 6th Street, NW Suite 1100
Washington, DC 20001
Phone: (202) 842-7800
Fax: (202) 842-7899

PTO/SB/44 (09-07)
Approved for use through 08/31/2010. OMB 0651-0033
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(Also Form PTO-1050)

UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT NO. : 6,043,230 C1

REEXAMINATION REQUEST NO.: 90/008,549

ISSUE DATE : October 14, 2008

INVENTOR(S) : Arimilli *et al.*

It is certified that errors appear in the above-identified patent and that said Letters Patent is hereby corrected as shown below

At claim 2, column 24, line 8, please replace "–$OC(R^2)OC(O)X(R)_a$" with -- – $OC(R^2)_2OC(O)X(R)_a$--.

At claim 2, column 24, line 9, please replace "–$OC(R^2)OC(O)X(R)_a$" with -- – $OC(R^2)_2OC(O)X(R)_a$--.

MAILING ADDRESS OF SENDER (Please do not use customer number below):

COOLEY LLP
ATTN: Patent Group
777 6th Street, NW Suite 1100
Washington, DC 20001

This collection of information is required by 37 CFR 1.322, 1.323, and 1.324. 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 1.14. This collection is estimated to take 1.0 hour 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: Attention Certificate of Corrections Branch, 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.

CH_2—$CH(CH_3)$—O—CH_2—P(O)(—O—CH_2—O—C(O)—N—$(CH_2)_2$ $OCH_3)_2$.

Column 34, lines 1–8:

One optionally conducts the carbonate synthesis reactions using at least about 1.0 and typically 2 equivalents of L—CHR^2—O—C(O)—OR. The reaction is conducted in the presence of an organic base in an organic solvent at a reaction temperature of about 4–100° C. for about 4–72 hours. Exemplary suitable organic bases included triethylamine or Hunig's base. Exemplary suitable organic solvents include DMF, DMPU, or NMP.

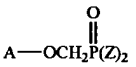
AS A RESULT OF REEXAMINATION, IT HAS BEEN DETERMINED THAT:

Claim 1 is determined to be patentable as amended.

New claims 2–4 are added and determined to be patentable.

1. A method comprising contacting a cell with a compound of formula (1a)

(1a)



wherein

Z is independently —$OC(R^2)_2OC(O)X(R)_a$, an ester, an amidate or —H, but at least one Z is —$OC(R^2)_2OC(O)X(R)_a$;

A is the residue of an antiviral phosphonomethoxy nucleotide analog;

X is N or O;

R^2 independently is —H, —C_1–C_{12} alkyl, C_5–C_{12} aryl, C_2–C_{12} alkenyl, C_2–C_{12} alkynyl, C_7–C_{12} alkenylaryl, C_7–C_{12} alkynylaryl, or C_6–C_{12} alkaryl, any one of which is unsubstituted or is substituted with 1 or 2 halo, cyano, azido, nitro or —OR^3 in which R^3 is C_1–C_{12} alkyl, C_2–C_{12} alkenyl, C_2–C_{12} alkynyl or C_5–C_{12} aryl;

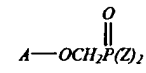
R is independently —H, C_1–C_{12} alkyl, C_5–C_{12} aryl, C_2–C_{12} alkenyl, C_2–C_{12} alkynyl, C_7–C_{12} alkenylaryl, C_7–C_{12} alkynylaryl, or C_6–C_{12} alkaryl, any one of which is unsubstituted or is substituted with 1 or 2 halo, cyano, azido, nitro, —$N(R^4)_2$ or —OR^3, where R^4 independently is —H or C_1–C_8 alkyl, provided that at least one R is not H; and

a is 1 when X is O, or 1 or 2 when X is N;

with the proviso that when a *is* 2 and X is N, (a) two N-linked R groups can be taken together to form a carbocycle or oxygen-containing heterocycle, (b) one N-linked R additionally can be —OR^3 or (c) both N-linked R groups can be —H.

2. A method comprising contacting a cell with a compound of formula (1a)

(1a)



wherein

Z is independently —$OC(R^2)OC(O)X(R)_a$-or —H, but at least one Z is —$OC(R^2)OC(O)X(R)_a$;

A is the residue of an antiviral phosphonomethoxy nucleotide analog;

X is N or O;

R^2 independently is —H, —C_1–C_{12} alkyl, C_2–C_{12} alkenyl, or C_2–C_{12} alkynyl, any one of which is unsubstituted or is substituted with azido, nitro or —OR^3 in which R^3 is C_1–C_{12} alkyl, C_2–C_{12} alkenyl, or C_2–C_{12} alkynyl;

R is independently —H, C_1–C_{12} alkyl, C_2–C_{12} alkenyl, or C_2–C_{12} alkynyl, any one of which is unsubstituted or is substituted with azido, nitro, or —OR^3; and

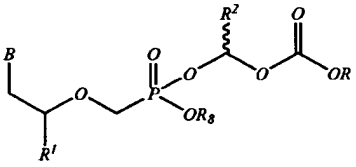
a is 1 when X is O, or 1 or 2 when X is N;

with the proviso that when a is 2 and X is N, (a) two N-linked R groups can be taken together to form a carbocycle or oxygen-containing heterocycle, or (b) one N-linked R additionally can be —OR^3;

and the salts, hydrates, tautomers and solvates thereof.

3. The method of claim 2, wherein said compound comprises formula (1)

(1)



wherein B is guanin-9-yl, adenin-9-yl, 2,6-diaminopurin-9-yl, 2-aminopurin-9-yl or their 1-deaza, 3-deaza, or 8-aza analogs, or B is cytosin-1-yl;

R is independently —H, C_1–C_{12} alkyl, C_1–C_{12} alkenyl, or C_2–C_{12} alkynyl, any one of which is unsubstituted or is substituted with azido, nitro or —OR^3 in which R^3 is C_1–C_{12} alkyl, C_2–C_{12} alkenyl, or C_2–C_{12} alkynyl;

R^1 is hydrogen, —CH_3, —CH_2OH, —CH_2F, —$CH{=}CH_2$, or —CH_2N_3, or R^1 and R^8 are joined to form —CH_2—;

R^2 independently is hydrogen or C_1–C_6 alkyl; and

R^8 is hydrogen or —CHR^2—O—C(O)—OR, or R^8 is joined with R^1 to form —CH_2—;

and the salts, hydrates, tautomers and solvates thereof.

4. The method of claim 3, wherein said compound comprises formula (1) and wherein

B is adenin-9-yl;

R^1 is $-CH_3$;

R^2 is H;

R is isopropyl; and

R^8 is CHR^2—O—C(O)—OR.

* * * * *

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P.O. Box 1450
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www.uspto.gov

Baker Botts LLP (for Patent Owner)
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Suite 600
Dallas, TX 75201-2980

MAILED

OCT 19 2011

CENTRAL REEXAMINATION UNIT

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300 S. Wacker Drive, 32nd Floor
Chicago, IL 60606

Otto O. Lee
Intellectual Property Law Group LLP (for Third Party Requester)
12 South First Street, Suite 1205
San Jose, CA 95113

In re Lowery et al. :
Reexamination Proceeding :
Control No.: 90/008,342 :
Filed: November 27, 2006 :
Control No.: 90/008,562 : DECISION ON PETITIONS
Filed: March 29, 2007 : UNDER 37 CFR 1.181
Control No.: 90/008,574 :
Filed: April 3, 2007 :
for: U.S. Patent 5,894,554 :

This is a decision on the petition filed August 23, 2009 for entry of the amendments presented in the response submitted on June 29, 2009 to a Final Office action issued April 29, 2009. This decision also addresses the six petitions, filed on January 14, 2010, which request entry of the amendments pursuant to 37 CFR 41. 33(a) that were filed on October 29 and 30, 2009 after receipt of a Notice of Appeal but prior to filing the Appeal Brief.

The petition is before the Director of Technology Center 1600, who oversees the Central Reexamination Unit, for decision.

The petition of August 23, 2009 is GRANTED for the reasons set forth below.

The six petitions of January 14, 2010 are DISMISSED for the reasons set forth below.

Review of Facts

1. On November 27, 2006, a first request for reexamination of USPN 5,894,554 was filed and assigned control number 90/008,342.

2. On January 25, 2007, reexamination was ordered in the 90/008,342 proceeding.

3. On March 29, 2007, a second request for reexamination of USPN 5,894,554 was filed and assigned control number 90/008,562.

4. On April 3, 2007, a third request for reexamination of USPN 5,894,554 was filed and assigned control number 90/008,574.

5. On May 4, 2007, reexamination was ordered in the 90/008,562 proceeding and 90/008,574 proceeding.

6. On May 13, 2008, the three proceedings were merged.

7. On June 30, 2008, a non-final Office action was mailed in the merged proceedings.

8. On September 2, 2008, a timely response to the non-final Office action was submitted and added proposed new claims 12-281.

9. On October 3, 2008, a Notice of Defective Paper was issued.

10. On November 3, 2008, a corrected response was submitted.

11. On April 29, 2009, a Final Office action was mailed.

12. On June 29, 2009, an after-final response was submitted. The response proposed to cancel claims 9, 10, 39, 40, 69, 70, 99, 100, and 121-200 and amend numerous claims, e.g., claims 21, 22, 51, 52, 61, 71, 81, 82, 91, 101, 111, 112, 210, 211, 230, 231, 250, 251, 270, 271, and 281, to address the rejections under 35 USC 112.

13. On July 9, 2009, an Advisory action was mailed indicating the amendment of June 29, 2009 would not be entered because it raised new issues requiring further consideration and search, contained new matter, and did not place the proceeding in better form for appeal.

14. On August 23, 2009, Patent Owner filed this petition requesting entry of the amendment of June 29, 2009.

15. On August 31, 2009, Patent Owner filed a Notice of Appeal.

16. On October 29, 2009, Patent Owner filed First, Second, and Third amendments.

17. On October 30, 2009, Patent Owner filed Fourth, Fifth, and Sixth amendments.

18. On November 2, 2009, Patent Owner filed an Appeal Brief.

19. On November 14, 2009, an Advisory action was mailed indicating the six amendments, filed on October 29 and 30, 2009, are not entered because the amendments fail to put the proceeding in better form for appeal.

20. On December 14, 2009, a Notice of Defective Brief was mailed.

21. On December 18, 2009, another Notice of Defective Brief was mailed.

22. On December 30, 2009, Patent Owner filed an amendment that proposed to cancel claim 281.

23. On January 14, 2010, Patent Owner filed six petitions requesting entry of each of the six amendments filed on October 29-30, 2009.

24. On January 15, 2010, a replacement Appeal Brief was submitted.

Decision

37 CFR 1.116 provides, in part:

(b) After a final rejection or other final action (§ 1.113) in an application or in an *ex parte* reexamination filed under § 1.510, .., but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title):

(1) An amendment may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action;

(2) An amendment presenting rejected claims in better form for consideration on appeal may be admitted; or

(e) An affidavit or other evidence submitted after a final rejection or other final action (§ 1.113) ... in an *ex parte* reexamination filed under § 1.510 ... may be admitted upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented.

37 CFR 1.550(a) provides:

All *ex parte* reexamination proceedings, including any appeals to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office. After issuance of the *ex parte* reexamination order and expiration of the time for submitting any responses, the examination will be conducted in accordance with §§ 1.104 through 1.116 and will result in the issuance of an *ex parte* reexamination certificate under § 1.570.

MPEP 2271 provides, in part:

> Before a final action is in order, a clear issue should be developed between the examiner and the patent owner. To bring the prosecution to a speedy conclusion and at the same time deal justly with the patent owner and the public, the examiner will twice provide the patent owner with such information and references as may be useful in defining the position of the Office as to unpatentability before the action is made final. Initially, the decision ordering reexamination of the patent will contain an identification of the new questions of patentability that the examiner considers to be raised by the prior art considered. In addition, the first Office action will reflect the consideration of any arguments and/or amendments contained in the request, the owner's statement filed pursuant to 37 CFR 1.530, and any reply thereto by the requester, and should fully apply all relevant grounds of rejection to the claims. ...
>
> It is intended that the second Office action in the reexamination proceeding following the decision ordering reexamination will be made final in accordance with the guidelines set forth in MPEP § 706.07(a).

The patent owner (petitioner) states that the examiner erred in deciding not to enter the June 29, 2009 proposed amendment. The petitioner explained his attempts to schedule an interview for the merged reexamination proceedings prior to the Final Office action and how he filed amendments to address the issues raised in the Final Office action. See pages 2-3 of the petition. Specifically, the patent owner presented reasons why the June 29, 2009 amendment was necessary and not earlier presented. See pages 4-6.

In response to patent owner's arguments that the examiner erred in deciding not to enter the June 29, 2009 proposed amendment, the director finds there is a good and sufficient reason to enter the amendment. Turning to the specific facts of this merged proceeding, the director finds that the June 29, 2009 amendment, on balance, significantly reduces or simplifies the issues for appeal. Specifically, the June 29, 2009 amendment proposed to cancel claims 9, 10, 39, 40, 69, 70, 99, 100, and 121-200 and amend numerous other claims to reduce issues under 35 U.S.C. 112. As outlined in detail below, entry of the amendment would eliminate numerous issues (e.g., issues II. A & B on page 47, III.A. 1-12 & 19-42 on pages 47-59, and III. B. 1 & 3 on pages 60-61 of the June 29, 2009 response) and reduce other issues (e.g., issues III. A. 13-15 on pages 50-53, III. B. 2 on page 61, and V.A., B., F., and G. on pages 63-77 and 85-92 of the June 29, 2009 response). Therefore, in light of the facts and circumstances of the present situation, the entry of the amendment of June 29, 2009 is considered the best course to further prosecution.

Accordingly, good and sufficient reasons to enter the June 29, 2009 amendment in the merged reexamination proceedings have been provided. In view of the above, the petition, dated August 23, 2009, is GRANTED.

The six petitions dated January 14, 2010 request entry of amendments filed on either October 29 or 30, 2009. Upon review of the record, these six amendments, *en total*, appear to present substantially similar amendments to the June 29, 2009 amendment. Patent owner filed the six separate amendments, after the June 29, 2009 amendment was denied entry, because of the Office's policy that amendments are not entered-in-part. See, e.g., page 4 of the January 14,

2010 petition requesting entry of the sixth amendment. Accordingly, it is deemed that entry of the June 29, 2009 amendment renders the October 29 and 30, 2009 amendments as duplicative amendment submissions. Therefore, the six petitions of January 14, 2010 are DISMISSED as moot in light of the relief granted for the August 23, 2009 petition.

In summary, the amendment of June 29, 2009 is entered. In addition, the proposed amendment of December 30, 2009, which cancelled independent claim 281, is entered. In view of the complexity of the action/issues, it is further determined that the best course of action at this point is to return this proceeding to the examiner for issuance of a new Final Office action.

Conclusion

1. The Patent Owner's petition, dated August 23, 2009, for entry of the amendments presented in the response submitted on June 29, 2009 is GRANTED.

2. The six petitions filed on January 14, 2010 are dismissed as moot in light of the relief provided in granting the petition of August 23, 2009.

3. The proceeding is returned to the examiner for issuance of a Final Office action.

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

Irem Yucel, Director
Technology Center 1600

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.
90/008,568	03/29/2007	6415335	06-455	7319

7590 02/02/2012

MATTHEW B. TALPIS, ESQ.
BAKER BOTTS LLP
2001 ROSS AVENUE
SUITE 600
DALLAS, TX 75201

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 02/02/2012

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patents and Trademark Office
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Alexandria, VA 22313-1450
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Date:

MAILED

FEB 0 2 2012

CENTRAL REEXAMINATION UNI

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008568
PATENT NO. : 6415335
ART UNIT : 3900

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

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

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UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,568	03/29/2007	6415335	06-455	7319

7590 02/02/2012

MATTHEW B. TALPIS, ESQ.
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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 02/02/2012

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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
Public Patent Foundation
1375 Broadway, Suite 600
New York, NY 10018

Date: MAILED

FEB 0 2 2012

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008343
PATENT NO.: 6415335
ART UNIT : 3900

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

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

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UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,584	04/03/2007	6415335	FRIENDFINDER.RX2	3276

7590 02/02/2012

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 02/02/2012

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patents and Trademark Office
P.O.Box 1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008584
PATENT NO. : 6415335
ART UNIT : 3900

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

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CENTRAL REEXAMINATION UNIT

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San Jose, CA 95113

In re Lowery et al.
Reexamination Proceeding
Control No.: 90/008,343
Filed: November 27, 2006
Control No.: 90/008,568
Filed: March 29, 2007
Control No.: 90/008,584
Filed: April 3, 2007
for: U.S. Patent 6,415,335

: DECISION ON PETITIONS
: UNDER 37 CFR 1.181

This is a decision on the petition filed August 23, 2009 for reconsideration of the petition decision rendered August 13, 2009 for entry of the amendments presented in the response submitted on June 19, 2009 to a Final Office action issued March 30, 2009. This decision also addresses the seven petitions, filed on December 22, 2009, which request entry of the after-final amendments pursuant to 37 CFR 41. 33(a) that were filed on August 27, 28 and 30, 2009 after receipt of a Notice of Appeal but prior to filing the Appeal Brief.

The petitions are before the Director of the Central Reexamination Unit, for decision.

The petition of August 23, 2009 is granted for the reasons set forth below.

The seven petitions of December 22, 2009 are dismissed for the reasons set forth below.

Review of Facts

1. On March 30, 2009, a Final Office action was mailed.

2. On April 20, 2009, a personal interview was conducted with Charles Fish (for Patent Owner), M. Steelman (examiner), F. Ferris (examiner) and Eric Keasal (supervisor).

3. On April 30, 2009, a first after-Final amendment was submitted that proposed amending claims 1, 2, 15, 16, and 29 and added new claims 30-184. This submission also included a Statement of the Interview (see page 35 of the response).

4. On May 28, 2009, an Advisory action was mailed denying entry of the After-final amendment.

5 On June 19, 2009, a second after-final response was submitted. The response proposed essentially the same amendments that were proposed on April 30, 2009. The editorial difference in claim 29 did not change the meaning of that claim and it was not in compliance with 37 CFR 1.530(f).

6. On June 30, 2009, a Notice of Appeal was filed.

7. On June 30, 2009, a petition under 37 CFR 1.181 was filed requesting entry of the amendment filed June 19, 2009.

8 On July 1, 2009, an Advisory action was mailed indicating the amendment of June 19, 2009 would not be entered because it raised new issues requiring further consideration and search, contained new matter, and did not place the proceeding in better form for appeal.

9. On August 13, 2009, the petition under 37 CFR 1.181, filed June 30, 2009, was dismissed.

10. On August 23, 2009, a petition under 37 CFR 1.181(a)(3) was filed requesting the decision of August 13, 2009 be overturned.

11. On August 23, 2009, Patent Owner also filed an amendment pursuant to 37 CFR 41.33(a).

12. On August 27, 2009, Patent Owner filed Second, Third, Fourth, Fifth and Sixth amendments pursuant to 37 CFR 41.33(a).

13. On August 28, 2009, Patent Owner filed Seventh and Eighth amendments pursuant to 37 CFR 41.33(a).

14. On August 30, 2009, Patent Owner filed a supplement to the Sixth after-final amendment.

15. On August 31, 2009, Patent Owner filed an Appeal Brief.

16. On October 16, 2009, a Notice of Defective Appeal Brief was mailed.

17. On October 23, 2009, an Advisory action was mailed indicating the amendments filed on August 27, 28, and 30, 2009, are not entered because the amendments fail to put the proceeding in better form for appeal

18. On November 16, 2009, an Appeal Brief was filed.

19. On December 22, 2009, seven Petitions under 37 CFR 1.181 were filed for entry of each of the amendments filed August 28, 28, and 30, 2009,

Decision

37 CFR 1.116 provides, in part:

> (b) After a final rejection or other final action (§ 1.113) in an application or in an *ex parte* reexamination filed under § 1.510, .., but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title):
>
> (1) An amendment may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action;
>
> (2) An amendment presenting rejected claims in better form for consideration on appeal may be admitted; or
>
> (e) An affidavit or other evidence submitted after a final rejection or other final action (§ 1.113) ... in an *ex parte* reexamination filed under § 1.510 ... may be admitted upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented.

MPEP 2271 provides, in part:

> Before a final action is in order, a clear issue should be developed between the examiner and the patent owner. To bring the prosecution to a speedy conclusion and at the same time deal justly with the patent owner and the public, the examiner will twice provide the patent owner with such information and references as may be useful in defining the position of the Office as to unpatentability before the action is made final. Initially, the decision ordering reexamination of the patent will contain an identification of the new questions of patentability that the examiner considers to be raised by the prior art considered. In addition, the first Office action will reflect the consideration of any arguments and/or amendments contained in the request, the owner's statement filed pursuant to 37 CFR 1.530, and any reply thereto by the requester, and should fully apply all relevant grounds of rejection to the claims. ...

It is intended that the second Office action in the reexamination proceeding following the decision ordering reexamination will be made final in accordance with the guidelines set forth in MPEP § 706.07(a).

The patent owner (petitioner) states that the examiner erred in deciding not to enter the June 19, 2009 proposed amendment. The petitioner explained his attempts to submit the amendments suggested at the interview held on April 20, 2009 to address the issues raised in the Final Office action. See page 5 of the petition. Specifically, the patent owner presented reasons why the June 19, 2009 amendment was necessary and not earlier presented. See pages 6-7.

In response to patent owner's arguments that the examiner erred in deciding not to enter the June 19, 2009 proposed amendment, the director finds there is a good and sufficient reason to enter the amendment. Turning to the specific facts of this merged proceeding, the director finds that the June 19, 2009 amendment, on balance, significantly reduces or simplifies the issues for appeal. Specifically, the June 19, 2009 submission proposed amendments that would eliminate numerous issues under 35 USC 112 that were discussed at the interview conducted on April 20, 2009. Therefore, in light of the facts and circumstances of the present situation, the entry of the amendment of June 19, 2009 is considered the best course to further prosecution.

Accordingly, good and sufficient reasons to enter the June 19, 2009 amendment in the merged reexamination proceedings have been provided. In view of the above, the petition, dated August 23, 2009, is GRANTED.

The seven petitions dated December 22, 2009 request entry of amendments filed on August 27, 28 and 30, 2009. Upon review of the record, these amendments, *en total*, are present in the amendment of June 19, 2009 and are considered redundant. Therefore, the seven petitions of December 23, 2009 are DISMISSED.

In summary, the amendment of June 19, 2009 is entered. In view of the complexity of the action/issues, it is further determined that the best course of action at this point is to return this proceeding to the examiner for issuance of a new Final office action.

Conclusion

1. The Patent Owner's petition, dated August 23, 2009, for reconsideration of the decision rendered August 13, 2009 for entry of the amendments presented in the response submitted on June 19, 2009 is GRANTED.

2. The amendment filed June 19, 2009 is entered.

3. The seven petitions filed on December 23, 2009 are DISMISSED as moot in light of the relief provided ingranting the petition of August 23, 2009. 4. The amendment filed August 23, 2009 is entered and considered the most current edition of the claims in this proceeding.

5. The proceeding is returned to the examiner for issuance of a Final office action based of the claims as amended on June 19, 2009.

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

Irem Yucel, Director
Technology Center 1600

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In re Lowery et al.
Reexamination Proceeding
Control No.: 90/008,342
Filed: November 27, 2006
Control No.: 90/008,562
Filed: March 29, 2007
Control No.: 90/008,574
Filed: April 3, 2007
for: U.S. Patent 5,894,554

: DECISION ON PETITIONS
: UNDER 37 CFR 1.181

This is a decision on the petition filed August 23, 2009 for entry of the amendments presented in the response submitted on June 29, 2009 to a Final Office action issued April 29, 2009. This decision also addresses the six petitions, filed on January 14, 2010, which request entry of the amendments pursuant to 37 CFR 41. 33(a) that were filed on October 29 and 30, 2009 after receipt of a Notice of Appeal but prior to filing the Appeal Brief.

The petition is before the Director of Technology Center 1600, who oversees the Central Reexamination Unit, for decision.

The petition of August 23, 2009 is GRANTED for the reasons set forth below.

The six petitions of January 14, 2010 are DISMISSED for the reasons set forth below.

Review of Facts

1. On November 27, 2006, a first request for reexamination of USPN 5,894,554 was filed and assigned control number 90/008,342.

2. On January 25, 2007, reexamination was ordered in the 90/008,342 proceeding.

3. On March 29, 2007, a second request for reexamination of USPN 5,894,554 was filed and assigned control number 90/008,562.

4. On April 3, 2007, a third request for reexamination of USPN 5,894,554 was filed and assigned control number 90/008,574.

5. On May 4, 2007, reexamination was ordered in the 90/008,562 proceeding and 90/008,574 proceeding.

6. On May 13, 2008, the three proceedings were merged.

7. On June 30, 2008, a non-final Office action was mailed in the merged proceedings.

8. On September 2, 2008, a timely response to the non-final Office action was submitted and added proposed new claims 12-281.

9. On October 3, 2008, a Notice of Defective Paper was issued.

10. On November 3, 2008, a corrected response was submitted.

11. On April 29, 2009, a Final Office action was mailed.

12. On June 29, 2009, an after-final response was submitted. The response proposed to cancel claims 9, 10, 39, 40, 69, 70, 99, 100, and 121-200 and amend numerous claims, e.g., claims 21, 22, 51, 52, 61, 71, 81, 82, 91, 101, 111, 112, 210, 211, 230, 231, 250, 251, 270, 271, and 281, to address the rejections under 35 USC 112.

13. On July 9, 2009, an Advisory action was mailed indicating the amendment of June 29, 2009 would not be entered because it raised new issues requiring further consideration and search, contained new matter, and did not place the proceeding in better form for appeal.

14. On August 23, 2009, Patent Owner filed this petition requesting entry of the amendment of June 29, 2009.

15. On August 31, 2009, Patent Owner filed a Notice of Appeal.

16. On October 29, 2009, Patent Owner filed First, Second, and Third amendments.

17. On October 30, 2009, Patent Owner filed Fourth, Fifth, and Sixth amendments.

18. On November 2, 2009, Patent Owner filed an Appeal Brief.

19. On November 14, 2009, an Advisory action was mailed indicating the six amendments, filed on October 29 and 30, 2009, are not entered because the amendments fail to put the proceeding in better form for appeal.

20. On December 14, 2009, a Notice of Defective Brief was mailed.

21. On December 18, 2009, another Notice of Defective Brief was mailed.

22. On December 30, 2009, Patent Owner filed an amendment that proposed to cancel claim 281.

23. On January 14, 2010, Patent Owner filed six petitions requesting entry of each of the six amendments filed on October 29-30, 2009.

24. On January 15, 2010, a replacement Appeal Brief was submitted.

Decision

37 CFR 1.116 provides, in part:

(b) After a final rejection or other final action (§ 1.113) in an application or in an *ex parte* reexamination filed under § 1.510, .., but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title):

(1) An amendment may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action;

(2) An amendment presenting rejected claims in better form for consideration on appeal may be admitted; or

(e) An affidavit or other evidence submitted after a final rejection or other final action (§ 1.113) ... in an *ex parte* reexamination filed under § 1.510 ... may be admitted upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented.

37 CFR 1.550(a) provides:

All *ex parte* reexamination proceedings, including any appeals to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office. After issuance of the *ex parte* reexamination order and expiration of the time for submitting any responses, the examination will be conducted in accordance with §§ 1.104 through 1.116 and will result in the issuance of an *ex parte* reexamination certificate under § 1.570.

MPEP 2271 provides, in part:

> Before a final action is in order, a clear issue should be developed between the examiner and the patent owner. To bring the prosecution to a speedy conclusion and at the same time deal justly with the patent owner and the public, the examiner will twice provide the patent owner with such information and references as may be useful in defining the position of the Office as to unpatentability before the action is made final. Initially, the decision ordering reexamination of the patent will contain an identification of the new questions of patentability that the examiner considers to be raised by the prior art considered. In addition, the first Office action will reflect the consideration of any arguments and/or amendments contained in the request, the owner's statement filed pursuant to 37 CFR 1.530, and any reply thereto by the requester, and should fully apply all relevant grounds of rejection to the claims. ...
>
> It is intended that the second Office action in the reexamination proceeding following the decision ordering reexamination will be made final in accordance with the guidelines set forth in MPEP § 706.07(a).

The patent owner (petitioner) states that the examiner erred in deciding not to enter the June 29, 2009 proposed amendment. The petitioner explained his attempts to schedule an interview for the merged reexamination proceedings prior to the Final Office action and how he filed amendments to address the issues raised in the Final Office action. See pages 2-3 of the petition. Specifically, the patent owner presented reasons why the June 29, 2009 amendment was necessary and not earlier presented. See pages 4-6.

In response to patent owner's arguments that the examiner erred in deciding not to enter the June 29, 2009 proposed amendment, the director finds there is a good and sufficient reason to enter the amendment. Turning to the specific facts of this merged proceeding, the director finds that the June 29, 2009 amendment, on balance, significantly reduces or simplifies the issues for appeal. Specifically, the June 29, 2009 amendment proposed to cancel claims 9, 10, 39, 40, 69, 70, 99, 100, and 121-200 and amend numerous other claims to reduce issues under 35 U.S.C. 112. As outlined in detail below, entry of the amendment would eliminate numerous issues (e.g., issues II. A & B on page 47, III.A. 1-12 & 19-42 on pages 47-59, and III. B. 1 & 3 on pages 60-61 of the June 29, 2009 response) and reduce other issues (e.g., issues III. A. 13-15 on pages 50-53, III. B. 2 on page 61, and V.A., B., F., and G. on pages 63-77 and 85-92 of the June 29, 2009 response). Therefore, in light of the facts and circumstances of the present situation, the entry of the amendment of June 29, 2009 is considered the best course to further prosecution.

Accordingly, good and sufficient reasons to enter the June 29, 2009 amendment in the merged reexamination proceedings have been provided. In view of the above, the petition, dated August 23, 2009, is GRANTED.

The six petitions dated January 14, 2010 request entry of amendments filed on either October 29 or 30, 2009. Upon review of the record, these six amendments, *en total*, appear to present substantially similar amendments to the June 29, 2009 amendment. Patent owner filed the six separate amendments, after the June 29, 2009 amendment was denied entry, because of the Office's policy that amendments are not entered-in-part. See, e.g., page 4 of the January 14,

2010 petition requesting entry of the sixth amendment. Accordingly, it is deemed that entry of the June 29, 2009 amendment renders the October 29 and 30, 2009 amendments as duplicative amendment submissions. Therefore, the six petitions of January 14, 2010 are DISMISSED as moot in light of the relief granted for the August 23, 2009 petition.

In summary, the amendment of June 29, 2009 is entered. In addition, the proposed amendment of December 30, 2009, which cancelled independent claim 281, is entered. In view of the complexity of the action/issues, it is further determined that the best course of action at this point is to return this proceeding to the examiner for issuance of a new Final Office action.

Conclusion

1. The Patent Owner's petition, dated August 23, 2009, for entry of the amendments presented in the response submitted on June 29, 2009 is GRANTED.

2. The six petitions filed on January 14, 2010 are dismissed as moot in light of the relief provided in granting the petition of August 23, 2009.

3. The proceeding is returned to the examiner for issuance of a Final Office action.

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

Irem Yucel, Director
Technology Center 1600

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,584	04/03/2007	6415335	FRIENDFINDER.RX2	3276

7590 02/02/2012

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 02/02/2012

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
MR. OTTO O. LEE
INTELLECTUAL PROPERTY LAW GROUP LLP
12 SOUTH FIRST STREET, SUITE 1205
SAN JOSE, CA 95113

Date: **MAILED**

FEB 0 2 2012

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008584
PATENT NO. : 6415335
ART UNIT : 3900

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,343	11/27/2006	6415335		3417

7590 02/02/2012

Matthew B. Talpis, Esq.
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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 02/02/2012

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
Public Patent Foundation
1375 Broadway, Suite 600
New York, NY 10018

Date: MAILED

FEB 0 2 2012

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008343
PATENT NO. : 6415335
ART UNIT : 3900

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United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,568	03/29/2007	6415335	06-455	7319

7590 02/02/2012

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 02/02/2012

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

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CHICAGO, IL 60606

Date: MAILED

FEB 0 2 2012

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008568
PATENT NO. : 6415335
ART UNIT : 3900

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(for Patent Owner)

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FEB 0 2 2012

CENTRAL REEXAMINATION UNIT

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In re Lowery et al.
Reexamination Proceeding
Control No.: 90/008,343
Filed: November 27, 2006
Control No.: 90/008,568
Filed: March 29, 2007
Control No.: 90/008,584
Filed: April 3, 2007
for: U.S. Patent 6,415,335

: DECISION ON PETITIONS
: UNDER 37 CFR 1.181

This is a decision on the petition filed August 23, 2009 for reconsideration of the petition decision rendered August 13, 2009 for entry of the amendments presented in the response submitted on June 19, 2009 to a Final Office action issued March 30, 2009. This decision also addresses the seven petitions, filed on December 22, 2009, which request entry of the after-final amendments pursuant to 37 CFR 41. 33(a) that were filed on August 27, 28 and 30, 2009 after receipt of a Notice of Appeal but prior to filing the Appeal Brief.

The petitions are before the Director of the Central Reexamination Unit, for decision.

The petition of August 23, 2009 is granted for the reasons set forth below.

The seven petitions of December 22, 2009 are dismissed for the reasons set forth below.

Review of Facts

1. On March 30, 2009, a Final Office action was mailed.

2. On April 20, 2009, a personal interview was conducted with Charles Fish (for Patent Owner), M. Steelman (examiner), F. Ferris (examiner) and Eric Keasal (supervisor).

3. On April 30, 2009, a first after-Final amendment was submitted that proposed amending claims 1, 2, 15, 16, and 29 and added new claims 30-184. This submission also included a Statement of the Interview (see page 35 of the response).

4. On May 28, 2009, an Advisory action was mailed denying entry of the After-final amendment.

5 On June 19, 2009, a second after-final response was submitted. The response proposed essentially the same amendments that were proposed on April 30, 2009. The editorial difference in claim 29 did not change the meaning of that claim and it was not in compliance with 37 CFR 1.530(f).

6. On June 30, 2009, a Notice of Appeal was filed.

7. On June 30, 2009, a petition under 37 CFR 1.181 was filed requesting entry of the amendment filed June 19, 2009.

8 On July 1, 2009, an Advisory action was mailed indicating the amendment of June 19, 2009 would not be entered because it raised new issues requiring further consideration and search, contained new matter, and did not place the proceeding in better form for appeal.

9. On August 13, 2009, the petition under 37 CFR 1.181, filed June 30, 2009, was dismissed.

10. On August 23, 2009, a petition under 37 CFR 1.181(a)(3) was filed requesting the decision of August 13, 2009 be overturned.

11. On August 23, 2009, Patent Owner also filed an amendment pursuant to 37 CFR 41.33(a).

12. On August 27, 2009, Patent Owner filed Second, Third, Fourth, Fifth and Sixth amendments pursuant to 37 CFR 41.33(a).

13. On August 28, 2009, Patent Owner filed Seventh and Eighth amendments pursuant to 37 CFR 41.33(a).

14. On August 30, 2009, Patent Owner filed a supplement to the Sixth after-final amendment.

15. On August 31, 2009, Patent Owner filed an Appeal Brief.

16. On October 16, 2009, a Notice of Defective Appeal Brief was mailed.

17. On October 23, 2009, an Advisory action was mailed indicating the amendments filed on August 27, 28, and 30, 2009, are not entered because the amendments fail to put the proceeding in better form for appeal

18. On November 16, 2009, an Appeal Brief was filed.

19. On December 22, 2009, seven Petitions under 37 CFR 1.181 were filed for entry of each of the amendments filed August 28, 28, and 30, 2009,

Decision

37 CFR 1.116 provides, in part:

> (b) After a final rejection or other final action (§ 1.113) in an application or in an *ex parte* reexamination filed under § 1.510, .., but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title):
>
> (1) An amendment may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action;
>
> (2) An amendment presenting rejected claims in better form for consideration on appeal may be admitted; or
>
> (e) An affidavit or other evidence submitted after a final rejection or other final action (§ 1.113) ... in an *ex parte* reexamination filed under § 1.510 ... may be admitted upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented.

MPEP 2271 provides, in part:

> Before a final action is in order, a clear issue should be developed between the examiner and the patent owner. To bring the prosecution to a speedy conclusion and at the same time deal justly with the patent owner and the public, the examiner will twice provide the patent owner with such information and references as may be useful in defining the position of the Office as to unpatentability before the action is made final. Initially, the decision ordering reexamination of the patent will contain an identification of the new questions of patentability that the examiner considers to be raised by the prior art considered. In addition, the first Office action will reflect the consideration of any arguments and/or amendments contained in the request, the owner's statement filed pursuant to 37 CFR 1.530, and any reply thereto by the requester, and should fully apply all relevant grounds of rejection to the claims. ...

It is intended that the second Office action in the reexamination proceeding following the decision ordering reexamination will be made final in accordance with the guidelines set forth in MPEP § 706.07(a).

The patent owner (petitioner) states that the examiner erred in deciding not to enter the June 19, 2009 proposed amendment. The petitioner explained his attempts to submit the amendments suggested at the interview held on April 20, 2009 to address the issues raised in the Final Office action. See page 5 of the petition. Specifically, the patent owner presented reasons why the June 19, 2009 amendment was necessary and not earlier presented. See pages 6-7.

In response to patent owner's arguments that the examiner erred in deciding not to enter the June 19, 2009 proposed amendment, the director finds there is a good and sufficient reason to enter the amendment. Turning to the specific facts of this merged proceeding, the director finds that the June 19, 2009 amendment, on balance, significantly reduces or simplifies the issues for appeal. Specifically, the June 19, 2009 submission proposed amendments that would eliminate numerous issues under 35 USC 112 that were discussed at the interview conducted on April 20, 2009. Therefore, in light of the facts and circumstances of the present situation, the entry of the amendment of June 19, 2009 is considered the best course to further prosecution.

Accordingly, good and sufficient reasons to enter the June 19, 2009 amendment in the merged reexamination proceedings have been provided. In view of the above, the petition, dated August 23, 2009, is GRANTED.

The seven petitions dated December 22, 2009 request entry of amendments filed on August 27, 28 and 30, 2009. Upon review of the record, these amendments, *en total*, are present in the amendment of June 19, 2009 and are considered redundant. Therefore, the seven petitions of December 23, 2009 are DISMISSED.

In summary, the amendment of June 19, 2009 is entered. In view of the complexity of the action/issues, it is further determined that the best course of action at this point is to return this proceeding to the examiner for issuance of a new Final office action.

Conclusion

1. The Patent Owner's petition, dated August 23, 2009, for reconsideration of the decision rendered August 13, 2009 for entry of the amendments presented in the response submitted on June 19, 2009 is GRANTED.

2. The amendment filed June 19, 2009 is entered.

3. The seven petitions filed on December 23, 2009 are DISMISSED as moot in light of the relief provided ingranting the petition of August 23, 2009. 4. The amendment filed August 23, 2009 is entered and considered the most current edition of the claims in this proceeding.

5. The proceeding is returned to the examiner for issuance of a Final office action based of the claims as amended on June 19, 2009.

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

Irem Yucel, Director
Technology Center 1600

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,637	05/16/2007	7,012,512 B2	SA121/000SA	3695

24350 7590 06/03/2011

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/03/2011

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Date:
MAILED
JUN 03 2011
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008637
PATENT NO. : 7012512
ART UNIT : 3992

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JUN 03 2011

CENTRAL REEXAMINATION UNIT

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: (For third party Requester)

Ex Parte Reexamination Proceeding
Control No. 90/008,637
Filed: May 16, 2007
For: U.S. Patent No. 7,012,512

: DECISION
: GRANTING
: PETITION

This is a decision on patent owner's petition entitled "Petition Pursuant to 37 C.F.R. 1.181" filed June 1, 2010. The petition is before the Director of the Central Reexamination Unit for consideration.

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

RELEVANT BACKGROUND

1. On March 16, 2006, the Office issued U.S. Patent No. 7,012,512 (the '512 patent) to St. Denis.

2. A request for *ex parte* reexamination of the '512 patent was received on May 16, 2007, and assigned control number 90/008,637 (the '8637 proceeding).

3. Reexamination was ordered for the '8637 proceeding on June 26, 2007.

4. On December 22, 2008, a non-final action was mailed.

5. On January 21, 2009, an amendment was received from the patent owner (PO), and a final action in response was mailed on August 31, 2009.

6. On September 28, 2009, an after final response was filed by PO, and on October 28, 2009, a Notice of Appeal was filed by PO. On November 14, 2009, the examiner issued an advisory action.

7. On February 16, 2010, an Appeal Brief from PO was accepted and entered into the record, and on March 29, 2010, an Examiner's Answer to the Appeal Brief was mailed.

8. On May 12, 2010, a Reply Brief was filed, and on May 28, 2010 the examiner mailed a Reply Brief Not Considered miscellaneous action.

9. On June 1, 2010, a petition was filed pursuant to 37 C.F.R. 1.181 to enter the reply brief. In addition, a supplemental reply brief was concurrently filed striking "footnote 4" of the originally filed reply brief.

7. This decision addresses the present petition.

Applicable Statute or Regulation

MPEP 1.181 Provides:

§ 1.181 Petition to the Director.

(a) Petition may be taken to the Director:
(1) From any action or requirement of any examiner in the ex parte prosecution of an application, or in ex parte or inter partes prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;
(2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and
(3) To invoke the supervisory authority of the Director in appropriate circumstances. For petitions involving action of the Board of Patent Appeals and Interferences, see § 41.3 of this title.

MPEP 41.41 Provides:

§ 41.41 Reply brief.

(a)(1) Appellant may file a reply brief to an examiner's answer within two months from the date of the examiner's answer.

(2) A reply brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence. See § 1.116 of this title for amendments, affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.33 for amendments, affidavits or other evidence filed after the date of filing the appeal.

(b) A reply brief that is not in compliance with paragraph (a) of this section will not be considered. Appellant will be notified if a reply brief is not in compliance with paragraph (a) of this section.

(c) Extensions of time under § 1.136 (a) of this title for patent applications are not applicable to the time period set forth in this section. See § 1.136 (b) of this title for extensions of time to reply for patent applications and § 1.550 (c) of this title for extensions of time to reply for ex parte reexamination proceedings.

MPEP 41.63 Provides:

§ 41.63 Amendments and affidavits or other evidence after appeal.

(a) Amendments filed after the date of filing an appeal pursuant to § 41.61 canceling claims may be admitted where such cancellation does not affect the scope of any other pending claim in the proceeding.

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

(c) Affidavits or other evidence filed after the date of filing an appeal pursuant to § 41.61 will not be admitted except as permitted by reopening prosecution under § 41.77(b)(1).

DECISION

The present petition has been filed to request that the reply brief filed May 12, 2010, or in the alternative the supplemental Reply Brief filed June 1, 2010, be entered into the record.

The miscellaneous action mailed May 28, 2010 did not enter the reply brief filed May 12, 2010 for two separate reasons. First, the examiner noted that footnote 2 at page 5 of the reply brief contained reference to a US Patent that was not previously considered. Secondly, the examiner noted that footnote 4 at page 10 of the reply brief contained testimony not previously considered. Therefore, the reply brief was not entered as it was considered not in compliance with 37 C.F.R. 41.41 and 41.63 as noted above.

With regards to footnote 2 on page 5 of the reply brief, patent owner has correctly noted that an improper patent number was utilized by the examiner. The correct patent, US Patent No. 7,577,503, was already cited and discussed in the previously filed appeal brief. Therefore, the examiner erred in holding the reply brief not in compliance with regard to this subject.

With regard to footnote 4 at page 10, the examiner's position is well founded. An offer to provide evidence to a stated effect is an argument and/or evidence that such evidence exists and does carry weight. As the record for appeal must be fixed, a reply brief is an inappropriate time for the evidence or the offer to provide the evidence to be first submitted. It is noted that patent owner has submitted a supplemental reply brief on June 1, 2010, which strikes this footnote. Therefore, the aspect of the reply brief that was considered non-compliant will be effectively removed upon entering of the supplemental reply brief. This relief is granted.

Therefore, the current petition is granted to the extent to allow entry of the reply brief filed June 1, 2010. The file will be forwarded to the examiner for notation of the reply brief and forwarding of the file to the Board of Patent Appeals and Interferences for decision.

CONCLUSION

1. Petitioner's request is hereby **granted – in - part**. The June 1, 2010 reply brief is entered.

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
Attn: Central Reexamination Unit
Commissioner for Patents
United States Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX to: (571) 273-9900
Central Reexamination Unit
By hand: Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

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

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

Irem Yucel
Director, Technology Center 1600

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.
90/008,640	05/07/2007	RE35370	5841-04202	3051

27890 7590 08/12/2010

STEPTOE & JOHNSON LLP
1330 CONNECTICUT AVENUE, N.W.
WASHINGTON, DC 20036

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 08/12/2010

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Date:

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AUG 1 2 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008640
PATENT NO. : re35370
ART UNIT : 3900

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

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AUG 12 2010

CENTRAL REEXAMINATION UNIT

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Meyertons, Hood, Kivlin, (For Third Party Requester)
Kowert & Goetzel
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Austin, Texas 78701

In re: Henry
Ex Parte Reexamination Proceeding : DECISION DISMISSING
Control No.: 90/008,640 : PETITION TO REQUEST ENTRY OF
Filed: May 7, 2007 : COLOR PHOTOGRAPHS
For: U.S. Patent No. 5,421,192 :

This is a decision on the June 1, 2010, petition entitled "Petition under 37 C.F.R. 1.182 to request entry of color photographs".

The petition is being treated as a petition under 37 CFR 1.181 and is before the Central Reexamination Unit (CRU) for consideration.

The petition is **dismissed as moot** for the reasons set forth below

DECISION

While the MPEP references color photographs in several instances, those instances relate to drawings (37 CFR 1.84) and models (37 CFR 1.91) in a patent application. It is presently the practice in the Central Reexamination Unit to create an artifact folder when color photographs are received even in the absence of a petition. Accordingly, the present petition is unnecessary and is **dismissed as moot** for that reason. This is not a decision as to the merits of the affidavit or even as to whether the affidavit is properly entered to the record. However, in this proceeding the

affidavit will not be denied entry solely because there are color photographs where patent owner has made a good-faith effort to present the same information in a black-and-white image that is presently in the Image File Wrapper system.

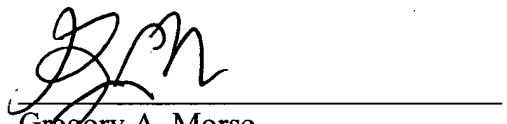
CONCLUSION

1. Petitioner's request is **dismissed as moot** and no fee has been charged.

2. At present, the USPTO has not created an artifact folder for these photographs as they have not been located. The CRU has requested a copy of the physical submission from storage to create an appropriate artifact folder for the examiner. However, Patent Owner is strongly encouraged to contact Manuel Saldana, Paralegal in the CRU, at 571-272-7740 one week from the mail date of this decision to ensure that the USPTO is able to locate the physical copies and create an artifact folder.

3. This is not a decision to enter the affidavit of June 1, 2010. However, should the remainder of the affidavit be suitable for entry, the affidavit will not be denied entry for the presence of color photographs where patent owner has made a good faith attempt to submit black-and-white copies of the same information. As the technology of this proceeding relates to dyes and their fluorescence under various conditions, color shown in a photograph is likely to be important and the examiner should review any resulting artifact folder in preparing the next office action.

4. Telephone inquiries with regard to this decision should be directed to Mark Reinhart, at (571) 272-1611, in the event that he is unavailable, 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.
90/008,640	05/07/2007	RE35370	5841-04202	3051

27890 7590 04/13/2011

STEPTOE & JOHNSON LLP
1330 CONNECTICUT AVENUE, N.W.
WASHINGTON, DC 20036

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/13/2011

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Date:

MAILED

APR 13 2011

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008640
PATENT NO. : re35370
ART UNIT : 3900

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

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

Decision Granting 37 CFR 1.59 Petition in Reexamination	Control No.: 90/008,640

1. The petition under 37 CFR 1.59 to expunge proprietary, protective order and/or trade secret documents under 37 CFR 1.59 filed 19 December 2008 is granted.

2. The Patent owner's representative requests expungement of document(s) that have been filed under MPEP 724.02. The examiner has determined that the information in such document(s) presented under seal are not material to patentability in the instant reexamination proceeding. Further, the petitioner has complied with all of the requirements of MPEP 724.05.

   A. ☒ Since the petition does not specify otherwise, the documents have been:
      i. ☒ Destroyed.
      ii. ☐ Expunged.

   B. ☐ Other/Comment:

3. CONCLUSION

   Telephone inquiries with regard to this decision should be directed to Mark Reinhart at 571-272-1611, SPE AU 3992. In his/her absence, calls may be directed to Eric Keasel at 571-272-4929, SPE in AU 3992 in the Central Reexamination Unit

/Mark Reinhart/	SPE AU 3992
[*Signature*]	(Title)

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

WAKE FOREST UNIVERSITY HEALTH SCIENCES
Patent Owner

DEC 22 2010

SUSAN G. L. GLOVSKY
Third Party Requester – *Ex parte* Reexamination Control 90/008,693

SMITH & NEPHEW, INC. and BLUESKY MEDICAL GROUP, INC.
Third Party Requester – *Inter partes* Reexamination Control 95/001,048

Merged *Ex parte* and *Inter partes* Reexamination Control 90/008,693 and 95/001,048
Patent 7,216,651

ORDER VACATING DECISION ON PETITION

This Order is responsive to Patent Owner's "Petition Under 37 C.F.R. § 1.181(a)(3)," filed December 12, 2010 ("Petition"). The Petition seeks reversal of the Decision on Petition entered November 10, 2010 denying entry of Patent Owner's Respondent Brief filed July 14, 2010, and further seeks entry of the Respondent Brief.

FINDINGS

1. On November 10, 2010, the Chief Administrative Patent Judge entered a Decision on Petition denying Patent Owner's petition seeking a

waiver of the page/word limits for Patent Owner's Respondent Brief filed July 14, 2010.

2. In the present Petition, Patent Owner argues, *inter alia,* that the Chief Administrative Patent Judge has no authority to decide petitions concerning appeal briefs filed earlier than August 17, 2010 in *inter partes* reexamination proceedings, citing 75 Fed. Reg. 50,750-51 (Aug. 17, 2010). Petition, pp. 5-6.

DICUSSION

As correctly argued by Patent Owner, in regard to appeal briefs in reexamination proceedings filed on or after August 17, 2010, the Federal Register Notice of August 17, 2010 expressly provides that the Chief Judge "will address any inquiries and petitions regarding entry of [such] appeal briefs." However, the Federal Register Notice does not expressly preclude the Chief Judge from deciding petitions concerning briefs filed earlier than August 17, 2010. Patent Owner has not cited any statute, rule or written guideline (MPEP) that requires such preclusion.

Notwithstanding the foregoing, the Office is desirous that its procedures be clearly understood as expressed by applicable statutes, rules and guidelines. In this situation, it is understandable how the relevant Federal Register Notice could be interpreted as precluding the Chief Judge from deciding petitions concerning appeal briefs filed before August 17, 2010.

DECISION

In view of the forgoing, the present Petition is GRANTED to the extent that the Decision on Petition of November 10. 2010 is vacated and the Petition of July 14, 2010 is remanded to the Office of Patent Legal Administration for disposition.

James T. Moore
Acting Chief Administrative Patent Judge

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,693	10/05/2007	7,216,651	0101-P00636US8	4961

110 7590 06/06/2011

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/06/2011

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Date:
MAILED
JUN 06 2011
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

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

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

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

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JUN 06 2011

CENTRAL REEXAMINATION UNIT

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

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

DECISION

GRANTING

PETITION

This is a decision on patent owner's petition entitled "Petition by Patent Owner Under 37 C.F.R. 1.183 to Suspend or Waive the Page and/or Word Count Limits of 37 C.F.R. 1.943", filed on July 14, 2010 (the July 14, 2010 patent owner petition).

This decision also addresses two respondent's briefs filed by patent owner on July 14, 2010.

The July 14, 2010 patent owner petition, the July 14, 2010 patent owner respondent's briefs, and the record as a whole, are before the Office of Patent Legal Administration (OPLA).

SUMMARY

Patent owner's July 14, 2010 petition is **granted to the extent that** patent owner's concurrently-filed 42-page respondent brief with accompanying appendices is deemed to be **page-length compliant**. Specifically, the provisions of 37 CFR 1.943(c) are being **waived**, and the format requirements set forth in this decision for waiver under 37 CFR 1.183 of the provisions of 37 CFR 1.943 are being ***sua sponte*** **waived, to the extent that** patent owner's 42-page respondent brief with accompanying appendices, filed on July 14, 2010, is deemed to be page-length compliant.

Patent owner's 14-page respondent's brief with an accompanying appendix filed on July 14, 2010 is **improper**, and has been **expunged from the official record** by closing this paper in the Office's Image File Wrapper (IFW) database, and by marking it "non-public".

DECISION

On December 22, 2010, the Board of Patent Appeals and Interferences (Board) mailed a decision in this merged reexamination proceeding, granting an earlier-filed petition by patent owner[1] that requested supervisory review of a previous Board decision mailed on November 10, 2010. The Board's December 22, 2010 decision 1) grants patent owner's earlier-filed petition to the extent that the Board's November 10, 2010 decision is vacated; and 2) remands patent owner's July 14, 2010 petition to the Office of Patent Legal Administration (OPLA).

In view of the Board's remand of patent owner's July 14, 2010 petition, this decision is limited to a procedural analysis of the July 14, 2010 petition, and to a procedural analysis of the compliance of two patent owner's respondent's briefs, both of which were filed on July 14, 2010, with the provisions of 37 CFR 1.943, including the requirements of 37 CFR 1.52 pursuant to 37 CFR 1.943(a), and the page limit requirements set forth in 37 CFR 1.943(c). Thus, this decision does not analyze or otherwise address the content of patent owner's July 14, 2010 respondent's briefs pursuant to 37 CFR 41.68.

The patent owner requests waiver under 37 CFR 1.183 of the 15-page limit set forth in 37 CFR 1.943(c) for its July 14, 2010 42-page respondent's brief[2] with accompanying appendices. After brief review, a total of 42 pages of this brief is determined to be subject to the page limit.[3]

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party.

In support of its request for waiver of 37 CFR 1.943, the patent owner argues that the *inter partes* requester "seeks review on appeal of . . . 57 originally proposed grounds of rejection, based on 18 references, against all 125 claims, including 12 independent claims of Patent Owner's '651 patent". The 57 originally proposed grounds, now on appeal, includes 30 grounds of rejection proposed by the *inter partes* requester, which the examiner determined not to adopt in the first non-final Office action that was mailed after merger of the *ex parte* and *inter partes* reexamination proceedings. The patent owner asserts that for this reason, it "has had no occasion to make arguments with respect to these 30 [non-adopted] proposed grounds that have already been fully argued by [the *inter partes* requester] in their . . . Request and . . . [accompanying] claim chart," which are referenced in *inter partes* requester's appellant brief. Thus, the patent owner requests waiver of the provisions of 37 CFR 1.943(c) to permit the entry of its July 14, 2010 42-page respondent's brief with accompanying appendices, which is asserted by the patent owner to be in 11 point font, in lieu of its concurrently-filed 14-page respondent's brief.

---

[1] The patent owner's earlier-filed petition was filed on December 10, 2010.
[2] Excluding the table of contents.
[3] The accompanying appendices are not deemed to be subject to the page limit.

In order to obtain a waiver of the page length requirements of 37 CFR 1.943, however, any grantable petition under 37 CFR 1.183 must be accompanied by a submission that:

1) is one-and-a-half or double-spaced;
2) is in a non-script type font (e.g., Arial, Times New Roman, or Courier);
3) **has a font size no smaller than 12-point;**
4) conforms to the margin requirements of 37 CFR 1.52(a)(1)(ii); and
5) has sufficient clarity and contrast to permit direct reproduction of readily legible copies in any number by use of photographic, electrostatic, photo-offset, and microfilming processes and electronic capture by digital imaging and optical character recognition pursuant to 37 CFR 1.52(a)(1)(v).

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

In view of the specific circumstances of the present merged proceeding, the provisions of 37 CFR 1.943(c) are being **waived**, and the above-identified format requirements for waiver under 37 CFR 1.183 of the provisions of 37 CFR 1.943 are being ***sua sponte*** **waived, to the extent that** patent owner's July 14, 2010 42-page respondent brief with accompanying appendices is deemed to be **page-length compliant**.[4]

The patent owner also argues that "Patent Owner, concurrently with this Petition, has already filed a Respondent's Brief that complies with the page requirements of 37 CFR 1.943(c) and the form requirements of 37 CFR 1.943(a)". The patent owner appears to be referring to its 14-page respondent brief[5] with an accompanying appendix, also filed on July 14, 2010. However, the 14-page respondent's brief with an accompanying appendix filed on July 14, 2010 is not readily legible when reproduced, in this case, by scanning, contrary to 37 CFR 1.52(a)(1)(v).[6] For this reason, patent owner's 14-page respondent's brief and accompanying appendix filed on July 14, 2010 is **improper**, and has been **expunged from the official record** by closing this paper in the Office's Image File Wrapper (IFW) database, and by marking it "non-public".

CONCLUSION

- The July 14, 2010 patent owner petition is **granted to the extent that** patent owner's concurrently-filed 42-page respondent brief with accompanying appendices is deemed to be **page-length compliant**. Specifically, the provisions of 37 CFR 1.943(c) are being **waived**, and the format requirements set forth in this decision for waiver under 37 CFR

---

[4] The patent owner is reminded, when filing future papers in *inter partes* reexamination proceedings with the Office, of the format requirements for waiver under 37 CFR 1.183 of the provisions of 37 CFR 1.943.

[5] The brief is believed to be 14 pages long, excluding the appendix, based on the page number appearing beneath the signature block of the last page of text.

[6] 37 CFR 1.52(a)(1)(v) provides, in pertinent part (emphasis added):

> [All papers must be] [p]resented in a form having sufficient clarity and contrast between the paper and the writing thereon **to permit the direct reproduction of readily legible copies** in any number by use of photographic, electrostatic, photo-offset, and microfilming processes and electronic capture by use of digital imaging and optical character recognition.

1.183 of the provisions of 37 CFR 1.943 are being ***sua sponte*** **waived, to the extent that** patent owner's 42-page respondent brief with accompanying appendices, filed on July 14, 2010, is deemed to be page-length compliant.

- Patent owner's 14-page respondent's brief and accompanying appendix filed on July 14, 2010 is **improper**, and has been **expunged from the official record** by closing this paper in the Office's Image File Wrapper (IFW) database, and by marking it "non-public".

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

Cynthia L. Nessler

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

6/02/11

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,693	10/05/2007	7,216,651	0101-P00636US8	4961

110 7590 02/23/2012

DANN, DORFMAN, HERRELL & SKILLMAN
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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 02/23/2012

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

110 7590 02/23/2012

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 02/23/2012

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

WAKE FOREST UNIVERSITY HEALTH SCIENCES
Patent Owner

SUSAN G. L. GLOVSKY
Third Party Requester – *Ex parte* Reexamination Control 90/008,693

SMITH & NEPHEW, INC. and BLUESKY MEDICAL GROUP, INC.
Third Party Requester – *Inter partes* Reexamination Control 95/001,048

Merged *Ex parte* and *Inter partes* Reexamination Control 90/008,693 and 95/001,048
Patent 7,216,651

DECISION ON PETITION

This is a decision on Patent Owner's "Petition Under 37 C.F.R. § 1.183," filed November 22, 2011 ("Petition") to:

> suspend or waive 37 C.F.R. § 1.939 to grant Patent Owner leave to submit a response to that portion of the Appellant/Requester Smith & Nephew . . . Rebuttal Brief which discusses material entered into the IFW after the date of filing the appeal and after the due date for submission of Patent Owner's Respondent Brief.

Petition, 1 (emphasis in original).

FINDINGS

1. On May 15, 2007, the Office issued Patent 7,216,651 ("'651 patent"), which is assigned to Wake Forest University Health Sciences ("Wake Forest").

2. On October 5, 2007, Susan G. L. Glovsky filed a request for *ex parte* reexamination of the '651 patent.

3. On November 26, 2007, the Office ordered *ex parte* reexamination of the '651 patent under control number 90/008,693.

4. On May 30, 2008, Smith & Nephew, Inc. and BlueSky Medical Group, Inc. (Smith & Nephew) filed a request for *inter partes* reexamination of the '651 patent.

5. On August 4, 2008, the Office ordered *inter partes* reexamination of the '651 patent under control number 95/001,048.

6. On October 14, 2008, the Office ordered that the *ex parte* and *inter partes* reexamination proceedings be merged.

7. Prosecution continued until the Office entered a Right of Appeal Notice (RAN) on March 12, 2010, confirming claims 1-125.

8. On April 12, 2010, Smith & Nephew filed a Notice of Appeal.

9. On June 14, 2010, Smith & Nephew filed an Appellant Brief.

10. On July 14, 2010, Wake Forest filed a Respondent Brief.

11. On October 18, 2010, the U.S. District Court for the Western District of Texas entered a judgment holding claims of the '651 patent invalid under 35 U.S.C. § 103.

12. On October 19, 2010, Smith & Nephew submitted a copy of the Texas Court judgment to the Office.

13. Also on October 19, 2010, Wake Forest submitted a copy of the Texas Court judgment to the Office.

14. On September 30, 2011, the Examiner entered an Examiner's Answer.

15. On October 31, 2011, Smith & Nephew filed a Rebuttal Brief presenting, *inter alia*, arguments based on the Texas Court judgment.

RELEVANT LEGAL AUTHORITY

37 C.F.R § 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.

Concerning the contents of a rebuttal brief filed by a requester in an *inter partes* reexamination proceeding, 37 C.F.R. § 41.71 specifies that:

> (c) (1) The rebuttal brief of any requester may be directed to the examiner's answer and/or the respondent brief of the owner.
>
> (2) The rebuttal brief of a requester may not be directed to the respondent brief of any other requester.
>
> (3) No new ground of rejection can be proposed by a requester.
>
> (4) The rebuttal brief of a requester shall not include any new or non-admitted affidavit or other evidence. See § 1.116(d) of this title for affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.63(c) for affidavits or other evidence filed after the date of filing the appeal.

With respect to suspension or waiver of the rules, 37 C.F.R. § 1.183 provides:

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

As stated in 75 Fed. Reg. 50750 (Aug. 17, 2010):

> The Chief Judge of the Board . . . or his designee . . . will have the sole responsibility for determining whether appeal briefs filed in inter partes reexamination proceedings . . . comply with the applicable regulations . . . .

DISCUSSION

Pursuant to Rule 41.71(c), if Smith & Nephew's Rebuttal Brief were to present any new rejection or evidence, the Brief should be expunged. However, it appears that the Rebuttal Brief presents no new rejection or evidence but new arguments which arise from the Texas Court judgment in support of rejections that were proposed during prosecution of the present merged reexamination proceedings.

It cannot be disputed that, due to the timing of Wake Forest's Respondent Brief, filed July 14, 2010, and the Texas Court judgment, entered October 18, 2010, Wake Forest has not had an opportunity to address on the record in the present merged reexamination proceedings its position on the rationale applied by the Texas Court in holding claims of the '651 patent invalid. The situation in which the timing in an *inter partes*

reexamination proceeding appeal allows a requester to rely upon a newly entered district court judgment adverse to the patent in reexamination without the patent owner having an opportunity to respond is rare and extraordinary. Pursuant to Rule 1.183, in such a situation, the Office has authority to waive applicable rules. Accordingly, Wake Forest will be granted leave to respond to Smith & Nephew's arguments based on the Texas Court judgment.

DECISION

In view of the foregoing, Wake Forest's Petition is GRANTED and Wake Forest is given twenty-one days in which to file a response to the arguments presented in Smith & Nephew's Rebuttal Brief concerning the Texas Court judgment.

Smith & Nephew is given twenty-one days following the filing of Wake Forest's response in which to file a reply to such response.

Both Wake Forest's response and Smith & Nephew's reply are limited to ten pages.

James Donald Smith
Chief Administrative Patent Judge

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FEB 17 2011

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(For Patent Owner)

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(For Requester)

In re Keich *et al.*
Ex Parte Reexamination Proceeding
Control No. 90/008,751
Filed: June 29, 2007
For: U.S. Patent No. 6,846,477 B2

DECISION ON REQUEST FOR RECONSIDERATION

This is a decision on the April 22, 2010 patent owner petition entitled "PETITION UNDER § 1.181 REQUESTING RECONSIDERATION." This petition is read as requesting reconsideration of the March 23, 2010 Office decision dismissing the prior petition under § 1.182. Patent owner requests that "should this Petition be denied, such denial constitute[] final agency action."

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

For the reasons set forth below, the petition under 37 CFR 1.181(a)(3) requesting reconsideration of the March 23, 2010 decision is granted to the extent that the prior decision has been fully reconsidered, and the petition is denied as to the underlying relief requested.

This decision is designated as a final agency action under 5 U.S.C. § 704 for the purposes of seeking judicial review.

BACKGROUND

1. On June 29, 2007, a request for *ex parte* reexamination was filed by the third party requester, and the resulting reexamination proceeding was assigned control number 90/008,751 ("the '8751 proceeding").

2. Reexamination of claims 1-4, 6-12, and 14-17 was ordered in an Office decision issued on September 20, 2007.

3. On January 8, 2008, a nonfinal Office action was issued that included rejections based upon WO 94/07531 (Bhogal '531).

4. On August 15, 2008, patent owner submitted claim amendments and remarks in response to the nonfinal Office action, and in particular, to the rejection over Bhogal '531.

5. On October 8, 2008, the Office mailed a final Office action in which the rejections over Bhogal '531 were withdrawn, as stated on page 5 of that action, in view of the August 15, 2008 amendment to claim 1 in which the phrases "consisting essentially of administering a single dose of vaccination" and "wherein said animal is not derived from a *M. hyopneumoniae* vaccinated animal" were added.

6. On January 21, 2009, the Office mailed an advisory Office action denying entry of after-final claim amendments submitted on January 8, 2009, as raising new issues, as being noncompliant with 37 C.F.R. § 1.530(f), and as proposing to amend a claim not subject to reexamination.

7. On February 6, 2009, patent owner submitted a supplemental (second) amendment after final rejection, and on February 7, 2009, patent owner filed a Notice of Appeal.

8. On March 5, 2009, an advisory Office action was mailed refusing entry of the February 6, 2009 patent owner supplemental amendment. The advisory action stated that "the proposed amendment to claim 1 would re-raise prior art rejections over Bhogal et al," and that other new issues would be raised through entry of the amendment, which would not overcome the prior art rejection of record.

9. On March 25, 2009, an interview was held between the patent owner's representative and Office staff. Patent owner's statement summarizing the interview was filed on April 7, 2009, and stated on page 1 that the proposed amendment would "concisely limit and focus the issues that will be present on appeal, in order to facilitate review by the Board or a Court, and that thus, on this basis, the amendments should be entered of record for further consideration."

10. On May 4, 2009, patent owner submitted a (third) after-final submission - a request for reconsideration, in which the "wherein said animal is not derived from a *M. hyopneumoniae* vaccinated animal" language was removed from claim 1.

11. On May 7, 2009, patent owner timely submitted an Appeal Brief.

12. On July 17, 2009, the Office mailed a final Office action, withdrawing the previous final Office action of October 8, 2008, entering the May 4, 2009 patent owner submission and amendment, and rejecting all of the claims under reexamination, including rejections over Bhogal '531.

13. On September 16, 2009, patent owner submitted a (fourth) after-final submission [1] including claim amendments, a declaration by Dr. Foss, and an Information Disclosure Statement.

14. On September 29, 2009, the Office issued an advisory Office action entering the proposed amendment and declaration by Dr. Foss, and maintaining certain rejections set forth in the final Office action of July 17, 2009. A further advisory Office action, issued on October 7, 2009, clarified that the Foss declaration was considered, but was insufficient to overcome the art rejections.

15. On November 2, 2009, patent owner filed a (fifth) after-final submission, including a second declaration by Dr. Foss, and an Information Disclosure Statement.

16. On November 12, 2009, the Office issued an advisory action refusing entry of the November 2, 2009 response, including the second Foss declaration, as the declaration was stated not to overcome the art rejections of record, and as the patent owner "has not provided a sufficient reason why the declaration is necessary and was not presented with the After final amendment filed on 9/16/09."

17. On November 16, 2009, patent owner filed a petition under 37 C.F.R. § 1.181," requesting entry of the evidence submission and remarks filed on November 2, 2009.

18. On November 17, 2009, patent owner filed a notice of appeal; patent owner filed a request for oral hearing on November 18, 2009.

19. On January 19, 2010, patent owner filed an appeal brief.

20. Also on January 19, 2010, the Office mailed a decision denying patent owner's petition under § 1.181, as lacking a good and sufficient reason why the second declaration was not earlier presented.

21. On February 26, 2010, patent owner filed a petition entitled "PETITION UNDER § 1.182 REQUESTING CONTINUED REEXAMINATION," requesting entry of the declaration and remarks filed on November 2, 2009.

22. On March 23, 2010, the Office mailed a decision dismissing patent owner's February 26, 2010 petition.

23. On April 22, 2010, patent owner filed the instant petition entitled "PETITION UNDER § 1.181 REQUESTING RECONSIDERATION."

24. On October 21, 2010, the Office issued an examiner's answer to the appeal brief.

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[1] *E.g.*, the first after-final submission with respect to the July 17, 2009 final Office action.

25. On December 21, 2010, patent owner filed a reply brief.

26. On January 13, 2011, the appeal was docketed at the Board of Patent Appeals and Interferences (BPAI), and assigned Appeal No: 2011-004052.

27. On January 25, 2011, a Notice of Appeal Hearing, setting a hearing date of April 6, 2001, was mailed.

28. On February 11, 2011, jurisdiction over the proceeding was transferred to the Office of Patent Legal Administration by the Board of Patent Appeals and Interferences for treatment of the April 22, 2010 patent owner petition for the sole purpose of treating this petition.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 CFR 1.181(a) provides:

Petition may be taken to the Director:

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

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

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

37 CFR 1.182 provides:

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

DECISION ON PETITION UNDER 37 C.F.R § 1.181

I. Issues Raised and Relief Requested

Patent owner requests that prosecution be reopened so that the November 2, 2009 "Foss II declaration" will be entered and considered. The "Foss II declaration" was denied entry in the advisory Office action of November 12, 2009, and the examiner's decision was upheld in the §

1.181 petition decision of January 19, 2010. On February 25, 2010, patent owner filed a petition under § 1.182 seeking entry of these papers and declaration, which were alleged, at pages 5-6 of the petition, to focus and narrow the issues for appeal by supplying additional references that "directly cast doubt upon" the basis of the rejections of the claims over Bhogal, and patent owner seeks entry of this evidence "to address any further rejections and/or rebuttals." That petition was dismissed in an Office decision issued on March 23, 2010. The March 23, 2010 decision found the petition failed to establish that entry of the "Foss II declaration" would define the issues for appeal such that continued prosecution is warranted.[2] The decision also found that the petition failed to establish that it addressed any issue that had not arisen at an earlier point in the reexamination proceeding.[3] Accordingly, the February 25, 2010 petition was dismissed.

In this request for reconsideration of that decision, patent owner argues that the previous dismissal ignores the fact that (1) the examiner's response is not clear to the patentee, and to the extent that it is clear, it is erroneous, and (2) entry of the "Foss II declaration" would serve directly to advance prosecution.

II. Basis for the Requested Relief

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."[4] 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.

III. Findings and Analysis

The filing of such a § 1.182 petition is strictly controlled by the Office so as to further the statutory mandate of 35 U.S.C. § 305 that "[a]ll reexamination proceedings under this section . . . will be conducted with **special dispatch** within the Office" [emphasis added]. The present proceeding has reached a point where the appeal has been briefed, answered, and docketed at the BPAI with a hearing date having been set. Granting continued reexamination at this stage would require drawing the case back from an advanced state of the appeal process. Regressing the proceeding from its advanced appeal stage, as requested by the instant petition, does not facilitate handling of the proceeding with special dispatch.

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[2] The March 23, 2010 decision stated "35 U.S.C. § 305 (for *ex parte* reexamination) and 35 U.S.C. § 314 (for *inter partes* reexamination) mandate that reexamination proceedings must be conducted "with special dispatch within the Office." Accordingly, the patent owner must make a *bona fide* effort, in the submission accompanying the § 1.182 petition, to define the issues for appeal, or the issuance of a reexamination certificate, since this is a key factor in reducing pendency of a reexamination proceeding. The petition should therefore clearly discuss the manner in which the entry of the submission would so act such that continued prosecution is warranted."

[3] The March 23, 2010 decision further stated "Thus, a petition for continuation of the reexamination prosecution should explain why the patent owner did not become aware of the need for the new amendment or evidence earlier in the prosecution (i.e., before issuance of the final rejection)."

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

It in the above-mentioned (see part II above) 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, it is stated that "patent owners are advised to use either: (1) the petition procedure under 37 CFR 1.181 to seek review of a denial of entry of an amendment submitted after final rejection in an *ex parte* reexamination proceeding ... or (2) the petition procedure under 37 CFR 1.182 to seek relief that is not currently provided by an existing rule" [emphasis added]. The § 1.182 petition was created to address, in an *ex parte* reexamination proceeding, a need for an amendment or evidence submission, the need for which was not apparent to patent owner until the issuance of the final rejection, because of an issue raised for the first time at final rejection. It was not created for the purpose of permitting the patent owner to obtain entry of an amendment or evidence after the filing of an appeal brief, at which point the examiner has already begun considering the issues of the existing situation. At that point, the examiner would be required to do unjustified re-work to consider the newly proffered amendment or evidence submission, and the proceeding would be delayed. This clearly runs contrary to special dispatch. If such a § 1.182 petition is to be filed, it is to be filed as the Notice states - after final rejection in an *ex parte* reexamination proceeding such that delay is minimized.

Even if the § 1.182 and reconsideration petitions in this case had been filed prior to filing the appeal brief, the § 1.182 petition would not have been grantable, because neither of petitioner's grounds for seeking reconsideration are persuasive.

Patent owner's first asserted ground for reconsideration of the March 23, 2010 decision contends that the examiner's response is not clear to the patentee, and to the extent that it is clear, it is erroneous.[5] However, an asserted question of clarity of a ground of rejection is not a matter for a petition for § 1.182, which only covers matters not otherwise provided for. Petitions for relief from an asserted lack of clarity of a ground of rejection by an examiner are provided for under § 1.181. Such a petition under § 1.181 was advanced by patent owner on November 16, 2009, and was denied on January 19, 2010, and no reconsideration of that denial was petitioned for. Therefore, such arguments addressing error in an action taken by an examiner, as presented in patent owner's first ground, are not persuasive to grant relief under § 1.182.

Patent owner's second asserted ground for reconsideration of the March 23, 2010 decision contends that the patentee's response of November 2, 2009, including the "Foss II Declaration," "serves directly to advance prosecution." [6] The petition does not detail how entry would directly advance prosecution, except in that such would "demonstrate that the Examiner's interpretation of the cited references is flawed." [7] However, as stated in the March 23, 2010 decision, patent owner's response is not persuasive as to the reasons why such an evidence submission addressing this issue could not have been presented prior to the July 17, 2009 final Office action. To the contrary, this issue had been raised by the Office in the first Office action of January 8,

[5] Reconsideration Petition, at 2-5.
[6] Reconsideration Petition, at 4.
[7] Reconsideration Petition, at 4.

2008, argued in patent owner's response of June 20, 2008, and addressed by evidence filed by patent owner on September 16, 2009. [8]

Neither of patent owner's grounds for seeking reconsideration of the previous petition are persuasive as to error in the previous decision under § 1.182. As stated in the previous decision, patent owner has had numerous opportunities to present the November 2, 2009 Foss evidence submission and failed to do so earlier. Neither patent owner, nor the file history, provides reasons why the contents of the November 2, 2009 submission could not have been presented at an earlier date, nor explains the manner in which entry of the submission would advance the proceedings such that a reopening of the prosecution is warranted at this late stage of the proceeding. It is to be noted that the resolution of the substantial new question of patentability is this proceeding has previously been delayed for reopening of prosecution to enter an after-final amendment submitted by patent owner to place the proceeding in better condition for appeal.

In view of these facts, reopening of the prosecution to consider this evidence submission at this stage in the proceedings, in which a date for oral briefing has been set, would inappropriately validate the unnecessary delay (by patent owner) in presenting the instant evidence submission in this proceeding contrary to the requirement of "special dispatch within the Office."

Based on the facts and circumstances of the present situation, it is found that petitioner patent owner's response is not deemed to provide the requisite *bona fide* effort in a manner consistent with the requirement of 35 U.S.C. § 305 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 denied.

CONCLUSION

1. The patent owner petition requesting reconsideration of the March 23, 2010 decision is granted to the extent that the prior decision has been fully reconsidered, and is denied as to the underlying relief requested.

2. This decision is designated as a final agency action under 5 U.S.C. § 704 for purposes of seeking judicial review. See MPEP 1002.02.

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

4. Any inquiry concerning this decision should be directed to Michael Cygan, Legal Advisor, at (571) 272-7700.

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[8] See the detailed account of the patent owner and Office position on the issue in the March 23, 2010 decision, dismissing patent owner's petition under § 1.182.

5. Any further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop
Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

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

February 15, 2010
Kenpet8/

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,751	06/29/2007	6846477		2036

23913 7590 10/13/2011

PFIZER INC
Mary J Hosley
150 EAST 42ND STREET
MS: 150/02/E112
NEW YORK, NY 10017-5612

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 10/13/2011

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PFIZER, INC.

Appeal 2011-004052
Reexamination Control 90/008,751
Patent 6,846,477 B2
Technology Center 3900

DECISION ON PETITION

This is a decision on the patent owner's "PETITION UNDER 37 C.F.R. §1.198," filed September 14, 2011 ("Petition"). The Petition requests "reopening prosecution for the purpose of amending claim 1 to include a wherein clause that the vaccine in the claimed method is capable of providing protection to 'both' seropositive and seronegative animals." (Petition 2). The petition fee of $400 pursuant to 37 C.F.R. § 1.17(f) has not yet been charged to Petitioner's deposit account, although Petitioner provides the authorization in the Petition.

FINDINGS

1) On June 29, 2007, a third party filed a Request for Ex Parte Reexamination.

2) On September 20, 2007, an Order Granting *Ex Parte* Reexamination was mailed to Petitioner. Claims 1-4, 6-12, and 14-17 were subject to reexamination, while claims 5 and 13 were not.

3) On January 8, 2008, a non-final rejection was mailed to Petitioner. Claims 1-4, 6-12, and 14-17 were rejected.

4) On June 20, 2008, Petitioner filed a response to the non-final rejection and an amendment amending claims 1 and 4, and adding claim 18.

5) On July 30, 2008, a Notice of Defective Paper was mailed to Petitioner. The Notice stated that the claim amendments were in improper form.

6) On August 15, 2008, Petitioner filed a Supplemental Response putting the claim amendments in proper form.

7) On October 8, 2008, a final rejection was mailed to Petitioner. Claims 1-4, 6-12, and 14-18 were rejected.

8) On January 8, 2009, Petitioner filed an after final amendment amending claims 1-6, 8-12, 14, 15, 17, and 18, and adding claim 19.

9) On January 12, 2009, an advisory action was mailed to Petitioner indicating that the amendment filed January 8, 2009 was not entered into the record.

10) On February 6, 2009, Petitioner filed an after final amendment amending claims 1, cancelling claim 18, and adding claim 19.

11) On February 7, 2009, Petitioner filed a Notice of Appeal.

12) On March 5, 2009, an advisory action was mailed to Petitioner indicating that the amendment filed February 6, 2009, was not entered into the record.

13) On May 4, 2009, Petitioner filed an after final amendment amending claim 1, and cancelling claim 18.

14) On May 7, 2009, Petitioner filed an Appeal Brief.

15) On July 17, 2009, a second final rejection was mailed to Petitioner rejecting claims 1-4, 6-12, and 14-17 and entering the amendment filed May 4, 2009.

16) On September 16, 2009, Petitioner filed an after final amendment amending claims 1 and 2.

17) On September 29, 2009, an advisory action was mailed to Petitioner entering the amendment filed September 16, 2009.

18) On November 2, 2009, Petitioner filed an after supplemental reply after final action including further arguments, references and a declaration of Dr. Dennis L. Foss under 37 C.F.R. § 1.132, but no amendments to the claims.

19) On November 12, 2009, an advisory action was mailed to Petitioner. The supplemental reply filed November 2, 2009, was not entered into the record.

20) On November 16, 2009, Petitioner filed a petition under 37 C.F.R. § 1.181 requesting entry of the supplemental reply and declaration filed November 2, 2009.

21) On November 17, 2009, Petitioner filed a Notice of Appeal.

22) On January 19, 2010, Petitioner filed an appeal brief, a declaration under 37 C.F.R. § 1.132 and an information disclosure statement containing 16 references.

23) Also on January 19, 2010, a decision denying the petition filed November 16, 2009, was mailed to Petitioner.

24) On February 26, 2010, Petitioner filed a petition requesting continued reexamination under 37 C.F.R. § 1.182.

25) On March 23, 2010, a decision dismissing the petition filed February 26, 2009, was mailed to Petitioner.

26) On April 22, 2010, Petitioner filed a petition requesting reconsideration of the petition filed February 26, 2010.

27) On October 21, 2010, an Examiner's Answer was mailed to Petitioner.

28) On December 21, 2010, Petitioner filed a Reply Brief.

29) On January 6, 2011, an acknowledgement of the Reply Brief was mailed to Petitioner.

30) On February 17, 2011, a decision denying the petition requesting reconsideration filed April 22, 2010, was mailed to Petitioner.

31) On May 18, 2011, Petitioner provided arguments at oral hearing.

32) On June 16, 2011, a transcript of the May 18, 2011, oral hearing was mailed to Petitioner.

33) On July 15, 2011, a Decision on the appeal was mailed to Petitioner.

34) On September 14, 2011, Petitioner filed the instant Petition with a Request for Rehearing and an amendment amending claim 1.

RELEVANT AUTHORITY

35 U.S.C. § 305 states

> After the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title. In any reexamination proceeding under this chapter, the patent owner will be permitted to propose any amendment to his patent and a new claim or claims thereto, in order to distinguish the invention as claimed from the prior art cited under the provisions of section 301 of this title, or in response to a decision adverse to the patentability of a claim of a patent. No proposed amended or new claim enlarging the scope of a claim of the patent will be permitted in a reexamination proceeding under this chapter. All reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office.

37 C.F.R. § 1.182 states

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

37 C.F.R. § 1.198 states

> When a decision by the Board of Patent Appeals and Interferences on appeal has become final for judicial review, prosecution of the proceeding before the primary examiner will not be reopened or reconsidered by the primary examiner except under the provisions of § 1.114 or § 41.50 of this title without the written authority of the Director, and then only for the consideration of matters not already adjudicated, sufficient cause being shown.

MPEP § 1002.02(c)(1) states

> Petitions and Requests Decided by the Technology Center Directors
>
> 1. Petitions or requests to reopen prosecution of patent applications or to reinstate a rejection after decision by the Board of Patent Appeals and Interferences under 37 CFR 1.198, where no court action has been filed.

MPEP § 1214.07 states

> Sometimes an amendment is filed after the Board's decision which does not carry into effect any recommendation made by the Board and which presents a new or amended claim or claims. In view of the fact that prosecution is closed, the appellant is not entitled to have such amendment entered as a matter of right. However, if the amendment is submitted with a request for continued examination (RCE) under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e), prosecution of the application will be reopened and the amendment will be entered. [] If the amendment obviously places an application in condition for allowance, regardless of whether the amendment is filed with an RCE, the primary examiner should recommend that the amendment be entered, and with the concurrence of the supervisory patent examiner, the amendment will be entered.

ARGUMENT

Appellants, in their current Petition, argue:

> [T]he Board affirmed one of the Examiner's grounds of rejection of the claim, but the Board reasonably suggested that a claim requiring that the vaccine in the claimed method is effective to treat "both" seropositive and seronegative animals would distinguish the prior art cited in the rejection. The Board, however, refused to exercise its discretion to permit amendment under 37 C.F.R. § 41.50(c). Because the referenced patent is in reexamination, neither the filing of a continuation application nor the submission of a Request for Continued Examination is permitted. Accordingly, reopening prosecution by granting this Petition is the most efficient and equitable, if not the only viable, means by which Appellant can make the amendment.

Petition 2.

DISCUSSION

Petitioner filed both a Request for Rehearing and the instant PETITION UNDER 37 C.F.R. §1.198 at the same time. The Request for Rehearing is properly before the Board, but a petition to reopen prosecution under 37 C.F.R. §1.198 is a matter for the Patent Examination Corps decision. MPEP 1002.02(c)(1). This petition is premature, as jurisdiction has not yet passed to the Patent Examination Corps.

DECISION

For the reasons set forth above, the Petition is DISMISSED.

James Donald Smith
Chief Administrative Patent Judge

Third Party Requester:

JUDY JARECKI-BLACK, PH.D, J.D.
MERIAL LIMITED
3239 SATELITTE BLVD
DULUTH, GA 30096-4640

Patent Owner:

PFIZER INC
150 EAST 42ND STREET
MS: 150/02/E112
NEW YORK, NY 10017-5612

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.
90/008,751	06/29/2007	6846477		2036

23913 7590 03/26/2012

PFIZER INC
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NEW YORK, NY 10017-5612

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/26/2012

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

JUDY JARECKI-BLACK, PH.D, J.D.
MERIAL LIMITED
3239 SATELITTLE BLVD
DULUTCH, GA 30096-4640

Date: 3-26-12

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008751
PATENT NO. : 6846477
ART UNIT : 3900

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAILED

MAR 26 2012

CENTRAL REEXAMINATION UNIT

Mary J Hosley
PFIZER INC
150 EAST 42ND STREET
MS: 150/02/E112
NEW YORK NY 10017-5612

(For Patent Owner)

Judy Jarecki-Black
MERIAL LIMITED
3229 SATELLITE BOULEVARD
DULUTH, GA 30096-4640

(For Requester)

In re Keich *et al.*
Ex Parte Reexamination Proceeding
Control No. 90/008,751
Filed: June 29, 2007
For: U.S. Patent No. 6,846,477 B2

: **DECISION ON**
: **PETITION UNDER**
: **37 CFR 1.198**

This is a decision on the February 3, 2012 patent owner petition entitled "RENEWED PETITION UNDER § 1.198" (hereinafter "the petition"). The petition is requesting entry of a concurrently-filed amendment, which was filed after the January 4, 2012 decision that denied the request for rehearing before the Board of Patent Appeals and Interferences (BPAI).

The patent owner petition is before the Director of the Central Reexamination Unit for decision as the record does not show that patent owner has sought review under 35 U.S.C. 141. See MPEP 1214.07 and 1002.02(c).

For the reasons set forth below, the petition under 37 CFR 1.198 is denied as to the entry of the February 3, 2012 amendment.

BACKGROUND

1. On June 29, 2007, a request for *ex parte* reexamination was filed by the third party requester, and the resulting reexamination proceeding was assigned control number 90/008,751 ("the '8751 proceeding").

2. Reexamination of claims 1-4, 6-12, and 14-17 was ordered in an Office decision issued on September 20, 2007.

3. On January 8, 2008, a nonfinal Office action was issued that included rejections based upon WO 94/07531 (Bhogal '531).

4. On August 15, 2008, patent owner submitted claim amendments and remarks in response to the nonfinal Office action, and in particular, to the rejection over Bhogal '531.

5. On October 8, 2008, the Office mailed a final Office action in which the rejections over Bhogal '531 were withdrawn, as stated on page 5 of that action, in view of the August 15, 2008 amendment to claim 1 in which the phrases "consisting essentially of administering a single dose of vaccination" and "wherein said animal is not derived from a *M. hyopneumoniae* vaccinated animal" were added.

6. On January 21, 2009, the Office mailed an advisory Office action denying entry of after-final claim amendments submitted on January 8, 2009, as raising new issues, as being noncompliant with 37 C.F.R. § 1.530(f), and as proposing to amend a claim not subject to reexamination.

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8. On March 5, 2009, an advisory Office action was mailed refusing entry of the February 6, 2009 patent owner supplemental amendment. The advisory action stated that "the proposed amendment to claim 1 would re-raise prior art rejections over Bhogal et al," and that other new issues would be raised through entry of the amendment, which would not overcome the prior art rejection of record.

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10. On May 4, 2009, patent owner submitted a (third) after-final submission - a request for reconsideration, in which the "wherein said animal is not derived from a *M. hyopneumoniae* vaccinated animal" language was removed from claim 1.

11. On May 7, 2009, patent owner timely submitted an Appeal Brief.

12. On July 17, 2009, the Office mailed a final Office action, withdrawing the previous final Office action of October 8, 2008, entering the May 4, 2009 patent owner submission and amendment, and rejecting all of the claims under reexamination, including rejections over Bhogal '531.

13. On September 16, 2009, patent owner submitted a (fourth) after-final submission[1] including claim amendments, a declaration by Dr. Foss, and an Information Disclosure Statement.

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15. On November 2, 2009, patent owner filed a (fifth) after-final submission, including a second declaration by Dr. Foss, and an Information Disclosure Statement.

16. On November 12, 2009, the Office issued an advisory action refusing entry of the November 2, 2009 response, including the second Foss declaration, as the declaration was stated not to overcome the art rejections of record, and as the patent owner "has not provided a sufficient reason why the declaration is necessary and was not presented with the After final amendment filed on 9/16/09."

17. On November 16, 2009, patent owner filed a petition under 37 C.F.R. § 1.181," requesting entry of the evidence submission and remarks filed on November 2, 2009.

18. On November 17, 2009, patent owner filed a notice of appeal; patent owner filed a request for oral hearing on November 18, 2009.

19. On January 19, 2010, patent owner filed an appeal brief.

20. Also on January 19, 2010, the Office mailed a decision denying patent owner's petition under § 1.181, as lacking a good and sufficient reason why the second declaration was not earlier presented.

21. On February 26, 2010, patent owner filed a petition entitled "PETITION UNDER § 1.182 REQUESTING CONTINUED REEXAMINATION," requesting entry of the declaration and remarks filed on November 2, 2009.

22. On March 23, 2010, the Office mailed a decision dismissing patent owner's February 26, 2010 petition.

---

[1] *E.g.*, the first after-final submission with respect to the July 17, 2009 final Office action.

23. On April 22, 2010, patent owner filed a petition entitled "PETITION UNDER § 1.181 REQUESTING RECONSIDERATION."

24. On October 21, 2010, the Office issued an examiner's answer to the appeal brief.

25. On December 21, 2010, patent owner filed a reply brief.

26. On January 13, 2011, the appeal was docketed at the Board of Patent Appeals and Interferences (BPAI), and assigned Appeal No: 2011-004052.

27. On February 17, 2011, a decision denying the April 22, 2010 patent owner petition was mailed.

28. On May 18, 2011, an Oral Hearing was held.

29. On July 15, 2011, the BPAI rendered a decision that affirmed the examiner's anticipation rejections of claims 1-3, 6-12, and 14-17 and reversed the examiner rejections for claim 4.

30. On September 14, 2011, the patent owner filed a petition under 37 CFR 1.198, a request for rehearing, and a proposed amendment.

31. On October 13, 2011, the BPAI dismissed the petition under 37 CFR 1.198 as premature due the request for rehearing.

32. On January 4, 2012, the BPAI denied the request for rehearing.

33. On February 3, 2012, the patent owner filed a renewed petition under 37 CFR 1.198 to request entry of an amendment filed the same day.

REGULATIONS AND PATENT EXAMINING PROCEDURES

37 CFR 1.198 provides:

When a decision by the Board of Patent Appeals and Interferences on appeal has become final for judicial review, prosecution of the proceeding before the primary examiner will not be reopened or reconsidered by the primary examiner except under the provisions of § 1.114 or § 41.50 of this title without the written authority of the Director, and then only for the consideration of matters not already adjudicated, sufficient cause being shown.

MPEP 1214.07 provides, in part:

Sometimes an amendment is filed after the Board's decision which does not carry into effect any recommendation made by the Board and which presents a new or amended claim or claims. In view of the fact that * prosecution is closed, the appellant is not entitled to have such amendment entered as a matter of right. However, if the amendment is submitted with a request for continued examination (RCE) under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e), * prosecution of the application will be reopened

and the amendment will be entered. See MPEP § 706.07(h), paragraph XI. Note that the RCE practice under 37 CFR 1.114 does not apply to utility or plant patent applications filed before June 8, 1995 or to design applications. See 37 CFR 1.114(d) and MPEP § 706.07(h), paragraph I. If the amendment obviously places an application in condition for allowance, regardless of whether the amendment is filed with an RCE, the primary examiner should recommend that the amendment be *>entered<, and with the concurrence of the supervisory patent examiner, the amendment will be entered. Note MPEP § 1002.02(d).

...

Petitions under 37 CFR 1.198 to reopen or reconsider prosecution of a case after decision by the Board, where no court action has been filed, are decided by the Technology Center Director, MPEP § 1002.02(c).

DECISION ON PETITION UNDER 37 C.F.R § 1.198

Patent owner requests that prosecution be reopened so that the February 3, 2012 amendment will be entered and considered. The amendment, dated February 3, 2012, seeks to amend independent claim 1 to include, for the first time, a limitation that the "... single dose is capable of providing protective immunity for both animals seropositive and seronegative for *M. hyopneumoniae*" (emphasis added). See page 2 of the petition. Claim 1 is the only independent claim in the patent. On appeal, independent claim 1 did not include such a limitation and only required administering a single dose to an "... animal [that] is either seropositive or seronegative for *M. hyopneumoniae*." See claim 1 reproduced in the December 21, 2010 Reply Brief. It is further noted that none of the patent claims included, or were proposed to be amended to include, the limitation proposed to be added to independent claim 1 by the February 3, 2012 amendment.

The granting of a § 1.198 petition is strictly limited so as to further the statutory mandate of 35 U.S.C. § 305 that reexamination proceedings will be conducted with **special dispatch** within the Office (emphasis added). The present proceeding has reached a point where the appeal before the BPAI has concluded and the proceeding is ripe for review by the courts. In other words, the Office proceeding has resolved the patentability issues raised in the request for reexamination. The granting of the § 1.198 petition at this stage would require drawing the proceeding back from the point where the Office proceedings are essentially concluded. Reopening prosecution at this advanced stage, as requested by the petition, does not facilitate handling of the proceeding with special dispatch.

Moreover, § 1.198 clearly prohibits reopening prosecution of the proceeding after a decision by the BPAI has become final for judicial review, except under the provisions of § 1.114 or § 41.50, without the written authority of the Director, and then only for the consideration of matters not already adjudicated and requires sufficient cause. The provisions of § 1.114 for a request for continued examination do not apply to reexamination proceedings. In an *ex parte* reexamination proceeding, a § 1.182 petition was created to address a need for an amendment or evidence submission, when the need for which was not apparent to patent owner until the issuance of the final rejection because of an issue raised for the first time at final rejection. To the extent that a petition under § 1.182 for continued reexamination may be considered an equivalent to the provisions of § 1.114, it is noted that patent owner has submitted such petitions and they have not been granted. See the decisions mailed March 23, 2010 and February 17, 2011. For these

reasons, the provisions of § 1.114 are not applicable. In addition, the provisions of § 41.50 are also not applicable. The record is clear that the BPAI affirmed-in-part the rejections made by the examiner and did not introduce any new grounds of rejection that would reopen prosecution. See the July 15, 2011 decision. As recognized by the petitioner, the record is also explicitly clear that the BPAI declined to exercise the authority under § 41.50(c) to make a statement as to how a claim on appeal may be amended to overcome a specific rejection. See pages 20-22 of the July 15, 2011 decision and the January 4, 2012 rehearing decision. See also page 3 of the petition. Therefore, the provisions of § 41.50 are not applicable to the present situation. While the BPAI did seemingly agree with patent owner that the Bhogal references did not teach being effective in treating both seropositive and seronegative piglets, the BPAI did not address the issue of obviousness that would need to be resolved prior to conclusion of this proceeding. See pages 21-22 of the July 15, 2011 decision. Therefore, entry of the February 3, 2012 amendment would require reopening of prosecution in order to perform a substantive patentability analysis for proposed amended claim 1. In other words, the February 3, 2012 proposed amendment goes beyond correcting a "curable defect." Thus, in accordance with § 1.198 and the statutory mandate of "special dispatch," prosecution will not be reopened at this advanced point in the proceedings.

In summary, reopening of the prosecution to consider an amendment at this stage in the proceedings would inappropriately validate the unnecessary delay (by patent owner) in presenting the instant amendment in this proceeding contrary to the requirement of "special dispatch within the Office." The record is clear that patent owner had ample opportunities to propose amendments prior to this late stage in the proceedings. See the background subsection. See also the decisions mailed March 23, 2010 and February 17, 2011, which discuss such opportunities. Likewise, the record is clear that patent owner could have petitioned under § 1.181 for entry of post-final proposed amendments containing similar amendments to claim 1 as in the February 3, 2012 amendment and failed to do so. See pages 20-22 of the July 15, 2011 decision and the January 4, 2012 rehearing decision. Specifically, patent owner could have submitted such amendments prior to the final rejection, and such amendments would have been entered as a matter of right. In addition, patent owner could have petitioned under § 1.181 for entry of the January 8, 2009 or February 6, 2009 after-final amendments, but declined to exercise that option. Patent owner could have submitted additional after-final amendments to include similar amendments to claim 1 as in the February 3, 2012 amendment, but failed to do so. Based on the facts and circumstances of the present situation, it is found that patent owner's February 3, 2012 petition and amendment are not deemed consistent with the requirement of 35 U.S.C. § 305 to conduct reexamination proceedings "with special dispatch within the Office."

In view of the above-mentioned reasons, the petition is denied.

CONCLUSION

1. The patent owner petition requesting entry of the February 3, 2012 amendment is denied.

2. The proceeding will be concluded by the issuance of a "Notice of Intent to Issue *Ex Parte* Reexamination Certificate," in due course, unless the record subsequently shows that the patent owner has filed an appeal under 35 USC 141.

3. Telephone inquiries related to this decision should be directed to Deborah Jones, Supervisory Patent Examiner, at (571) 272-1535.

Irem Yucel, Director
Central Reexamination Unit

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.:20110914

DATE : September 14, 2011

TO SPE OF : ART UNIT 3992

SUBJECT : Request for Certificate of Correction on Patent No.: 6,307,955 C1

A response is requested with respect to the accompanying request for a certificate of correction.

Please complete this form and return with file, within **7** days to:
Certificates of Correction Branch - PK 3-910
Palm location **7590** - Tel. No. 305-8201

With respect to the change(s) requested, correcting Office and/or Applicant's errors, should the patent read as shown in the certificate of correction? No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Thank You For Your Assistance **Certificates of Correction Branch**

The request for issuing the above-identified correction(s) is hereby:
Note your decision on the appropriate box.

☒ **Approved** **All** changes apply.

☐ **Approved in Part** Specify below which changes **do not** apply.

☐ **Denied** State the reasons for denial below.

Comments:

The corrections to the reexamination certificate are approved.

SPE: /Eric Keasel/ **Art Unit** 3992

ERIC S. KEASEL
CRU SPE-AU 3992

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 02/28/11

TO SPE OF : ART UNIT 3729

90/008,799

SUBJECT : Request for Certificate of Correction for Appl. No.: ~~09/117,970~~ Patent No.: 6233818 C1

CofC mailroom date: 12/8/10

Please respond to this request for a certificate of correction within 7 days.

FOR IFW FILES:

Please review the requested changes/corrections as shown in the **COCIN** document(s) in the IFW application image. No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Please complete the response (see below) and forward the completed response to scanning using document code **COCX**.

FOR PAPER FILES:

Please review the requested changes/corrections as shown in the attached certificate of correction. Please complete this form (see below) and forward it with the file to:

Certificates of Correction Branch (CofC)
Randolph Square – 9D10-A
Palm Location 7580

RoChaun Johnson
Certificates of Correction Branch
703-756-1580

Thank You For Your Assistance

The request for issuing the above-identified correction(s) is hereby:
Note your decision on the appropriate box.

- X **Approved** — **All** changes apply.
- ☐ **Approved in Part** — Specify below which changes **do not** apply.
- ☐ **Denied** — State the reasons for denial below.

Comments: Approved

/Derris H. Banks/

SPE **Art Unit**
3729

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 03-14-2012

TO SPE OF : ART UNIT 3993

SUBJECT : Request for Certificate of Correction for Appl. No.: 90008866 Patent No.: RE39368F1

CofC mailroom date: 11-07-11

Please respond to this request for a certificate of correction within 7 days.

FOR IFW FILES:

Please review the requested changes/corrections as shown in the **COCIN** document(s) in the IFW application image. No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Please complete the response (see below) and forward the completed response to scanning using document code **COCX**.

FOR PAPER FILES:

Please review the requested changes/corrections as shown in the attached certificate of correction. Please complete this form (see below) and forward it with the file to:

Certificates of Correction Branch (CofC)
Randolph Square – 9D10-A
Palm Location 7580

Certificates of Correction Branch
703-756-1814

Thank You For Your Assistance

The request for issuing the above-identified correction(s) is hereby:

Note your decision on the appropriate box.

- ☒ **Approved** — **All** changes apply.
- ☐ **Approved in Part** — Specify below which changes **do not** apply.
- ☐ **Denied** — State the reasons for denial below.

Comments: _____

3/15/12

CRU 3993

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,875	10/10/2007	5279051	R67340	1907

40401 7590 08/04/2010

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 08/04/2010

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

David K.S. Cornwell, Esq.
Sterne, Kessler, Goldstein & Fox P.L.L.C.
1100 New York Avenue, N.W.
Washington, DC 20005

Date:

MAILED

AUG 04 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008875
PATENT NO. : 5279051
ART UNIT : 3993

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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

(For Patent Owner)

MAILED

AUG 04 2010

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

(For Requester)

CENTRAL REEXAMINATION UNIT

In re Whatley
Reexamination Proceeding
Control No. 90/008,875
For: U.S. Patent No. 5,279,051

: DECISION DENYING
: PETITION UNDER
: 37 CFR 1.181
:

This is a decision on the July 22, 2010 paper entitled "PETITION UNDER 37 CFR 1.181 TO USPTO DIRECTOR KAPPOS, HIMSELF, TO WITHDRAW SECOND NOTICE OF INTENT TO ISSUE REEXAMINATION CERTIFICATE, AND ISSUE CERTIFICATE BASED ON FIRST NOTICE OF INTENT." No fee is required. The petition is before the Director of the Central Reexamination Unit for decision.[1]

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

REVIEW OF FACTS

1. A Notice of Intent to Issue an *Ex Parte* Reexamination Certificate (NIRC) was mailed in 90/008,875 on December 14, 2009.

2. Prior to publication of a reexamination certificate, U.S. patent 5,279,051 expired on February 12, 2010. While the face of U.S. patent 5,279,051 refers to a disclaimer of the portion of the patent past October 29, 2008, this was changed by certificate of correction mailed 1/6/2009 in the parent patent.

[1] While the petition is styled as a petition to "USPTO Director Kappos, himself," this is plainly a petition to invoke the supervisory authority of the director as specified in 37 CFR 1.181(a)(3). See petition of July 22, 2010, page 1. Rather than having the incumbent USPTO Director individually answer petitions such as this, the authority to decide these petitions has been delegated as outlined in MPEP 1001.01 and 1002.02.

3. On April 30, 2010, a second NIRC was mailed which cancelled all "newly presented" claims (i.e. those added during the reexamination proceeding).

4. On July 22, 2010, the present petition was filed.

DECISION

A review of the record indicates that the actions of the examiner were in compliance with MPEP 2250 III and 2287 IV (M). In particular, MPEP 2250 III states:

> Pursuant to 37 CFR 1.530(j), "[n]o amendment may be proposed for entry in an expired patent." Thus, if a patent expires during the pendency of a reexamination proceeding for a patent, all amendments to the patent claims and all claims added during the proceeding are withdrawn. This is carried out by placing a diagonal line across all amended and new claims (and text added to the specification) residing in the amendment papers. The patent owner should be notified of this in the next Office action. The Office action will hold the amendments to be improper, and state that all subsequent reexamination will be on the basis of the unamended patent claims. This procedure is necessary since no amendments will be incorporated into the patent by a certificate after the expiration of the patent.
>
> 37 CFR 1.530(j) further states that "[m]oreover, no amendment, other than the cancellation of claims, will be incorporated into the patent by a certificate issued after the expiration of the patent."
>
> Thus, at the time the NIRC is to be issued, the examiner should ensure that all rejected and objected to claims are canceled. The examiner should issue an examiner's amendment canceling any such claims not already canceled.
>
> The cancellation of the original patent claims is the only "amendatory" change permitted in an expired patent.

The NIRC of April 30, 2010 cancels the claims not present in the issued patent as described in USPTO policy. Thus, the actions of the examiner do not warrant invoking supervisory authority.

Accordingly, the petition is **denied**.

SUMMARY AND CONCLUSION

1. The petition is **DENIED**.

2. This decision is not a final agency action and is without prejudice to a request for reconsideration or higher level review. See MPEP 1002.02.

3. Telephone inquiries related to this decision should be directed to Andres Kashnikow, Supervisory Patent Examiner, at (571) 272-4361 or in his absence to the undersigned at (571) 272-3838.

Gregory Morse, Director
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,876	10/10/2007	5060401	R67339	1124

40401 7590 08/04/2010

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 08/04/2010

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
David K.S. Cornwell
STERNE, KESSLER, GOLDSTEIN & FOX, P.L.L.C.
1100 New York Ave., NW
Washington, DC 20005

Date:
MAILED

AUG 04 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008876
PATENT NO. : 5060401
ART UNIT : 3993

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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

(For Patent Owner)

MAILED

AUG 04 2010

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

(For Requester)

CENTRAL REEXAMINATION UNIT

In re Whatley
Reexamination Proceeding
Control No. 90/008,876
For: U.S. Patent No. 5,060,401

: DECISION DENYING
: PETITION UNDER
: 37 CFR 1.181
:

This is a decision on the July 22, 2010 paper entitled "PETITION UNDER 37 CFR 1.181 TO USPTO DIRECTOR KAPPOS, HIMSELF, TO WITHDRAW SECOND NOTICE OF INTENT TO ISSUE REEXAMINATION CERTIFICATE, AND ISSUE CERTIFICATE BASED ON FIRST NOTICE OF INTENT." No fee is required. The petition is before the Director of the Central Reexamination Unit for decision.[1]

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

REVIEW OF FACTS

1. A Notice of Intent to Issue an *Ex Parte* Reexamination Certificate (NIRC) was mailed in 90/008,876 on December 14, 2009.

2. Prior to publication of a reexamination certificate, U.S. patent 5,060,401 expired on February 12, 2010.

[1] While the petition is styled as a petition to "USPTO Director Kappos, himself," this is plainly a petition to invoke the supervisory authority of the director as specified in 37 CFR 1.181(a)(3). See petition of July 22, 2010, page 1. Rather than having the incumbent USPTO Director individually answer petitions such as this, the authority to decide these petitions has been delegated as outlined in MPEP 1001.01 and 1002.02.

3. On April 30, 2010, a second NIRC was mailed which cancelled all "newly presented" claims (i.e. those added during the reexamination proceeding).

4. On July 2, 2010, the present petition was filed.

DECISION

A review of the record indicates that the actions of the examiner were in compliance with MPEP 2250 III and 2287 IV (M). In particular, MPEP 2250 III states:

> Pursuant to 37 CFR 1.530(j), "[n]o amendment may be proposed for entry in an expired patent." Thus, if a patent expires during the pendency of a reexamination proceeding for a patent, all amendments to the patent claims and all claims added during the proceeding are withdrawn. This is carried out by placing a diagonal line across all amended and new claims (and text added to the specification) residing in the amendment papers. The patent owner should be notified of this in the next Office action. The Office action will hold the amendments to be improper, and state that all subsequent reexamination will be on the basis of the unamended patent claims. This procedure is necessary since no amendments will be incorporated into the patent by a certificate after the expiration of the patent.
>
> 37 CFR 1.530(j) further states that "[m]oreover, no amendment, other than the cancellation of claims, will be incorporated into the patent by a certificate issued after the expiration of the patent."
>
> Thus, at the time the NIRC is to be issued, the examiner should ensure that all rejected and objected to claims are canceled. The examiner should issue an examiner's amendment canceling any such claims not already canceled.
>
> The cancellation of the original patent claims is the only "amendatory" change permitted in an expired patent.

The NIRC of April 30, 2010 cancels the claims not present in the issued patent as described in USPTO policy. Thus, the actions of the examiner do not warrant invoking supervisory authority.

Accordingly, the petition is **denied**.

SUMMARY AND CONCLUSION

1. The petition is **DENIED**.

2. This decision is not a final agency action and is without prejudice to a request for reconsideration or higher level review. See MPEP 1002.02.

3. Telephone inquiries related to this decision should be directed to Andres Kashnikow, Supervisory Patent Examiner, at (571) 272-4361 or in his absence to the undersigned at (571) 272-3838.

Gregory Morse, Director
Central Reexamination Unit

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : November 17, 2011

TO SPE OF : ART UNIT 3993 SPE Andres Kashnikow.

SUBJECT : Request for Certificate of Correction for Appl. No.: 90/008,896 Patent No.: RE39,400 F1

Please respond to this request for a certificate of correction within 7 days.

FOR IFW FILES:

Please review the requested changes/corrections as shown in the **COCIN** document(s) in the IFW application image. No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Please complete the response (see below) and forward the completed response to scanning using document code **COCX**.

FOR PAPER FILES:

Please review the requested changes/corrections as shown in the attached certificate of correction. Please complete this form (see below) and forward it with the file to:

Certificates of Correction Branch (CofC)
Randolph Square Building
2800 South Randolph Street
Arlington, VA 22206

Should the changes in the claims be approved as requested by applicant?
See COCIN dated 11-8-2011

Antonio Johnson

Certificates of Correction Branch
(571)272-0483 Fax – (571)270-9846

Thank You For Your Assistance

The request for issuing the above-identified correction(s) is hereby:
Note your decision on the appropriate box.

- [X] **Approved** — **All** changes apply.
- [ ] **Approved in Part** — Specify below which changes **do not** apply.
- [ ] **Denied** — State the reasons for denial below.

Comments: AS TO ITEMS "M" AND "N" THERE IS A TYPO IN THE REQUEST. IT SHOULD REFER TO COLUMN 5 RATHER THAN 4 AS CLAIM 152 IS FOUND IN ~~CLAIM~~ COLUMN 5.

_____ SPE Andres Kashnikow Art Unit 3993

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

DATE : 11/14/11

TO SPE OF : ART UNIT: 3993 **Attn: KASHNIKOW ANDRES (ANDY) (SPE)**

SUBJECT : Request for Certificate of Correction for Appl. No.: 90/008898 Patent No.: RE39401

CofC mailroom date: 11/07/2011

Please respond to this request for a certificate of correction within 7 days.

FOR IFW FILES:

Please review the requested changes/corrections as shown in the **COCIN** document(s) in the IFW application image. No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Please complete the response (see below) and forward the completed response to scanning using document code **COCX**.

FOR PAPER FILES:

Please review the requested changes/corrections as shown in the attached certificate of correction. Please complete this form (see below) and forward it with the file to:

Certificates of Correction Branch (CofC)
Randolph Square – 9D10-A
Palm Location 7580

Note: **Please check the Claims for the requested corrections should these be amended or not**

Tasneem Siddiqui
Certificates of Correction Branch
703-756-1814 & 703-756-1593

Thank You For Your Assistance

The request for issuing the above-identified correction(s) is hereby:
Note your decision on the appropriate box.

☐ **Approved**	**All** changes apply.
☒ **Approved in Part**	Specify below which changes **do not** apply.
☐ **Denied**	State the reasons for denial below.

Comments: (1) CORRECTION "i" IT IS THE SECOND "MEMORY" THAT NEEDS TO BE BOLDED.
(2) CORRECTION "N" IS NOT APPROVED AS IT AFFECTS THE SCOPE OF THE CLAIMS.

Andy Kashnikow 3993
SPE Art Unit

United States Patent and Trademark Office

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

Michael E. Attaya
CESARI AND MCKENNA, LLP
88 BLACK FALCON AVENUE
BOSTON MA 02210

(For Patent Owner)

MAILED

JAN 18 2012

CENTRAL REEXAMINATION UNIT

Ronald L. Yin
DLA PIPER LLP (US)
2000 UNIVERSITY AVENUE
EAST PALO ALTO, CA 94303-2248

(For Third Party Requester)

In re Hitz et al.
Ex Parte Reexamination Proceeding
Control No. 90/008,903
Filed: December 26, 2007
For: U.S. Patent No. 5,819,292

In re Hitz et al.
Ex Parte Reexamination Proceeding
Control No. 90/009,103
Filed: April 4, 2008
For: U.S. Patent No. 5,819,292

DECISION DENYING PETITION UNDER 1.181

This is a decision on the May 24, 2010 patent owner petition entitled "PETITION FOR DESIGNATION OF EXAMINER'S ANSWER AS CONTAINING NEW GROUNDS OF REJECTION (37 CFR § 1.181 AND MPEP § 1207.03(IV))."

The patent owner petition is before the Director of the Central Reexamination Unit for determination.

The petition is denied with respect to designating the grounds of rejection as new grounds of rejection and reopening prosecution.

STATEMENT OF RELEVANT FACTS

1. On December 26, 2007, a request for *ex parte* reexamination of claims 1-4 and 8-20 of U.S. Patent Number 5,819,292 was filed by the third party requester; the resulting reexamination proceeding was given a filing date and assigned control number 90/008,903.

2. On March 18, 2008, an order granting reexamination of claims 1 and 4 of the '292 patent was mailed in the '8903 proceeding.

3. On April 4, 2008, a request for ex parte reexamination of claims 4, 8, 11-15, and 20 of U.S. Patent Number 5,819,292 was filed by the third party requester; the resulting reexamination proceeding was given a filing date and assigned control number 90/009,103.

4. On June 6, 2008, an order granting reexamination of claims 4, 8, 11-15, and 20 of the '292 patent was mailed in the '9103 proceeding.

5. On September 5, 2008, a decision merging the '8903 and '9103 proceedings (hereinafter, the merged '8903/'9103 proceeding) was issued.

6. On September 26, 2008, a non-final Office action, in which all claims subject to reexamination (claims 1, 4, 8, 11-15, and 20) were rejected under multiple grounds based upon 35 U.S.C. § 102(b), was mailed in the merged '8903/'9103 proceeding.

7. On May 12, 2009, patent owner submitted a timely and compliant response to the outstanding Office action, including an amendment to claim 1 and new claims 21-24.

8. On June 16, 2009, a final rejection was mailed, finding claims 1, 21, and 22 patentable, and rejecting claims 4, 8, 11-15, 20 on grounds previously set forth in the September 26, 2008 rejection, and rejecting newly added claims 20, 23, and 24.

9. On August 17, 2009, patent owner submitted a timely submission as a response to the June 16, 2009 final rejection. The submission included amendments to claims 11, 15, 23, and 24. Rejected independent claim 4 was not sought to be amended.

10. On September 8, 2009, the Office issued an advisory action refusing entry to the claim amendments proposed in the August 17, 2009 patent owner submission, finding that the amendments neither simplified the issues for appeal nor placed the claims in condition for allowance/confirmation. Rather, the advisory action stated that the amendments would raise new issues requiring further consideration and/or search.

11. On October 15, 2009, patent owner filed a Notice of appeal.

12. On December 15, 2009, the Office granted a December 11, 2009 petition under 37 c.f.r. § 1.550(c) granting an extension of time for filing an appeal brief until January 15, 2010.

13. On February 16, 2010, patent owner filed an appeal brief.

14. On April 19, 2010, an Examiner's Answer was mailed.

15. On May 24, 2010, the instant petition under 37 CFR 1.181 was filed.

16. On June 30, 2010, patent owner filed a reply brief.

DECISION

The patent owner (petitioner) states that the examiner made, in effect, new grounds of rejection in the Examiner's Answer. In the May 24, 2010 petition, the petitioner explains that the Examiner's Answer contains "new" grounds of rejection based upon a "new" alternative claim construction for the term "consistency point" or reliance on personal knowledge. See pages 10-15 of the May 24, 2010 petition. Petitioner considers these alleged "new" responses as new grounds of rejection, and requests that prosecution be reopened.

In response to patent owner's arguments that the examiner introduced new grounds of rejection in the Examiner's Answer, the director finds there are not good and sufficient reasons to designate the rejections as new grounds of rejection. First, 35 U.S.C. 305 requires that all *ex parte* reexamination proceedings to be acted upon with "special dispatch." The rules and procedures of the Office were established through notice and comment in order to achieve special dispatch in a reasonable manner. Office rules and procedures encourage examiners to look at the facts involved in a particular proceeding and to weigh the equities before issuing a final rejection, for consideration of after final responses, and for designating new grounds of rejection in Examiner's Answers. See MPEP 2272 and 1207.03.

Turning to the facts in this proceeding, the record is clear that patent owner has been given numerous opportunities to respond to the prior art rejections and to understand how the prior art is being applied to the claim limitations. See the relevant facts section above and see below for a more detailed summary.

Pre-Appeal:
A first non-final rejection was mailed by the USPTO on September 26, 2008. Patent claim 4 was rejected under 35 USC 102(b) as being anticipated by each of the references to Rosenblum, Sidebotham, Quinlan and Gait and patent claim 20 was rejected under 35 USC 102(b) as being anticipated by each of the references to Quinlan and Gait.

Patent owner filed a compliant response on May 12, 2009. In the response, patent owner discussed the teachings of the '292 patent on pages 15-16 thereof. Patent owner discussed the teachings of Rosenblum on pages 21-24 of the response. Specifically, patent owner presented the following arguments with regard to claim 4 and Rosenblum on page 24 of the response:

> "Thus, a fair and proper reading of the Rosenblum paper, in light of the Rosenblum dissertation, reveals that a second superblock is not stored. Thus, the element of claim 4 of 'storing in said non-volatile storage means a second file system information structure for said second consistency point, said second file system

information structure comprising data describing a layout said file system at said second consistency point of said file system' is not satisfied. Accordingly, Patent Owner respectfully requests withdrawal of the rejection of claim 4."

Patent owner discussed the teachings of Sidebotham on pages 24-26 of the response. Specifically, patent owner also presented the following arguments with regard to claim 4 and Sidebotham on page 26 of the response:

"Thus, in this respect, the clone of Sidebotham is more similar to a snapshot of the '292 patent and not a consistency point, as claimed in the patent. Accordingly, Sidebotham is silent as the first element of claim 4 'storing a first file system information structure for a first consistency point in said non-volatile storage means, said first file system information structure comprising data describing a layout of said file system at said first consistency point of said file system.'"

...

"The Office Action then states 'each clone represents a different consistency point of the file system. Yet, as noted above, the clone of Sidebotham is not a consistency point as claimed in the '292 patent. Accordingly, Sidebotham does not teach or suggest 'storing in said non-volatile storage means a second file system information structure, said second file system information structure comprising data describing a layout of said file system at said second consistency point of said file system.'"

Patent owner discussed the teachings of Quinlan and Gait on pages 26-29 and 31-33 of the response. Specifically, patent owner presented the following arguments with regard to claim 4 and each of Quinlan and Gait on pages 28 and 33 of the response:

"Accordingly, the ... reference is silent with regard to the limitations of claim 4 that recite two consistency points:

'storing a first file system information structure for a first consistency point in said non-volatile storage means, said first file system information structure comprising data describing a layout of said file system at said first consistency point of said file system'; and

'storing in said non-volatile storage means a second file system information structure for said second consistency point, said second file system information structure comprising data describing a layout of said file system at said second consistency point of said file system.'"

Claim 20 which depends from claim 8 was argued as being patentable for the reasons set forth with regard to claim 8. See, e.g., "[a]ccordingly, the Quinlan reference fails to satisfy the limitation of claim 8 'making a copy of said meta-data at each of a plurality of said states of said file system" (see pages 29-31 of response) and "[a]s such, Gait appears to be silent with respect to a plurality of write-protected versions (read-only copies) of a file system, as recited in claim 8. Regarding 'marking a copy of said meta-data ... ' recited in the second element of claim 8, the Office Action cites to Figure 3 only of Gait. To the extent the Examiner is pointing to Gait's 'timestamps' as representing the claimed 'meta-data,' then Gait fails to satisfy the second element of claim 8 because a timestamp is not copied. On the contrary, a new timestamp is written periodically. By the same reasoning, Gait does not satisfy the third element of claim 8. See, Gait at pp. 82-83 (paragraph following 'RELIABILITY')." (see pages 33-35 of the response).

A final rejection was mailed by the USPTO on June 16, 2009. Patent claim 4 was again rejected under 35 USC 102(b) as being anticipated by each of the references to Rosenblum, Sidebotham, Quinlan and Gait and patent claim 20 was again rejected under 35 USC 102(b) as being anticipated by each of the references to Quinlan and Gait. Additionally, on pages 13-17 of the Office action, the examiner responded to Patent Owner's arguments with regard to claim 4 and Rosenblum. See especially paragraph 29, in which the examiner explained, in part:

> "Because Rosenblum teaches performing more than one check pointing operation that preserves a complete file system structure at a consistency point, the limitation 'storing ... a second file system information structure for said second consistency point ...' is met. The claim requires storage of 'a second file system information structure,' not 'a second file system information structure that comprises a second superblock.'"

With regard to claim 4 and Sidebotham, the examiner responded, in part, on pages 14-15 of the action :

> "According to Patent Owner, the clone of Sidebotham is more similar to a snapshot of the '292 patent and not a consistency points. (Remarks, p.26). Patent owner provides no basis for these definitions of snapshots and consistency points. A consistency point is simply a point at which a file system is consistent. Snapshots, checkpoint operations, and other types of backup or cloning operations are operations that capture and preserve a file system state at a consistency point so that the file system can be restored at that consistency point if needed. Whether the blocks involved are writable or read-only is a matter of design choice, not a characteristic of a consistency point or a snapshot as Patent Owner asserts. Moreover, reusability of blocks is not an element of the claim."

With regard to claim 4 and Quinlan, the examiner stated, in part, on page 15 of the action:

> "Patent Owner's assertion ... this is true for all file systems including the file system disclosed in the '292 patent. There can only be one consistent state for any file system at any given time. As to Patent Owner's arguments regarding the differences between a snapshot and a consistency point (see Remarks, p. 28), they have been addressed above."

With regard to claim 4 and Gait, the examiner responded on page 16 of the action:

> Patent Owner's arguments against the Quinlan regarding claim 4 are almost identical to those against Quinlan. They have been addressed above.

On July 30, 2009, a personal interview was held. As indicated by the examiner's interview summary of July 30, 2009, several possible amendments to the file system information structure and consistency point limitations of claim 4 were discussed in attempts to distinguish the claimed invention from the applied prior art references. According to the patent owner's summary of the interview, the examiners provided guidance and suggested possible claim language, but that no agreement was reached. See page 16 of the August 17, 2009 response.

On August 17, 2009, patent owner filed a response traversing the rejection of the claims, amending only claims 11 and 15 and adding new claims 23-24. On pages 16-17 of the response, the patent owner stated that they realized that the examiner embraced a broader claim interpretation by the final Office action and the personal interview. Specifically, on page 17 of the response, patent owner recognized that the construction of the phrase "file system information structure" will be at issue during the appeal. The response also included arguments

pertaining to discussion of the terms "consistency point" and "file system information structure" on pages 21-23 of the response. Specifically, on page 23 of the response, patent owner states that:

> "The '292 patent repeatedly states that the 'consistency point' refers to 'the set of self-consistent blocks on disk that is rooted by [a] root inode.' *See, e.g.*, '292 patent at 4:11-13 and 11:66-12:1. Furthermore, the '292 patent specification states that a new consistency point occurs when the file system information structure, in its current fixed location, is updated by writing a new root inode. *Id.* at 12:9-24.
>
> The '292 patent specification repeatedly states that the 'file system information structure' is stored in a fixed location on disk. *Id.* at 9:33-35, 10:58-60 and 11:3-5."

With regard to claim 4 and Rosenblum, Sidebotham, Quinlan and Gait, the patent owner made substantially the same argument. For example, see page 24, in which the patent owner states:

> "The preamble of claim 4 states that the claim is directed to a method for maintaining a file system at successive 'consistency points.' To that end, the claim recites the steps of storing a first file system information structure for a 'first consistency point' in the non-volatile storage means and writing blocks that have been modified from the first consistency point 'as of the commencement of a second consistency point.' The claim then concludes with the step of storing a second file information structure for a 'second consistency point' in the non-volatile storage means. Read in the context of the '292 patent specification, this language means that the file system stored on the non- volatile storage means transitions from one consistency point to a next consistency point, and is always in a consistent state on the non-volatile storage means."
>
> See also page 28 of the response, in which the patent owner states: "In contrast to the requirements of claim 4, Sidebotham, like Rosenblum, describes a file system that is not *always* in a consistent state."
>
> On page 30 of the response, patent owner argues : "... nothing in Quinlan discloses or suggests that the file system as a whole, including the information stored on the WORM cache, transitions from one consistency point to a next consistency point, as recited in claim 4, to thereby always be in a consistent state in the non-volatile storage means."
>
> Regarding Gait, the patent owner states on page 35 that: "One version remains consistent as a prior instance of the file system, but the other continues as an active system, subject to inconsistency. See id. at p. 83. Of course, this implies that when the system of Gait is between timestamps, the state of the system stored in nonvolatile memory is not consistent."

An advisory action was mailed by the USPTO on September 8, 2009 indicating the after-final amendment would not be entered because of the amendments to claims 11, 23 and 24. The examiner also indicated that the request for reconsideration had been considered but did not place the application in condition for allowance. The examiner commented in pertinent part:

> "The Examiner agrees that the term 'consistency point' is defined in the specification to mean a 'set of self-consistent blocks on disk that is rooted by a root inode' (see Abstract, c4: 11-13, cl 1:66-cl2:1). However, the Examiner does not agree that the term 'file system

information structure' is defined in the specification as Patent Owner asserts. A single sentence that points to an illustrative structure does not define the structure. Patent Owner is free to define the structure by claiming structural components as limitations to the structure, but is not free to import limitations from an illustration in the specification without expressly claiming them.

Claim 4: Patent Owner's argument that the disclosed file system is always in consistent state on the non-volatile system is not supported by the specification or the arguments. The portion of the specification discussed (c4:13-15) discloses how the disclosed system implements consistency point as defined in the specification, but does not support Patent Owner's assertion that the disclosed file system is always in consistent state. Snapshots and checkpoints are generally created to recover from crashes and to restore the file system to a known and recoverable consistent state of the file system. If the disclosed file system can never become inconsistent as Patent Owner seems to claim, there would be no need for snapshots or need to recover the file system as described in the specification. If Patent Owner's disclosed system crashes while performing any of the steps 510-540 of Figure 5, Patent Owner's file system becomes inconsistent just as in Rosenbloom's [sic] system, but it does have a consistency point to roll back to just as in Rosenbloom's [sic] system. Patent Owner has not provided any satisfactory explanation that patentably distinguishes successive consistency points generated by flushing operations disclosed in Figure 5 and successive consistency points generated by flushing operations performed in Rosenbloom's [sic] system (see page 9, 4.1 Checkpoints, "it writes out all modified information to the log ... "; "Sprite performs checkpoints at periodic intervals ... ") or any other prior art file system. Also claim 4 does not require the file system to be always consistent. The claim merely requires performance of steps recited in the body of the claim.

Patent Owner makes similar arguments regarding other prior art references. These arguments are just as unpersuasive as the argument againt[sic] Rosenbloom [sic]."

On October 15, 2010, patent owner filed a notice of Appeal.

Post Appeal:

Patent owner filed an Appeal Brief on February 16, 2010. On page 3 of the brief, the patent owner recognizes that the advisory action discussed the construction of the "consistency point" limitation and offered an alternative construction, as argued by the patent owner. In the arguments section VIII, Section A, Sections 2-4 included arguments directed to "2. The Final Office Action Failed To Set Forth A Prima Facie Case Of Anticipation Of Claims 4 And 20 Based On The Express Definition Of 'Consistency Point' That Governs The Construction Of Those Claims"; "3. The Limitation "File System Information Structure" Recited In Claim 4 Must Be Construed In Light Of The Specification"; and "4. Claim 4, Properly Construed, Recites A File System That Is Always In A Consistent State On The Non-Volatile Storage Means." See pages 14-17 of the Brief. See also, subsection B, subparts 2-5, on pages 18-22 and 24-24 of the brief, which included arguments with regard to claims 4 and/or 20 with regard to each of the references Rosenblum, Sidebotham, Quinlan and Gait. The patent owner argues that the references do not describe a file system that is not always in a consistent state.

An Examiner's Answer was mailed by the USPTO on April 19, 2010. The Examiner's Answer

> maintained the previous rejections of claims 4 and 20. In section (10) of the Answer, beginning on page 13, the examiner responded to patent owner's arguments utilizing the similar headings used in the appeal brief, e.g. pages 13-16 of the answer, which responded to subsection A, subparts 2-4 of the Brief, and pages 16-25 of the answer, which responded to subsection B, subparts 2-5 of the Brief.

Specifically, upon careful review of the record, the advisory action of September 8, 2009 explained the different constructions for the "consistency point" claim limitation and the examiner's knowledge regarding the file system limitations. Patent owner acknowledged that the advisory action stated such positions on page 3 of the appeal brief, as discussed above. In other words, the advisory action stated the examiner's position on these issues, and such position is consistent with the examiner's response beginning on page 13 of the April 19, 2010 Examiner's Answer. For example, like in the advisory action, the examiner recognized that the '292 patent set forth a definition of the term "consistency point." See page 13 of the Answer. The examiner goes on to explain why this definition is not controlling when applying the references to the claims, and even if it was applied, the same applied references would teach the limitation. See pages 13-14 of the Answer. This position is consistent with the position set forth in the advisory action. Moreover, the record is clear that during the entire prosecution of this proceeding, the construction of the "consistency point" and "file system information structure" limitations were at issue and these issues were further defined by responses by the patent owner and examiner throughout the prosecution. For similar reasons, the record shows that the examiner's "personal knowledge" position in the brief on page 19 of the Answer was in response to arguments raised by the appeal brief, and is consistent with the position set forth in the advisory action concerning the consistency of the file system. Accordingly, the record does not support patent owner's allegation that the Examiner's Answer stated new rationales in the grounds of rejection for the first time.

In addition, MPEP 1207.02 mandates that the Examiner's Answer make a statement of whether the examiner disagrees with each of the contentions raised by the appellant brief and an explanation of the reasons for disagreement with any such contentions. The examiner must use headings and subheadings paralleling the headings and subheadings utilized in the appellant's brief. The prosecution history indicates that such was provided on pages 13 *et seq.* of the Examiner's Answer. In the petition, the patent owner recognized that where the statutory basis for the rejection remains the same, and the evidence relied upon in support of the rejection remains the same, a change in the discussion of, or rationale in support of, the rejection does not necessarily constitute a new ground of rejection. See In re Kronig, 539 F.2d 1300, 1302-03,190 USPQ 425, 426-27 (CCPA 1976) and MPEP 1207.03. In addition, there is no new ground of rejection when the basic thrust of the rejection remains the same such that an appellant has been given a fair opportunity to react to the rejection. Patent owner alleges the explanations in the Examiner's Answer regarding "consistency point" and the "file system information structure" change the basic thrust of the rejection such that the patent owner was not given a fair opportunity to react to the rejection. However, for the reasons explained in the above paragraph, it cannot be said that the Examiner's Answer changed the basic thrust of the rejections to such an extent that it resulted in new grounds of rejection. To reiterate, on pages 13-25 of the Examiner's Answer, the examiner was addressing arguments of the patent owner by clarifying issues and explaining why he disagrees with patent owner's contentions in accordance with

Office policies, and did not modify or alter the grounds of rejection. Therefore, in summary, no new grounds of rejection were made in the Examiner's Answer.

Upon review of the record, the basic thrust of the rejections have been and continue to be the interpretation of the terminology "consistency point," the interpretation of the claim limitations of claim 4 including such terminology, for example:

> "storing a first file system information structure for a first consistency point in said non-volatile storage means, said first file system information structure comprising data describing a layout of said file system at said first consistency point of said file system"; and
> "storing in said non-volatile storage means a second file system information structure for said second consistency point, said second file system information structure comprising data describing a layout of said file system at said second consistency point of said file system."

In other words, the examiner's broad interpretation of these limitations, the patent owner's narrower interpretation of the same limitations, and application of the teachings of the Rosenblum, Sidebotham, Quinlan and Gait to the same limitations have consistently been the issues present during the prosecution of this proceeding. As discussed in detailed above, the patent owner has, since the first Office action, addressed the claim interpretation as well how the teachings of the references do not apply to the limitations at issue.

Finally, the allegation that the patent owner is "clearly prejudiced" because of the failure to designate the rejections as new grounds, which precluded the patent owner from exercising the option to reopen prosecution, is also not supported by the prosecution history and evidence of record. Specifically, patent owner argues the lack of such opportunity amounts to the lack of opportunity to address the alleged newly presented rejections. However, as discussed above, the record does not support that the Examiner's Answer contains new grounds of rejection or that patent owner has not had a fair opportunity to respond to the rejections. For the reasons set forth above, it is deemed that the examiner followed Office rules and procedures and did not prejudice the patent owner by not designating the grounds of rejection as new.

Accordingly the petition fails to establish the existence of procedural error due to a change to the basic thrust of the rejection such that the patent Owner was not given a fair opportunity to respond to the rejection as set forth in MPEP 1207. In conclusion, the record does not support patent owner's statement that the examiner had made new grounds of rejection in the Examiner's Answer.

Finally, to the extent that the petitioner is requesting review of the substance of the examiner's response, such issues touch on matters that are appealable, and therefore will not be addressed in this petition. See MPEP 1002 and 1201. Specifically, MPEP 1202 states "[t]he line of demarcation between appealable matters for the Board of Patent Appeals and Interferences (Board) and petitionable matters for the Director of the U.S. Patent and Trademark Office (Director) should be carefully observed. The Board will not ordinarily hear a question that should be decided by the Director on petition, and the Director will not ordinarily entertain a petition where the question presented is a matter appealable to the Board."

In summary, the examiner appropriately followed the reexamination laws and procedures in deciding to issue the Examiner's Answer in the interest of "special dispatch," in accordance with Office rules and procedures. Accordingly, good and sufficient reasons to designate certain rejections as new grounds of rejection in the Examiner's Answer and to reopen prosecution in the reexamination proceeding have not been provided. Therefore, the patent owner's petition, as it relates to reopening prosecution of the instant reexamination proceeding because the examiner failed to follow the laws and procedures, is denied.

CONCLUSION

1. The petition under 37 CFR 1.181 for consideration of designating certain rejections as new grounds of rejection in the Examiner's Answer is denied.

2. This proceedings will be forwarded to the Board of Patent Appeals and Interferences in due course.

3. Telephone inquiries related to this decision should be directed to Alexander J. Kosowski, Supervisory Patent Examiner, at (571) 272-3744.

Irem Yucel, 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.
90/009,020	05/20/2008	5617539	362427.05080	1256

84666 7590 08/19/2010

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 08/19/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
SHOOK, HARDY & BACON L.L.P.
INTELLECTUAL PROPERTY DEPARTMENT
2555 GRAND BOULEVARD
KANSAS CITY, MO 64108-2613

Date:
MAILED

AUG 19 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009020
PATENT NO. : 5617539
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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(For Patent Owner)

MAILED

AUG 19 2010

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(For Third Party Requester)

CENTRAL REEXAMINATION UNIT

In re: Ludwig *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/009,020
Deposited on: 20 May 2008
For: US Patent No. 5,617,539

DECISION
GRANTING
PETITION FOR EXTENSION
OF TIME
[37 CFR §§ 1.550(c) & 1.181]

This is a decision on the 12 August 2010 petition entitled, "Petition For Extension of Time Under 37 CFR § 1.550(c)" requesting the response period for response be extended. The petition was timely filed with certificate of service and fee.

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

The petition is granted for the reasons set forth below.

DECISION

The Patent Owner's representative requests the period for response to be extended for responding to the Office action dated 19 March 2010, which sets two (2) months time for filing a response thereto. The petition for extension of time was timely filed on 12 August 2010, together with authorization for the $200.00 petition fee as required by 37 CFR § 1.550(c) and 37 CFR § 1.17 (g). A certificate of service was not provided with the petition.

The request is hereby granted.

CITATION OF RELEVENT AUTHORITY

37 CFR § 1.550 (c) states:

> (c) The time for taking any action by a patent owner in an *ex 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 § 1.550 (c) to make a showing of "sufficient cause" to grant an extension of time request, **MPEP § 2265** states, in pertinent part:

> Evaluation of whether sufficient cause has been shown for an extension must be made in the context of providing the patent owner with a fair opportunity to present an argument against any attack on the patent, and the requirement of the statute (35 U.S.C. § 305) that the proceedings be conducted with special dispatch.
>
> Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. The reasons 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. All requests must be submitted in a separate paper which will be forwarded to the CRU or TC Director for action. A request for an extension of the time period to file a

petition from the denial of a request for reexamination can only be entertained by filing a petition under 37 CFR § 1.183 with appropriate fee to waive the time provisions of 37 CFR § 1.515(c). Since the reexamination examination process (for a reexamination request filed under 35 U.S.C. § 302 and 37 CFR 1.510) is intended to be essentially *ex parte*, the party requesting reexamination can anticipate that requests for an extension of time to file a petition under 37 CFR §1.515(c) will be granted only in extraordinary situations....

ANALYSIS AND FINDINGS

The patent owner petitions to extend the period for response by adding 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 relates the patent owner requires additional time to submit the Notice of Appeal. The advisory action mailed 19 July 2010 should have permitted sufficient time for filing the Notice of Appeal pursuant to MPEP § 2272. On balance, the petition supports the requirement for "sufficient cause" to grant extension of time.

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

CONCLUSION

1. The patent owner's petition for extension of time in which to file Notice of Appeal is hereby **granted.**

2. The Notice of Appeal filed 12 August 2010 is timely.
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

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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

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Morgan, Lewis & Bockius, LLP (For Patent Owner)
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MAILED
AUG 20 2010
CENTRAL REEXAMINATION UNIT

Shook, Hardy & Bacon, L.L.P. (For Requester)
2555 Grand Blvd.
Kansas City, MO 64108-2613

In re Ludwig et al : DECISION DENYING
Reexamination Proceeding : PETITION UNDER
Control No. 90/009,042 : 37 CFR 1.181 AND
For: U.S. Patent No. 6,594,688 : 37 CFR 1.515(c)

This is a decision on the June 30, 2008 paper entitled "PETITION TO DIRECTOR UNDER 37 CFR §§ 1.515(c) AND 1.181 SEEKING REVIEW OF DENIAL OF REQUEST FOR REEXAMINATION." No fee is required. The petition is before the Director of the Central Reexamination Unit for decision.

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

REVIEW OF FACTS

1. U.S. Patent No. 6,594,688 (hereinafter, the '688 patent) issued on July 15, 2003 to Ludwig et al.

2. On February 14, 2008, the instant request for *ex parte* reexamination of the '688 patent was deposited by a third party requester, and this reexamination proceeding was assigned Control No. 90/009,042 (hereinafter, the '9042 proceeding).

3. On February 28, 2008, a notice of failure to comply with *ex parte* reexamination request filing requirements was mailed.

4. On March 7, 2008, a corrected request for *ex parte* reexamination of the '688 patent was deposited by a third party requester and was assigned a filing date. The corrected request sought reexamination of claims 1, 28, 36, 44, 47, 50, and 54.

5. An order denying the request for *ex parte* reexamination was mailed on May 30, 2008. The order did not find that a Substantial New Question (SNQ) of Patentability was raised for any of the requested claims.

6. On June 30, 2008, the present petition was filed.

DECISION

Third party requester ("Petitioner") in the '9042 reexamination proceeding has petitioned seeking relief from the Examiner's May 30, 2008 Order denying *ex parte* reexamination for all requested claims.

I. Standard of Review

37 CFR 1.515(c) and 1.181 provide for the filing of a petition to review an examiner's determination refusing to order *ex parte* reexamination. The CRU Director's review of the reexamination request on petition is *de novo*. Therefore, this review will determine whether the examiner's refusal to order reexamination for patent claims 1, 28, 36, 44, 47, and 50 was correct.

The following rules and procedures are applicable to this review:

35 U.S.C. § 303(c) provides:

A determination by the Director pursuant to subsection (a) of this section that no substantial new question of patentability has been raised will be final and nonappealable. Upon such a determination, the Director may refund a portion of the reexamination fee required under section 302 of this title.

37 CFR § 1.515(c) provides:

The requester may seek review by a petition to the Director under 37 CFR § 1.181 within one month of the mailing date of the examiner's determination refusing *ex parte* reexamination. Any such petition must comply with 37 CFR § 1.181(b). If no petition is timely filed or if the decision on petition affirms that no substantial new question of patentability has been raised, the determination shall be final and nonappealable."

MPEP § 2248 provides, in pertinent part:

If a petition seeking review of the examiner's determination refusing reexamination is filed, it is forwarded (together with the reexamination file) to the Office of the CRU Director for decision. Where a petition is filed, the CRU Director will review the examiner's determination that a substantial new question of patentability has not been raised. The Director's review will be *de novo.*

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. MPEP §2242.

II. Summary of the Prosecution and Reexamination History of the '688 Patent

The '688 patent issued on July 15, 2003 to Ludwig et al. During the prosecution of the '688 patent on December 2, 2002, the Applicant submitted the following arguments against the rejections on record:

With regards to patented claims 1, 28, and 36 (original claims 22, 66, and 74), the Applicant argued that the prior art failed to teach a "teleconferencing system for conducting a teleconference among a plurality of participants, each of said plurality of participants having a desktop workstation comprising ... at least one adaptive acoustical echo canceller in communication with at least one of said desktop workstations."

With regards to patented claims 44 and 47 (original claims 82 and 85), the Applicant argued that the cited prior art failed to teach "the at least one speaker and at least one microphone are integrated into said unitary housing in a fixed spatial relationship with respect to each other and cooperate with said at least one adaptive acoustic echo canceller to reduce echo during said audio reproduction."

With regards to patented claims 50 and 54 (original claims 88 and 92), the Applicant argued that the prior art failed to teach the use of multiple echo cancellers with a separate echo canceller for each microphone.

Following these remarks, the Examiner allowed the claims. Hence, the record suggests that the arguments were persuasive and the distinguishing features asserted therein were the basis of the reasons for allowance.

III. *De Novo* Review of the Request for Reexamination

In accordance with the requirements of the reexamination statute and rules, a review of the record as it appeared before the Examiner at the time of the order has been undertaken prior to the preparation of this decision. A de novo determination, has been made as to whether the March 7, 2008 request for ex parte reexamination raises at least one substantial new question of patentability (hereinafter "SNQ"). This review will focus on the correctness of the ultimate decision to grant or deny reexamination and will not review specific findings in the order denying reexamination.

For the reasons set forth below, the request for *ex parte* reexamination of the '688 patent filed in the '9042 reexamination proceeding has been found not to present any SNQ. Therefore, the examiner's decision to deny reexamination is proper.

Petitioner first argues that the Rapport references in combination with Baumhauer are properly combinable to render claims 1, 28, 36, 44 and 47 obvious. As an initial matter, it is noted that the question at issue is not whether the Rapport and Baumhauer references render the claims obvious, but is instead whether any of the references raise a SNQ over the requested claims. The Rapport and Baumhauer references will raise a SNQ if their teachings are 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. *MPEP §2242.*

Beginning with Rapport, Rapport does not raise a SNQ over claims 1, 28, 36, 44, and 47 because Rapport does not teach the distinguishing features of the requested claims. The request sets forth that Rapport teaches the claimed elements relating to the teleconferencing system. *See Request for Reexamination, Pages 4-7.* The request does not assert that Rapport teaches any of the above noted distinguishing features of the '688 patent relating to an adaptive acoustical echo canceller. Accordingly, the Rapport reference would not have been important to a reasonable examiner in determining the patentability of claims 1, 28, 36, 44, and 47 in the '688 patent.

Turning to Baumhauer, the request relies upon Baumhauer to disclose the claimed adaptive acoustical echo cancellers. The request states:

> "U.S. Patent No. 5,121,426 issued to Baumhauer, Jr. et al. June 9, 1992 generally discloses a loud speaking telephone station (speakerphone) including a loud speaker and one or more microphones, both of which are in fixed locations within the same housing. *See Baumhauer, Abstract; see also, FIG. 20.* More particularly, the loud speaker is positioned with respect to the microphone(s) so as to substantially reduce acoustic coupling between the loud speaker and the microphone. *See id., col. 2, 11. 40-49.* In embodiments, one or more echo cancellers may be utilized to reduce acoustic coupling,

> for instance, a first echo canceller may be used to further reduce acoustic coupling between the loud speaker and the microphone and a second echo canceller may be use to reduce electrical coupling across the hybrid circuit. *See id., col. 2, 11. 50-55; see also, col. 9, 11. 36-38 and col. 10, 11. 1-11.* A multiple echo canceller embodiment is illustrated in FIG. 21." *see Request for Reexamination, Pages 7-8.*

Baumhauer does not raise a SNQ over claims 1, 28, 36, 44, and 47 because Baumhauer's teachings are cumulative to the teachings previously on the record. Notably, Baumhauer does not teach at least one adaptive acoustical echo canceller in communication with at least one of said desktop workstations or an audio/video conferencing device with at least one microphone are integrated into said unitary housing in a fixed spatial relationship with respect to each other and cooperate with said at least one adaptive acoustic echo canceller to reduce echo during said audio reproduction. Instead, Baumhauer discloses a loud speaking telephone station that includes an acoustical echo canceller. *See Baumhauer, Abstract.* The prior art made of record in the '688 patent similarly teaches acoustical echo cancellers being used in standard environments. For example, Baumhauer's teachings are cumulative to the admitted prior art of the '688 patent. The '688 patent notes the existence of prior art echo cancellers by describing the included echo canceller as a standard echo canceller. *'688 patent, column 17 lines 25-35.* Thus, Baumhauer's disclosure of an acoustical echo canceller in a telephone system is not new and noncumulative with respect to the '688 patent's disclosure of prior art standard echo cancellers that are incorporated into the claimed invention. Accordingly, Baumhauer would not have been important to a reasonable examiner in determining the patentability claims 1, 28, 36, 44, and 47 in the '688 patent.

Turning to claims 50 and 54, Petitioner argues that Rapport, Baumhauer, and Fields are all analogous art and are properly combinable to show the obviousness of claims 50 and 54. As noted above, the question at issue is not whether the Rapport, Fields and Baumhauer references render the claims obvious, but is instead whether any of the references raise a SNQ over the requested claims. Fields and Rapport do not raise a SNQ over claims 50 and 54 because Rapport and Fields do not teach the distinguishing features of the requested claims. The request sets forth that Rapport and Fields teach the claimed elements relating to the teleconferencing system. *Request for Reexamination, Appendix I, Pages xi-xii.* The request does not assert that Rapport or Fields teach any of the above noted distinguishing features of the '688 patent relating to multiple adaptive acoustical echo cancellers. Accordingly, the Rapport and Fields would not have been important to a reasonable examiner in determining the patentability of claims 50 and 54 in the '688 patent.

Further, Baumhauer does not raise a SNQ over claims 50 and 54 because Baumhauer does not teach the distinguishing features of claims 50 and 54 of the '622 patent. The request relies upon Baumhauer to teach the distinguishing feature of multiple echo cancellers with a separate echo canceller for each microphone. The relevant claim limitation requires "at least two echo cancellers that reduce echo during a reproduction of audio signals at said at least one audio reproduction device, wherein said at least two echo cancellers are configured to process audio

signals comprising multiple audio channels." *'688 Patent, Claim 50.* The request states that Baumhauer meets this limitation by teaching:

> "Fig. 21 of Baumhauer illustrates multiple echo cancellers - 218 and 219. "The speech network includes...echo cancellers 218, 219 for reducing acoustic and electrical feedback respectively. In accordance with the invention, loudspeaker 217 is positioned in the null of the directivity pattern of microphone 210 and its associated housing (not shown), the null residing between the major lobe and an adjacent side lobe." [Baumhauer, col. 10, 11. 1-11]
>
> "Echo cancellers 218, 219 are implemented as adaptive transversal filters which automatically adapt their coefficients to the impulse response of the echo path." [Baumhauer, col. 9, 11. 36- 38]" *Request for Reexamination, Appendix I, Pages xi-xii*

The portions of Baumhauer relied upon by the Request do not show at least two echo cancellers...configured to process audio signals comprising multiple channels. The Request has not shown how the portions of Baumhauer disclose multiple audio channels where each channel has an echo canceller. Baumhauer's Figure 21 suggests two echo cancellers operating on the same audio channel. Accordingly, Baumhauer would not have been important to a reasonable examiner in determining the patentability of claims 50 and 54 in the '688 patent.

Accordingly, the petition is **denied**.

SUMMARY AND CONCLUSION

1. The petition is **DENIED**. This decision is without prejudice to the right of the requester to file a new request for reexamination. The new request must set forth a substantial new question of patentability that is different from the substantial new question of patentability set forth in the prior examinations.

2. The decision is final and nonappealable. See 35 USC 303(c) and 37 CFR 1.515(c). No further communication on this matter will be acknowledged or considered.

Gregory Morse, Director
Central Reexamination Unit

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.:20110303

DATE : March 3, 2011

TO SPE OF : ART UNIT 3992

SUBJECT : Request for Certificate of Correction on Patent No.: 6177932 C1

A response is requested with respect to the accompanying request for a certificate of correction.

Please complete this form and return with file, within **7** days to:
Certificates of Correction Branch - PK 3-910
Palm location **7590** - Tel. No. 305-8201

With respect to the change(s) requested, correcting Office and/or Applicant's errors, should the patent read as shown in the certificate of correction? No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Thank You For Your Assistance **Certificates of Correction Branch**

The request for issuing the above-identified correction(s) is hereby:
Note your decision on the appropriate box.

☒ **Approved** **All** changes apply.

☐ **Approved in Part** Specify below which changes **do not** apply.

☐ **Denied** State the reasons for denial below.

Comments:

Eric Keasel

SPE: Eric Keasel **Art Unit** 3992

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In re Ludwig et al : DECISION DENYING
Reexamination Proceeding : PETITION UNDER
Control No. 90/009,081 : 37 CFR 1.181 AND
For: U.S. Patent No. 7,054,904 : 37 CFR 1.515(c)

This is a decision on the June 30, 2008 paper entitled "PETITION TO DIRECTOR UNDER 37 CFR §§ 1.515(c) AND 1.181 SEEKING REVIEW OF DENIAL OF REQUEST FOR REEXAMINATION." No fee is required. The petition is before the Director of the Central Reexamination Unit for decision.

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

REVIEW OF FACTS

1. U.S. Patent No. 7,054,904 (hereinafter, the '904 patent) issued on May 30, 2006 to Ludwig et al.

2. On March 14, 2008, the instant request for *ex parte* reexamination of the '904 patent was deposited by third party requester, and this reexamination proceeding was assigned Control No. 90/009,081 (hereinafter, the '9081 proceeding).

3. An order denying the request for *ex parte* reexamination was mailed on June 3, 2008. The order did not find that a Substantial New Question (SNQ) of Patentability was raised for any of the requested claims.

4. On July 3, 2008, the present petition was filed.

DECISION

Third party requester ("Petitioner") in the '9081 reexamination proceeding has petitioned seeking relief from the Examiner's June 3, 2008 Order denying *ex parte* reexamination for all requested claims.

I. Standard of Review

37 CFR 1.515(c) and 1.181 provide for the filing of a petition to review an examiner's determination refusing to order *ex parte* reexamination. The CRU Director's review of the reexamination request on petition is *de novo*. Therefore, this review will determine whether the examiner's refusal to order reexamination for patent claims 1-32 was correct.

The following rules and procedures are applicable to this review:

35 U.S.C. § 303(c) provides:

A determination by the Director pursuant to subsection (a) of this section that no substantial new question of patentability has been raised will be final and nonappealable. Upon such a determination, the Director may refund a portion of the reexamination fee required under section 302 of this title.

37 CFR § 1.515(c) provides:

The requester may seek review by a petition to the Director under 37 CFR § 1.181 within one month of the mailing date of the examiner's determination refusing *ex parte* reexamination. Any such petition must comply with 37 CFR § 1.181(b). If no petition is timely filed or if the decision on petition affirms that no substantial new question of patentability has been raised, the determination shall be final and nonappealable."

MPEP § 2248 provides, in pertinent part:

If a petition seeking review of the examiner's determination refusing reexamination is filed, it is forwarded (together with the reexamination file) to the Office of the CRU Director for decision. Where a petition is filed, the CRU Director will review the

examiner's determination that a substantial new question of patentability has not been raised. The Director's review will be *de novo.*

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. MPEP §2242.

II. Summary of the Prosecution and Reexamination History of the '709 Patent

The '709 patent issued on May 30, 2006 to Ludwig et al. During the prosecution of the '709 patent, the Examiner issued a final rejection of claims 21, 24, 39, and 42. The Applicant subsequently appealed the Examiner's rejection. On September 29, 2005, the BPAI reversed the Examiner's rejections stating that the cited prior art relied upon in the final rejection did not teach the claimed searchable markers. The claim limitation corresponding to the searchable markers requires:

wherein the system is configured to
D) mark the captured audio/video signals,
i) such that the marked audio/video signals
ii) can later be searched
iii) to access a selected portion thereof;

III. *De Novo* Review of the Request for Reexamination

In accordance with the requirements of the reexamination statute and rules, a review of the record as it appeared before the Examiner at the time of the order has been undertaken prior to the preparation of this decision. A de novo determination, has been made as to whether the March 14, 2008 request for ex parte reexamination raises at least one substantial new question of patentability (hereinafter "SNQ"). This review will focus on the correctness of the ultimate decision to grant or deny reexamination and will not review specific findings in the order denying reexamination.

For the reasons set forth below, the request for *ex parte* reexamination of the '709 patent filed in the '9081 reexamination proceeding has been found not to present any SNQ. Therefore, the examiner's decision to deny reexamination is proper.

Petitioner first argues that the Rapport references in combination with Klingler are properly combinable to render claims 1 and 17 obvious. As an initial matter, it is noted that the question at issue is not whether the Rapport and Klingler references render the claims obvious, but is instead whether any of the references raise a SNQ over the requested claims. The Rapport and Klingler references will raise a SNQ if their teachings are 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. *MPEP §2242.*

Rapport and Klingler do not raise a SNQ over claims 1 and 17 because Rapport does not teach the distinguishing features of the requested claims and because Klingler is cumulative to the prior art considered during the prosecution of the '709 patent. To teach the distinguishing feature of searchable markers, the Request cites the following portions of Rapport and Klingler:

> " Rapport also "supports a recording service, which could provide the basis for the minutes of a conference." Ahuja '88, p. 4. As set forth above, as evidenced by the exchange of information from the virtual meeting room to the VCR associated with a workstation of one of the participants in Figure 3 of Ahuja '92, the Rapport Multimedia Conferencing System provides for storage of the audio, video and data exchanged during a virtual meeting. Such stored information may then be retrieved and played back, in a synchronized manner, by a participant or other individual at a later point in time. See Ahuja '92, pp. 39, 42, FIG. 3. Klingler recognizes the benefits of performing digital image processing operations of stored audio/video content, including the marking of beginning and end points of particular content clips. See Klingler, col. 1, 11.9-11, 11. 29-31, col. 8, 11. 61-64." *see Request for Reexamination, Pages 18-19.*
>
> "...these real-time communications might need synchronization among the message streams." [Ahuja '92, p. 39]
>
> "When multimedia information is exchanged...the delays experienced in each medium should be bound relative to the others .... In this communication environment, the data can be timestamped and buffered when necessary so that separate portions can be recombined for synchronized presentation." [Ahuja '92, p. 42]
>
> It is inherent that once marked, a marked portion of a message may be selectively searched and displayed utilizing known inter- file and intra-file searching capabilities.
>
> "a frame or group of frames may be selected... a number of other icon buttons 126-134 are provided in the ribbon controller 74 for quick positioning and easy control of the marked media... One or more frames can be selected as indicated by the selection bar 136 by clicking and dragging along the horizontal frame display strip 116." [Klingler, Col. 8 lines 36-54]" *see Request for Reexamination, Appendix I, Page iii.*

These teachings cited in the Request do not establish that Rapport teaches the distinguishing features of claims 1 and 17. The cited teachings of Rapport (cited as Ahuja '92) merely disclose the time stamping of portions of a message in order to allow those portions to be recombined for synchronized presentation. Rapport is silent as to the marking of an audio/video signal such that the marked signal can later be searched to access a selected portion thereof. Rapport provides no discussion or suggestion of utilizing the time stamp to facilitate searching to access a selected portion of a marked signal. Accordingly, the Rapport reference would not have been important to a reasonable examiner in determining the patentability of claims 1 and 17 in the '904 patent.

Turning to Klingler, the teachings of Klingler cited in the Request are cumulative to the teachings of Rangan that was cited and applied against the claims of the '709 patent during prosecution. The cited portions of Klingler disclose the marking of the beginning and end points of particular content clips and the selection of particular frames through the use of a ribbon controller. *see Request for Reexamination, Pages 18-19; Appendix I, Page iii.* These features of Klingler are similarly taught by Rangan. Rangan discloses the recording of a video stream into a video rope data structure that is recorded as a sequence of intervals of consecutive frames *(Rangan, Page 1401, right column).* Any part of the video rope may then be selected for playback, moved, copied, or deleted using the control bar *(Rangan, Page 1402, left column).* The question of whether the cited portions of Klingler render the '709 patent obvious or anticipated has previously been decided because those teachings are cumulative to that taught by Rangan. Accordingly, Klingler would not have been important to a reasonable examiner in determining the patentability of one or more claims in the '709 patent because the same question of patentability as to the patent and has already been decided.

Petitioner further argues that the Rapport references in combination with Klingler and Bowker are properly combinable to render claims 11-15 and 27-31 obvious. As noted above, the question at issue is not whether the Rapport, Klingler and Bowker references render the claims obvious, but is instead whether any of the references raise a SNQ over the requested claims. For the same reasons as described above, Rapport and Klingler do not raise a SNQ over the requested claims. Turning to Bowker, the Request does not rely upon Bowker to teach the distinguishing features of independent claims 1 and 17. Instead, the Request relies upon Bowker to teach elements of dependent claims 11-15 and 27-31. Accordingly, Bowker would not have been important to a reasonable examiner in determining the patentability of the claims in the '904 patent.

Accordingly, the petition is **denied**.

SUMMARY AND CONCLUSION

1. The petition is **DENIED**. This decision is without prejudice to the right of the requester to file a new request for reexamination. The new request must set forth a substantial new

question of patentability that is different from the substantial new question of patentability set forth in the prior examinations.

2. The decision is final and nonappealable. See 35 USC 303(c) and 37 CFR 1.515(c). No further communication on this matter will be acknowledged or considered.

Gregory Morse, Director
Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,083	04/18/2008	6629556	038569/340590	6059

71274 7590 04/02/2012

BORGWARNER INC. C/O PATENT CENTRAL LLC
1401 HOLLYWOOD BOULEVARD
HOLLYWOOD, FL 33020-5237

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/02/2012

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

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Date:

MAILED
APR 02 2012
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000434 + 90009083
PATENT NO. : 6629556
TECHNOLOGY CENTER : 3999
ART UNIT : 3991

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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APR 02 2012
CENTRAL REEXAMINATION UNIT
CENTRAL REEXAMINATION UNIT

Ex parte Reexamination Proceeding
Control No. 90/009,083
Filed: April 18, 2008
For: U.S. Patent No. 6,629,556

Inter Partes Reexamination Proceeding
Control No. 95/000,434
Filed: January 21, 2009
For: U.S. Patent No. 6,629,556

DECISION GRANTING PETITION

This is a decision on patent owner's petition paper entitled, "RENEWED PETITION UNDER 37 CFR § 1.183 TO WAIVE RULE 1.955 (REQUEST FOR INTERVIEW)," filed on December 3, 2011.

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

No fee is required for the renewed petition under 37 CFR 1.183.[1]

The petition under 37 CFR 1.183 is granted to the extent set forth herein.

REVIEW OF THE RELEVANT FACTS

1. On October 7, 2003, U.S. Patent No. 6,629,556 ("the '556 patent") issued to Decker *et al.*

2. On April 18, 2008, a request for *ex parte* re-examination, assigned control number 90/009,083 (the '9083 proceeding) was filed, by Honeywell Int'l.[2]

3. On May 28, 2008, the Office ordered re-examination in the '9083 proceeding.

[1] *See* November 18, 2011 decision dismissing patent owner's August 24, 2011 petition under 37 CFR 1.183.
[2] An incomplete request was first deposited on March 18, 2008,

4. On January 29, 2009, a request for *inter partes* re-examination was filed by a third party requester, which request was assigned control no. 95/000,434 ("the '434 proceeding"). Honeywell Int'l was identified as the real party-in-interest.

5. On March 30, 2009, re-examination was ordered in the '434 proceeding.

6. On November 12, 2009, the Office issued a decision *sua sponte* merging the '9083 and '434 proceedings.

7. On June 24, 2011, the Office issued an Action Closing Prosecution (ACP) in the merged proceeding.

8. On August 11, 2011, the '434 third party requester filed a paper entitled "THIRD PARTY REQUESTER'S WITHDRAWAL FROM THE PROCEEDING" in the merged proceeding.

9. On August 24, 2011, patent owner filed a paper entitled "RESPONSE BY PATENT OWNER PURSUANT TO 37 C.F.R. §1.951," responsive to the June 24, 2011 ACP.

10. Concurrently, on August 24, 2011, patent owner filed a petition paper entitled "PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE RULE 1.955 (REQUEST FOR INTERVIEW)."

11. On November 18, 2011, the Office mailed a decision dismissing patent owner's August 24, 2011 petition under 37 CFR 1.183.

12. On December 3, 2011, patent owner filed the instant petition paper entitled, "RENEWED PETITION UNDER 37 CFR § 1.183 TO WAIVE RULE 1.955 (REQUEST FOR INTERVIEW)."

DECISION

Relevant Statutes, Regulations and Procedures

37 CFR 1.183 provides:

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

37 CFR 1.955 provides:

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

Renewed Request to Waive the 37 CFR 1.955 Prohibition of Interviews

In the December 3, 2011 renewed petition under 37 CFR 1.183, patent owner requests waiver of the requirements of 37 CFR 1.955, prohibiting interviews in an *inter partes* reexamination proceeding, to conduct a single interview. The instant petition has been fully considered. 37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule.

A review of the *Notice of Final Rule Making, Rules to Implement Optional Inter Partes Reexamination Proceedings*, 65 FR 76755 (Dec. 7, 2000), 1242 *Off. Gaz. Pat. Office* 12 (Jan. 2, 2001) (final rule) reveals that the Notice of Proposed Rule Making proposed implementation of a regulation that would have permitted interviews in *inter partes* reexamination proceedings. In the final rule, however, the Office decided to preclude both *ex parte* and *inter partes* interviews in an *inter partes* reexamination proceeding, and accordingly published 37 CFR 1.955 in its present form.[3] The Office concluded that, for a variety of reasons, "[n]o matter what the structure of the interview, the presence of a third party requester (or a separate interview with the requester) will complicate the reexamination proceeding and significantly delay it."[4] Thus, the basis for the present 37 CFR 1.955 proscription of all and any interviews in an *inter partes* reexamination proceeding was that the presence of two (or more) parties in the proceeding would interfere with the Office's ability to conduct an *inter partes* reexamination proceeding with special dispatch as mandated by 35 U.S.C. § 314.

In this instance, however, third party requester has stated on the record that it will not further participate in the '434 *inter partes* reexamination proceeding.[5] Thus, only a single party (patent owner) will now participate in the '434 *inter partes* reexamination proceeding, and in any interview that might be permitted in the proceeding. Based on the present facts and circumstances, it is found that permitting an interview to be conducted at this point in the '434 *inter partes* proceeding would not be anticipated to potentially hinder the ability of the Office to conduct the '434 *inter partes* proceeding with special dispatch, but rather may well assist the Office in expeditiously resolving the proceeding.

In support of its request for waiver of 37 CFR 1.955 to conduct a single interview with the Office prior to issuance of the next Office action, patent owner asserts that, given the complexity of the subject technology (turbocharger technology), an interview would enhance the understanding of the technology and the relevant patentability issues.[6] Patent owner asserts the expertise of the inventors would enhance the understanding of the technology and the presently claimed invention, with support regarding inventor expertise, to assist the Office in addressing the

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[3] 65 FR at 76768.
[4] 65 FR at 76769.
[5] *Requester's Notice to the Patent Office*, filed August 11, 2011 (stating "Requester hereby notifies the Office that it has entered into a Settlement Agreement with the patent owner and will not further participate in this reexamination proceeding.")
[6] Initial petition under 37 CFR 1.183.

outstanding issues in the proceeding.[7] Further, patent owner has identified the critical technical and claim language issues for discussion in the interview, which may result in advancement of prosecution with special dispatch.[8]

In view of the particular facts and circumstances set forth herein, in this instance, the record in the '434 *inter partes* reexamination proceeding is deemed to present an extraordinary situation which justifies waiver of 37 CFR 1.955 to further the interests of the patent owner, members of the public who may be interested in the outcome of the proceedings, and the Office. Thus, patent owner's renewed petition under 37 CFR 1.183 is granted to the extent that a single interview will be permitted. It is noted, however, that there are no established regulatory or practice guidelines to govern the manner in which an interview in an *inter partes* reexamination proceeding is to be conducted. Therefore, the waiver of 37 CFR 1.955 so as to permit an interview is granted to the extent that patent owner satisfies the following preliminary requirements.[9]

Requirements and Guidelines for Conducting Interview

A. Preliminary Requirements

1. Promptly upon receipt of the present decision, patent owner must contact the examiner in charge of the proceeding to identify the issues that are sought to be discussed, to determine if an interview will be granted with respect to those issues (which the examiner is directed to consider based on criteria analogous to that of granting *ex parte* reexamination interviews), and to ascertain the examiner's desktop facsimile number.

2. At least three (3) working days prior to the interview, patent owner must file an informal written statement of the issues to be discussed at the interview, and an informal copy of any proposed claims to be discussed, unless the examiner waives this requirement. The copy of these materials is to be submitted by facsimile transmission (FAX) directly to the examiner or hand-carried to the examiner so as to avoid the possibility of delay in matching the materials with the file. The informal copies that are considered by the examiner will be made of record in the reexamination proceeding as an attachment to the Interview Summary form PTOL-474 completed by the examiner after the interview.

3. Patent owner must serve a copy of the papers discussed in item (2) above on the third party requester in accordance with 37 CFR 1.903, and include a copy of the certificate of service of such papers in the papers as filed in item (2) above.

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[7] Renewed petition under 37 CFR 1.183 at pages 3-5.
[8] Renewed petition under 37 CFR 1.183 at pages 2-3.
[9] The requirements and guidelines are analogous to those set forth in MPEP 2281 for interviews in *ex parte* reexamination proceedings.

B. Guidelines for Conducting the Interview

1. The interview must be conducted in the Office at such times, within Office hours as examiner may designate. The interview will not be permitted at any other time or place, without the authority of the Director.

2. Patent owner must make every effort to conduct the interview in not more than one (1) hour. Patent owner may, however, show cause, at the interview, why more time is needed, and the examiner is free to extend the interview, at the examiner's sole discretion.

3. The interview should be attended by the conferees who signed the June 24, 2011 Office action, or their substitutes (if the conferees are not reasonably available).

4. At the conclusion of the interview, the examiner will prepare an interview summary, using form PTOL-474, the *Ex Parte* Interview Summary Form, and making appropriate modifications thereto. A copy of the interview summary should be given to patent owner at the conclusion of the interview. A copy of the interview summary form will also be mailed to third party requester, and the original will be made of record in the Image File Wrapper for the proceeding.

C. Prosecution after the Interview

1. Patent owner must file a complete written statement of the reasons presented at the interview as warranting favorable action, to avoid termination or limitation of the proceeding as appropriate under 37 CFR 1.957. The written statement must be filed either as a separate part of a response to an Office action outstanding at the time of the interview, or as a separate paper filed within one month from the date of the interview, whichever is later.

2. All papers filed by patent owner in the '434 *inter partes* reexamination proceeding must continue to be served in accordance with 37 CFR 1.903, and service must be reflected by attaching a certificate of service, or consideration of the document may be refused.

CONCLUSION

1. Patent owner's December 3, 2011 renewed petition under 37 CFR 1.183 to waive the provisions of 37 CFR 1.955 is granted to the extent that a single interview will be permitted, upon compliance with the Preliminary Requirements set forth above.

2. The provisions of 37 CFR 1.955 are waived solely on the present facts and circumstances, and solely for the purposes of conducting one interview with respect to the June 24, 2011 Office action.

3. Any future petition for waiver of 37 CFR 1.955 will not be granted absent a further strong showing of necessity, including an explanation of why the basis for any further interview could not have been addressed in the first interview.

4. Any questions concerning this communication should be directed to Joseph F. Weiss, Jr., Legal Advisor, at (571) 272-7759.

Pinchus M. Laufer
Senior Legal Advisor
Office of Patent Legal Administration

March 30, 2012

United States Patent and Trademark Office

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(For Patent Owner)

MAILED

JAN 18 2012

CENTRAL REEXAMINATION UNIT

Ronald L. Yin
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2000 UNIVERSITY AVENUE
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(For Third Party Requester)

In re Hitz et al.
Ex Parte Reexamination Proceeding
Control No. 90/008,903
Filed: December 26, 2007
For: U.S. Patent No. 5,819,292

In re Hitz et al.
Ex Parte Reexamination Proceeding
Control No. 90/009,103
Filed: April 4, 2008
For: U.S. Patent No. 5,819,292

DECISION
DENYING PETITION
UNDER 1.181

This is a decision on the May 24, 2010 patent owner petition entitled "PETITION FOR DESIGNATION OF EXAMINER'S ANSWER AS CONTAINING NEW GROUNDS OF REJECTION (37 CFR § 1.181 AND MPEP § 1207.03(IV))."

The patent owner petition is before the Director of the Central Reexamination Unit for determination.

The petition is denied with respect to designating the grounds of rejection as new grounds of rejection and reopening prosecution.

STATEMENT OF RELEVANT FACTS

1. On December 26, 2007, a request for *ex parte* reexamination of claims 1-4 and 8-20 of U.S. Patent Number 5,819,292 was filed by the third party requester; the resulting reexamination proceeding was given a filing date and assigned control number 90/008,903.

2. On March 18, 2008, an order granting reexamination of claims 1 and 4 of the '292 patent was mailed in the '8903 proceeding.

3. On April 4, 2008, a request for ex parte reexamination of claims 4, 8, 11-15, and 20 of U.S. Patent Number 5,819,292 was filed by the third party requester; the resulting reexamination proceeding was given a filing date and assigned control number 90/009,103.

4. On June 6, 2008, an order granting reexamination of claims 4, 8, 11-15, and 20 of the '292 patent was mailed in the '9103 proceeding.

5. On September 5, 2008, a decision merging the '8903 and '9103 proceedings (hereinafter, the merged '8903/'9103 proceeding) was issued.

6. On September 26, 2008, a non-final Office action, in which all claims subject to reexamination (claims 1, 4, 8, 11-15, and 20) were rejected under multiple grounds based upon 35 U.S.C. § 102(b), was mailed in the merged '8903/'9103 proceeding.

7. On May 12, 2009, patent owner submitted a timely and compliant response to the outstanding Office action, including an amendment to claim 1 and new claims 21-24.

8. On June 16, 2009, a final rejection was mailed, finding claims 1, 21, and 22 patentable, and rejecting claims 4, 8, 11-15, 20 on grounds previously set forth in the September 26, 2008 rejection, and rejecting newly added claims 20, 23, and 24.

9. On August 17, 2009, patent owner submitted a timely submission as a response to the June 16, 2009 final rejection. The submission included amendments to claims 11, 15, 23, and 24. Rejected independent claim 4 was not sought to be amended.

10. On September 8, 2009, the Office issued an advisory action refusing entry to the claim amendments proposed in the August 17, 2009 patent owner submission, finding that the amendments neither simplified the issues for appeal nor placed the claims in condition for allowance/confirmation. Rather, the advisory action stated that the amendments would raise new issues requiring further consideration and/or search.

11. On October 15, 2009, patent owner filed a Notice of appeal.

12. On December 15, 2009, the Office granted a December 11, 2009 petition under 37 c.f.r. § 1.550(c) granting an extension of time for filing an appeal brief until January 15, 2010.

13. On February 16, 2010, patent owner filed an appeal brief.

14. On April 19, 2010, an Examiner's Answer was mailed.

15. On May 24, 2010, the instant petition under 37 CFR 1.181 was filed.

16. On June 30, 2010, patent owner filed a reply brief.

DECISION

The patent owner (petitioner) states that the examiner made, in effect, new grounds of rejection in the Examiner's Answer. In the May 24, 2010 petition, the petitioner explains that the Examiner's Answer contains "new" grounds of rejection based upon a "new" alternative claim construction for the term "consistency point" or reliance on personal knowledge. See pages 10-15 of the May 24, 2010 petition. Petitioner considers these alleged "new" responses as new grounds of rejection, and requests that prosecution be reopened.

In response to patent owner's arguments that the examiner introduced new grounds of rejection in the Examiner's Answer, the director finds there are not good and sufficient reasons to designate the rejections as new grounds of rejection. First, 35 U.S.C. 305 requires that all *ex parte* reexamination proceedings to be acted upon with "special dispatch." The rules and procedures of the Office were established through notice and comment in order to achieve special dispatch in a reasonable manner. Office rules and procedures encourage examiners to look at the facts involved in a particular proceeding and to weigh the equities before issuing a final rejection, for consideration of after final responses, and for designating new grounds of rejection in Examiner's Answers. See MPEP 2272 and 1207.03.

Turning to the facts in this proceeding, the record is clear that patent owner has been given numerous opportunities to respond to the prior art rejections and to understand how the prior art is being applied to the claim limitations. See the relevant facts section above and see below for a more detailed summary.

Pre-Appeal:
A first non-final rejection was mailed by the USPTO on September 26, 2008. Patent claim 4 was rejected under 35 USC 102(b) as being anticipated by each of the references to Rosenblum, Sidebotham, Quinlan and Gait and patent claim 20 was rejected under 35 USC 102(b) as being anticipated by each of the references to Quinlan and Gait.

Patent owner filed a compliant response on May 12, 2009. In the response, patent owner discussed the teachings of the '292 patent on pages 15-16 thereof. Patent owner discussed the teachings of Rosenblum on pages 21-24 of the response. Specifically, patent owner presented the following arguments with regard to claim 4 and Rosenblum on page 24 of the response:

> "Thus, a fair and proper reading of the Rosenblum paper, in light of the Rosenblum dissertation, reveals that a second superblock is not stored. Thus, the element of claim 4 of 'storing in said non-volatile storage means a second file system' information structure for said second consistency point, said second file system

> information structure comprising data describing a layout said file system at said second consistency point of said file system' is not satisfied. Accordingly, Patent Owner respectfully requests withdrawal of the rejection of claim 4."

Patent owner discussed the teachings of Sidebotham on pages 24-26 of the response. Specifically, patent owner also presented the following arguments with regard to claim 4 and Sidebotham on page 26 of the response:

> "Thus, in this respect, the clone of Sidebotham is more similar to a snapshot of the '292 patent and not a consistency point, as claimed in the patent. Accordingly, Sidebotham is silent as the first element of claim 4 'storing a first file system information structure for a first consistency point in said non-volatile storage means, said first file system information structure comprising data describing a layout of said file system at said first consistency point of said file system.'"
>
> ...
>
> "The Office Action then states 'each clone represents a different consistency point of the file system. Yet, as noted above, the clone of Sidebotham is not a consistency point as claimed in the '292 patent. Accordingly, Sidebotham does not teach or suggest 'storing in said non-volatile storage means a second file system information structure, said second file system information structure comprising data describing a layout of said file system at said second consistency point of said file system.'"

Patent owner discussed the teachings of Quinlan and Gait on pages 26-29 and 31-33 of the response. Specifically, patent owner presented the following arguments with regard to claim 4 and each of Quinlan and Gait on pages 28 and 33 of the response:

> "Accordingly, the ... reference is silent with regard to the limitations of claim 4 that recite two consistency points:
> 'storing a first file system information structure for a first consistency point in said non-volatile storage means, said first file system information structure comprising data describing a layout of said file system at said first consistency point of said file system'; and
> 'storing in said non-volatile storage means a second file system information structure for said second consistency point, said second file system information structure comprising data describing a layout of said file system at said second consistency point of said file system.'"

Claim 20 which depends from claim 8 was argued as being patentable for the reasons set forth with regard to claim 8. See, e.g., "[a]ccordingly, the Quinlan reference fails to satisfy the limitation of claim 8 'making a copy of said meta-data at each of a plurality of said states of said file system" (see pages 29-31 of response) and "[a]s such, Gait appears to be silent with respect to a plurality of write-protected versions (read-only copies) of a file system, as recited in claim 8. Regarding 'marking a copy of said meta-data ... ' recited in the second element of claim 8, the Office Action cites to Figure 3 only of Gait. To the extent the Examiner is pointing to Gait's 'timestamps' as representing the claimed 'meta-data,' then Gait fails to satisfy the second element of claim 8 because a timestamp is not copied. On the contrary, a new timestamp is written periodically. By the same reasoning, Gait does not satisfy the third element of claim 8. See, Gait at pp. 82-83 (paragraph following 'RELIABILITY')." (see pages 33-35 of the response).

A final rejection was mailed by the USPTO on June 16, 2009. Patent claim 4 was again rejected under 35 USC 102(b) as being anticipated by each of the references to Rosenblum, Sidebotham, Quinlan and Gait and patent claim 20 was again rejected under 35 USC 102(b) as being anticipated by each of the references to Quinlan and Gait. Additionally, on pages 13-17 of the Office action, the examiner responded to Patent Owner's arguments with regard to claim 4 and Rosenblum. See especially paragraph 29, in which the examiner explained, in part:

> "Because Rosenblum teaches performing more than one check pointing operation that preserves a complete file system structure at a consistency point, the limitation 'storing ... a second file system information structure for said second consistency point ...' is met. The claim requires storage of 'a second file system information structure,' not 'a second file system information structure that comprises a second superblock.'"

With regard to claim 4 and Sidebotham, the examiner responded, in part, on pages 14-15 of the action :

> "According to Patent Owner, the clone of Sidebotham is more similar to a snapshot of the '292 patent and not a consistency points. (Remarks, p.26). Patent owner provides no basis for these definitions of snapshots and consistency points. A consistency point is simply a point at which a file system is consistent. Snapshots, checkpoint operations, and other types of backup or cloning operations are operations that capture and preserve a file system state at a consistency point so that the file system can be restored at that consistency point if needed. Whether the blocks involved are writable or read-only is a matter of design choice, not a characteristic of a consistency point or a snapshot as Patent Owner asserts. Moreover, reusability of blocks is not an element of the claim."

With regard to claim 4 and Quinlan, the examiner stated, in part, on page 15 of the action:

> "Patent Owner's assertion ... this is true for all file systems including the file system disclosed in the '292 patent. There can only be one consistent state for any file system at any given time. As to Patent Owner's arguments regarding the differences between a snapshot and a consistency point (see Remarks, p. 28), they have been addressed above."

With regard to claim 4 and Gait, the examiner responded on page 16 of the action:

> Patent Owner's arguments against the Quinlan regarding claim 4 are almost identical to those against Quinlan. They have been addressed above.

On July 30, 2009, a personal interview was held. As indicated by the examiner's interview summary of July 30, 2009, several possible amendments to the file system information structure and consistency point limitations of claim 4 were discussed in attempts to distinguish the claimed invention from the applied prior art references. According to the patent owner's summary of the interview, the examiners provided guidance and suggested possible claim language, but that no agreement was reached. See page 16 of the August 17, 2009 response.

On August 17, 2009, patent owner filed a response traversing the rejection of the claims, amending only claims 11 and 15 and adding new claims 23-24. On pages 16-17 of the response, the patent owner stated that they realized that the examiner embraced a broader claim interpretation by the final Office action and the personal interview. Specifically, on page 17 of the response, patent owner recognized that the construction of the phrase "file system information structure" will be at issue during the appeal. The response also included arguments

pertaining to discussion of the terms "consistency point" and "file system information structure" on pages 21-23 of the response. Specifically, on page 23 of the response, patent owner states that:

> "The '292 patent repeatedly states that the 'consistency point' refers to 'the set of self-consistent blocks on disk that is rooted by [a] root inode.' *See, e.g.*, '292 patent at 4:11-13 and 11:66-12:1. Furthermore, the '292 patent specification states that a new consistency point occurs when the file system information structure, in its current fixed location, is updated by writing a new root inode. *Id.* at 12:9-24.
>
> The '292 patent specification repeatedly states that the 'file system information structure' is stored in a fixed location on disk. *Id.* at 9:33-35, 10:58-60 and 11:3-5."

With regard to claim 4 and Rosenblum, Sidebotham, Quinlan and Gait, the patent owner made substantially the same argument. For example, see page 24, in which the patent owner states:

> "The preamble of claim 4 states that the claim is directed to a method for maintaining a file system at successive 'consistency points.' To that end, the claim recites the steps of storing a first file system information structure for a 'first consistency point' in the non-volatile storage means and writing blocks that have been modified from the first consistency point 'as of the commencement of a second consistency point.' The claim then concludes with the step of storing a second file information structure for a 'second consistency point' in the non-volatile storage means. Read in the context of the '292 patent specification, this language means that the file system stored on the non- volatile storage means transitions from one consistency point to a next consistency point, and is always in a consistent state on the non-volatile storage means."
>
> See also page 28 of the response, in which the patent owner states: "In contrast to the requirements of claim 4, Sidebotham, like Rosenblum, describes a file system that is not *always* in a consistent state."
>
> On page 30 of the response, patent owner argues : "... nothing in Quinlan discloses or suggests that the file system as a whole, including the information stored on the WORM cache, transitions from one consistency point to a next consistency point, as recited in claim 4, to thereby always be in a consistent state in the non-volatile storage means."
>
> Regarding Gait, the patent owner states on page 35 that: "One version remains consistent as a prior instance of the file system, but the other continues as an active system, subject to inconsistency. See id. at p. 83. Of course, this implies that when the system of Gait is between timestamps, the state of the system stored in nonvolatile memory is not consistent."

An advisory action was mailed by the USPTO on September 8, 2009 indicating the after-final amendment would not be entered because of the amendments to claims 11, 23 and 24. The examiner also indicated that the request for reconsideration had been considered but did not place the application in condition for allowance. The examiner commented in pertinent part:

> "The Examiner agrees that the term 'consistency point' is defined in the specification to mean a 'set of self-consistent blocks on disk that is rooted by a root inode' (see Abstract, c4: 11-13, cl 1:66-cl2:1). However, the Examiner does not agree that the term 'file system

information structure' is defined in the specification as Patent Owner asserts. A single sentence that points to an illustrative structure does not define the structure. Patent Owner is free to define the structure by claiming structural components as limitations to the structure, but is not free to import limitations from an illustration in the specification without expressly claiming them.

Claim 4: Patent Owner's argument that the disclosed file system is always in consistent state on the non-volatile system is not supported by the specification or the arguments. The portion of the specification discussed (c4:13-15) discloses how the disclosed system implements consistency point as defined in the specification, but does not support Patent Owner's assertion that the disclosed file system is always in consistent state. Snapshots and checkpoints are generally created to recover from crashes and to restore the file system to a known and recoverable consistent state of the file system. If the disclosed file system can never become inconsistent as Patent Owner seems to claim, there would be no need for snapshots or need to recover the file system as described in the specification. If Patent Owner's disclosed system crashes while performing any of the steps 510-540 of Figure 5, Patent Owner's file system becomes inconsistent just as in Rosenbloom's [sic] system, but it does have a consistency point to roll back to just as in Rosenbloom's [sic] system. Patent Owner has not provided any satisfactory explanation that patentably distinguishes successive consistency points generated by flushing operations disclosed in Figure 5 and successive consistency points generated by flushing operations performed in Rosenbloom's [sic] system (see page 9, 4.1 Checkpoints, "it writes out all modified information to the log ... "; "Sprite performs checkpoints at periodic intervals ... ") or any other prior art file system. Also claim 4 does not require the file system to be always consistent. The claim merely requires performance of steps recited in the body of the claim.

Patent Owner makes similar arguments regarding other prior art references. These arguments are just as unpersuasive as the argument againt[sic] Rosenbloom [sic]."

On October 15, 2010, patent owner filed a notice of Appeal.

Post Appeal:

Patent owner filed an Appeal Brief on February 16, 2010. On page 3 of the brief, the patent owner recognizes that the advisory action discussed the construction of the "consistency point" limitation and offered an alternative construction, as argued by the patent owner. In the arguments section VIII, Section A, Sections 2-4 included arguments directed to "2. The Final Office Action Failed To Set Forth A Prima Facie Case Of Anticipation Of Claims 4 And 20 Based On The Express Definition Of 'Consistency Point' That Governs The Construction Of Those Claims"; "3. The Limitation "File System Information Structure" Recited In Claim 4 Must Be Construed In Light Of The Specification"; and "4. Claim 4, Properly Construed, Recites A File System That Is Always In A Consistent State On The Non-Volatile Storage Means." See pages 14-17 of the Brief. See also, subsection B, subparts 2-5, on pages 18-22 and 24-24 of the brief, which included arguments with regard to claims 4 and/or 20 with regard to each of the references Rosenblum, Sidebotham, Quinlan and Gait. The patent owner argues that the references do not describe a file system that is not always in a consistent state.

An Examiner's Answer was mailed by the USPTO on April 19, 2010. The Examiner's Answer

> maintained the previous rejections of claims 4 and 20. In section (10) of the Answer, beginning on page 13, the examiner responded to patent owner's arguments utilizing the similar headings used in the appeal brief, e.g. pages 13-16 of the answer, which responded to subsection A, subparts 2-4 of the Brief, and pages 16-25 of the answer, which responded to subsection B, subparts 2-5 of the Brief.

Specifically, upon careful review of the record, the advisory action of September 8, 2009 explained the different constructions for the "consistency point" claim limitation and the examiner's knowledge regarding the file system limitations. Patent owner acknowledged that the advisory action stated such positions on page 3 of the appeal brief, as discussed above. In other words, the advisory action stated the examiner's position on these issues, and such position is consistent with the examiner's response beginning on page 13 of the April 19, 2010 Examiner's Answer. For example, like in the advisory action, the examiner recognized that the '292 patent set forth a definition of the term "consistency point." See page 13 of the Answer. The examiner goes on to explain why this definition is not controlling when applying the references to the claims, and even if it was applied, the same applied references would teach the limitation. See pages 13-14 of the Answer. This position is consistent with the position set forth in the advisory action. Moreover, the record is clear that during the entire prosecution of this proceeding, the construction of the "consistency point" and "file system information structure" limitations were at issue and these issues were further defined by responses by the patent owner and examiner throughout the prosecution. For similar reasons, the record shows that the examiner's "personal knowledge" position in the brief on page 19 of the Answer was in response to arguments raised by the appeal brief, and is consistent with the position set forth in the advisory action concerning the consistency of the file system. Accordingly, the record does not support patent owner's allegation that the Examiner's Answer stated new rationales in the grounds of rejection for the first time.

In addition, MPEP 1207.02 mandates that the Examiner's Answer make a statement of whether the examiner disagrees with each of the contentions raised by the appellant brief and an explanation of the reasons for disagreement with any such contentions. The examiner must use headings and subheadings paralleling the headings and subheadings utilized in the appellant's brief. The prosecution history indicates that such was provided on pages 13 *et seq.* of the Examiner's Answer. In the petition, the patent owner recognized that where the statutory basis for the rejection remains the same, and the evidence relied upon in support of the rejection remains the same, a change in the discussion of, or rationale in support of, the rejection does not necessarily constitute a new ground of rejection. See In re Kronig, 539 F.2d 1300, 1302-03,190 USPQ 425, 426-27 (CCPA 1976) and MPEP 1207.03. In addition, there is no new ground of rejection when the basic thrust of the rejection remains the same such that an appellant has been given a fair opportunity to react to the rejection. Patent owner alleges the explanations in the Examiner's Answer regarding "consistency point" and the "file system information structure" change the basic thrust of the rejection such that the patent owner was not given a fair opportunity to react to the rejection. However, for the reasons explained in the above paragraph, it cannot be said that the Examiner's Answer changed the basic thrust of the rejections to such an extent that it resulted in new grounds of rejection. To reiterate, on pages 13-25 of the Examiner's Answer, the examiner was addressing arguments of the patent owner by clarifying issues and explaining why he disagrees with patent owner's contentions in accordance with

Office policies, and did not modify or alter the grounds of rejection. Therefore, in summary, no new grounds of rejection were made in the Examiner's Answer.

Upon review of the record, the basic thrust of the rejections have been and continue to be the interpretation of the terminology "consistency point," the interpretation of the claim limitations of claim 4 including such terminology, for example:

> "storing a first file system information structure for a first consistency point in said non-volatile storage means, said first file system information structure comprising data describing a layout of said file system at said first consistency point of said file system"; and
> "storing in said non-volatile storage means a second file system information structure for said second consistency point, said second file system information structure comprising data describing a layout of said file system at said second consistency point of said file system."

In other words, the examiner's broad interpretation of these limitations, the patent owner's narrower interpretation of the same limitations, and application of the teachings of the Rosenblum, Sidebotham, Quinlan and Gait to the same limitations have consistently been the issues present during the prosecution of this proceeding. As discussed in detailed above, the patent owner has, since the first Office action, addressed the claim interpretation as well how the teachings of the references do not apply to the limitations at issue.

Finally, the allegation that the patent owner is "clearly prejudiced" because of the failure to designate the rejections as new grounds, which precluded the patent owner from exercising the option to reopen prosecution, is also not supported by the prosecution history and evidence of record. Specifically, patent owner argues the lack of such opportunity amounts to the lack of opportunity to address the alleged newly presented rejections. However, as discussed above, the record does not support that the Examiner's Answer contains new grounds of rejection or that patent owner has not had a fair opportunity to respond to the rejections. For the reasons set forth above, it is deemed that the examiner followed Office rules and procedures and did not prejudice the patent owner by not designating the grounds of rejection as new.

Accordingly the petition fails to establish the existence of procedural error due to a change to the basic thrust of the rejection such that the patent Owner was not given a fair opportunity to respond to the rejection as set forth in MPEP 1207. In conclusion, the record does not support patent owner's statement that the examiner had made new grounds of rejection in the Examiner's Answer.

Finally, to the extent that the petitioner is requesting review of the substance of the examiner's response, such issues touch on matters that are appealable, and therefore will not be addressed in this petition. See MPEP 1002 and 1201. Specifically, MPEP 1202 states "[t]he line of demarcation between appealable matters for the Board of Patent Appeals and Interferences (Board) and petitionable matters for the Director of the U.S. Patent and Trademark Office (Director) should be carefully observed. The Board will not ordinarily hear a question that should be decided by the Director on petition, and the Director will not ordinarily entertain a petition where the question presented is a matter appealable to the Board."

In summary, the examiner appropriately followed the reexamination laws and procedures in deciding to issue the Examiner's Answer in the interest of "special dispatch," in accordance with Office rules and procedures. Accordingly, good and sufficient reasons to designate certain rejections as new grounds of rejection in the Examiner's Answer and to reopen prosecution in the reexamination proceeding have not been provided. Therefore, the patent owner's petition, as it relates to reopening prosecution of the instant reexamination proceeding because the examiner failed to follow the laws and procedures, is denied.

CONCLUSION

1. The petition under 37 CFR 1.181 for consideration of designating certain rejections as new grounds of rejection in the Examiner's Answer is denied.

2. This proceedings will be forwarded to the Board of Patent Appeals and Interferences in due course.

3. Telephone inquiries related to this decision should be directed to Alexander J. Kosowski, Supervisory Patent Examiner, at (571) 272-3744.

Irem Yucel, 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.
90/009,119	04/21/2008	6988920	4637/0125PUS3	3291

60601 7590 04/07/2011

Muncy, Geissler, Olds & Lowe, PLLC
4000 Legato Road
Suite 310
FAIRFAX, VA 22033

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/07/2011

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
LAW OFFICES OF CLEMENT CHENG
17220 NEWHOPE STREET #127
FOUNTAIN VALLEY, CA 92708

Date: MAILED
APR 07 2011
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009119
PATENT NO. : 6988920
ART UNIT : 3993

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

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

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United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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MAILED
APR 07 2011
CENTRAL REEXAMINATION UNIT

MUNCY, GEISSLER, OLDS & LOWE, PLLC (For Patent Owner)
4000 LEGATO ROAD
SUITE 310
FAIRFAX, VA 22033

CLEMENT CHENG (For Requester)
LAW OFFICES OF CLEMENT CHENG
17220 NEWHOPE STREET
SUITE 127
FOUNTAIN VALLEY, CA 92708

In re Yeh Reexamination Proceeding
Control No.: 90/009,119
Filed: April 21, 2008
For: U.S. Patent No.: 6,988,920

: **DECISION ON PETITION**
: **UNDER 37 CFR 1.198**
: **TO ENTER**
: **EVIDENCE**

This is a decision on the February 15, 2011, entitled "Contingent Petition under 37 CFR 1.198 and MPEP 1214.07" requesting that two expert declarations, filed concurrently with the petition, be entered into the reexamination record. The patent owner has petitioned under 37 CFR 1.198 for entry of evidence after a decision by the Board of Patent Appeals and Interferences (BPAI).

The petition is before the Director of Technology Center 1600, who also oversees the Central Reexamination Unit, for decision.

The petition is dismissed for the reasons set forth below.

REVIEW OF THE RELEVANT FACTS

1. On January 24, 2006, U.S. Patent 6,988,920 (the '920 patent) issued to *Yeh*.

2. On April 21, 2008, a request for *ex parte* reexamination of claims 1, 4, 6-8, 10, and 12-14 of the '920 patent was filed by a third party requester. The request was assigned reexamination control number 90/009,119 (the '119 proceeding).

3. On May 16, 2008, the Office issued an order granting the'119 *ex parte* reexamination request and setting a two month time period for a Patent Owner's Statement. The order stated that claims 1, 4, 6-8, 10, and 12-14 of the '920 patent would be subject to reexamination.

4. On July 16, 2008, the patent owner filed a statement pursuant to 37 CFR 1.530 in the '119 *ex parte* reexamination proceeding. The statement included proposed amendments to claims 4, 6, 8, 10, and 12 and cancellation of claims 2, 3, 5, 7, 9, and 11. No evidence was provided in support of the remarks alleging patentability.

5. On March 18, 2009, a first Office action on the merits issued rejecting claims 1, 4, 6, 8, 10, and 12-14 as unpatentable over Chang et al. in view of Szabad, Jr. (and other secondary references for some of the claims).

6. On May 15, 2009, the patent owner filed a response adding new claims 15-28 and providing remarks asserting patentability over the prior art of record. No evidence was provided in support of the remarks alleging patentability.

7. On June 18 2009, a final Office action was issued in the '119 proceeding rejecting claims 1, 4, 6, 8, 10, and 12-28 as unpatentable over Chang et al. in view of Szabad, Jr. (and other secondary references).

8. On August 17, 2009, the patent owner submitted an after-final response under 37 CFR 1.116 consisting of the cancellation of proposed new claims 8-27 and an amendment to proposed new claim 28. No evidence was provided in support of the remarks alleging patentability.

9. On August 27, 2009, the Office issued an Advisory action responding to patent owner's after-final submissions. The action stated that the amendments to the claims would be entered for purposes of appeal and that the request for reconsideration was considered but does not overcome the rejections, except for the rejections of claims 23-28 under 35 USC 112.

10. On October 19, 2009, the patent owner filed a notice of appeal in the '119 proceeding.

11. On October 22, 2009, the patent owner filed another after-final response under 37 CFR 1.116 consisting of proposed amendments to claims 1, 4, 6, 8, 10, 12-14, and 28. No evidence was provided in support of the remarks alleging patentability.

12. On December 10, 2009, the Office issued an Advisory action responding to patent owner's after-final submissions. The action stated that the amendments to the claims would not be entered because they raised new issues, new matter, and do not place the proceeding in better form for appeal.

13. On December 22, 2009, the patent owner submitted an appeal brief.

14. On March 25, 2010, the Office mailed an Examiner's Answer.

15. On May 25, 2010, the patent owner filed a reply brief.

16. On December 15, 2010, the Office mailed a Decision by the BPAI that affirmed the rejections of claims 1, 6, 15, and 16 based on Chang et al. (and other secondary references).

17. On February 15, 2011, the patent owner filed a Request for Rehearing and the instant petition under 37 CFR 1.198 if the BPAI should not find the request for rehearing persuasive.

18. On April 1, 2011, the Office mailed a Decision on Request for Rehearing and denied the request to modify the December 15, 2010 Decision.

19. This decision is in response to the February 15, 2011 patent owner petition under 37 CFR 1.198 requesting the entry of the two expert declarations dated February 15, 2011.

DISCUSSION

In response to patent owner's arguments that February 15, 2011 expert declarations should be entered and prosecution should be reopened to consider the declarations, the director finds there are not good and sufficient reasons to enter the declarations. First, 35 U.S.C. 305 requires that all *ex parte* reexamination proceedings to be acted upon with "special dispatch." The rules and procedures of the Office were established through notice and comment in order to achieve special dispatch in a reasonable manner. See MPEP 2271.

The criteria for entry of evidence declarations in an *ex parte* reexamination proceeding is analogous to that set forth in MPEP 716.01 for entry of evidence declarations in an application. The policy regarding timeliness states in part:

> "Evidence traversing rejections must be timely or seasonably filed to be entered and entitled to consideration. *In re Rothermel,* 276 F.2d 393, 125 USPQ 328 (CCPA 1960). Affidavits and declarations submitted under 37 CFR 1.132 and other evidence traversing rejections are considered timely if submitted:
>
> (1) prior to a final rejection,
>
> (2) before appeal in an application not having a final rejection, *
>
> (3) after final rejection **>, but before or on the same date of filing an appeal, upon a showing of good and sufficient reasons why the affidavit or other

> evidence is necessary and was not earlier presented in compliance with 37 CFR 1.116(e);..."

In addition, MPEP 2271 states, in part:

> "Before a final action is in order, a clear issue should be developed between the examiner and the patent owner. To bring the prosecution to a speedy conclusion and at the same time deal justly with the patent owner and the public, the examiner will twice provide the patent owner with such information and references as may be useful in defining the position of the Office as to unpatentability before the action is made final. Initially, the decision ordering reexamination of the patent will contain an identification of the new questions of patentability that the examiner considers to be raised by the prior art considered. In addition, the first Office action will reflect the consideration of any arguments and/or amendments contained in the request, the owner's statement filed pursuant to 37 CFR 1.530, and any reply thereto by the requester, and should fully apply all relevant grounds of rejection to the claims."
>
> ...
>
> "It is intended that the second Office action in the reexamination proceeding following the decision ordering reexamination will generally be made final. The criteria for making a rejection final in an *ex parte* reexamination proceeding is analogous to that set forth in MPEP § 706.07(a) for making a rejection final in an application."

Furthermore, MPEP 1214.07 states, in part:

> The Director of the USPTO also entertains petitions under 37 CFR 1.198 to reopen certain cases in which an appellant has sought review under 35 U.S.C. 141 or 145. This procedure is restricted to cases which have been decided by the Board and which are amenable to settlement without the need for going forward with the court proceeding. Such petitions will ordinarily be granted only in the following categories of cases:
>
> > (A) When the decision of the Board asserts that the rejection of the claims is proper because the claims do not include a disclosed limitation or because they suffer from some other curable defect, and the decision reasonably is suggestive that claims including the limitation or devoid of the defect will be allowable;
> >
> > (B) When the decision of the Board asserts that the rejection of the claims is proper because the record does not include evidence of a specified character, and is reasonably suggestive that if such evidence were presented, the appealed claims would be allowable, and it is demonstrated that such evidence presently exists and can be offered; or
> >
> > (C) When the decision of the Board is based on a practice, rule, law, or judicial precedent which, since the Board's decision, has been rescinded, repealed, or overruled.

Turning to the facts in this proceeding, the request for reexamination was based on a number of references. The order granting reexamination agreed with the request that the Chang reference raised a substantial new question of patentability for claims 1, 6, 7, and 13. The patent owner filed comments under 37 CFR 1.530, including claim amendments, but did not file any evidence to support their patentability arguments. The first Office action dated March 18, 2009, set forth rejections based on Chang in view of Szabad (and other secondary references for some of the claims). Patent owner filed a response but did not include any evidence to support their patentability arguments. The final Office action maintained rejections based on Chang in view of Szabad substantially similar to as presented in the first Office action. New grounds of rejections were only added against the newly submitted claims, which rejections were necessitated by amendment. All arguments presented by patent owner were responded to in the final Office action. Patent owner filed two responses after the final Office action, neither of which contained any evidence to support their patentability arguments. In summary, Chang was consistently applied in prior art rejections against the claims and none of the four patent owner responses included evidence to support their patentability arguments.

On December 15, 2010, the BPAI issued a decision that agreed with some of the rejections set forth by the examiner. Specifically, the BPAI found that the record lacked support for patent owner's arguments that the layers in Chang are not heat laminated layers (see, e.g., pages 16-20). The BPAI stated that "... no objective evidence has been submitted to persuasively establish that the claim recitation 'heat laminated' requires the recited layers to be unaltered or to remain distinct." See page 19 of the December 15, 2010 decision. Also, on April 1, 2011, the BPAI granted the request for rehearing but denied the request to modify their original decision. In particular, this decision also did not find patent owner's arguments persuasive that Chang failed to teach the heat-laminated layers. Additionally, pages 8-9 of the April 1, 2011 decision clearly states that the December 15, 2010 decision was not "requesting" evidence but only making a point that the record failed to have any evidence to support patent owner's arguments.

In the February 15, 2011 petition, patent owner states that they do not believe any evidence is necessary to support their arguments regarding the teachings of Chang. See page 2 of the petition. Nonetheless, patent owner has now submitted expert declaration evidence in light of the BPAI's December 15, 2010 decision that affirmed the rejections based on Chang. Patent owner acknowledges that entry of evidence at this point in the prosecution of a reexamination proceeding is unusual but believes entry would be proper to avoid further appellate review and in light of the fact that prosecution cannot be continued through other means. Patent owner also contends that the evidence is "... exactly the kind of evidence that the Board was looking for." See page 3 of the petition. Therefore, the patent owner conditionally requests entry of the two expert declarations filed on February 15, 2011 if the BPAI is not persuaded by the request for rehearing.

As explained above, petitions under 37 CFR 1.198 will ordinarily be granted only in the following categories of cases:

> (A) When the decision of the Board asserts that the rejection of the claims is proper because the claims do not include a disclosed limitation or because they suffer from some other

curable defect, and the decision reasonably is suggestive that claims including the limitation or devoid of the defect will be allowable;

(B) When the decision of the Board asserts that the rejection of the claims is proper because the record does not include evidence of a specified character, and is reasonably suggestive that if such evidence were presented, the appealed claims would be allowable, and it is demonstrated that such evidence presently exists and can be offered; or

(C) When the decision of the Board is based on a practice, rule, law, or judicial precedent which, since the Board's decision, has been rescinded, repealed, or overruled.

In this case, only clause (B) is applicable because patent owner is requesting entry of evidence. The record is clear that the patent owner made no attempt to file evidence to support their arguments until after the BPAI decision affirming some of the rejections of the examiner. Reexamination procedures are required to proceed with special dispatch under 35 U.S.C. 305. To reiterate, the record shows that no evidence was filed in accordance with the policies set forth in MPEP 716.01 and MPEP 2271 and the petition does not state why such evidence was not produced earlier in the prosecution. In addition, the December 15, 2010 and April 1, 2011 decisions by the BPAI make it clear that the December 15, 2010 decision was not "... reasonably suggestive that if such evidence were presented, the appealed claims would be allowable." As discussed above, the April 1, 2011 decision is clear that the BPAI was not suggesting or requesting evidence be filed, but only stating that the record did not have any evidence to support patent owner's arguments that the examiner's interpretation of Chang's teachings were in error.

The record shows that the criteria for granting a petition under 37 CFR 1.198 is not met and the February 15, 2011 expert declarations should not be entered in the interest of special dispatch. For the reasons set forth above, the petition is dismissed.

CONCLUSION

1. The patent owner's petition under 37 CFR 1.198 to enter the expert declarations, dated February 15, 2011, is hereby **dismissed**.

2. The two-month period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 304 continues to run from the mail date (April 1, 2011) of the "Decision on Request for Rehearing".

3. Response should be addressed as follows:

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

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

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

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

4. Telephone inquiries with regard to this decision should be directed to Supervisory Patent Examiner Andres Kashnikow at (571) 272-4361.

Irem Yucel, Director
Technology Center 1600

UNITED STATES PATENT AND TRADEMARK OFFICE

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Kevin J. Zilka
Zilka-Kotab, PC
PO Box 721120
San Jose, CA 95172-1120

MAILED

MAR 03 2011

TECHNOLOGY CENTER 2000
SPECIAL PROGRAM CENTER

In re Application of :
Banzhof :
Control No. 90/009,120 : DECISION ON PETITION
Filed: May 29, 2008 : TO WITHDRAW
Attorney Docket No. NAI1P708ARE.02.260.02 : 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 February 25, 2011

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 Kevin J. Zilka on behalf of all attorneys of record who are associated with customer No. 28875.

All attorneys/agents associated with the Customer Number 28875 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 address indicated below.

McAfee, Inc.
C/O Louis Riley
5000 Headquarters Drive
Plano, TX 75024

Telephone inquiries concerning this decision should be directed to Sharon S. Hoppe at 571-272-1586.

Sharon S. Hoppe for

Mark Reinhart
Supervisory Patent Examiner
CRU 3992

cc: McAfee, Inc.
C/O Louis Riley
5000 Headquarters Drive
Plano, TX 75024

cc: POSZ Law Group, PLC
12040 South Lakes Drive
Suite 101
Reston, VA 20191

Enclosure:

Copy of request for withdrawal as attorney or agent and change of correspondence address filed on 02/25/11. There is no indication it was served on the Third Party Requester.

Doc Code: PET.POA.WDRW
Document Description: Petition to withdraw attorney or agent (SB83)

PTO/SB/83 (11-08)
Approved for use through 11/30/2011. 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.

REQUEST FOR WITHDRAWAL AS ATTORNEY OR AGENT AND CHANGE OF CORRESPONDENCE ADDRESS		
	Application Number	90/009,120
	Filing Date	5/29/2008 12:00:00 AM
	First Named Inventor	7308712
	Art Unit	3992
	Examiner Name	LEE, CHRISTOPHER E
	Attorney Docket Number	NAI1P708ARE/02.260.02

To: Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Please withdraw me as attorney or agent for the above identified patent application, and

☐ all the practitioners of record;

☐ the practitioners (with registration numbers) of record listed on the attached paper(s); or

☒ the practitioners of record associated with Customer Number: **28875**

NOTE: The immediately preceding box should only be marked when the practitioners were appointed using the listed Customer Number.

The reason(s) for this request are those described in 37 CFR :

☐ 10.40(b)(1)	☐ 10.40(b)(2)	☐ 10.40(b)(3)	☐ 10.40(b)(4)
☐ 10.40(c)(1)(i)	☐ 10.40(c)(1)(ii)	☐ 10.40(c)(1)(iii)	☐ 10.40(c)(1)(iv)
☐ 10.40(c)(1)(v)	☐ 10.40(c)(1)(vi)	☐ 10.40(c)(2)	☐ 10.40(c)(3)
☐ 10.40(c)(4)	☒ **10.40(c)(5)**	☐ 10.40(c)(6) Please explain below:	

Certifications

Check each box below that is factually correct. WARNING: If a box is left unchecked, the request will likely not be approved.

1. ☒ I/We have given reasonable notice to the client, prior to the expiration of the response period, that the practitioner(s) intend to withdraw from employment.

2. ☒ I/We have delivered to the client or a duly authorized representative of the client all papers and property (including funds) to which the client is entitled.

3. ☒ I/We have notified the client of any responses that may be due and the time frame within which the client must respond.

Please provide an explanation, if necessary:

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 12 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/83 (11-08)
Approved for use through 11/30/2011. OMB 0651-0035
U.S. Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE
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REQUEST FOR WITHDRAWAL AS ATTORNEY OR AGENT AND CHANGE OF CORRESPONDENCE ADDRESS

Complete the following section only when the correspondence address will change. *Changes of address will only be accepted to an inventor or an assignee that has properly made itself of record pursuant to 37 CFR 3.71.*

Change the correspondence address and direct all future correspondence to:

A. ☒ The address of the inventor or assignee associated with Customer Number: **92527**

OR

B. ☐ Inventor or Assignee Name				
Address				
City	State	Zip	Country	
Telephone		Email		

I am authorized to sign on behalf of myself and all withdrawing practitioners.

Signature	**/KEVINZILKA/**			
Name	**Kevin J. Zilka**		Registration No. **41,429**	
Address	**P.O. Box 721120**			
City	**San Jose**	State **CA**	Zip **95172-1120**	Country **US**
Date	February 25, 2011		Telephone No. **408-971-2573**	

NOTE: ***Withdrawal is effective when approved rather than when received.***

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 12 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.

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UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
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www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,121	05/27/2008	6,611,686 B1	047274-0031-00-US	7607

26604 7590 09/28/2010

KENNETH L. NASH
P.O. BOX 680106
HOUSTON, TX 77268-0106

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 09/28/2010

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
DRINKER, BIDDLE & REATH
ONE LOGAN SQUARE
18th & CHERRY STREETS
PHILADELPHIA, PA 19103-6996

Date:
MAILED
SEP 2 8 2010
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009121
PATENT NO. : 6611686
ART UNIT : 3992

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

KENNETH L. NASH
P.O. BOX 680106
HOUSTON TX 77268-0106

(For Patent Owner)

MAILED

OCT 19 2010

CENTRAL REEXAMINATION UNIT

DRINKER BIDDLE & REATH
ATTN: INTELLECTUAL PROPERTY GROUP
ONE LOGAN SQUARE, SUITE 2000
PHILADELPHIA, PA 19103-6996

(For Third Party Requester)

In re: Smith *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/009,121
Deposited on: 27 May 2008
For: US Patent No. 6,611,686 B1

In re: Smith *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/010,601
Deposited on: 03 September 2009
For: US Patent No. 6,611,686 B1

DECISION
GRANTING –IN-PART
PETITION FOR EXTENSION
OF TIME
[37 CFR §§ 1.50(c) & 1.181]

This is a decision on the 08 September 2010 petition titled, "Petition for Two Month Extension of Time" requesting the response period for response be extended by two(2) months for response to the non-final Office action dated 20 August 2010. The petition submitted 08 September 2010 was timely filed with certificate of service and fee.

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.

DECISION

The Patent Owner's representative requests the period for response be extended by two (2) months for responding to the non-final Office action dated 20 August 2010, which sets one (1) months time for filing a response thereto. The petition for extension of time was timely filed on 08 September 2010, together with authorization for the $200.00 petition fee as required by 37 CFR § 1.550(c) and 37 CFR § 1.17 (g). A certificate of service was not provided with the petition.

There is "sufficient cause" for granting a one (1) month extension of time.

The request is hereby granted-in-part.

CITATION OF RELEVENT AUTHORITY

37 CFR § 1.550 (c) states:

> (c) The time for taking any action by a patent owner in an *ex 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 § 1.550 (c) to make a showing of "sufficient cause" to grant an extension of time request, **MPEP § 2265** states, in pertinent part:

> Evaluation of whether sufficient cause has been shown for an extension must be made in the context of providing the patent owner with a fair opportunity to present an argument against any attack on the patent, and the requirement of the statute (35 U.S.C. § 305) that the proceedings be conducted with special dispatch.
>
> Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. The reasons 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. All requests must be submitted in a separate paper which will be forwarded to the CRU or TC Director for action. A request for an extension of the time period to file a petition from the denial of a request for reexamination can only be entertained by filing a petition under 37 CFR § 1.183 with appropriate fee to waive the time provisions of 37 CFR § 1.515(c). Since the reexamination examination process (for a reexamination request filed under 35 U.S.C. § 302 and 37 CFR 1.510) is intended to be essentially *ex parte*, the party requesting reexamination can anticipate that requests for an extension of time to file a petition under 37 CFR §1.515(c) will be granted only in extraordinary situations.

...

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)

...

ANALYSIS AND FINDINGS

The patent owner petitions to extend the period for response by adding two (2) months to the period for response. The decision to extend the period for response is evaluated based upon a showing of "sufficient cause." There is always the consideration to balance the need for the patent owner to have a fair opportunity to respond to the Office action between the need for special dispatch.

Per MPEP § 2665, "Second or subsequent requests for extensions of time, or requests for more than one month, will be granted only in extraordinary situations." To be granted two months extension of time the patent owner must provide sufficient cause indicating extraordinary situations.

The petitioner articulates the voluminous length of the Office action and the time required by the first named inventor. On balance, there is "sufficient cause" to grant one (1) month 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 two(2) months time in which to file a response to the non-final Office action dated 20 August 2010 is hereby granted-in-part.

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

3. The response is due 20 October 2010.

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

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

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

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

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

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

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

/Mark Reinhart/

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

UNITED STATES PATENT AND TRADEMARK OFFICE

MAILED

AUG 20 2010

CENTRAL REEXAMINATION UNIT

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

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

(For Patent Owner)

Howrey LLP
Attn: Renee Dubord Brown
1950 University Ave., 4th Floor
East Palo Alto, CA 94303-2281

(For Requester)

In re Porras *et alia*
Reexamination Proceeding
Control No. 90/008,125
For: U.S. Patent No. 6,484,203

: DECISION DISMISSING
: PETITION UNDER
: 37 CFR 1.116

In re Porras *et alia*
Reexamination Proceeding
Control No. 90/009,126
For: U.S. Patent No. 6,484,203

This is a decision on the February 24, 2009 "PETITION FOR ADMISSION OF EVIDENCE UNDER 37 C.F.R. §1.116" requesting that appendices of evidence submitted on February 24, 2009 be entered.

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

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

DECISION

Petitioner's attention is respectfully directed to the petition decision of December 3, 2008, which addressed the same issue.

It is premature to petition for the entry of the evidence when the examiner has not yet made a determination to not enter the evidence. It is also noted that the examiner did enter the evidence as noted in the advisory action mailed May 14, 2009.

Therefore, the petition is **dismissed as moot**.

CONCLUSION

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

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 Eric Keasel, at (571) 272-4929, or Mark Reinhart, at (571) 272-1611.

Eric Keasel
SPE, Art Unit 3992

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,127	04/25/2008	6711615	18033-0005RX2	7612

26181 7590 08/19/2010

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 08/19/2010

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

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Day Casebeer Madrid & Batchelder LLP

Attn: Renee DuBord Brown, Esq.

20300 STEVENS CREEK BOULEVARD

SUITE 400

Cupertino, CA 95014

MAILED

AUG 19 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/009,127*.

PATENT NO. *6711615*.

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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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Renee DuBoard Brown
Howrey LLP
4th Floor
1950 University Avenue
East Palo Alto, CA 94303-2281

MAILED

AUG 19 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/009,127*.

PATENT NO. *6711615*.

ART UNIT *3992*.

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

FISH & RICHARDSON P.C. (For Patent Owner)
PO BOX 1022
MINNEAPOLIS, MN 55440-1022

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AUG 19 2010

CENTRAL REEXAMINATION UNIT

DAY CASEBEER MADRID & BATCHELDER LLP (For Requester)
20300 STEVENS CREEK BOULEVARD
SUITE 400
CUPERTINO, CA 95014

In re Porras *et alia*
Reexamination Proceeding
Control No. 90/008,113
For: U.S. Patent No. 6,484,203

: DECISION DISMISSING
: PETITIONS UNDER
: 37 CFR 1.116 AND
: 37 CFR 1.550(c)

In re Porras *et alia*
Reexamination Proceeding
Control No. 90/009,127
For: U.S. Patent No. 6,484,203

This is a decision on the March 2, 2009 "RENEWED PETITION FOR ADMISSION OF EVIDENCE UNDER 37 C.F.R. §1.116" requesting that appendices of evidence submitted on March 2, 2009 be entered and the April 29, 2009 "PETITION FOR AN EXTENSION OF TIME UNDER 37 C.F.R. §1.550(C)"

The petitions are before the Director of the Central Reexamination Unit for consideration.

The petitions are **dismissed as moot** for the reasons set forth below.

DECISION

Petitioner's attention is respectfully directed to the petition decision of December 4, 2008, which addressed the same issue as the admission of evidence under 37 CFR 1.116.

It is premature to petition for the entry of the evidence when the examiner has not yet made a determination to not enter the evidence. It is also noted that the examiner did enter the evidence as noted in the advisory action mailed May 14, 2009.

Therefore, the petition "for admission of evidence" is **dismissed as moot**.

The petition for extension of time is **dismissed as moot** in view of the timely filed appeal brief on May 4, 2009.

CONCLUSION

1. Petitioner's requests are **dismissed as moot**.

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 Eric Keasel, at (571) 272-4929, or Mark Reinhart, at (571) 272-1611.

Eric Keasel
SPE, Art Unit 3992

UNITED STATES PATENT AND TRADEMARK OFFICE

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Alexandria, VA 22313-1450
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AUG 16 2011

CENTRAL REEXAMINATION UNIT

CESARI AND MCKENNA, LLP
88 BLACK FALCON AVENUE
BOSTON, MA 02210

(for Patent Owner)

RONALD Y. YIN
DLA PIPER US LLP
2000 UNIVERSITY AVENUE
EAST PALO ALTO, CA 94303

(for Requester)

In re Application of: Kleiman *et al.*
Control No.: 90/009,129
Deposited: April 29, 2008
For: US Patent No. 7,174,352 B2

: Response to Petition
: Under 37 CFR 1.59

This is a response to the petition under 37 CFR 1.59(b), filed on October 27, 2009, by which petitioners request to expunge information from the above identified proceeding.

The decision on the petition is will be held in abeyance until prosecution on the merits is closed, at which time the petition will be decided.

Petitioner requests that two documents submitted under seal in the Information Disclosure Statement, filed October 27, 2009, be expunged from the record. Petitioner states that either (A) that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in 37 CFR 1.17(g) has been paid.

The decision on the petition is held in abeyance because prosecution on the merits is not closed. Accordingly, it is not appropriate to make a final determination of whether or not the material requested to be expunged is "material", with "materiality" being defined as any information which the examiner considers as being important to a determination of patentability of the claims. Thus, the decision on the petition to expunge must be held in abeyance at this time.

During prosecution on the merits, the examiner will determine whether or not the identified document is considered to be "material." If the information is not considered by the examiner to be material, the information will be removed from the official file.

The documents in question will not be available to the public during prosecution.

CONCLUSION

1. The decision on the petition under 37 CFR 1.59(b) will be held in abeyance until the mailing of a Notice of Intent to Issue Reexamination Certificate (NIRC), at which time the petition will be decided.

2. Telephone inquiries related to this decision should be directed to Andy Kashnikow, Supervisory Patent Examiner, at (571) 272-4361.

Andy Kashnikow
SPE AU 3993
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.
90/009,130	04/30/2008	7326094	4637/0124PUS4	7942

60601 7590 04/07/2011

Muncy, Geissler, Olds & Lowe, PLLC
4000 Legato Road
Suite 310
FAIRFAX, VA 22033

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/07/2011

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
LAW OFFICES OF CLEMENT CHENG
17220 NEWHOPE STREET #127
FOUNTAIN VALLEY, CA 92708

Date:
MAILED
APR 07 2011
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009130
PATENT NO. : 7326094
ART UNIT : 3993

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MUNCY, GEISSLER, OLDS & LOWE, PLLC
4000 LEGATO ROAD
SUITE 310
FAIRFAX, VA 22033

(For Patent Owner)

MAILED
APR 07 2011
CENTRAL REEXAMINATION UNIT

CLEMENT CHENG
LAW OFFICES OF CLEMENT CHENG
17220 NEWHOPE STREET
SUITE 127
FOUNTAIN VALLEY, CA 92708

(For Requester)

In re Yeh Reexamination Proceeding
Control No.: 90/009,130
Filed: April 30, 2008
For: U.S. Patent No.: 7,326,094

: **DECISION ON PETITION**
: **UNDER 37 CFR 1.198**
: **TO ENTER**
: **EVIDENCE**

This is a decision on the February 15, 2011, entitled "Contingent Petition under 37 CFR 1.198 and MPEP 1214.07" requesting that two expert declarations, filed concurrently with the petition, be entered into the reexamination record. The patent owner has petitioned under 37 CFR 1.198 for entry of evidence after a decision by the Board of Patent Appeals and Interferences (BPAI).

The petition is before the Director of Technology Center 1600, who also oversees the Central Reexamination Unit, for decision.

The petition is dismissed for the reasons set forth below.

REVIEW OF THE RELEVANT FACTS

1. On February 5, 2008, U.S. Patent 7,326,094 (the '094 patent) issued to *Yeh*.

2. On April 30, 2008, a request for *ex parte* reexamination of claims 1-8 of the '094 patent was filed by a third party requester. The request was assigned reexamination control number 90/009,130 (the '130 proceeding).

3. On June 23, 2008, the Office issued an order granting the'130 *ex parte* reexamination request and setting a two month time period for a Patent Owner's Statement. The order stated that claims 1-8 of the '094 patent would be subject to reexamination.

4. On August 23, 2008, the time period for filing a patent owner's statement pursuant to 37 CFR 1.530 in the '130 *ex parte* reexamination proceeding expired without the submission of a statement by the patent owner.

5. On February 6, 2009, a first Office action on the merits issued rejecting claims 1-8 as unpatentable over Chang et al. in view of Szabad, Jr. (and other secondary references for some of the claims).

6. On April 3, 2009, the patent owner filed a response amending claims 1 & 6, cancelling claim 5, and adding new claims 9-14, and providing remarks asserting patentability over the prior art of record. No evidence was provided in support of the remarks alleging patentability.

7. On April 22 2009, a final Office action was issued in the '130 proceeding rejecting claims 1-4 and 6-14 as unpatentable over Chang et al. in view of Szabad, Jr. (and other secondary references).

8. On May 26, 2009, the patent owner submitted an after-final response under 37 CFR 1.116 consisting of further proposed amendments to claims 1 and 6, cancellation of proposed new claims 9-14, and addition of proposed new claims 15 and 16. No evidence was provided in support of the remarks alleging patentability.

9. On June 10, 2009, the Office issued an Advisory action responding to patent owner's after-final submissions. The action stated that the amendments to the claims would not be entered because they raised new issues and that the request for reconsideration was considered but does not overcome the rejections.

10. On July 22, 2009, the patent owner filed a notice of appeal in the '130 proceeding and another after-final response under 37 CFR 1.116 consisting of further proposed amendments to claims 1 and 6 and cancellation of proposed new claims 9-14. No evidence was provided in support of the remarks alleging patentability.

11. On July 29, 2009, the Office issued an Advisory action responding to patent owner's after-final submissions. The action stated that the amendments to the claims would not be entered

because they raised new issues and that the request for reconsideration was considered but does not overcome the rejections.

12. On September 21, 2009, the patent owner submitted another after-final response under 37 CFR 1.116 consisting of further proposed amendments to claims 1 and 6 and cancellation proposed new claims 9-14. No evidence was provided in support of the remarks alleging patentability.

13. On September 22, 2009, the patent owner submitted an appeal brief.

14. On November 24, 2000, the Office mailed an Advisory action responding to September 21, 2009 patent owner's after-final submissions. The action stated that the amendments to the claims would be entered for purposes of appeal.

15. On December 23, 2009, the Office mailed an Examiner's Answer.

16. On February 23, 2010, the patent owner filed a reply brief.

17. On December 15, 2010, the Office mailed a Decision by the BPAI that affirmed the rejections of claims 1-4 and 6-8 based on Chang et al. (and other secondary references).

18. On February 15, 2011, the patent owner filed a Request for Rehearing and the instant petition under 37 CFR 1.198 if the BPAI should not find the request for rehearing persuasive.

19. On April 1, 2011, the Office mailed a Decision on Request for Rehearing and denied the request to modify the December 15, 2010 Decision.

20. This decision is in response to the February 15, 2011 patent owner petition under 37 CFR 1.198 requesting the entry of the two expert declarations dated February 15, 2011.

DISCUSSION

In response to patent owner's arguments that February 15, 2011 expert declarations should be entered and prosecution should be reopened to consider the declarations, the director finds there are not good and sufficient reasons to enter the declarations. First, 35 U.S.C. 305 requires that all *ex parte* reexamination proceedings to be acted upon with "special dispatch." The rules and procedures of the Office were established through notice and comment in order to achieve special dispatch in a reasonable manner. See MPEP 2271.

The criteria for entry of evidence declarations in an *ex parte* reexamination proceeding is analogous to that set forth in MPEP 716.01 for entry of evidence declarations in an application. The policy regarding timeliness states in part:

> "Evidence traversing rejections must be timely or seasonably filed to be entered and entitled to consideration. *In re Rothermel,* 276 F.2d 393, 125 USPQ 328 (CCPA

1960). Affidavits and declarations submitted under 37 CFR 1.132 and other evidence traversing rejections are considered timely if submitted:

(1) prior to a final rejection,
(2) before appeal in an application not having a final rejection, *
(3) after final rejection **>, but before or on the same date of filing an appeal, upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented in compliance with 37 CFR 1.116(e);..."

In addition, MPEP 2271 states, in part:

"Before a final action is in order, a clear issue should be developed between the examiner and the patent owner. To bring the prosecution to a speedy conclusion and at the same time deal justly with the patent owner and the public, the examiner will twice provide the patent owner with such information and references as may be useful in defining the position of the Office as to unpatentability before the action is made final. Initially, the decision ordering reexamination of the patent will contain an identification of the new questions of patentability that the examiner considers to be raised by the prior art considered. In addition, the first Office action will reflect the consideration of any arguments and/or amendments contained in the request, the owner's statement filed pursuant to 37 CFR 1.530, and any reply thereto by the requester, and should fully apply all relevant grounds of rejection to the claims."

...

"It is intended that the second Office action in the reexamination proceeding following the decision ordering reexamination will generally be made final. The criteria for making a rejection final in an *ex parte* reexamination proceeding is analogous to that set forth in MPEP § 706.07(a) for making a rejection final in an application."

Furthermore, MPEP 1214.07 states, in part:

The Director of the USPTO also entertains petitions under 37 CFR 1.198 to reopen certain cases in which an appellant has sought review under 35 U.S.C. 141 or 145. This procedure is restricted to cases which have been decided by the Board and which are amenable to settlement without the need for going forward with the court proceeding. Such petitions will ordinarily be granted only in the following categories of cases:

(A) When the decision of the Board asserts that the rejection of the claims is proper because the claims do not include a disclosed limitation or because they suffer from some other curable defect, and the decision reasonably is suggestive that claims including the limitation or devoid of the defect will be allowable;

(B) When the decision of the Board asserts that the rejection of the claims is proper because the record does not include evidence of a specified character, and is reasonably suggestive that if such evidence were presented, the appealed claims

would be allowable, and it is demonstrated that such evidence presently exists and can be offered; or

(C) When the decision of the Board is based on a practice, rule, law, or judicial precedent which, since the Board's decision, has been rescinded, repealed, or overruled.

Turning to the facts in this proceeding, the request for reexamination was based on a number of references. The order granting reexamination agreed with the request that the Chang and Szabad references raised a substantial new question of patentability for claims 1-8. The patent owner chose not to file comments under 37 CFR 1.530. The first Office action dated February 2, 2009, set forth rejections based on Chang in view of Szabad (and other secondary references for some of the claims). Patent owner filed a response but did not include any evidence to support their patentability arguments. The final Office action maintained rejections based on Chang in view of Szabad substantially similar to as presented in the first Office action. New grounds of rejections were only added against the amended or newly submitted claims, which rejections were necessitated by amendment. All arguments presented by patent owner were responded to in the final Office action. Patent owner filed three responses after the final Office action, none of which contained any evidence to support their patentability arguments. In summary, Chang was consistently applied in prior art rejections against the claims and none of the four patent owner responses included evidence to support their patentability arguments.

On December 15, 2010, the BPAI issued a decision that agreed with the rejections set forth by the examiner. Specifically, the BPAI found that the record lacked support for patent owner's arguments that the layers in Chang are not bonded separate layers (see, e.g., pages 16-20). The BPAI stated that "... Appellant does not direct us to any evidence or definition which established a meaning of 'bonded' which would distinguish the claimed structure from that of Chang." See pages 17-18 of the December 15, 2010 decision. Also, on April 1, 2011, the BPAI granted the request for rehearing but denied the request to modify their original decision. In particular, this decision also did not find patent owner's arguments persuasive that Chang failed to teach bonded, separate layers. Additionally, pages 7-8 of the April 1, 2011 decision clearly states that the December 15, 2010 decision was not "requesting" evidence but only making a point that the record failed to have any evidence to support patent owner's arguments.

In the February 15, 2011 petition, patent owner states that they do not believe any evidence is necessary to support their arguments regarding the teachings of Chang. See page 2 of the petition. Nonetheless, patent owner has now submitted expert declaration evidence in light of the BPAI's December 15, 2010 decision that affirmed the rejections based on Chang. Patent owner acknowledges that entry of evidence at this point in the prosecution of a reexamination proceeding is unusual but believes entry would be proper to avoid further appellate review and in light of the fact that prosecution cannot be continued through other means. Patent owner also contends that the evidence is "... exactly the kind of evidence that the Board was looking for." See page 3 of the petition. Therefore, the patent owner conditionally requests entry of the two expert declarations filed on February 15, 2011 if the BPAI is not persuaded by the request for rehearing.

As explained above, petitions under 37 CFR 1.198 will ordinarily be granted only in the following categories of cases:

> (A) When the decision of the Board asserts that the rejection of the claims is proper because the claims do not include a disclosed limitation or because they suffer from some other curable defect, and the decision reasonably is suggestive that claims including the limitation or devoid of the defect will be allowable;
>
> (B) When the decision of the Board asserts that the rejection of the claims is proper because the record does not include evidence of a specified character, and is reasonably suggestive that if such evidence were presented, the appealed claims would be allowable, and it is demonstrated that such evidence presently exists and can be offered; or
>
> (C) When the decision of the Board is based on a practice, rule, law, or judicial precedent which, since the Board's decision, has been rescinded, repealed, or overruled.

In this case, only clause (B) is applicable because patent owner is requesting entry of evidence. The record is clear that the patent owner made no attempt to file evidence to support their arguments until after the BPAI decision affirming the rejections of the examiner. Reexamination procedures are required to proceed with special dispatch under 35 U.S.C. 305. To reiterate, the record shows that no evidence was filed in accordance with the policies set forth in MPEP 716.01 and MPEP 2271 and the petition does not state why such evidence was not produced earlier in the prosecution. In addition, the December 15, 2010 and April 1, 2011 decisions by the BPAI make it clear that the December 15, 2010 decision was not "... reasonably suggestive that if such evidence were presented, the appealed claims would be allowable." As discussed above, the April 1, 2011 decision is clear that the BPAI was not suggesting or requesting evidence be filed, but only stating that the record did not have any evidence to support patent owner's arguments that the examiner's interpretation of Chang's teachings were in error.

The record shows that the criteria for granting a petition under 37 CFR 1.198 is not met and the February 15, 2011 expert declarations should not be entered in the interest of special dispatch. For the reasons set forth above, the petition is dismissed.

CONCLUSION

1. The patent owner's petition under 37 CFR 1.198 to enter the expert declarations, dated February 15, 2011, is hereby **dismissed**.

2. The two-month period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 304 continues to run from the mail date (April 1, 2011) of the "Decision on Request for Rehearing".

3. Response should be addressed as follows:

   By Mail to: Mail Stop *Ex Parte* Reexam

Central Reexamination Unit
Commissioner for Patents
United States Patent & Trademark Office
P. O. Box 1450
Alexandria, VA 22313-1450

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

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

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

4. Telephone inquiries with regard to this decision should be directed to Supervisory Patent Examiner Andres Kashnikow at (571) 272-4361.

Irem Yucel, Director
Technology Center 1600

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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JAN 21 2011

CENTRAL REEXAMINATION UNIT

Hershkovitz & Associates, LLC : (For Patent Owner)
2845 Duke Street :
Alexandria VA 22314 :

Rajiv P. Patel : (For Requester)
Fenwick & West LLP
801 California Street
Mountain View, CA 94041

In re Rice *et alia* : DECISION on File Correction
Reexamination Proceeding : Letter construed as Petition
Control No. 90 / 009,155 : under 37 CFR 1.181
Request Deposited: May 21, 2008 :
For: U.S. Patent No. 6,411,947 :

This is a decision on patent owner's request for file clarification and correction of the Notice of Intent to Issue Ex Parte Reexamination Certificate (NIRC) mailed October 1, 2010. The request is construed as a petition filed under 37 CFR 1.181 for correction of the Notice of Intent to Issue Reexamination Certificate. The request appears timely. No fee is due with this petition.

The petition is dismissed for the reasons set forth below.

REVIEW OF RELEVANT FACTS

1. Reexamination of U.S. Patent No. 6,411,947 was ordered in the Determination mailed June 12, 2008.

2. A final Office action on the merits was mailed May 11, 2010.

3. A response was received from owner on July 12, 2010.

4. An advisory action was mailed by the Office on July 23, 2010 indicating the proposed Response overcame some but not all rejections, and would be entered only for the purposes of appeal.

5. On August 7, 2010 patent owner expressly waived his right to appeal.

6. The Office issued a NIRC on October 1, 2010.

7. On October 20, 2010 patent owner filled the instant request for correction of the NRIC.

DECISION

Petitioner requests correction of the October 20, 2010 NIRC as petitioner is of the impression that the amendment presented after final rejection on July 12, 2010 was entered into the record and that the examiner erroneously canceled claims which should stand confirmed in the NIRC of October 20, 2010. Petitioner requests the NIRC be amended to be in accordance with the status of the claims as stated in the advisory action.

Review of the file, however, clearly indicates that the amendments presented on July 12, 2010 were not entered into the record by the examiner as they did not remove all rejections and a NIRC was not issued at that time. Rather, it was determined that as some issues were removed by the proposed amendments, the proposed amendments would be entered upon the filing of an appeal for the sole purpose of reducing issues upon appeal. This was clearly communicated in the advisory action.

Patent owner is reminded it is intended that prosecution before the examiner in a reexamination proceeding will be concluded with the final action. Once a final rejection that is not premature has been entered in a reexamination proceeding, the patent owner no longer has any right to unrestricted further prosecution. Consideration of amendments submitted after final rejection and prior to, or with, the appeal will be governed by the strict standards of 37 CFR 1.116. See MPEP 2272.

While it is noted that patent owner did expressly waive his right to appeal prior to expiration of the period for response set in the advisory action, this action at best could only be seen as an effort to expedite conclusion of the proceeding on owner's part. The Office has no authority to enter – in – part any proposed amendments which would have overcome some of the outstanding rejections. In reexamination proceedings, after final amendments are fully entered and the proceeding concluded with a NIRC, or they may be fully entered upon appeal. As noted in the advisory action :

> "1. [X] Unless a timely appeal is filed, or other appropriate action by the patent owner is taken to overcome all of the outstanding rejections(s), this prosecution of the present ex parte reexamination WILL BE TERMINATED and a Notice of Intent to Issue *Ex Parte* Reexamination Certificate will be mailed in due course. Any finally rejected claims, or claims objected to, will be CANCELLED".

Here, owner did not take steps to re-present the proposed amendments such that the amendment could have been entered in its entirety and the proceeding concluded as amended, and owner did not appeal. Thus, owner's inaction resulted in the proceeding terminating with the status of the

claims as stated in the Final rejection. There appears to be no basis in fact for granting the relief petitioner seeks.

CONCLUSION

1. As no basis for relief is seen, Petitioner's request is **DISMISSED**.

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

Irem Yucel.
Director, Technology Center 1600

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,155	05/21/2008	6411947	R66337A	8203

40401 7590 08/30/2011

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 08/30/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Rajiv P. Patel
FENWICK & WEST LLP
801 California Street
Mountain View, CA 94041

Date:

MAILED

AUG 30 2011

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009155
PATENT NO. : 6411947
ART UNIT : 3992

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

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

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AUG 30 2011

CENTRAL REEXAMINATION UNIT

Hershkovitz & Associates, LLC (For Patent Owner)
2845 Duke Street
Alexandria VA 22314

Rajiv P. Patel (For Third Party Requester)
Fenwick & West LLP
801 California Street
Mountain View, CA 94041

In re Rice *et al.*
Reexamination Proceeding
Control No.: 90/009,155
Filed: May 21, 2008
For: U.S. Patent No.: 6,411,947

: DECISION
: ON
: PETITION

This is a decision on (a) the patent owner March 10, 2011 petition entitled "PETITION UNDER 37 CFR 1.182 (WITH CONCURRENTLY FILED RE-PRESENTED AMENDMENT)" requesting entry of an amendment after issuance of a Notice on Intent to Issue a Reexamination Certificate (NIRC) and (b) the May 3, 2011 patent owner petition entitled "REQUEST FOR DECISION ON PETITION UNDER 37 CFR 1.182, AND COMMENTS REGARDING NOTICE TO ISSUE REEXAMINATION CERTIFICATE (NIRC)," requesting the March 10, 2011 petition be granted, the March 22, 2011 reexamination certificate be vacated and that a new reexamination certificate be issued based upon the granted March 10, 2011 petition's concurrently filed amendment.

The petitions are before the Office of Patent Legal Administration.

For the reasons set forth below, both petitions under 37 CFR 1.182 are dismissed.

REVIEW OF THE FACTS

1. On June 25, 2002, the Office issued U.S. Patent 6,411,947 (the '947 patent) to Rice *et al.*

2. On May 21, 2008, a request for *ex parte* reexamination of all the claims (claims 1-66) of the '947 patent was filed by a third party requester. The resulting reexamination proceeding was assigned control number 90/009,155 (the '9155 proceeding).

3. On June 12, 2008, the Office issued an order granting the'9155 *ex parte* reexamination request on all the claims (claims 1-66) of the '947 patent.

4. On June 13, 2009, a first Office action on the merits issued rejecting claims 1-4, 6-8, 11-13, 15-32, 34-45, 52-55 and 62-65 as unpatentable and confirming claims 5, 9, 10, 14, 33, 46, 50-51, 56-61 and 66 as patentable.

5. The proceeding advanced to the point that on May 11, 2010 the Office issued a final Office action finally rejection original claims 1-8, 11-13, 15-29, 38-49, 52-56, 62, and new claims 67-92, 95-124 as unpatentable. The final Office action finally confirmed original claims 9-10, 14, 30-37, 50-51, 57-61, 63-66, and new claims 93-94 as patentable.

6. On July 12, 2010, patent owner filed an after-final amendment in the '9155 proceeding.

7. On July 23, 2010, the Office issued an advisory action stating that the July 12, 2010 proposed response failed to overcome all the rejections in the May 2010 final Office action. The advisory action stated that unless a timely appeal was filed a NIRC would issue any finally rejected or objected claim would be cancelled. The advisory action also stated the July 12, 2010 amendment would be entered for purposes of appeal. The advisory action indicated that the status of claims 9-10, 14, 30-37, 50-51, 57-61, 63-66 and 69-124 will be patentable and/or confirmed and that claims 1-8, 11-13, 15-29, 38-49, 52-56, 62, and 67-68 will be rejected.

8. On August 7, 2010, patent owner filed a paper entitled, "WAIVER OF RIGHT TO APPEAL UNDER 35 USC 306" requesting issuance of a NIRC "as quickly as possible."

9. On October 1, 2010, the Office issued a NIRC confirming original claims 9-10, 14, 30-37, 50-51, 57-61, 63-66, designating new claims 69-89 and 91-95 as patentable, and canceling as unpatentable original claims 1-8, 11-13, 15-29, 38-49, 52-56, 62 and new claims 67-68, 90 and 96-124.

10. On October 20, 2010, patent owner filed a paper entitled, "REQUEST FOR CORRECTION OF NOTICE OF INTENT TO ISSUE EX PARTE REEXAMINATION CERTIFICATE," requesting issuance of a corrected NIRC to include as patentable additional claims as allowable as of the July 23, 2010 advisory action and not the May 11, 2010 final Office action.

11. On October 22, the '9155 proceeding was forwarded to the Office of Publications for printing and issuance of a reexamination certificate, thus entering the print cycle.

12. On January 21, 2011, the Office issued a decision treating patent owner October 20, 2010 paper as a petition under 37 CFR 1.181 and dismissing the petition.

13. On March 2, 2011, the '9155 proceeding was assigned a reexamination certificate number and issue date of March 22, 2011.

14. On March 10, 2011, patent owner filed a petition under 37 CFR 1.182 entitled, PETITION UNDER 37 CFR 1.182 (WITH CONCURRENTLY FILED RE-

PRESENTED AMENDMENT)," requesting entry of a concurrently filed new amendment.

15. On March 22, 2011, the reexamination proceeding was concluded by the issuance and publication of *Ex Parte* Reexamination Certificate (8106th), US 6,411,947 C1.

16. On May 3, 2011, patent owner filed a petition under 37 CFR 1.182 entitled "REQUEST FOR DECISION ON PETITION UNDER 37 CFR 1.182, AND COMMENTS REGARDING NOTICE TO ISSUE REEXAMINATION CERTIFICATE (NIRC)," requesting the March 10, 2011 petition be granted, the March 22, 2011 reexamination certificate be vacated, and that a new reexamination certificate be issued based upon the granted March 10, 2011 petition's concurrently filed amendment.

17. This decision addresses patent owner's March 10, 2011 and May 3, 2011 petitions.

DECISION

The present reexamination proceeding concluded with the issuance of *Ex Parte* Reexamination Certificate (8106th), US 6,411,947 C1. As of the issuance of the certificate, the Office was divested of jurisdiction over the '947 patent. Therefore, the submission of the amendment for entry and consideration by the examiner is not authorized by statute. Accordingly, the petition is **dismissed.**

ADDITIONAL DISCUSSION

Even if the certificate had not issued, the petitions would not have been grantable based upon what follows.

MPEP 2287 states (in part):

A NIRC informs the patent owner and any third party requester that the reexamination prosecution has been terminated. The rules do not provide for an amendment to be filed in a reexamination proceeding after prosecution has been terminated. The provisions of 37 CFR 1.312 do not apply in reexamination. Any amendment, information disclosure statement, or other paper related to the merits of the reexamination proceeding filed after prosecution has been terminated must be accompanied by a petition under 37 CFR 1.182 to have the amendment considered.

MPEP 2287.01 states (in part):

The rules do not provide for an amendment to be filed in a reexamination proceeding after a Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) has been issued. Note that 37 CFR 1.312 does not apply in a reexamination proceeding. Any amendment, information disclosure statement, or other paper related to the merits of the reexamination proceeding filed after the NIRC must be accompanied by a petition under 37 CFR 1.182. The

> petition must be granted, in order to have the amendment, information disclosure statement, or other paper related to the merits considered. Where an amendment, information disclosure statement, or other paper related to the merits of the reexamination proceeding is filed after the NIRC, and the accompanying petition under 37 CFR 1.182 is granted, the examiner will reconsider the case in view of the new information, and if appropriate, will reopen prosecution.

A review of the record shows that the examiner terminated prosecution on the merits by issuing a NIRC on October 1, 2010, and the proceeding has now matured into *Ex Parte* Reexamination Certificate (8106th). The equities of the present proceeding do not justify the Office now vacating the reexamination certificate, entering the amendment, and reissuing a reexamination certificate.

Patent owner filed the March 10, 2011 petition, requesting entry and consideration of an amendment after NIRC, several months after issuance of the NIRC and well after the '9155 proceeding had entered the printing cycle for issuance of a reexamination certificate. Furthermore the '9155 proceeding was so far advanced into the print cycle that it had already been assigned a publication date and reexamination certificate number a week prior to patent owner's filing of the March 10, 2011 petition. There is no regulatory provision for withdrawal of a reexamination proceeding from the publication process for entry and consideration of an amendment, for *ex parte* reexamination, and 35 U.S.C. 305 mandates that all *ex parte* reexamination proceedings "will be conducted with special dispatch within the Office." In this instance, patent owner waited seven weeks after the Office issued a decision refusing to grant patent owner's "REQUEST FOR CORRECTION OF NOTICE OF INTENT TO ISSUE EX PARTE REEXAMINATION CERTIFICATE" – the present petition was filed just 13 days before the certificate was projected to issue. Further, it was patent owner that created this situation by waiving the right to appeal and requesting expedited issuance of a NIRC. Requiring the examiner to now enter and consider the amendment would *drastically* regress the proceeding and be *completely* contrary to the Office's *statutory mandate for special dispatch.* Therefore, equity does not call for the relief requested by patent owner in the March 10, 2011 and the May 3, 2011 petitions.

CONCLUSION

1. Both petitions under 37 CFR 1.182 are dismissed.

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

/Kenneth M. Schor/

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

8-30-11

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,155	05/21/2008	6411947	R66337A	8203

40401 7590 02/28/2012

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 02/28/2012

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
Rajiv P. Patel
FENWICK & WEST LLP
801 California Street
Mountain View, CA 94041

Date:

MAILED

FEB 28 2012

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009155
PATENT NO. : 6411947
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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FEB 28 2012

CENTRAL REEXAMINATION UNIT

Hershkovitz & Associates, LLC
2845 Duke Street
Alexandria VA 22314

(For Patent Owner)

Rajiv P. Patel
Fenwick & West LLP
801 California Street
Mountain View, CA 94041

(For Third Party Requester)

In re Rice *et al.*
Reexamination Proceeding
Control No.: 90/009,155
Filed: May 21, 2008
For: U.S. Patent No.: 6,411,947

: DECISION
: ON
: PETITION

This is a decision on patent owner's October 28, 2011 petition entitled, "PETITION FOR GENERAL SUPERVISORY REVIEW BY DIRECTOR UNDER 37 CFR 1.181," requesting review of the August 30, 2011 Office decision dismissing patent owner's request for entry of an amendment after issuance of a Notice of Intent to Issue a Re-examination Certificate (NIRC).

The petition is before the Office of Patent Legal Administration.

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

REVIEW OF THE FACTS

1. On June 25, 2002, the Office issued U.S. Patent 6,411,947 (the '947 patent) to Rice *et al.*

2. On May 21, 2008, a request for *ex parte* reexamination of all the claims (claims 1-66) of the '947 patent was filed by a third party requester. The resulting reexamination proceeding was assigned control number 90/009,155 (the '9155 proceeding).

3. On June 12, 2008, the Office issued an order granting the'9155 *ex parte* reexamination request on all the claims (claims 1-66) of the '947 patent.

4. On June 13, 2009, a first Office action on the merits was issued rejecting claims 1-4, 6-8, 11-13, 15-32, 34-45, 52-55 and 62-65 as unpatentable and confirming claims 5, 9, 10, 14, 33, 46, 50-51, 56-61 and 66 as patentable.

5. The proceeding advanced to the point that on May 11, 2010 the Office issued a final Office action finally rejecting original claims 1-8, 11-13, 15-29, 38-49, 52-56, 62, and new claims 67-92, 95-124 as unpatentable. The final Office action finally confirmed

original claims 9-10, 14, 30-37, 50-51, 57-61, 63-66, and found new claims 93-94 to be patentable.

6. On July 12, 2010, patent owner filed an amendment after-final in the '9155 proceeding.

7. On July 23, 2010, the Office issued an advisory action stating that the July 12, 2010 proposed response failed to overcome all the rejections in the May 2010 final Office action. The advisory action stated that unless a timely appeal was filed, the prosecution would be terminated and a NIRC would issue and that any finally rejected claims, or claims objected to, would be cancelled. The advisory action also stated if a timely appeal were to be filed, the July 12, 2010 amendment would be entered for purposes of appeal. The advisory action indicated that for purposes of the appeal the status of claims would be as follows: 9-10, 14, 30-37, 50-51, 57-61, 63-66 and 69-124 will be patentable and/or confirmed and that claims 1-8, 11-13, 15-29, 38-49, 52-56, 62, and 67-68 will be rejected.

8. On August 7, 2010, patent owner filed a paper entitled, "WAIVER OF RIGHT TO APPEAL UNDER 35 USC 306" requesting issuance of a NIRC "as quickly as possible."

9. On October 1, 2010, the Office issued a NIRC confirming original claims 9-10, 14, 30-37, 50-51, 57-61, 63-66, designating new claims 69-89 and 91-95 as patentable, and canceling as unpatentable original claims 1-8, 11-13, 15-29, 38-49, 52-56, 62 and new claims 67-68, 90 and 96-124.

10. On October 20, 2010, patent owner filed a paper entitled, "REQUEST FOR CORRECTION OF NOTICE OF INTENT TO ISSUE EX PARTE REEXAMINATION CERTIFICATE," requesting issuance of a corrected NIRC to include as patentable additional claims as allowable as of the July 23, 2010 advisory action and not the May 11, 2010 final Office action.

11. On October 22, the '9155 proceeding was forwarded to the Office of Publications for printing and issuance of a reexamination certificate, thus entering the print cycle.

12. On January 21, 2011, the Office issued a decision treating patent owner October 20, 2010 paper as a petition under 37 CFR 1.181 and dismissing the petition.

13. On March 2, 2011, the '9155 proceeding was assigned a reexamination certificate number and issue date of March 22, 2011.

14. On March 10, 2011, patent owner filed a petition under 37 CFR 1.182 entitled, PETITION UNDER 37 CFR 1.182 (WITH CONCURRENTLY FILED RE-PRESENTED AMENDMENT)," requesting entry of a concurrently filed new amendment.

15. On March 22, 2011, the reexamination proceeding was concluded by the issuance and publication of *Ex Parte* Reexamination Certificate (8106th), US 6,411,947 C1.

16. On May 3, 2011, patent owner filed a petition under 37 CFR 1.182 entitled "REQUEST FOR DECISION ON PETITION UNDER 37 CFR 1.182, AND COMMENTS REGARDING NOTICE TO ISSUE REEXAMINATION CERTIFICATE (NIRC)," requesting the March 10, 2011 petition be granted, the March 22, 2011 reexamination certificate be vacated, and that a new reexamination certificate be issued based upon the granted March 10, 2011 petition's concurrently filed amendment.

17. On August 30, 2011, the Office issued a decision dismissing patent owner's March 10, 2011 and May 3, 2011 petitions.

18. On October 28, 2011, patent owner filed a petition entitled, "PETITION FOR GENERAL SUPERVISORY REVIEW BY DIRECTOR UNDER 37 CFR 1.181."

DECISION

The present reexamination proceeding was concluded with the issuance of *Ex Parte* Reexamination Certificate (8106th), US 6,411,947 C1 on March 22, 2011. As of the issuance of the certificate, the Office was divested of jurisdiction over the '947 patent. Therefore, the submission of the amendment for entry and consideration by the examiner is not authorized by statute. Accordingly, the petition is **dismissed.**

RESPONSE TO PATENT OWNER ARGUMENTS

Patent owner asserts that the August 30, 2011 Office decision is in error because (1) the Office erroneously canceled claims 90, 96-124; (2) the Office retains jurisdiction over the proceeding for the correction of Office errors; and (3) the MPEP 2287 based additional discussion procedure is not controlling. Patent owner's arguments are not persuasive for the reasons noted below.

No Office Error Regarding Claims 90, 96-124

On October 20, 2010 patent owner filed a petition under 37 CFR 1.181 requesting review of the examiner's actions for error in the '9155 proceeding, specifically the issuance of a NIRC canceling new claims 90, and 96-124. Patent owner's request was in accord with Office procedure as set forth in MPEP 2272. On January 21, 2011, the Office issued a decision in response to patent owner's October 20, 2010 petition. The decision correctly noted that no error occurred, and that new claims 90, and 96-124 were properly canceled since patent owner did not file an appeal in the reexamination proceeding. Therefore, the claims that were proposed in the July 12, 2010 amendment under 37 CFR 1.116 were not entered. Any indications of allowability of those claims are not at issue.

Patent Owner argues that the advisory action of July 23, 2010 stated (on pages 4 and 5) that "the rejections of claims 90 and 96-124 '**are hereby** withdrawn,'" and thus the Office mistakenly cancelled claims 90 and 96-124 in the October 1, 2010 NIRC.[1] [Emphasis in petition.]

[1] Petition at 4

A review of the record reveals that the examiner withdrew ***some, but not all***, of the rejections applied to the claims of record – i.e., the claims as entered in the file prior to the non-entered July 12, 2011 amendment after final. Specifically, the rejections of claims 67, 68, 86, 87, and 90, 116, and 119 under the first paragraph of 35 U.S.C. 112 were withdrawn in view of patent owner's comments and discussion.[2] However, in the final Office action dated May 11, 2010, claims 67, 68, 86, and 87, and 90 were rejected under 35 U.S.C. 102(e) over Allen (see page 29) and claims 90 and 119 were rejected under the second paragraph of 35 U.S.C. 112 (see page 7). Finally, with respect to claim 116, claim 96 was rejected under 35 U.S.C. 305 (see page 3), and thus claims 116 and 119 which depend form claim 96 were not patentable as they appeared in the record. Thus, the record reflects that each pending claim that was not confirmed was subject to at least one rejection that was not withdrawn. Accordingly, there was no mistake in *Ex Parte* Reexamination Certificate (8106th), US 6,411,947 C1 as issued.

Furthermore, as patent owner DID NOT request further review of the January 21, 2011 Office decision,[3] further review of the actions taken with regard to canceled claims 90, and 96-124 are now time barred in accordance with 37 CFR 1.181 (f).

No Office Jurisdiction over the Concluded Reexamination Proceeding

Patent owner argues the Office has jurisdiction over the '947 patent in accordance with 35 U.S.C. 254 to address the issues raised by patent owner in connection with the '9155 proceeding.[4] However, (based upon patent owner's request of alternate relief under 35 U.S.C. 254[5]) it appears that patent owner is not requesting the Office to act under 35 USC 254. Patent owner is asking the Office to act under its jurisdiction over the '947 patent based upon the '9155 proceeding, as patent owner is petitioning for review of a decision issued in the '9155 proceeding. However, once a reexamination certificate issues, the Office's jurisdiction over a patent for that reexamination proceeding ends. Therefore, the Office no longer has jurisdiction over the '947 patent with regard to the '9155 proceeding.

No Basis for Issuing a Certificate of Correction under 35 U.S.C. 254

Patent owner requests, that" [i]n the alternative, the Director is urged to authorize issuance of a Certificate of Correction in the '947 Patent under 35 U.S.C. 254."[6]

To the extent that the Office has jurisdiction under 35 U.S.C. 254 to correct a patent, it is noted that such jurisdiction is limited to (a) mistakes "incurred through the fault of the Patent and Trademark Office" that are (b) "clearly disclosed by the records of the office", neither of which condition is met by the circumstances obtaining in the prosecution of the '9155 proceeding.

---

[2] Advisory action of July 23, 2010. See 2nd and 3rd paragraph on page 4 and 4th paragraph on page 4 and continues on page 5.

[3] The March 10, 2011 petition was a request for entry of an amendment after NIRC in accordance with MPEP 2287, not a request for review of the January 21, 2011 Office decision..

[4] Petition at 5.

[5] Petition at 1.

[6] Petition at 1.

Specifically, the correct claims appear on the certificate. Any discrepancy between the claims as reflected in the certificate and the claims which patent owner would have preferred is due to patent owner not properly and timely presenting those claims in a manner which would have entitled the claims for entry. A review of the record does not disclose any error on the part of the Office that demands correction. Therefore, no correction under 35 U.S.C. 254 is warranted and the Office has no jurisdiction to issue such a certificate.

Entry and Consideration of the March 10, 2011 Amendment

On March 10, 2011, patent owner, in accordance with MPEP 2287.01, submitted a petition under 37 CFR 1.182 requesting entry of a concurrently filed new amendment. Accordingly, patent owner invoked MPEP 2287.01 upon filing the March 10, 2011 petition, which requires a granted petition for consideration of any submission after NIRC. Twelve calendar days later, on March 22, 2011, the '9155 reexamination proceeding terminated upon issuance of *Ex parte* Reexamination Certificate (8106th), US 6,411,947 C1 divesting the Office of jurisdiction over the '947 patent. In the August 30, 2011 decision, the Office informed patent owner in an additional discussion section of the decision, that even if jurisdiction had not been lost, the drastic regression of the proceeding to enter and consider an amendment as such a late stage of the proceeding was contrary to the statutory mandate of special dispatch.

Patent owner now contends that the additional discussion section of the August 30, 2011 decision is not applicable, because the petition was filed before issuance of the reexamination certificate. Outside of the observation the petition was filed just before the Office lost jurisdiction, patent owner provides no basis as to why the additional discussion section is not applicable. The basis for the additional discussion's courtesy rationale for why the after NIRC submission was not enterable was the requirement of 35 U.S.C. 305 that reexamination proceedings be conducted with special dispatch. Statutory requirements regarding reexamination proceedings are applicable to all reexamination proceedings, including the '9155 proceeding.

Patent owner's filing of the petition for entry of an amendment after NIRC was very late in the proceeding; twenty-one weeks after issuance of a NIRC; nineteen weeks after the proceeding entered the print cycle; seven weeks after receiving an adverse decision on regarding the October 20, 2010 request for correction of the NIRC; and where reexamination certificate was scheduled for issuance in a matter of days after patent owner filed the petition. The Office provided patent owner with the additional discussion analysis in the August 30, 2011 decision, with regard to the request for entry of an amendment after NIRC, to inform patent owner that even if the Office had treated the petition on its merits, the request would not have been granted. Therefore, patent owner's reasons for entry of the amendment have been considered and not found persuasive.

Accordingly, for the reasoned noted above patent owner petition is dismissed.

CONCLUSION

1. The petition under 37 CFR 1.182 is dismissed.

2. Telephone inquiries related to this decision should be directed to Joseph F. Weiss, Jr., Legal Advisor, at (571) 272-7759 or in his absence to Pinchus M. Laufer, Senior Legal Advisor at (571) 272-7726.

Brian E. Hanlon

Brian E. Hanlon
Director
Office of Patent Legal Administration

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,156	05/20/2008	6345400	6214	8234

28960 7590 03/07/2011

HAVERSTOCK & OWENS LLP
162 N WOLFE ROAD
SUNNYVALE, CA 94086

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/07/2011

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Norman E. Lehrer, P.C.
1205 North Kings Highway
Cherry Hill, NJ 08034

Date:
MAILED

MAR 07 2011

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009156
PATENT NO. : 6345400
ART UNIT : 3993

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

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

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COMMISSIONER FOR PATENTS
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ALEXANDRIA, VA 22313-1450
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Haverstock & Owens LLP
162 N. Wolfe Road
Sunnyvale, CA 94086

(For Patent Owner)

MAILED

MAR 07 2011

Norman E. Lehrer, P.C.
1205 North Kings Highway
Cherry Hill, NJ 08034

(For Requester)

CENTRAL REEXAMINATION UNIT

In re Elliott et al.
Ex Parte Reexamination Proceeding
Control No. 90/009,156
Filed: May 20, 2008
For: U.S. Patent No. 6,345,400

DECISION
DISMISSING PETITION
UNDER 1.182

This is a decision on the January 31, 2011 patent owner petition entitled "PETITION UNDER 37 C.F.R. § 1.182 REQUESTING FOR CONTINUING REEXAMINATION."

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

The petition is **dismissed**.

RELEVANT BACKGROUND

- On February 12, 2002, U.S. Patent No. 6,345,400 was issued to Elliott et al., having claims 1-29 therein.

- On May 20, 2008, a request for *ex parte* reexamination of claims 1-29 of U.S. Patent No. 6,345,400 was filed by the third party requester, and the resulting reexamination proceeding was assigned control number 90/009,156 ("the '9156 proceeding"). Reexamination was ordered on June 20, 2008.

- Prosecution progressed until, on June 26, 2009, an Office action was issued, finally rejecting claims 1-29. No amendments were made or proposed to be made during the course of the reexamination.

- The '9156 proceeding subsequently entered the appeal process, and, on November 29, 2010, the Board of Patent Appeals and Interferences (the Board) issued a decision affirming the rejection of claims 1-29.

- On January 31, 2011, patent owner submitted the instant "PETITION UNDER 37 C.F.R. § 1.182 REQUESTING FOR CONTINUING REEXAMINATION." The submission further included remarks and an amendment to the claims.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 CFR 1.182 provides:

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

35 U.S.C. 305 provides, in pertinent part:

> After the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title. In any reexamination proceeding under this chapter, the patent owner will be permitted to propose any amendment to his patent and a new claim or claims thereto, in order to distinguish the invention as claimed from the prior art cited under the provisions of section 301 of this title, or in response to a decision adverse to the patentability of a claim of a patent. No proposed amended or new claim enlarging the scope of a claim of the patent will be permitted in a reexamination proceeding under this chapter. All reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, will be conducted with **special dispatch** within the Office. (emphasis added)

37 CFR 1.525(a) provides, in pertinent part:

> If a substantial new question of patentability is found pursuant to § 1.515 or § 1.520, the determination will include an order for *ex parte* reexamination of the patent for **resolution of the question**. (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

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

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.

In the reexamination setting, 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 is to make a *bona fide* effort, in the submission accompanying the § 1.182 petition, to define the issues for appeal, or the issuance of a reexamination certificate, as well as an effort to seasonably submit such a petition (rather than waiting to see what happens to the proceeding, without the amendment or evidence), since these are key factors in reducing pendency of a reexamination proceeding. Following the same rationale, the requirement of special dispatch favors continued prosecution where the need for the patent owner's proposed response could not have been anticipated earlier, and only became apparent as a result of a newly made statement in a final rejection.

The first issue, then, is whether patent owner's submission, if entered, would advance the issues towards resolution of the questions of patentability at issue in the proceeding. The questions of patentability at issue in the proceeding are whether the "Assembly Instructions" reference anticipates or, in view of other prior art, makes obvious the invention set forth in claims 1-29. This question has been answered in the affirmative by the Board. See the Board Decision of November 29, 2010, at 21. As these claims have been found unpatentable, the questions of patentability of these claims are considered to be resolved in the reexamination proceeding. Patent owner may request rehearing of the decision pursuant to 37 CFR 41.52, or appeal to the Court of Appeals for the Federal Circuit pursuant to 35 U.S.C. 141. Absent a timely request for rehearing or appeal, the proceeding can be most rapidly brought to resolution through issuance of an *ex parte* reexamination certificate through the procedure set forth at MPEP sections 2278 and 1214.06(II).

Patent owner proposes to advance the issues through amendment of the claims and addition of new claims. Such an amendment is permitted by 35 U.S.C. 305 to the extent that entry of the amendment would be consistent with the other provisions of the relevant statutes and regulations; in particular, the requirement in 35 U.S.C. 305 that the proceedings be conducted with special dispatch. At this stage in the proceedings, a submission raising new issues that would require significant consideration would be expected to unduly delay the proceeding. Where the examination/prosecution of the proceeding is not clearly advanced through the entry of the submission, such entry would clearly run counter to the mandate of conducting the reexamination proceeding to the resolution of the question of patentability with special dispatch.

In this instance, patent owner's response includes a submission directed towards the entry of claim amendments and accompanying remarks, as described in patent owner's instant petition. Entry of these claims would increase rather than decrease the amount of issues in the present proceeding, since the proposed amendments contain previously unconsidered claim limitations.[2]

[2] Petition at 11.

In view of the nature of the proposed amendments and the very late stage of the reexamination proceeding, continuation of the proceeding through entry of the proposed amendments would unduly introduce a multitude of new issues at a point where the original issues have been completely resolved and would result in unjustified delay, and would therefore not be conducive to conducting the reexamination proceeding with special dispatch.

The second issue is whether the submission comports with the requirement of special dispatch, in that the response could not have been presented earlier. Patent owner's response is not persuasive as to the reasons why such amendments could not have been presented earlier. Patent owner argues that no claim amendments were earlier thought desirable because the patent owner was of the opinion that the claims as presented for reexamination and appeal were in an allowable state. However, the anticipation rejections affirmed by the BPAI are made over the same "Assembly Instructions" reference applied in rejections in the first Office action of October 28, 2008. Although patent owner chose only to argue against the legal sufficiency of the rejections during the examination/prosecution stage, patent owner could have *also* presented new claims having the scope of the presently proposed amendments, in addition to the arguments against the rejected claims. Patent owner could have presented these claim amendments, or new claims having the scope of these amendments, in patent owner's response to the non-final Office action, and all issues could have been resolved together. It is not to be expected, in all instances, that the Office will change its position. The need for the instant amendment to define over the examiner's rejection could have been anticipated earlier, and entry at this stage would run counter to the requirement of special dispatch.

Based on the facts and circumstances of the present situation, it is found that petitioner patent owner's response is not deemed to provide the requisite *bona fide* effort in a manner consistent with the requirement of 35 U.S.C. 305 to conduct reexamination proceedings "with special dispatch within the Office."

In view of the above and the facts and circumstances presented by the present record, the petition is dismissed.

CONCLUSION

- The petition is **dismissed**.

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

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

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

- Any inquiry concerning this decision should be directed to Michael Cygan, Legal Advisor, at (571) 272-7700.

/Michael Cygan/

Michael Cygan
Legal Advisor
Office of Patent Legal Administration

March 4, 2011

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.:20100826

DATE : August 26, 2010

TO SPE OF : ART UNIT 3992

SUBJECT : Request for Certificate of Correction on Patent No.: 6,397,037 C1

A response is requested with respect to the accompanying request for a certificate of correction.

Please complete this form and return with file, within **7** days to:
Certificates of Correction Branch - PK 3-910
Palm location **7590** - Tel. No. 305-8201

With respect to the change(s) requested, correcting Office and/or Applicant's errors, should the patent read as shown in the certificate of correction? No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Thank You For Your Assistance **Certificates of Correction Branch**

The request for issuing the above-identified correction(s) is hereby:
Note your decision on the appropriate box.

☒ **Approved** — **All** changes apply.

☐ **Approved in Part** — Specify below which changes **do not** apply.

☐ **Denied** — State the reasons for denial below.

Comments:

Eric Keasel

SPE: Eric Keasel **Art Unit** 3992

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,179	06/06/2008	5826014	159291-0010	7720

28661 7590 02/11/2011

LEWIS AND ROCA LLP
1663 Hwy 395, Suite 201
Minden, NV 89423

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 02/11/2011

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NEWPORT BEACH, CA 92660

Date:

MAILED

[illegible] 17 2011

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009179
PATENT NO. : 5826014
ART UNIT : 3992

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

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

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(For patent owner)

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FEB 11 2011

CENTRAL REEXAMINATION UNIT

David C. McPhie, Esq.
Irell & Manella LLP
840 Newport Center Drive
Suite 400
Newport Beach, CA 92660

(For third party requester)

In re Christopher D. Coley et al.
Ex Parte Reexamination Proceeding
Control No. 90/009,179
Filed: June 6, 2008
For: U.S. Patent No. 5,826,014

: **DECISION**
: **GRANTING PETITION**
: **UNDER 37 CFR 1.137(b)**
: **AND VACATING**
: **CERTIFICATE**

This is a decision on the July 21, 2010 patent owner petition under 37 CFR 1.137(b) to accept an unintentionally delayed Appeal Brief and revive the present terminated reexamination ("the July 21, 2010 patent owner petition to revive").

The July 21, 2010 patent owner petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The July 21, 2010 patent owner petition to revive is **granted**.

Reexamination Certificate No. C1 5,826,014 issued August 24, 2010, for the present proceeding, and the June 2, 2010 Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) for the present proceeding, are hereby **vacated**.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

35 U.S.C. 41(a)(7) provides, in pertinent part:

> REVIVAL FEES. — On filing each petition ... for an unintentionally delayed response by the patent owner in any reexamination proceeding ...

35 U.S.C. 133 provides:

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

35 U.S.C. 305 provides, in pertinent part:

After the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title.

37 CFR 1.113 provides, in pertinent part:

(a) On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon ... for *ex parte* reexaminations filed under § 1.510, patent owner's reply is limited to appeal in the case of rejection of any claim (§ 41.31 of this title), or to amendment as specified in § 1.114 or § 1.116.

*****

(c) Reply to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the reply to a final rejection or action must comply with any requirements or objections as to form.

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.*
(1) ***
(2) ***

(3) The provisions of paragraph (d)(1) of this section do not apply to ... reexamination proceedings.

37 CFR 1.550 provides, in pertinent part:

(d) If the patent owner fails to file a timely and appropriate response to any Office action or any written statement of an interview required under § 1.560(b), the prosecution in the *ex parte* reexamination proceeding will be a terminated prosecution, and the Director will proceed to issue and publish a certificate concluding the reexamination proceeding under § 1.570 in accordance with the last action of the Office.

(e) If a response by the patent owner is not timely filed in the Office,

(1) ***

(2) The response may nevertheless be accepted if the delay was unintentional; a petition to accept an unintentionally delayed response must be filed in compliance with § 1.137(b).

37 CFR 41.33 provides, in pertinent part:

(a) Amendments filed after the date of filing an appeal pursuant to § 41.31(a)(1) through (a)(3) and prior to the date a brief is filed pursuant to § 41.37 may be admitted as provided in § 1.116 of this title.

37 CFR 41.37 provides, in pertinent part:

(a)(1) Appellant must file a brief under this section within two months from the date of filing the notice of appeal under § 41.31.

MPEP 2268 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, all *ex parte* reexamination proceedings by section 4605 of the American Inventors Protection Act of 1999. The unintentional delay provisions of 35 U.S.C. 41(a)(7) became effective in reexamination proceedings on November 29, 2000. Accordingly, the Office will consider, in appropriate circumstances, a petition showing unintentional delay under 37 CFR 1.137(b) where untimely papers are filed 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 set forth in 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).

MPEP 2274 provides, in pertinent part:

I. AMENDMENT

Where the appeal brief is not filed, but within the period allowed for filing the brief an amendment is presented which places the claims of the patent under reexamination in a patentable condition, the amendment may be entered.

*****

IV. FAILURE TO TIMELY FILE APPEAL BRIEF

Failure to file the brief and/or the appeal brief fee within the permissible time will result in dismissal of the appeal. ... The reexamination prosecution is then terminated, and a Notice of Intent to Issue Ex Parte Reexamination Certificate (NIRC) (see MPEP § 2287) will subsequently be issued indicating the status of the claims at the time of appeal.

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), prosecution of the instant reexamination proceeding was terminated due to the failure to timely submit a proper response, within the meaning of 37 CFR 1.113, to the August 14, 2009 final Office action. Patent owner timely filed a Notice of Appeal on November 13, 2009. Then, on January 12, 2010, patent owner filed an appeal brief, which was found to be non-compliant, resulting in the issuance of a February 19, 2010 Notification of Non-Compliant Appeal Brief. Patent owner failed to timely file a compliant appeal brief in response to the February 19, 2010 Notification.

Patent owner submitted a supplemental appeal brief on July 21, 2010. The July 21, 2010 appeal brief has been found, by the Board of Patent Appeals and Interferences, to be in compliance with the regulations. Further, patent owner was previously (on January 13, 2010) charged the requisite $540.00 fee under 37 CFR 41.20(b)(2) for filing a brief in support of an appeal. Item (1) has thus been satisfied.

A petition fee of $1,620.00 and a proper statement under 37 CFR 1.137(b)(3) were submitted as part of the July 21, 2010 patent owner petition to revive, which satisfy items (2) and (3), respectively.

Accordingly, the July 21, 2010 patent owner petition to accept an unintentionally delayed Appeal Brief is **granted**.

In this instance, Reexamination Certificate No. C1 5,826,014 issued for the present proceeding on August 24, 2010. Based on the granting of the petition to revive, both the Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) issued on June 2, 2010, and the reexamination certificate are hereby **vacated**.

In due course, the following *erratum* will be published in the *Official Gazette*:

> All reference to Reexamination Certificate No. C1 5,826,014 to Christopher D. Coley of Morgan Hill, CA (US) et al. for FIREWALL SYSTEM FOR PROTECTING NETWORK ELEMENTS CONNECTED TO A PUBLIC NETWORK, appearing in the *Official Gazette* of August 24, 2010, should be deleted, since the reexamination certificate has been vacated.

JULY 21, 2010 AMENDMENT PAPER

In addition to the petition to revive and supplemental appeal brief, patent owner also filed on July 21, 2010, an amendment paper titled "Pre-Appeal Amendment Per MPEP § 2274(I)." However, the July 21, 2010 amendment is not a part of the response required by 37 CFR 1.137(b)(1). As stated earlier herein, the instant reexamination proceeding was terminated due to patent owner's failure to timely file a compliant appeal brief in response to the February 19, 2010 Notification of Non-Compliant Appeal Brief. Therefore, the instant decision makes no finding on the issue of the entry of the July 21, 2010 amendment. Instead, the examiner having charge of the 90/009,179 reexamination proceeding will address the issue of entry of the July 21, 2010 amendment, after Art Unit 3992 of the Central Reexamination Unit has processed the July 21, 2010 supplemental appeal brief.

CONCLUSION

1. The July 21, 2010 patent owner petition to revive under 37 CFR 1.137(b) is **granted**.

2. The termination of prosecution noted in the June 2, 2010 NIRC, and the NIRC itself, are **vacated**.

3. The *Ex Parte* Reexamination Certificate issued August 24, 2010, is **vacated**.

4. The Office of Patent Publications will take action with respect to the 5,826,014 patent consistent with this decision.

5. Art Unit 3992 of the Central Reexamination Unit will process the July 21, 2010 supplemental appeal brief in the 90/009,179 reexamination proceeding, after which the examiner will proceed to (i) address the issue of entry of the July 21, 2010 amendment and (ii) issue an examiner's answer under 37 CFR 41.39 or take other appropriate action.

6. Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Mary Steelman, of CRU Art Unit 3992, at (571) 272-3704.

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

/Kenneth M. Schor/

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

02-10-2011

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,182	06/13/2008	6,843,372	050956/342119	8730

23580 7590 08/09/2010

MESMER & DELEAULT, PLLC
41 BROOK STREET
MANCHESTER, NH 03104

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 08/09/2010

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
ALSTON & BIRD LLP
BANK OF AMERICA PLAZA
101 SOUTH TRYON STREET, SUITE 4000
CHAROLOTTE, NC 28280-4000

Date:

MAILED

AUG 09 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009182
PATENT NO. : 6843372
ART UNIT : 3993

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

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

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Robert R. Deleault
Mesmer & Deleault, PLLC
41 Brook Street
Manchester, NH 03104

(For Patent Owner)

MAILED

AUG 09 2010

Todd M. Hess, Esq.
Alston & Bird LLP
Bank of America Plaza
101 S. Tryon St. Suite 4000
Charlotte, MC 28280

(For Requester)

CENTRAL REEXAMINATION UNIT

Ex Parte Reexamination Proceeding
Control No. 90/009,182
Filed: June 13, 2008
For: US Patent No. 6,843,372

DECISION ON
PETITION FOR
EXTENSION OF TIME
[37 CFR 1.550(c)]

This is a decision on the petition filed August 4, 2010 to request a one-month extension of time pursuant to 37 CFR 1.550 for responding to the Office action dated June 8, 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.

Decision

The Patent Owner requests an extension of time in which to file a response to the Office action dated June 8, 2010, which set a two-month date for filing a response thereto. The Office action is a 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 1.515(c).

37 CFR 1.550 (c) states:

> (c) The time for taking any action by a patent owner in an ex 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 1.550 (c) to make a showing of "sufficient cause" to grant an extension of time request, MPEP 2265 states, in pertinent part:

> Evaluation of whether sufficient cause has been shown for an extension must be made in the context of providing the patent owner with a fair opportunity to present an argument against any attack on the patent, and the requirement of the statute (35 U.S.C. 305) that the proceedings be conducted with special dispatch. ...
>
> Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. ...

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

The petition for extension of time states that, due to prior commitments and holiday schedules, counsel has not been available for consultation. The final Office action is extensive and counsel requests additional time to properly address the issues. An extension of one month is requested provide Patent Owner with a fair opportunity to reply to the outstanding rejections.

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 adequate to justify the grant of a one-month extension of time in which to file a response to the outstanding Office action. Accordingly, the period of time for filing a reply to the Office action dated June 8, 2010 is extended to run three (3) months from the date of the Office action and is due on September 8, 2010. Patent Owner should expect that future requests for extensions will not be granted absent strong and compelling reasons that establish the existence of an extraordinary situation necessitating the additional time.

Conclusion

1. The Patent Owner's petition for extension of time in which to file a response to the Office action dated June 8, 2010 is **granted** for one (1) month.
2. The Patent Owner's response is due September 8, 2010.
3. Response may be submitted as follows:

By EFS: See 37 CFR 1.8(a)(C)(ii)

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

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

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

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

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,670	09/10/2009	5148366	140.0001-00RX2	3203

22882 7590 03/23/2011

MARTIN & FERRARO, LLP
1557 LAKE O'PINES STREET, NE
HARTVILLE, OH 44632

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/23/2011

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

Copied from 90010670 on 03/24/2011

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,196	06/23/2008	5148366	140.0001-00REX	5652

22882 7590 03/23/2011

MARTIN & FERRARO, LLP
1557 LAKE O'PINES STREET, NE
HARTVILLE, OH 44632

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/23/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
SHOOK, HARDY & BACON L.L.P.
INTELLECTUAL PROPERTY DEPARTMENT
2555 GRAND BOULEVARD
KANSAS CITY, MO 64108-2613

Date:

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010670
PATENT NO. : 5148366
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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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Thomas M. Sullivan
LANDO & ANASTASI, LLP
One Main Street, Suite 1100
Cambridge, MA 02142

Date:

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009196
PATENT NO. : 5148366
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)).

Copied from 90010670 on 03/24/2011

Decision Granting 37 CFR 1.59 Petition in Reexamination	Control No.: 90/009,196 & 90/010,670

1. The petition under 37 CFR 1.59 to expunge proprietary, protective order and/or trade secret documents under 37 CFR 1.59 filed 04 March 2011 is granted.

2. The Patent owner's representative requests expungement of document(s) that have been filed under MPEP 724.02. The examiner has determined that the information in such document(s) presented under seal are not material to patentability in the instant reexamination proceeding. Further, the petitioner has complied with all of the requirements of MPEP 724.05.

   A. ☒ Since the petition does not specify otherwise, the documents have been:
      i. ☒ Destroyed.
      ii. ☐ Expunged.

   B. ☐ Other/Comment:

3. CONCLUSION

   Telephone inquiries with regard to this decision should be directed to Mark Reinhart at 571-272-1611, SPE AU 3992. In his/her absence, calls may be directed to Eric Keasel at 571-272-4929, SPE in AU 3992 in the Central Reexamination Unit

/Mark Reinhart/	SPE AU 3992
[*Signature*]	(Title)

Copied from 90010670 on 03/24/2011

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,213	10/14/2008	6188988	SMA002	1603

20792 7590 08/16/2010

MYERS BIGEL SIBLEY & SAJOVEC
PO BOX 37428
RALEIGH, NC 27627

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 08/16/2010

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Goodman, Allen, & Filetti PLLC
4501 Highwoods Parkway, Suite 210
Glen Allen VA 23060

MAILED

AUG 16 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/009,213*.

PATENT NO. *6188988*.

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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EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/009,213*.

PATENT NO. *6188988*.

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)).

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MYERS BIGEL SIBLEY & SAJOVEC
PO BOX 37428
RALEIGH NC 27627

(For Third-Party Requester)

Dechert LLP c/o Jonathan D. Loeb
2440 W. El Camino Real, Suite 700
Mountain View, CA 94040

(For Third-Party Requester)

GOODMAN, ALLEN & FILETTI PLLC
4501 HIGHWOODS PARKWAY
SUITE 210
GLEN ALLEN, VA 23060

In re Barry *et alia*
Reexamination Proceeding
Control No. 95/001,088
Request Deposited: October 13, 2008
For: U.S. Patent No. 6,188,988

In re Barry *et alia*
Reexamination Proceeding
Control No. 90/009,213
Request Deposited: June 26, 2008
For: U.S. Patent No. 6,188,988

: DECISION
: DISMISSING PETITIONS

This is a decision on the April 12, 2010 papers entitled "PETITION UNDER 37 C.F.R. §1.182 FOR RELIEF NOT OTHERWISE PROVDED FOR UNDER THE RULES – REQUEST FOR DISMISSAL OF APPEAL" and "PETITION UNDER 37 C.F.R. §1.182 FOR RELIEF NOT OTHERWISE PROVDED FOR UNDER THE RULES – REQUEST FOR REFUSAL OF CONSIDERATION OF REQUESTER'S IMPROPER ARGUMENTS". This decision also

addresses the papers filed April 15, 2010 entitled "OPPOSITION TO PATENT OWNER'S PETITION UNDER 37 C.F.R. §1.812 REQUESTING DISMISSAL OF THE APPEAL OR IN THE ALTERNATIVE, PETITION UNDER 37 C.F.R. §1.813 TO SUSPEND THE RULES IN THE INTEREST OF JUSTICE" and "PETITION UNDER 37 C.F.R. §1.182 IN OPPOSITION TO PATENT OWNER'S PETITION REQUESTING 'REFUSAL OF CONSIDERATION OF REQUESTER'S IMPROPER ARGUMENTS'".

The papers are before the Director of the Central Reexamination Unit for consideration.

The petitions are **dismissed** for the reasons set forth below.

BACKGROUND AND DECISION

Third-Party Requester in *inter partes* control number 95/001,088 filed a Notice of Appeal on January 21, 2010. Patent Owner was not entitled to file a cross appeal as no claims were finally rejected (see 37 CFR 41.61(b)(1)). An appellant's brief must be filed no later than two months from the latest filing date of the last-filed notice of appeal or cross-appeal, if any party to the proceeding is entitled to file an appeal or cross-appeal but fails to timely do so, no later than two months from the expiration of the time for filing (by the last party entitled to do so) such notice of appeal or cross appeal. The time for filing an appellant's brief or an amended appellant's brief may not be extended (see 37 CFR §41.66(a)). Appellant's brief was due on March 22, 2010 (as March 21, 2010 was a Sunday). The paper filed April 2, 2010 is untimely.

In view of the issuance of the Notice of Intent to Issue Reexamination Certificate mailed August 13, 2010, the petition to dismiss the appeal filed April 12, 2010 is **dismissed as moot**.

Similarly, the petition requesting to refuse to consider arguments presented in the untimely filed paper is **dismissed as moot**. The opposition petition to the petition requesting to refuse to consider arguments is also **dismissed as moot**.

The paper entitled "OPPOSITION TO PATENT OWNER'S PETITION UNDER 37 C.F.R. §1.812 REQUESTING DISMISSAL OF THE APPEAL OR IN THE ALTERNATIVE, PETITION UNDER 37 C.F.R. §1.813 TO SUSPEND THE RULES IN THE INTEREST OF JUSTICE" is **dismissed** under 37 CFR 1.4(c). Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects. Furthermore, it does not appear that 37 CFR 1.812 or 37 CFR 1.813 are the proper rules to cite.

CONCLUSION

1. The petitions filed on April 12, 2010 entitled "PETITION UNDER 37 C.F.R. §1.182 FOR RELIEF NOT OTHERWISE PROVDED FOR UNDER THE RULES – REQUEST FOR DISMISSAL OF APPEAL" and "PETITION UNDER 37 C.F.R. §1.182 FOR RELIEF NOT OTHERWISE PROVDED FOR UNDER THE RULES – REQUEST FOR REFUSAL OF CONSIDERATION OF REQUESTER'S IMPROPER ARGUMENTS" and the petitions filed on April 15, 2010 entitled "OPPOSITION TO PATENT OWNER'S PETITION UNDER 37 C.F.R. §1.812 REQUESTING DISMISSAL OF THE APPEAL OR IN THE ALTERNATIVE, PETITION UNDER 37 C.F.R. §1.813 TO SUSPEND THE RULES IN THE INTEREST OF JUSTICE" and "PETITION UNDER 37 C.F.R. §1.182 IN OPPOSITION TO PATENT OWNER'S PETITION REQUESTING 'REFUSAL OF CONSIDERATION OF REQUESTER'S IMPROPER ARGUMENTS'" are **dismissed**.

2. This decision is without prejudice to a request for reconsideration or higher-level review.

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

Eric Keasel
SPE, AU 3992, Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,215	07/18/2008	5663106	20164.2002	4164

7590 01/18/2012

LERNER DAVID LITTENBERG KRUMHOLZ & MENTLIK
600 South Ave. West
Westfield, NJ 07090

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 01/18/2012

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date: 1-18-12

Sanjeet K. Dutta
ORRICK, HERRINGTON & SUTCLIFFE, LLP
4 Park Plaza, Suite 1600
Irvine, CA 92614

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009215
PATENT NO. : 5663106
ART UNIT : 3993

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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JAN 18 2012

CENTRAL REEXAMINATION UNIT

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Lerner David Littenberg Krumholz & Mentlik (For Patent Owner)
600 South Ave. West
Westfield, NJ 07090

Sanjeet K. Dutta
Orrick, Herrington & Sutcliffe LLP (For Third Party Requester)
4 Park Plaza, Suite 1600
Irvine, CA 9261

In re Karavakis et al.
Reexamination Proceeding
Control No. 90/009,215
Filed: July 18, 2008
For: U.S. Patent No. 5,663,106

DECISION DISMISSING PETITION

This is a decision on patent owner's July 06, 2011 petition entitled "Petition Pursuant to 37 C.F.R. § 1.182 Regarding Related Reissue Applications" (the petition under 37 CFR 1.182).

The petition under 1.182 is before the Office of Patent Legal Administration for consideration.

The petition under 37 CFR 1.182 is **dismissed** for the reasons set forth herein.

BACKGROUND

1. On September 02, 1997, U.S. Patent No. 5,663,106 (the '106 patent) issued to Karavakis *et al.* with claims 1-47.

2. On July 18, 2008, a request for *ex parte* reexamination of claims 1-4, 9-10 and 33-35 of the '106 patent was filed by a third party requester, which request was assigned control number 90/009,215 (the '9215 proceeding).

3. On September 04, 2008, *ex parte* reexamination was ordered for claims 1-4, 9-10 and 33-35 of the '106 patent in the '9215 proceeding. During prosecution of the '9215 proceeding, patent owner filed amendments adding new claims 48-62.[1]

4. Prosecution in the '9215 proceeding progressed to the point where, on March 17, 2011, the Office issued an advisory action stating that claims 49 and 60-62 are patentable and/or confirmed, and claims 1-4, 9-10, 33-35, 48 and 50-59 are rejected.

[1] On June 10, 2009, patent owner filed an amendment in the '9215 proceeding presenting new claims 48-55. On January 22, 2010, patent owner filed an amendment in the '9215 proceeding presenting new claims 56-59. On June 09, 2010, patent owner filed an amendment in the '9215 proceeding presenting new claims 60-62.

5. On April 18, 2011, patent owner filed a notice of appeal and, on June 23, 2011, patent owner filed an appeal brief in the '9215 proceeding.

6. On June 30, 2011, patent owner filed a reissue application for reissue of the '106 patent, which application was assigned application number 13/173,527 (the '527 reissue application). A preliminary amendment was concurrently filed presenting new claims 48-62. A second preliminary amendment was filed on July 6, 2011 cancelling claims 49 and 60-62. To date, no Office action on the merits has been issued in the '527 reissue application.

7. On July 5, 2011, patent owner filed another reissue application for reissue of the '106 patent, which application was assigned application number 13/176,140 (the '140 reissue application). A preliminary amendment was concurrently filed cancelling original claims 1-47 and presenting new claims 48-51. To date, no Office action on the merits has been issued in the '140 reissue application.

8. On July 6, 2011 patent owner filed the instant petition under 37 CFR 1.182 requesting: (a) merger of the '9215 proceeding and the '527 reissue application and (b) that the '140 reissue application be passed to issue.

9. On August 9, 2011 a notice of the filing of the '527 and the '140 reissue applications was published in the *Official Gazette*.

APPLICABLE REGULATIONS AND EXAMINING PROCEDURE

35 U.S.C. § 305 provides, in part:

> All reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office.

37 CFR 1.565(d) provides, in part:

> 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.

MPEP § 2285 provides, in part:

> The general policy of the Office is that a reissue application examination and an ex parte reexamination proceeding will not be conducted separately at the same time as to a particular patent. The reason for this policy is to permit timely resolution of both proceedings to the extent possible and to prevent inconsistent, and possibly conflicting, amendments from being introduced into the two proceedings on behalf of the patent owner. Accordingly, if both a reissue

> application and an ex parte reexamination proceeding are pending concurrently on a patent, a decision will normally be made (A) to merge the two proceedings or (B) to stay one of the two proceedings. See In re Onda, 229 USPQ 235 (Comm'r Pat. 1985). The decision as to whether the proceedings are to be merged, or which proceeding (if any) is to be stayed is made in the Office of Patent Legal Administration (OPLA).

MPEP § 2285(II)(C) provides, in part:

> In making a decision on whether or not to merge the reissue application examination and the reexamination proceeding, consideration will be given as to whether issues are raised in the reissue application that would not be proper for consideration in reexamination. In addition, consideration will also be given to the status of the reexamination proceeding. For example, if the reexamination proceeding is on appeal to the Board or to the Court of Appeals for the Federal Circuit, or a Notice of Intent to Issue a Reexamination Certificate was issued for the reexamination, that fact would be considered in making a decision whether to merge the reissue application examination and the reexamination proceeding or stay one of them.

CLAIMS OF RECORD

A review of the file for the '9215 reexamination proceeding reveals that claims 1-4, 9, 10, 33-35, 48-62 are subject to reexamination. Claims 5-8, 11-32 and 36-47 are not subject to reexamination. Claims 49 and 60-62 are patentable and/or confirmed. Original, unamended claims 1-4, 9, 10, and 33-35 and new claims 48 and 50-59 stand rejected and have been appealed to the Board of Patent Appeals and Interferences (BPAI).

A review of the '527 reissue application file reveals that claims 1-48 and 50-59 are pending. Claims 1-47 are the original and unamended claims of the '106 patent and claims 48 and 50-59 are new claims.

A review of the '140 reissue application file reveals that claims 48-51 are pending. Original claims 1-47 of the '106 patent have been cancelled and claims 48-51 are new claims.

DECISION

I. Patent Owner's Petition under 37 CFR 1.182

In the instant petition under 37 CFR 1.182, patent owner requests (1) that the '527 reissue application be merged with the '9215 reexamination proceeding, and (2) that the '140 reissue application be passed to issue. In support of the request for merger of the '527 reissue application and the '9215 proceeding, patent owner states that the '140 reissue application "contains only claims that have already been held patentable in the ['9215] reexamination," while the '527 reissue application contains "the remaining claims involved in the

reexamination."[2] In other words, the pending claims in the '527 reissue application are the same claims that are pending on appeal in the '9215 proceeding.

In support of the request that the '140 reissue application be passed to issue, patent owner asserts that "[t]he Office has already decided that the Allowed Claims which are presented in the '140 Continuation Reissue Application are patentable to Patent Owner, and has further determined that the Allowed Claims do not broaden the original claims of the '106 Patent."[3] Patent owner also states that "[t]he '106 Patent will expire on May 19, 2014."[4] Thus, patent owner asserts that "considerable prejudice to Patent Owner's rights could occur if issuance of these claims in an enforceable document were delayed until resolution of the appeal concerning other claims in the reexamination."[5]

II. Request to Merge the '527 Reissue Application and '9215 Reexamination Proceeding

The '527 reissue application (proceeding) and the '9215 reexamination proceeding are currently pending for the same patent. The order has been mailed pursuant to 37 CFR 1.525 for the '9215 reexamination proceeding, the '527 reissue application has been announced in the *Official Gazette*, and the Office of Patent Legal Administration (OPLA) has been informed of the reissue and reexamination proceedings. Accordingly, consideration of patent owner's July 6, 2011 petition under 37 CFR 1.182, requesting merger of the '527 reissue application and the '9215 reexamination proceeding is appropriate at this time.[6] As set forth in 37 CFR 1.565(d), the practice in the circumstance where a reissue application and a reexamination for the same patent are concurrently pending in the Office is normally to merge the proceedings or suspend one of the proceedings pending conclusion of the other proceeding.

After consideration of the records of the '527 reissue application and the '9215 reexamination proceeding, and based on the present facts and circumstances, the Office has decided that merger of the two proceedings is not an appropriate option. This decision is based on the following considerations:

With respect to the option of merging the '527 reissue application and the '9215 reexamination proceeding, MPEP § 2285(II)(C) clearly points out that when the reexamination proceeding is on appeal to the BPAI, that circumstance would itself weigh against merger of the reexamination proceeding with a copending reissue application for the same patent. In this instance, a merger of the '527 reissue application and the '9215 reexamination proceeding would impede treatment of the '9215 reexamination proceeding with the special dispatch mandated by 35 U.S.C. § 305 in *ex parte* reexamination. A merger would pull the '9215 reexamination proceeding back from its advanced (appeal) stage, and return the proceeding to an earlier stage. Additionally, a merger would permit the entry of claim amendments after the close of prosecution in the reexamination. Also, the merger would now result in a proceeding that would be conducted under the broader

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[2] Petition at page 1.
[3] Id. at page 3. See also, petition at page 4 (stating that "[t]he claims of the '140 Continuation Reissue Application are not involved in the appeal" and that "the Office has already examined these claims and has held the same to be patentable").
[4] Id. at page 3.
[5] Id.
[6] *See* MPEP 2686.03.

reissue regulations, as required by 37 CFR 1.565(d). There is a public interest in the outcome of the present '9215 reexamination proceeding, and the public has a right to have this proceeding conducted with special dispatch, rather than have prosecution in this instance delayed indefinitely in favor of prosecution of a reissue application that has only recently been filed and which may be subject to prosecution that could subsequently be extended by multiple follow-on filings.

In this instance, the '527 reissue application was filed more than two years after the issue date of the '106 patent; thus, applicant/patent owner will not have the opportunity to provide broadening claims in the reissue application. However, the reissue application is subject to an entirely new examination on art of all the pending claims, including those not subject to the reexamination, as well as 35 U.S.C. § 112 and other non-reexamination matters, whereas examination in a reexamination proceeding is directed to art that raises the substantial new question of patentability for the proceeding. Thus, even if the claims are not broadened in the reissue application, the examiner of a merged proceeding, as proposed, would need to (a) consider any grounds of rejection of the patent claims other than those based solely on prior patents and printed publications, (b) consider any grounds of rejection of the patent claims other than those based solely on art that raises a substantial new question of patentability, and (c) evaluate the adequacy and propriety of the reissue declaration. Furthermore, the reexamination of the '106 patent is limited to a subset of the original claims, while the reissue application requires examination of all pending claims. These additional issues would retard the prompt resolution of the reexamination proceeding required by the statutory mandate of 35 U.S.C. § 305 for special dispatch.

In view of the foregoing considerations, it is not deemed beneficial to consolidate the '527 reissue application and '9215 reexamination proceedings within the Office. Accordingly, **patent owner's request for merger of the '570 reissue application and the '9215 reexamination proceeding is dismissed**. A separate decision, mailed on date even herewith, addresses suspension of the '527 reissue application pending the conclusion of the '9215 reexamination proceeding.

III. Request for Issuance of the '140 Reissue Application

After consideration of the record of the '140 reissue application, and based on present facts and circumstances, the Office has decided that the '140 reissue application is not ready for issuance. Though the claims of the '140 application correspond to those indicated as being patentable and/or confirmed over the prior art of record in the '9215 reexamination proceeding, the '140 reissue application is subject to an entirely new examination of the pending claims over ***all*** available prior art, as well as 35 U.S.C. § 112 and other non-reexamination matters, whereas examination in a reexamination proceeding is directed to art that raises the substantial new question of patentability for that proceeding. Thus, even though the claims of the '140 reissue application have been examined in the '9215 reexamination proceeding, the claims of the '140 reissue application are subject to examination on (a) any grounds of rejection of the patent claims other than those based solely on prior patents and printed publications and (b) any grounds of rejection of the patent claims other than those based solely on art that raises a substantial new question of patentability.

In view of the foregoing considerations, the '140 reissue application has yet to be examined and is not ready for issuance at this time. Accordingly, **patent owner's request for issuance of the '140 reissue application is dismissed**. A separate decision, mailed on date even herewith, addresses suspension of the '140 reissue application pending conclusion of the '9215 reexamination proceeding.

CONCLUSION

1. Patent owner's July 6, 2011 petition under 37 CFR 1.182 is **dismissed**.

2. Telephone inquiries relating to the examination of the '527 reissue application should be directed to the supervisory examiner, Derris Banks, Group Art Unit 3729, at (571) 272-4419.

3. Telephone inquiries related to the examination of the '140 reissue application should be directed to the examiner, Donghai Nguyen, Group Art Unit 3729, at (571) 272-4566.

4. Telephone inquires related to the prosecution of the '9215 reexamination proceeding should be directed to the examiner Jimmy Foster, Group Art Unit 3993, at (571) 272-4554.

5. Telephone inquiries relating to this decision should be directed to Nicole Haines, Legal Advisor, at (571) 272-7717, or the undersigned, at (571) 272-7726.

Pinchus M. Laufer
Senior Legal Advisor
Office of Patent Legal Administration

01-17-2012

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Brooks Kushman P.C. / Lear Corporation
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Twenty-Second Floor
Southfield, MI 48075-1238

For Patent Owner

MAILED

JAN 25 2011

CENTRAL REEXAMINATION UNIT

Fay Kaplun & Marcin, LLP
150 Broadway, Suite 702
New York, NY 10038

For 3rd Party Requester
(both Requests)

Ex Parte Reexamination Proceeding
Control No. 90/009,250
Filed: August 14, 2008
For: U.S. Patent No. 5,378,043

Ex Parte Reexamination Proceeding
Control No. 90/011,038
Filed: June 14, 2010
For: U.S. Patent No. 5,378,043

DECISION MERGING
REEXAMINATION
PROCEEDINGS

The above noted reexamination proceedings are before the Supervisory Patent Examiner of Central Reexamination Unit 3993 for consideration of merger as provided in 37 CFR 1.565(c).

Consideration of Merger

Under 37 CFR 1.565(c):

> "If *ex parte* reexamination is ordered while a prior *ex parte* reexamination proceeding is pending and prosecution in the prior *ex parte* reexamination proceeding has not been terminated, the *ex parte* reexamination proceedings will be consolidated and result in the issuance of a single certificate under §1.570."

Reexamination in application control No. 90/009,250 was ordered in a decision mailed October 10, 2008. The decision granted reexamination for patent claims 1-12, all of the claims of US Patent No. 5,378,043. On May 6, 2009, a non-final Office action was mailed rejecting claims 1-12, all of the claims in the patent undergoing reexamination. On July 6, 2009, patent owner filed a response canceling claim 1, amending claims 2, 4-6, 10, 11, and adding new claims 13-55. On January 15, 2010, another non-final Office

action was mailed rejecting claims 2, 4, 6, 7, 10-13, 15, 16, 18, 21, 24, 28-31, 34, 35, 40, 43, 44, 46, 54 and 55, and objecting to claims 3, 5, 8, 9, 14, 17, 19, 20, 22, 23, 25-27, 32, 33, 36-39, 41, 42, 45, and 47-53. The objected claims were indicated as being allowable but depending from a rejected base claim. On March 15, 2010, patent owner filed a response, and by this response, claim 1 was still cancelled, claims 2, 4-6, 10, and 11 stood as amended, and claims 13-56 were new to the proceeding. On July 22, 2010 a final Office action was mailed rejecting claims 10-12 and indicating that claims 2-9 and 13-56 were patentable and/or confirmed. No response was filed by patent owner to the final Office action. Accordingly, finally rejected claims 10-12 are deemed canceled and no longer pending in this examination proceeding.

Reexamination in application Control No. 90/011.088 was ordered in a decision mailed August 12, 2010. The decision indicating that original claims 1-12, all of the claims in US Patent 5,378,043 would be reexamined. As explained in section 2242(I) of the MPEP, where a second request for reexamination is requested before the conclusion of an earlier filed reexamination request, the second request may provide additional information raising a substantial new question of patentability (SNQ) with the respect to any new or amended claim which had been proposed under 37 CFR 1.530(d) in the ongoing pending reexamination proceeding. Third party requester did provide information raising a SNQ with respect to amended claims 2-12, and new claims 13-31, 34, 35, 40, 41, 43-50, and 54-56. The decision granting reexamination mailed August 12, 2010, agreed that a SNQ did exist with respect to amended claims 2-12, and new claims 13-31, 34, 35, 40, 41, 43-50, and 54-56, and therefore, these claims would be reexamined. The decision also acknowledged that no SNQ was asserted by the second request against claims 32, 33, 36-39, 42, and 51-53. No Patent Owner Statement under 37 CFR 1.530 was filed by patent owner in this second proceeding. No Office action has been rendered since the mailing of the decision ordering reexamination.

As evidenced by the above facts, reexamination Control No. 90/009,250 and reexamination control No. 90/011,088 are currently pending. Since the order to reexamine has been mailed in both reexamination proceedings and both proceedings are pending, a decision under 37 CFR 1.565(c) is timely. Accordingly, the above-captioned proceedings are hereby merged. A joint examination will be conducted in accordance with the following guidelines and requirements.

Requirement for Same Claims, Drawings, and Specification in Both Proceedings

As noted above, original patent claims 1 and 10-12 have been canceled; original claims 2, 4-6, 10, and 11 have been amended; and new claims 13-56 have been added by amendment in reexamination control No. 90/009,250. No amendment has been filed in reexamination control No. 90/011,088. As patent owner is required to maintain identical claims, drawings, and specification in both files, and keeping with the statutory requirement of 35 U.S.C. 305 that "All reexamination proceedings under this section ...will be conducted with special dispatch within the Office.", to expedite the proceedings, the attached appendix containing amended original claims 2, 4-6, 10 and 11, as well as new claims 13-56 will be entered into both files, and this version of the claims,

which is the most recent, along with unamended original claims 3, 7-9, and 12 will be the basis of the next Office action.

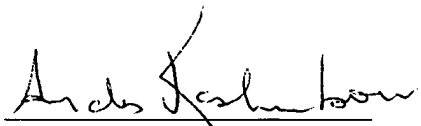
Conduct of Proceedings

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. As indicated above, original claims 2-12 (with 2, 4-6, 10 and 11 amended as in the attached appendix), and new claims 13-56 will be reexamined. All papers mailed by the Office will take the form of a single action that jointly applies to both reexaminations. All papers issued by the Office will contain the identifying data for both cases, and each paper will be entered into both files (which will be maintained as separate files). Any paper filed by the patent owner must consist of a single response, filed in duplicate, each bearing an original signature for entry into each file. All papers filed by patent owner must be served on the third party requester and requester will be sent copies of all papers mailed by the Office. Where a paper is filed that requires payment of a fee (e.g., petition fee, excess claims fee, appeal brief fee, brief fee, etc.) only a single feed need be paid. For example, only one fee need be paid for a patent owner's appellant brief, even though the brief relates to multiple proceedings and copies must be filed (as pointed out above) for each file in the merged proceeding. Further, upon return of the present merged proceedings to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior art patents and printed publications, and will cite such documents as necessary as part of the next action in order to place the files in identical condition.

Conclusion

Reexamination Control Nos. 90/009,250 and 9011,088 are hereby merged into a single proceeding. Upon the mailing of this decision, the files will be forwarded to the examiner in the Central Reexamination Unit for issuance of an Office action on the merits that is consistent with this decision.

Any inquiry concerning this decision should be directed to Andres Kashnikow, Supervisory Primary Examiner, at telephone No. (571) 272-4361.



Andres Kashnikow, SPE
Central Reexamination Unit 3993

Attachment: Appendix (Copy of amended and new claims for this merged reexamination proceeding).

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,261	08/21/2008	5,734,961	ED 017 954 148 US	8409

40401 7590 12/13/2010

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EXAMINER	
FOSTER, ROLAND G	
ART UNIT	PAPER NUMBER
3992	

MAIL DATE	DELIVERY MODE
12/13/2010	PAPER

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANTOR MEDIA CORPORATION

Appeal 2010-007531
Reexamination Control 90/007,839; 90/007,936; 90/007,942;
90/007,957; and 90/009,261
Technology Center 3900

DECISION ON PETITION

This is a decision on the "Petition Under 37 CFR 1.550(c) for Extension of Time to Request Rehearing of Board Decision" filed on December 6, 2010. In this Petition, directed to the Chief Judge of the Board of Patent Appeals and Interferences, the Appellant seeks a two month extension of time to request rehearing of the Decision on Appeal, which was mailed on October 21, 2010.

In support of the Petition, the Appellant's representative states that "In November, 2010" the patent owner and previous counsel agreed to terminate the representation. (Petition at 2). As no specific date is stated in the Petition, a logical conclusion is that this agreement was reached as early as November 1, about 10 days after the Decision was rendered. Read in this light, the Petition states that approximately 40 days prior to the filing of the instant Petition, the Appellant knew that it was going to seek new representation in these merged reexamination proceedings. The Petition does not indicate that any steps were taken to ensure compliance with approaching deadlines. This fact weighs against granting the Petition.

On November 29, about 40 days after the Decision, the petitioner states that the Appellant chose new representation. (Petition at 2). No reason for this period of delay is provided. This fact likewise weighs against granting the Petition.

The petitioner further states that the issues and prosecution history associated with the Decision are extensive. In support of this statement, the Appellant lists the Decision as being 27 pages long, the Examiner's Answer as being 231 pages long, and the Appeal Brief as being 90 pages long. (Petition at 2). However, in a request for rehearing a requestor must "state

with particularity the points believed to have been misapprehended or overlooked by the Board." 37 C.F.R. § 41.52(a)(1). In other words, the page lengths of the Briefing and Answer are not significantly relevant. On the other hand, the Board decision is concise at 27 pages and the issues, while complex, are not extraordinarily so. This fact likewise weighs against granting the Petition.

The petitioner further states that the patent attorney assigned to the case "is scheduled to spend 9 days out of the country in December" (Petition at 2.) However, the Petition does not state that no one else at the representative's offices is available to work on the case. Nor does the Petition state the gravity of the reason the patent attorney is out of the country, or whether the trip is optional and could be rescheduled. This fact weighs against granting the Petition.

The petitioner further states that the underlying patent, 5,734,961 is directed to complex telecommunications methods and systems, and requires extensive technical analysis and comparison against similarly complex applied art. (Petition at 2.) The posture of this case at this time is that the issues are developed, the analysis has been performed, and a decision has been rendered. Any issues to be raised in the context of a rehearing request are circumscribed by that decision and analysis, and we presume the Appellant's representative to be technologically capable. As a consequence, this fact likewise weighs against granting the Petition.

The Appellant's representative states that he "believes no fee is due with this petition." (Petition at 3). The Appellant's representative is directed to 37 C.F.R. § 41.52(b) which, with respect to extensions of time

for filing a request for rehearing in an ex parte reexamination proceeding appeal, states: "See . . . § 1.550(c) of this title for extensions of time to reply for ex parte reexamination proceedings." 37 C.F.R. § 1.550(c) in turn provides that "any action by a patent owner in an ex parte reexamination proceeding will be extended only for sufficient cause" and further that "[a]ny request for such extension must be accompanied by the petition fee set forth in § 1.17(g)." 37 C.F.R. § 1.17(g) specifies a $200 fee for a patent owner filing a request for extension of time in an ex parte reexamination proceeding.

Thus the appropriate fee of $200 shall be debited to the Appellant's representative's account.

DECISION

For the foregoing reasons, and in the absence of a showing of sufficient cause, the petition is hereby DENIED.

DENIED

James T. Moore
Acting Chief Administrative Patent Judge

Appeal 2010-007531
Reexamination Control 90/007,839; 90/007,936; 90/007,942; 90/007,957 and 90/009,261

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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40401 7590 12/22/2010

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EXAMINER	
FOSTER, ROLAND G	
ART UNIT	PAPER NUMBER
3992	

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12/22/2010	PAPER

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte ANTOR MEDIA CORPORATION

Appeal 2010-007531
Ex parte Reexamination Control 90/007,839; 90/007,936; 90/007,942; 90/007,957; 90/009,261
Patent 5,734,961
Technology Center 3900

DECISION ON PETITION

This is a decision on Patent Owner's "Request for Reconsideration of Decision Under 37 CFR 1.550(c) for Extension of Time to Request Rehearing of Board Decision," filed December 16, 2010 ("Request for Reconsideration"). In the Request for Reconsideration, Patent Owner seeks to have the Decision on Petition entered December 13, 2010 reversed and an extension of two months to file a request for rehearing of the Board Decision on Appeal of October 21, 2010.

FINDINGS

1. On December 13, 2010, the Acting Chief Administrative Patent Judge issued a Decision on Petition denying Patent Owner's "Petition Under 37 CFR 1.550(c) for Extension of Time to Request Rehearing of Board Decision," filed December 6, 2010.

2. In the present Request for Reconsideration, Patent Owner argues that, following the Decision on Appeal, it experienced difficulty in obtaining new representation and that time will be required for a new representative to become familiar with the issues relevant to patentability. Request for Reconsideration, pp. 3-4.

3. Although not discussed in either the initial Petition or the Request for Reconsideration, a review of the record in these merged reexamination proceedings reveals that Abraham Hershkovitz of Hershkovitz & Associates, LLC, Patent Owner's current representative, was among the prior representation appointed by Patent Owner in a Revocation of Powers of Attorney With New Powers of Attorney, filed November 5, 2007.

4. Although not discussed in either the initial Petition or the Request for Reconsideration, a review of the record in these merged reexamination proceedings further reveals Mr. Hershkovitz personally participated in interviews with USPTO personnel and representatives of Patent Owner during prosecution of the merged reexamination proceedings. See Ex Parte Reexamination Interview Summaries of January 29, 2008, September 9, 2008 and February 9, 2009.

ANALYSIS

As indicated by the forgoing, the record in these merged reexamination proceedings establishes that Mr. Hershkovitz previously participated in these proceedings as a representative for Patent Owner. While Mr. Hershkovitz was associated with a different firm at the time of his

initial representation of Patent Owner, i.e., Fulbright & Jaworski L.L.P., Mr. Hershkovitz is not "new" to the proceedings at this juncture.

In view of the foregoing, the representations made in Patent Owner's Request for Reconsideration concerning Mr. Hershkovtiz's status as Patent Owner's newly appointed representative are inconsistent with the underlying facts.

DECISION

For the forgoing reason, the Request for Reconsideration is DENIED.

James T. Moore
Acting Chief Administrative Patent Judge

Ex parte Reexamination Control 90/007,839; 90/007,936; 90/007,942; 90/007,957; 90/009,261
Patent 5,734,961

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(For Patent Owner)

MAILED

MAY 12 2011

CENTRAL REEXAMINATION UNIT

MANUEL F. DE LA CERRA
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(For Requester)

In re Huston et al.
Reexamination Proceeding
Control No.: 90/009,263
Filed: August 25, 2008
For: U.S. Patent No.: 5,364,093

: **DECISION ON PETITION**
: **UNDER 37 CFR 1.181**

This is a decision on a petition filed by the patent owner on April 18, 2011. The petition is entitled "PETITION TO CORRECT STATUS OF CLAIMS OR ALTERNATIVELY TO ENTER AMENDMENT PRESENTED WITH APPEAL, OR ALTERNATIVELY FOR REMAND TO ENTER AMENDMENT" [hereinafter "the petition"], and is a request to the Director to exercise his/her discretion pursuant to 37 CFR 1.181 and enter the amendment filed on June 30, 2010.

The petition is before the Director of Technology Center 1600, who also oversees the Central Reexamination Unit, for decision.

The petition under 37 CFR 1.181 to invoke the supervisory authority of the Director dated April 18, 2011 is denied with respect to entry of the amendment filed on June 30, 2010.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 5,364,093 (hereinafter, the '093 patent) issued on November 15, 1994.

2. A request for *ex parte* reexamination for claims 1 and 8-18 of the '093 patent, assigned control No. 90/009,263 (hereinafter, the '263 proceeding), was filed by a third party requester on August 25, 2008.

3. *Ex parte* reexamination was ordered for claims 1 and 8-18 of the '093 patent in the '263 proceeding on November 21, 2008.

4. On January 21, 2009, the patent owner filed a statement under 37 CFR 1.530, which included declaration evidence to remove one reference as prior art. The response did not include any amendments to the claim. The third party requester filed comments on March 10, 2009.

5. On November 3, 2009, a non-final Office action, which rejected claims 1, 8-15, and 17-18 based upon a Brochure entitled TRIMBLE NAVIGATION in view of U.S. Patent 5,095,430 to Bonito et al. (Bonito) or MAGELLAN in view of Bonito and claim 16 based upon the above-mention combinations in further view of Longaker, was mailed in the '263 reexamination proceeding.

6. On January 4, 2010, the patent owner filed a response, which included arguments and declarations under 37 CFR 1.132. The arguments and the declaration evidence pertain to whether it would have been obvious to use existing GPS systems in a golf-course application because existing GPS systems had a large measurement error and wouldn't be able to measure the distance between the ball and the cup in a golf application. No amendments were made to the claims.

7. On January 14, 2010, the Office issued a Final rejection Office action, which addressed the patent owner's response of January 4, 2010. The examiner explained how the arguments and evidence was not commensurate with the claims under the broadest reasonable interpretation standard. The Office action maintained the same rejections as in the November 3, 2009 Office action.

8. On March 3, 2010, a personal interview was held. Claim interpretation regarding the approximate distance was discussed.

9. On March 5, 2010, the patent owner filed a first after-final response, which included arguments and further evidentiary declarations under 37 CFR 1.132.

10. On March 19, 2010, the Office mailed an advisory action which stated that the request for reconsideration and the declarations were considered but do not overcome the rejection because they are not commensurate with the scope of the claims. The advisory action extended the time for response to 4 months from the mailing date of the final rejection.

11. On May 13, 2010, the patent owner filed a second after-final response, which included proposed amendment to claims 1 and 15 for the first time. The proposed amendment, however, did not include the markings required by 37 CFR 1.530.

12. On May 14, 2010, the patent owner filed a notice of appeal.

13. On May 24, 2010, the Office mailed a second advisory action which stated the proposed amendment of May 13, 2010 is not entered because it did not included the required markings under 37 CFR 1.530. The advisory action specifically informed the patent owner that additions to the claims must be underlined and deletions must be enclosed in brackets.

14. On June 30, 2010, the patent owner filed a third after-final response, which included more extensive proposed amendments to claims 1, 8, 11, 12, and 15. The proposed amendment was again not compliant with the requirements of 37 CFR 1.530 because the subject matter proposed to be deleted was struck-through or enclosed in double brackets and not enclosed in single brackets as required by 37 CFR 1.530.

15. On July 14, 2010, the patent owner filed an appeal brief. The claim appendix included the proposed amendments of June 30, 2010 in the same format that is not compliant with 37 CFR 1.530.

16. On July 17, 2010[1], a support staff member of the Central Reexamination Unit (CRU) mailed a "Notice of Defective Paper in Ex Parte Reexamination" because it was apparent on its face that the claims appendix did not include markings in compliance with the requirements of 37 CFR 1.530. The notice set a thirty day or one month response time.

[1] The patent owner advances that the July 17 notice was never mailed to the patent owner. See fact 12 on page 2 of the April 18, 2011 petition. The current IFW record does show a notice dated July 17, 2010.

17. On December 29, 2010, the patent owner submitted a replacement appeal brief. The claim appendix included the June 30, 2010 proposed amendments but in a format that complies with the requirements of 37 CFR 1.530.
18. On February 18, 2011, the Office mailed an examiner's answer. The answer stated that claims appendix in the December 29, 2010 brief is incorrect and supplied a correct copy of the claims in an appendix. This copy of the claims did not include any proposed amendments to the patent claims.

19. On April 18, 2011, the patent owner filed the instant petition under 37 CFR 1.181 to invoke the supervisory authority of the Director and requesting that the amendment of June 30, 2010 be entered. The patent owner also filed another proposed amendment and a reply brief.

DECISION

Although the petition contains statements that the petition seeks an alternative relief of suspension of the rules under 37 CFR 1.183, the petition is being decided solely under 37 CFR 1.181. Likewise, the alternative relief to enter the April 18, 2011 proposed amendment is premature because the examiner must first make his decision regarding entry prior to requesting supervisory review. In other words, the patent owner's combined petition under 37 CFR 1.181 and 1.183, which requests three different reliefs, is deemed improper because it combines multiple distinct petitions, which is not compliant with 37 CFR 1.4. In summary, this decision solely addresses the issues raised under 37 CFR 1.181, e.g., whether the examiner followed the laws and procedures in not entering the June 30, 2010 proposed amendment.

The patent owner (petitioner) states that the examiner erred in the examiner's answer in deciding not to enter the proposed amendment of June 30, 2010 because the patent owner reasonably believed the amendment was entered. See page 1 of the petition. The petitioner explains how the amendment of June 30, 2010 is commensurate with arguments presented for the claims in their responses to the Office actions and were made in response to the examiner's claim interpretation that the claims were not limited to "during play." See pages 3-4 of the petition. Specifically, the petitioner also states that the amendment incorporates the subject matter of dependent claim 10 and added the phrase "to the golfer during play." Patent owner argues that the amendments narrow issues for appeal because the amendments either clarify or more closely align the claim language with the arguments and evidence presented by the patent owner. See page 3 of the petition. The petition also states that the amendment may be dispositive of the issues and should be considered by the examiner to save judicial resources. See page 3 of the petition. In addition, the petition states that 37 CFR 41.33(b)(2) permits entry of this amendment because it is rewriting a dependent claim into independent format. Finally, the petition argues

that no burden is placed on the examiner if the amendment is entered because the examiner addressed the issues in the examiner's answer.

In response to patent owner's arguments that the examiner erred in deciding not to enter the proposed amendment of June 30, 2010, the director finds there are not good and sufficient reasons to enter the proposed amendment. First, 35 U.S.C. 305 requires that all *ex parte* reexamination proceedings to be acted upon with "special dispatch." The rules and procedures of the Office were established through notice and comment in order to achieve special dispatch in a reasonable manner. Office rules and procedures encourage examiners to look at the facts involved in a particular proceeding and to weigh the equities before issuing a final rejection and for consideration of after final responses. See MPEP 2272.

Turning to the facts in this proceeding, the Final Office action of January 14, 2010 sets forth the same grounds of rejection based on prior art as set forth in the first Office action. The patent owner chose not to make amendments to the claims in response to the order or the first Office action, which would have been entered as a matter of right. In the petition, patent owner alleges that the examiner erred in deciding not to enter the proposed amendment of June 30, 2010 because the proposed amendment clarifies the claim language in response to the examiner's claim interpretation explained in the advisory action dated March 19, 2010. The record, however, does not support this allegation. The record shows the patent owner was aware of how the examiner was interpreting the preamble of claims 1 and 15 prior to the March 19, 2010 advisory action. See, e.g., the response dated January 4, 2010 and the interview summary dated March 3, 2010. The issue regarding claim interpretation as to whether the claims are limited to "during play" was discussed via the "approximate distance" issues during the prior responses and in the personal interview. As discussed above, the patent owner, however, chose not to make any claim amendments to claims in their January 21, 2009 statement or in their January 4, 2010 response to the first Office action. It was only after the examiner maintained the rejection in the Final Office action and in the advisory action of March 19, 2010, and was not convinced by the responses, that the patent owner proposed claim amendments. Therefore, the record indicates that the patent owner was aware of how the examiner was interpreting the claims prior to the Final Office action, and chose not to make claim amendments in response to the order or first Office action.

Upon review of the entire record, the examiner appropriately applied Office policies and procedures in determining that the amendment of June 30, 2010 should not be entered for the additional reason that the amendment was not submitted in a format that complied with the requirements of 37 CFR 1.530. As stated in the section above, the June 30, 2010 amendment marked deletions by strike-outs and double brackets despite being explicitly informed in the May 24, 2010 advisory action that deletions must be enclosed in brackets, including a citation to 37 CFR 1.530.

In regard to the patent owner's arguments that it was reasonable for the patent owner to assume that the proposed amendment was entered, the record and reexamination policy does not support

such a statement. The record shows that two previous after-final amendments were not entered. The record shows that the May 13, 2010 proposed amendment was not entered because it failed to comply with the requirements of 37 CFR 1.530, and the patent owner was notified of this fact by the advisory action of May 24, 2010. Therefore, the patent owner was explicitly notified that amendments that do not comply with 37 CFR 1.530 will not be entered. The record shows that the June 30, 2010 amendment was not compliant with 37 CFR 1.530 for the same reason, in part, that the May 13, 2010 proposed amendment was not compliant (e.g., marking deletions by strike-outs). Therefore, for this reason alone, it was not reasonable for the patent owner to assume that a noncompliant amendment would be entered. Furthermore, reexamination policy makes it clear that amendments submitted after a final rejection are not entered as a matter of right. See MPEP 2272. In addition, MPEP 1206 clearly states that "[e]xcept for amendments that meet the conditions set forth above, all other amendments submitted after the date of filing a notice of appeal will not be entered except as permitted by 37 CFR 41.39(b)(1), 41.50(a)(2)(i), 41.50(b)(1) and 41.50(c)." As discussed above, the June 30, 2010 proposed amendment was not compliant with 37 CFR 1.530, and accordingly, did not satisfy the requirements for entry under 37 CFR 1.116 or 41.37. Also, the June 30, 2010 proposed amendment was not in response to a new grounds of rejection in an examiner's answer (37 CFR 41.39(b)) or a decision by the Board (37 CFR 41.50). In addition, the June 30, 2010 proposed amendment did more than just rewrite dependent claim 10 in independent format. As discussed by the patent owner, the proposed amendment included additional limitations not previously claimed. See pages 3-4 of the petition. Therefore, the proposed amendment was not permitted by 37 CFR 41.33(b)(2) as advanced by the patent owner on page 4 of the instant petition.

In regard to patent owner's arguments that the proposed amendment of June 30, 2010 should be entered because it narrows issues and aligns the claim language to previously presented arguments and evidence, the record does not support the patent owner's contention that it only simplifies issues for appeal. As discussed above, the Final Office action of January 14, 2010 makes it clear that the examiner did not consider the scope of the claims to be limited to "during play" argued by the patent owner in their January 4, 2010 response. See, e.g., paragraph 10 on pages 6-7 of the Final Office action, dated January 14, 2010. In addition, the reply brief of April 18, 2011 challenges the examiner's statements regarding post-processing (which are discussed in the paragraph below), and requests evidence to support the examiner's statements. Therefore, the record shows that such arguments and responses regarding the "during play" limitations are expanding the issues. Accordingly, it cannot be said that adding such limitations to the independent claims only narrows issues.

Finally, in regard to patent owner's arguments that the proposed amendment is dispositive and would not be a burden on the examiner, the record does not support patent owner's contentions. As discussed above, the examiner has consistently interpreted the claims to have a broader scope than argued by the patent owner. The record does not show that the proposed amendment of June 30, 2010 would resolve the issues as argued by the patent owner. See, e.g., page 10 of the examiner's answer that states that even if the claims are limited to "during play" (which could be through amendment or claim interpretation), the claims would still be obvious because the post-

processing technology that existed at the time of the invention would have reduced the measurement error and would have been within the knowledge of one of ordinary skill in this art. Accordingly, the record clearly shows that the examiner deemed entry of the June 30, 2010 proposed amendment would not result in patentability of the claims. In regard to the lack of burden arguments, this contention is also not supported because the record shows that the June 30, 2010 proposed amendment is not compliant with the requirements of 37 CFR 1.530 and entry would require the examiner do to so via an examiner's amendment. Therefore, for this reason and for the reasons discussed above, entry of the June 30, 2010 proposed amendment would be a burden on the examiner.

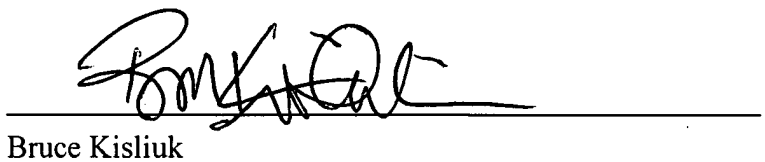
For the reasons set forth above, it is deemed that the examiner followed Office rules and procedures and did not abuse his discretion in deciding to not enter the amendment of June 30, 2010. Therefore, the examiner was following Office procedures by supplying a corrected claim appendix, which contained the original claims of the '093 patent, in the examiner's answer.

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

CONCLUSION

1. The petition under 37 CFR 1.181 for reconsideration of the entry of the amendment dated June 30, 2010 is denied.

2. Telephone inquiries related to this decision should be directed to Andy Kashnikow, Supervisory Patent Examiner, at (571) 272-4361.



Bruce Kisliuk
Assistant Deputy Commissioner for Patent Operations and
Acting Director, Central Reexamination Unit

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : April 14, 2011

TO SPE OF : ART UNIT 3992 - SPE

SUBJECT : Request for Certificate of Correction for Appl. No.: 90/009,282 Patent No.: 6,691,897 C1

Please respond to this request for a certificate of correction within 7 days.

FOR IFW FILES:

Please review the requested changes/corrections as shown in the **COCIN** document(s) in the IFW application image. No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Please complete the response (see below) and forward the completed response to scanning using document code **COCX**.

FOR PAPER FILES:

Please review the requested changes/corrections as shown in the attached certificate of correction. Please complete this form (see below) and forward it with the file to:

Certificates of Correction Branch (CofC)
Randolph Square Building
2800 South Randolph Street
Arlington, VA 22206

Should References Cited be added to title page of patent as requested by applicant? *See COCIN dated 3-16-2011*

Eva James

_____
Certificates of Correction Branch
(571)272-3422

Thank You For Your Assistance

The request for issuing the above-identified correction(s) is hereby:
Note your decision on the appropriate box.

- ☒ **Approved** — **All** changes apply.
- ☐ **Approved in Part** — Specify below which changes **do not** apply.
- ☐ **Denied** — State the reasons for denial below.

Comments: _____

_____

_____

_____ SPE Eric Frahm **Art Unit** 3992

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,287	10/03/2008	7120634	DN-CON	3847

37420 7590 10/06/2010

EXAMINER

SHUMAKER & SIEFFERT, P. A.
1625 RADIO DRIVE
SUITE 300
WOODBURY, MN 55125

ART UNIT	PAPER NUMBER

DATE MAILED: 10/06/2010

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,287	10/03/2008	7120634	DN-CON	3847

37420 7590 10/06/2010

VISTA PRINT USA, INC.
ATTN: PATENT COUNSEL
95 HAYDEN AVENUE
LEXINGTON, MA 02421

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 10/06/2010

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Jessica J Costa : (For Patent Owner)
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DEC 03 2010

CENTRAL REEXAMINATION UNIT

Ken J. Seiffert : (For Requester)
SHUMAKER & SIEFFERT, P.A.
1625 Radio Drive Suite 300
Woodbury MN 55125

In re Patent No. 7,120,634 :
Issue Date: October 10, 2006 :
Control No.: 90/009,314 :
Filed: October 28, 2008 : **DECISION GRANTING**
For: COMPUTERIZED PREPRESS : **PETITION**
: *37 CFR 1.324*

In re Patent No. 7,120,634 :
Issue Date: October 10, 2006 :
Control No.: 90/009,287
Filed: October 03, 2008
For: COMPUTERIZED PREPRESS

This is a decision on the petition filed August 9, 2010 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. 50-2765 per patent Owner authorization in the petition.

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/

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

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CENTRAL REEXAMINATION UNIT

John M White
BERENATO,WHITE & STAVISH
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BETHESDA MD 20817

(For Patent Owner)

James J Foster
WOLF GREENFIELD & SACKS, P.C.
600 ATLANTIC AVENUE
BOSTON, MA 02210-2206

(For Third Party)

In re: Allen *et alia*
Inter Partes Reexamination Proceeding
Control No. 95/000,425
Deposited on: 23 December 2008
For: US Patent No. 7,220,022 B2

DECISION
DISMISSING
PETITION
37 CFR §§ 1.181, 1.182, 1.183
1.137(b) & 1.958(b)

In re: Allen *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/009,292
Deposited on: 02 October 2008
For: US Patent No. 7,220,022 B2

This is a decision on the patent owner's petition dated 16 and 17 June 2010, which are entitled "Petition Under 37 CFR [§] 1.181 or, in the Alternative Under 37 CFR [§] 1.182 or, in the Alternative Under 37 CFR [§] 1.183 for Relief in Inter-Partes Reexam Regarding Notice of Intent to Issue Reexamination Certificate" and "Request for Reconsideration for Withdrawal of Notice of Intent to Issue Reexamination Certificate or, in the Alternative, Petition for Revival Under 37 CFR §§ 1.137(b) & 1.958(b)" requesting that the Office withdraw the Notice of Intent to Issue Reexamination Certificate.

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

The petition is dismissed for the reasons set forth below.

REVIEW OF RELEVANT FACTS

- U.S. Patent No. 7,220,022 B2 issued on 22 May 2007
- A request for *ex parte* reexamination of US Patent no. 7,220,022 B2 was filed by a third party requester on 02 October 2008 and assigned control number 90/009,292.
- Ex parte proceeding control no. 90/009,292 was ordered 30 October 2008.
- A request for *inter partes* reexamination was filed concerning the '2002 patent and assigned control no. 95/000,425 on 23 December 2008.
- *Inter partes* reexamination was ordered in 95/000,425 on 17 February 2009.
- *Sua Sponte* merger of proceedings 95/000,425 & 90/009,292 was mailed on 24 July 2009
- On 04 September 2009 a non-Final Office action was mailed.
- The patent owner filed a response with claim amendments on 04 December 2009.
- A Notice of Defective Paper was mailed on 17 December 2009 which instructs the patent owner that improper correction would result in termination of the proceeding according to 37 CFR § 1.957.
- On 09 February 2010 the third party requester responded to the patent owner's submission.
- The examiner mailed a Notice of Intent to Issue Reexamination Certificate since the patent owner's response remained non compliant.
- On 16 and 17 July 2010 the instant petitions were filed.

CITATION OF RELEVENT AUTHORITY

37 CFR § 1.4(c) Nature of Correspondence states:

> Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects.

37 CFR § 1.181(a) Petition to the Director.

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

37 CFR § 1.182 Questions not specifically provided for.

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

37 CFR § 1.183 Suspension of rules.

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

37 CFR § 1.137(b) Revival of abandoned application, terminated or limited reexamination prosecution, or lapsed patent.

> (b) Unintentional . If the delay in reply by applicant or patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive an abandoned application, a reexamination prosecution terminated under §§ 1.550(d) or 1.957(b) or limited under § 1.957(c), or a lapsed patent. A grantable petition pursuant to this paragraph must be accompanied by:
> (1) The reply required to the outstanding Office action or notice, unless previously filed;
> (2) The petition fee as set forth in § 1.17(m);

(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional; and
(4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

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

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

DECISION

The petition raises multiple issues which are distinct inquiries which may be addressed by different branches of the Office, as such, this is an improper paper not in compliance with 37 CFR § 1.4(c). In view of the fact that the petition improperly combines multiple, distinct subjects of inquiry in a single paper, the petition is dismissed under 37 CFR § 1.4(c). For example, petitions filed under 37 CFR 1.181 are handled by the Central Reexamination Unit whereas, petitions filed under 37 CFR §§ 1.182, 1.183 & 1.137(b), 1.958(b)are handled by the Office of Patent Legal Administration.

CONCLUSION

1. The above named petitions dated 16 and 17 July 2010 is hereby dismissed.

2. Telephone inquiries related to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner, at (571) 272-1611 or in his absence to the undersigned at (571) 272-3838.

Gregory A. Morse
Director, Central Reexamination Unit

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James J. Foster (For Requesters) FEB 16 2011
Wolf Greenfield & Sacks, P.C.
600 Atlantic Avenue
Boston, MA 02210-2206

In re Mark R. Allen et al.
Ex Parte Reexamination Proceeding
Control No. 90/009,292
Filed: October 2, 2008
For: U.S. Patent No. 7,220,022

In re Mark R. Allen et al.
Inter Partes Reexamination Proceeding
Control No. 95/000,425
Filed: December 23, 2008
For: U.S. Patent No. 7,220,022

DECISION GRANTING PETITION UNDER 37 CFR 1.137(b) AND VACATING CERTIFICATE

This is a decision on the October 8, 2010 patent owner petition titled "Re-Petition Under 37 CFR 1.182, 1.183 and Petition For Revival Under 1.137(b) and 1.958(b) For Relief In Inter-Partes Reexam Regarding Issuance Of Reexamination Certificate 7,220,022 C1." The October 8, 2010 patent owner petition is being treated as a petition under 37 CFR 1.137(b) to accept an unintentionally delayed response to an Office action and revive the present terminated merged reexamination proceeding ("the October 8, 2010 patent owner petition to revive").

The October 8, 2010 patent owner petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The October 8, 2010 patent owner petition is **granted** as a petition under 37 CFR 1.137(b) to accept an unintentionally delayed response to an Office action.

Reexamination Certificate No. C1 7,220,022 issued September 7, 2010, for the present merged proceeding, and the June 4, 2010 Notice of Intent to Issue *Inter Partes* Reexamination Certificate (NIRC) issued for the present merged proceeding, are hereby **vacated**.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

35 U.S.C. 41(a)(7) provides, in pertinent part:

> REVIVAL FEES. — On filing each petition ... for an unintentionally delayed response by the patent owner in any reexamination proceeding ...

35 U.S.C. 133 provides:

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

35 U.S.C. 314(a) provides, in pertinent part:

> IN GENERAL. — Except as otherwise provided in this section, reexamination shall be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title.

37 CFR 1.4(c) provides:

> Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects.

37 CFR 1.137 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.*
(1) ***
(2) ***
(3) The provisions of paragraph (d)(1) of this section do not apply to ... reexamination proceedings.

37 CFR 1.943(b) provides:

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

37 CFR 1.945(a) provides, 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

Improper Petition Under 37 CFR 1.4(c)

The October 8, 2010 patent owner petition paper titled "Re-Petition Under 37 CFR 1.182, 1.183 and Petition For Revival Under 1.137(b) and 1.958(b) For Relief In Inter-Partes Reexam Regarding Issuance Of Reexamination Certificate 7,220,022 C1" requests multiple forms of relief. When more than one form of relief is requested in a single petition, such petition is improper under 37 CFR 1.4(c).

However, in the interest of both equity and special dispatch, 37 CFR 1.4(c) is being waived in this instance to the extent that the October 8, 2010 patent owner petition paper is being treated as a petition under 37 CFR 1.137(b) to accept an unintentionally delayed response to an Office action and revive the present terminated merged reexamination proceeding. As such, the petition is grantable for the reasons set forth below.

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 merged reexamination proceeding prosecution was terminated under 37 CFR 1.957(b) due to patent owner's failure to timely submit a compliant response to the December 17, 2009 Notice Re Defective Paper In Inter Partes Reexamination.[1] MPEP 2666.60 states that the patent owner will be given a time period of one month or thirty days, whichever is longer, from the mailing date of the notice of defective paper or the time remaining in the response period set in the last Office action, to respond to the notice. A response to the December 17, 2009 Notice was not

[1] *See*: MPEP 2666.60.

filed until October 8, 2010, which was untimely.[2] However, for the purpose of evaluating whether the October 8, 2010 patent owner petition to revive is a grantable petition, patent owner's submission of the October 8, 2010 Corrected Response To Notice Re Defective Paper In Inter Partes Reexamination satisfies item (1).[3]

The 37 CFR 1.137(b)(2) petition fee of $1,620.00 was charged to patent owner on November 26, 2010, thereby satisfying item (2).

A proper statement under 37 CFR 1.137(b)(3) is presented at page 8 of the October 8, 2010 patent owner petition to revive, which satisfies item (3).

Accordingly, the October 8, 2010 patent owner petition to revive is **granted**.

In this instance, Reexamination Certificate No. C1 7,220,022 issued for the present merged proceeding on September 7, 2010. Based on the granting of the petition to revive, both the Notice of Intent to Issue *Inter Partes* Reexamination Certificate (NIRC) issued on June 4, 2010, and the reexamination certificate are hereby **vacated**.

In due course, the following *erratum* will be published in the *Official Gazette*:

> All reference to Reexamination Certificate No. C1 7,220,022 to Mark R. Allen of Encinitas, CA (US) et al. for JACKETED LED ASSEMBLIES AND LIGHT STRINGS CONTAINING SAME, appearing in the *Official Gazette* of September 7, 2010, should be deleted, since the reexamination certificate has been vacated.

CONCLUSION

1. 37 CFR 1.4(c) is being *sua sponte* waived in this instance to the extent that the October 8, 2010 patent owner petition paper is being treated as a petition under 37 CFR 1.137(b) to accept an unintentionally delayed response to an Office action

2. The October 8, 2010 patent owner petition under 37 CFR 1.137(b) is **granted**.

3. The termination of prosecution noted in the June 4, 2010 NIRC, and the NIRC itself, are **vacated**.

---

[2] Patent owner's October 8, 2010 Corrected Response To Notice Re Defective Paper In Inter Partes Reexamination contains 32 pages of arguments (excluding amendments) and, when combined with the 17-page Kuppler affidavit, meets the 37 CFR 1.943 50-page limit for response.

[3] This decision is not directed to the persuasiveness and propriety of the arguments presented in the October 8, 2010 response as to each of the rejections set forth in the September 4, 2009 Office action; such is the examiner's province.

4. The *Inter Partes* Reexamination Certificate issued September 7, 2010, is **vacated**.

5. The Office of Patent Publications will take action with respect to the 7,220,022 patent consistent with this decision.

5. Patent owner's October 8, 2010 Corrected Response To Notice Re Defective Paper In Inter Partes Reexamination is hereby entered in the record, thus triggering a comment right for the *inter partes* third party requester under 37 CFR 1.947. Accordingly, the *inter partes* third party requester may file comments to patent owner's response under 37 CFR 1.947 within **30 days** of the mailing date of this decision.

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

/Kenneth M. Schor/

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

02/15/2011

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,293	10/03/2008	6242830	10695.005.00	4935

38834 7590 08/31/2010

WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP
1250 CONNECTICUT AVENUE, NW
SUITE 700
WASHINGTON, DC 20036

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 08/31/2010

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
MCKENNA LONG & ALDRIDGE LLP
1900 K STREET, NW
WASHINGTON, DC 20006

Date:

MAILED

AUG 3 1 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009293
PATENT NO. : 6242830
ART UNIT : 3992

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

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,401	02/06/2009	6,242,830	10695.005.00	1820

38834 7590 08/31/2010

WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP
1250 CONNECTICUT AVENUE, NW
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WASHINGTON, DC 20036

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 08/31/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
SONG K. JUNG
McKENNA LONG & ALDRIDGE
1900 K STREET, N.W.
WASHINGTON, DC 20006

Date:
MAILED

AUG 3 1 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009401
PATENT NO. : 6242830
ART UNIT : 3992

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WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP
1250 CONNECTICUT AVENUE, NW
SUITE 700
WASHINGTON, DC 20036

(For Patent Owner)

MAILED

AUG 3 1 2010

MCKENNA LONG & ALDRIDGE LLP
1900 K STREET, NW
WASHINGTON, DC 20006

(For Requester)

CENTRAL REEXAMINATION UNIT

In re Katagiri
US Patent Number 6242830
Control No.: 90/009,293
Filed: October 03, 2008
For: **MOTOR**

In re Katagiri
US Patent Number 6242830
Control No.: 90/009,401
Filed: February 6, 2009
For: **MOTOR**

DECISION ON PETITION UNDER 37 CFR 1.59

This is a decision on the petition under 37 CFR 1.59(b), filed October 7, 2009, to expunge information from the above identified proceeding.

The petition is granted.

Petitioner requests that a document entitled:

Defendants LG Innotek Co. Ltd., and LG Innotek Huizhou, Inc.'s Invalidity Contentions Pursuant to P.R. 3-3 dated September 29, 2008 with Exhibits 1 and 2

Defendants LG Innotek USA, Inc.'s Invalidity Contentions Pursuant to P.R. 3-3 dated February 27, 2009 with Exhibits 1 and 2

Defendants LG Innotek Co. and LG Innotek Huizhou, Inc.'s First Supplemented Invalidity Contentions Pursuant to P.R. 3-3 dated March 27, 2009 with Exhibits 1 and 2

Defendants LG Innotek Co.'s, LG Innotek Huizhou, Inc.'s and LO Innotek U.S.A., Inc.'s Supplemented Invalidity Contentions Pursuant to P.R. 3-3

, filed October 7, 2009, be expunged from the record. Petitioner states that either (A) that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in 37 CFR 1.17(g) has been paid.

The information in question has been determined by the undersigned to not be material to the examination of the instant proceeding.

Patent Owner is required to retain the expunged material(s) for the life of the patent.

The expunged material has been removed from the official file. Rather than mailing the papers back to petitioner, the papers will be destroyed.

Eric Keasel

ERIC S. KEASEL
CRU SPE-AU 3992

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United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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SUGHRUE MION ZINN MACPEAK & SEAS
2100 PENNSYLVANIA AVENUE NW
WASHINGTON DC 20037-3202

(For Patent Owner)

WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP
1250 CONNECTICUT AVENUE, NW
SUITE 700
WASHINGTON, DC 20036

(Courtesy Copy)

MAILED

AUG 0 3 2010

CENTRAL REEXAMINATION UNIT

MCKENNA LONG & ALDRIDGE LLP
1900 K STREET, NW
WASHINGTON, DC 20006

(For Requester)

In re Matsushima
US Patent Number 6005311
Control No.: 90/009,294
Filed: October 03, 2008
For: **SPINDLE MOTOR AND TURN TABLE ASSEMBLY HAVING STRUCTURE FOR CANCELLING UNBALANCED CENTRIFUGAL FORCE**

DECISION ON PETITION UNDER 37 CFR 1.59

This is a decision on the petition under 37 CFR 1.59(b), filed October 7, 2009, to expunge information from the above identified proceeding.

The petition is granted.

Petitioner requests that a document entitled:

Defendants LG Innotek Co. Ltd., and LG Innotek Huizhou, Inc.'s Invalidity Contentions Pursuant to P.R. 3-3 dated September 29, 2008 with Exhibits 1 and 2

Defendants LG Innotek USA, Inc.'s Invalidity Contentions Pursuant to P.R. 3-3 dated February 27, 2009 with Exhibits 1 and 2

Defendants LG Innotek Co. and LG Innotek Huizhou, Inc.'s First Supplemented Invalidity Contentions Pursuant to P.R. 3-3 dated March 27, 2009 with Exhibits 1 and 2

Defendants LG Innotek Co.'s, LG Innotek Huizhou, Inc.'s and LO Innotek U.S.A., Inc.'s Supplemented Invalidity Contentions Pursuant to P.R. 3-3

, filed October 7, 2009, be expunged from the record. Petitioner states that either (A) that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in 37 CFR 1.17(g) has been paid.

The information in question has been determined by the undersigned to not be material to the examination of the instant proceeding.

Patent Owner is required to retain the expunged material(s) for the life of the patent.

The expunged material has been removed from the official file. Rather than mailing the papers back to petitioner, the papers will be destroyed.

ERIC S. KEASEL
CRU SPE-AU 3992

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,306	10/20/2008	6415831	0275A-400028	9326

7590 09/07/2010

EXAMINER	
ART UNIT	PAPER NUMBER

Adan Ayala, Esq.
THE BLACK & DECKER CORP.
701 East Joppa Road
Towson, MD 21286

DATE MAILED: 09/07/2010

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

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Adan Ayala, Esq.
The Black & Decker Corp.
701 East Joppa Road
Towson, MD 21286

MAILED

SEP 07 2010

CENTRAL REEXAMINATION UNIT

In re Adan Ayala et al. :
Ex Parte Reexamination Proceeding : **DECISION**
Control No. 90/009,306 : **GRANTING**
Filed: October 20, 2008 : **RENEWED PETITION UNDER**
For: U.S. Patent No. 6,415,831 : **37 CFR 1.137(b)**

This is a decision on the June 23, 2010 patent owner renewed petition under 37 CFR 1.137(b) to accept an unintentionally delayed response to final Office action and revive the present terminated reexamination[1] ("the June 23, 2010 patent owner renewed petition to revive").

The June 23, 2010 patent owner renewed petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The June 23, 2010 patent owner renewed petition to revive is **granted**.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

35 U.S.C. 41(a)(7) provides, in pertinent part:

> REVIVAL FEES. — On filing each petition ... for an unintentionally delayed response by the patent owner in any reexamination proceeding ...

35 U.S.C. 133 provides:

> Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Director in such action, the

---

[1] Although a Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) has not been mailed to set forth the termination of the prosecution in this instance, the prosecution was "terminated" within the meaning of 37 CFR 1.550(d) for failure of the patent owner to timely file a proper response, within the meaning of 37 CFR 1.113, to the final Office action of January 29, 2010.

application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Director that such delay was unavoidable.

35 U.S.C. 305 provides, in pertinent part:

After the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title.

37 CFR 1.113 provides, in pertinent part:

(a) On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon ... for *ex parte* reexaminations filed under § 1.510, patent owner's reply is limited to appeal in the case of rejection of any claim (§ 41.31 of this title), or to amendment as specified in § 1.114 or § 1.116.

*

*

(c) Reply to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the reply to a final rejection or action must comply with any requirements or objections as to form.

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 1.550 provides, in pertinent part:

(b) The patent owner in an *ex parte* reexamination proceeding will be given at least thirty days to respond to any Office action. In response to any rejection, such response

may include further statements and/or proposed amendments or new claims to place the patent in a condition where all claims, if amended as proposed, would be patentable.

*

(d) If the patent owner fails to file a timely and appropriate response to any Office action or any written statement of an interview required under § 1.560(b), the prosecution in the *ex parte* reexamination proceeding will be a terminated prosecution, and the Director will proceed to issue and publish a certificate concluding the reexamination proceeding under § 1.570 in accordance with the last action of the Office.

(e) If a response by the patent owner is not timely filed in the Office,

*

*

(2) The response may nevertheless be accepted if the delay was unintentional; a petition to accept an unintentionally delayed response must be filed in compliance with § 1.137(b).

MPEP 711.03(c)(II)(A)(2)(b) provides, in pertinent part:

A reply under 37 CFR 1.113 to a final action must include ... cancellation of, or appeal from the rejection of, each claim so rejected. Accordingly, ... the reply required for consideration of a petition to revive must be:

(A) a Notice of Appeal and appeal fee; [or]

(B) an amendment under 37 CFR 1.116 that cancels all the rejected claims or otherwise prima facie places the application in condition for allowance;

*

*

When a notice of appeal is the reply filed pursuant to 37 CFR 1.137(a)(1) or 1.137(b)(1), the time period under 37 CFR 41.37 for filing the appeal brief will be set by the Director of the USPTO in the decision granting the petition.

MPEP 2268 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, all *ex parte* reexamination proceedings by section 4605 of the American Inventors Protection Act of 1999. The unintentional delay provisions of 35 U.S.C. 41(a)(7) became effective in reexamination proceedings on November 29, 2000. Accordingly, the Office will consider, in appropriate circumstances, a petition showing unintentional delay under 37 CFR 1.137(b) where untimely papers are filed 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 set forth in 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 Renewed Petition Under 37 CFR 1.137(b) is Dismissed

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.

The present proceeding is a reexamination proceeding; thus, the June 23, 2010 renewed petition does not require a terminal disclaimer.[2]

Regarding item (1), the instant reexamination proceeding was terminated due to the failure to timely submit a response to the January 29, 2010 final Office action pursuant to 37 CFR 1.550(b). In a reexamination proceeding terminated for failure to reply to a final Office action, the reply required for consideration of a petition to revive must be (i) an amendment under 37 CFR 1.116 that cancels all the rejected claims or otherwise *prima facie* places the proceeding in condition for issuance of a reexamination certificate by making all pending claims patentable or (ii) a Notice of Appeal and appeal fee.[3]

Patent owner submitted a paper titled "Response" on June 23, 2010. The primary examiner for the instant reexamination proceeding has confirmed that the June 23, 2010 Response would *prima facie* place the proceeding in condition for issuance of a reexamination certificate by making all pending claims patentable (once the present proceeding is restored to pendency). Therefore, item (1) is deemed to have been satisfied.

The fee of $1,620.00 and the proper statement under 37 CFR 1.137(b)(3) were submitted as part of the first patent owner petition to revive filed on April 21, 2010, thereby satisfying items (2) and (3), respectively.

---

[2] *See*: 37 CFR 1.137(d)(3).
[3] *See*: MPEP 2268(IV) and MPEP 711.03(c)(II)(A)(2)(b).

Accordingly, the June 23, 2010 patent owner renewed petition to revive is **granted**.

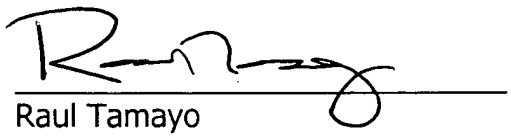
CONCLUSION

1. The June 23, 2010 patent owner renewed petition under 37 CFR 1.137(b) is **granted**.

2. Jurisdiction over this reexamination proceeding is being returned to the Central Reexamination Unit (CRU), Art Unit 3993, for treatment in due course of the June 23, 2010 Response.

3. Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Matthew Graham, of CRU Art Unit 3993, at (571) 272-7116.

4. Any inquiry concerning this decision should be directed to the undersigned at (571) 272-7728.



Raul Tamayo
Legal Advisor
Office of Patent Legal Administration

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UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,307	10/22/2008	5417691	00167-0615RX1	9956

60597 7590 01/06/2011

HANCOCK HUGHEY LLP
P.O. BOX 6553
PORTLAND, OR 97228

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 01/06/2011

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
STEPHEN A. SOFFEN
DICKSTEIN SHAPIRO LLP
1825 EYE STREET,NW
WASHINGTON, DC 20006-5403

Date:
MAILED
JAN 06 2011
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009307
PATENT NO. : 5417691
ART UNIT : 3993

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

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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Hancock Hughey LLP
P.O. Box 6553
Portland, OR 97228

(For Patent Owner)

Stephen A. Soffen
Dickstein Shapiro LLP
1825 Eye Street, NW
Washington, DC 20006-5403

(For Third Party Requester)

MAILED

JAN 0 3 2011

CENTRAL REEXAMINATION UNIT

In re John O. Hayhurst
Ex Parte Reexamination Proceeding
Control No. 90/009,307
Filed: October 22, 2008
For: U.S. Patent No. 5,417,691

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

This is a decision on the November 15, 2010 patent owner petition under 37 CFR 1.137(b) to accept an unintentionally delayed response to final Office action and revive the present terminated[1] reexamination ("the November 15, 2010 patent owner petition to revive").

The November 15, 2010 patent owner petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The November 15, 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 *Ex Parte* 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 1.550(d) for failure of the patent owner to timely file a proper response, within the meaning of 37 CFR 1.113, to the final Office action of June 10, 2010.

35 U.S.C. 133 provides:

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

35 U.S.C. 305 provides, in pertinent part:

> After the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title.

37 CFR 1.113 provides, in pertinent part:

> (a) On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon ... for *ex parte* reexaminations filed under § 1.510, patent owner's reply is limited to appeal in the case of rejection of any claim (§ 41.31 of this title), or to amendment as specified in § 1.114 or § 1.116.
>
> *
>
> *
>
> (c) Reply to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the reply to a final rejection or action must comply with any requirements or objections as to form.

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 1.550 provides, in pertinent part:

> (d) If the patent owner fails to file a timely and appropriate response to any Office action or any written statement of an interview required under § 1.560(b), the prosecution in the *ex parte* reexamination proceeding will be a terminated prosecution, and the Director will proceed to issue and publish a certificate concluding the reexamination proceeding under § 1.570 in accordance with the last action of the Office.
>
> (e) If a response by the patent owner is not timely filed in the Office,
>
> *
>
> *
>
> (2) The response may nevertheless be accepted if the delay was unintentional; a petition to accept an unintentionally delayed response must be filed in compliance with § 1.137(b).

MPEP 711.03(c)(II)(A)(2)(b) provides, in pertinent part:

> A reply under 37 CFR 1.113 to a final action must include ... cancellation of, or appeal from the rejection of, each claim so rejected. Accordingly, ... the reply required for consideration of a petition to revive must be:
>
> (A) a Notice of Appeal and appeal fee; [or]
>
> (B) an amendment under 37 CFR 1.116 that cancels all the rejected claims or otherwise prima facie places the application in condition for allowance;
>
> *
>
> *
>
> When a notice of appeal is the reply filed pursuant to 37 CFR 1.137(a)(1) or 1.137(b)(1), the time period under 37 CFR 41.37 for filing the appeal brief will be set by the Director of the USPTO in the decision granting the petition.

MPEP 2268 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, all *ex parte* reexamination proceedings by section 4605 of the American Inventors Protection Act of 1999. The unintentional delay provisions of 35 U.S.C. 41(a)(7) became effective in reexamination proceedings on November 29, 2000. Accordingly, the Office will consider, in appropriate circumstances, a petition showing unintentional delay under 37 CFR 1.137(b) where untimely papers are filed 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 set forth in 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.

Patent owner submitted a Notice of Appeal and paid the corresponding fee of $540.00 on November 15, 2010, thereby satisfying item (1).[2]

A petition fee of $1,620.00 was submitted as part of the November 15, 2010 patent owner petition to revive, thereby satisfying item (2).

A proper statement under 37 CFR 1.137(b)(3) was submitted on November 15, 2010. Therefore, item (3) is deemed to have been satisfied.

The present proceeding is a reexamination proceeding; thus, the petition does not require a terminal disclaimer.[3]

Accordingly, the November 15, 2010 patent owner petition to revive is **granted**.

CONCLUSION

1. The November 15, 2010 patent owner petition to revive under 37 CFR 1.137(b) is **granted**.

2. Art Unit 3993 of the Central Reexamination Unit will process the November 15, 2010 Notice of Appeal in the 90/009,307 reexamination proceeding.

3. The time period for filing an appeal brief is set to expire **TWO MONTHS** from the mailing date of this decision. See MPEP 711.03(c)(II)(A)(2)(b). The time

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[2] *See*: MPEP 2268(IV) and MPEP 711.03(c)(II)(A)(2)(b).
[3] *See*: 37 CFR 1.137(d)(3).

period is extendable under the provisions of 37 CFR 1.550(c). See 37 CFR 41.37(e).

4. Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, David Reip, of CRU Art Unit 3993, at (571) 272-4702.

5. Any inquiry concerning this decision should be directed to the undersigned at (571) 272-7728.

Raul Tamayo
Legal Advisor
Office of Patent Legal Administration

01/05/11

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,310	11/03/2008	7291182	OHI 1717-096C	3646

8698 7590 05/12/2011

STANDLEY LAW GROUP LLP
6300 Riverside Drive
Dublin, OH 43017

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 05/12/2011

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
Dr. Aldo A. Laghi
c/o Ronald A. Christaldi
101 East Kennedy Blvd., Suite 2800
Tampa, FL 33602

Date: MAILED
MAY 12 2011
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009310
PATENT NO. : 7291182
ART UNIT : 3993

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

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

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P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Eric M. Gayan
Standley Law Group LLP
6300 Riverside Drive
Dublin, Ohio 43017

(For Patent Owner)

MAILED
MAY 12 2011
CENTRAL REEXAMINATION UNIT

Dr. Aldo A. Laghi
c/o Ronald A. Christaldi
Shumaker, Loop & Kendrick LLP
101 East Kennedy Boulevard, Suite 2800
Tampa, FL 33602

(For Third Party Requester)

Ex Parte Reexamination Proceeding
Control No. 90/009,310
Filed: November 3, 2008
For: U.S. Patent No. 7,291,182

: **DECISION DISMISSING REQUEST**
: **TO ORDER SUBMISSION**
: **OF A DOCUMENT AND**
: **RETURNING IMPROPER PAPERS**

This decision addresses the petition filed March 7, 2011 entitled "Petition to the Commissioner under 37 CFR § 1.181". The petition is being treated under 37 CFR § 1.182 as it is a situation not specifically provided for in the regulations.

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

The petition is dismissed for reasons below. Additionally, the petition and accompanying declaration are improper papers and have been stricken from the record and marked 'closed' in the Image File Wrapper (IFW).

DECISION

Patent owner requests that the Commissioner order that a certain document be required and necessary for a fair and proper decision to the appeal. The document, according to patent owner, is confidential and covered by a protective order governing concurrent litigation. In the petition, patent owner makes assertions regarding the conduct of the third party requester.

The U.S. Patent & Trademark Office (the Office) will not accept information that has been designated by a court as confidential or subject to a protective order, or is a third party's confidential information, **absent express permission from the court or third party that the information may be submitted to the Office and may become part of the file open to the**

public.[1] Although provisions are provided for expunging confidential information by petition, as noted in MPEP § 724.04(c), if any portion or all of such submitted information is found to be material to patentability, the petition to expunge will be denied and the information will thereafter become a permanent part of the reexamination file and open to the public. The Office will not accept confidential information that may be later opened to the public without permission from a court or the owner of that information.

Patent owner has provided no evidence that the court or owner of the confidential information has granted permission to open the information to the public. In fact, it appears that the court has denied a request to submit such documents. See the March 29, 2011 paper filed by the third party requester entitled "Notice of Filing Order from Southern District of Ohio" including an Opinion and Order dated March 18, 2011 denying a motion by plaintiff Ohio Willow Wood Company to permit disclosure of documents covered by the protective order for submission to the Patent and Trademark Office.

The petition request is dismissed, as the Commissioner will not order that documents covered by a protective order be filed in this proceeding without permission from the court in which the protective order is applicable.

As to the petition papers themselves, the papers are improper as they include disparaging comments regarding the third party requester, which is improper content for this reexamination proceeding. As noted in MPEP 2209, the reexamination statute, regulations, and published examining procedures do not countenance so-called "litigation tactics" in reexamination proceedings. The parties are expected to conduct themselves accordingly and to adhere to the provisions of 37 CFR 11.18(b) throughout the course of a reexamination proceeding. It is also to be noted that there is no statutory basis for inserting remarks as to conduct of a third party in a reexamination proceeding. The petition and accompanying declaration have been marked 'closed' in the IFW and will not be available to the public as they are stricken from the record.

Telephone inquiries with regard to the substance of the decision should be directed to Caroline D. Dennison, Senior Legal Advisor, at (571) 272-7729.

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

5-10-11
Kenpet8/

[1] The party submitting the information would need to provide either:

a certification that the party filing the information in the reexamination proceeding has, prior to filing the information, informed the court of its intention to submit the information to the Office in a proceeding that will open the information to unlimited public access, if found to be material to patentability, and that the court has approved such submission, or

a copy of the consent by the entity whose information is being submitted waiving the confidentiality and protection of the protective order for the information.

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United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,314	03/23/2009	7120634	1117-0010001	6635

37420 7590 10/06/2010

VISTA PRINT USA, INC.
ATTN: PATENT COUNSEL
95 HAYDEN AVENUE
LEXINGTON, MA 02421

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 10/06/2010

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,314	03/23/2009	7120634	1117-0010001	6635

37420 7590 10/06/2010

EXAMINER	
ART UNIT	PAPER NUMBER

Kent J Seiffert
SHUMAKER & SIEFFERT, P. A.
1625 RADIO DRIVE
SUITE 300
WOODBURY, MN 55125

DATE MAILED: 10/06/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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Jessica J Costa : (For Patent Owner)
VISTA PRINT USA, INC.
ATTN: PATENT COUNSEL
95 HAYDEN AVENUE
LEXINGTON MA -2421

MAILED
OCT 03 2010
CENTRAL REEXAMINATION UNIT

Ken J. Seiffert : (For Requester)
SHUMAKER & SIEFFERT, P.A.
1625 Radio Drive Suite 300
Woodbury MN 55125

In re Patent No. 7,120,634 :
Issue Date: October 10, 2006 :
Control No.: 90/009,314 :
Filed: October 28, 2008 : **DECISION GRANTING**
For: COMPUTERIZED PREPRESS : **PETITION**
: *37 CFR 1.324*

In re Patent No. 7,120,634 :
Issue Date: October 10, 2006 :
Control No.: 90/009,287
Filed: October 03, 2008
For: COMPUTERIZED PREPRESS

This is a decision on the petition filed August 9, 2010 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. 50-2765 per patent Owner authorization in the petition.

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/

Jessica J. Harrison
Supervisory Patent Examiner
Art Unit 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.
90/009,317	10/30/2008	7261947	7007/0101PUS1	8859

112 7590 08/26/2010

Dresch IP Law, PPLC
P.O. Box 650903
Potomac Falls, Virginia 20165

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 08/26/2010

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UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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P.O. Box 1450
Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,317	10/30/2008	7261947	7007/0101PUS1	8859

112 7590 08/26/2010

ARMSTRONG WORLD INDUSTRIES, INC.
LEGAL DEPARTMENT
P. O. BOX 3001
LANCASTER, PA 17604-3001

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 08/26/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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Armstrong World Industries, Inc.
Legal Department
P.O. Box 3001
Lancaster, PA 17604-3001

(For Patent Owner)

Muncy, Geissler, Olds & Lowe, PLLC
P.O. Box 1364
Fairfax, VA 22038-1364

(For Requester)

MAILED

AUG 23 2010

CENTRAL REEXAMINATION UNIT

Ex Parte Reexamination Proceeding
Control No. 90/009,317
Filed: October 30, 2008
For: US Patent No. 7,261,947

DECISION ON
PETITION UNDER
37 C.F.R. 1.181

This is a decision on the petition filed June 18, 2010 under 37 CFR 1.181 to request withdrawal of the finality of the Office action mailed April 23, 2010.

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

The petition is dismissed as moot for the reasons stated herein.

REVIEW OF FACTS

On August 23, 2010, the Office action of April 23, 2010 was re-mailed as a non-final Office action with a 2-month period for response.

CONCLUSION

The Patent Owner's petition to request withdrawal of the finality of the Office action mailed April 23, 2010 is **dismissed as moot**.

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

Gregory Morse,
Director, Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O. Box 1450
Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,329	11/10/2008	6233389	2513.002REX0	2859

29000 7590 12/01/2010

IRELL & MANELLA LLP
1800 AVENUE OF THE STARS
SUITE 900
LOS ANGELES, CA 90067

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 12/01/2010

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
MORRISON & FOERSTER LLP
DAVID L. FEHRMAN
555 WEST FIFTH STREET
LOS ANGELES, CA 90013

Date: MAILED

DEC 0 1 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009329
PATENT NO. : 6233389
ART UNIT : 3992

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

IRELL & MANELLA LLP
1800 AVENUE OF THE STARS
SUITE 900
LOS ANGELES CA 90067

(Patent Owner)

MAILED

DEC 0 1 2010

Morrison & Foerster LLP
555 West Fifth Street
Suite 3500
Los Angeles, CA 90013-1024

(Third Party Requester)

CENTRAL REEXAMINATION UNIT

In re Barton *et al.*
Reexamination Proceeding
Control No.: 90/009,329
Filed: November 10, 2008
For: U.S. Patent No.: 6,233,389

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

This is a decision on the October 25, 2010 patent owner petition under 37 CFR 1.182 to enter, and to have the examiner consider, patent owner's third information disclosure statement (IDS) filed after the termination of the prosecution in this reexamination proceeding.

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

The petition is dismissed for the reasons set forth below.

Thus, the IDS filed October 25, 2010, has not been entered for consideration by the examiner.

FEE

The petition fee of $400 set forth in 37 CFR 1.17(f) for the present petition under 37 CFR 1.182 has been charged to Deposit Account No. 09-0946 in accordance with petitioner's authorization in the October 25, 2010 EFS-web fee transmittal.

BACKGROUND

1. On May 15, 2001, the Office issued U.S. Patent No. 6,233,389 to Barton *et al.* (the '389 patent).

2. On November 10, 2008, a third party requester filed a request for *ex parte* reexamination of the '389 patent. The request was assigned reexamination proceeding control number 90/009,329 (the '9329 proceeding).

3. On January 7, 2009, the Office issued an order granting reexamination for the '9329 reexamination proceeding.

4. Prosecution progressed to the point where, on October 6, 2010, the Office issued a Notice of Intent to Issue a Reexamination Certificate (NIRC) for the '9329 proceeding.

5. On October 8, 2010, patent owner filed an IDS in the '9329 proceeding, unaccompanied by a petition under 37 CFR 1.182, requesting consideration of an IDS submission after issuance of a NIRC.

6. On October 15, 2010, the '9329 proceeding entered the publication cycle and was accordingly assigned a 452 status.

7. Also on October 15, 2010, the Office issued a communication informing patent owner that the October 8, 2010 IDS submission was an untimely, improper post-NIRC submission which was being marked "closed" and "non-public" in the '9329 proceeding's IFW, because the submission was not accompanied by a petition under 37 CFR 1.182.

8. On October 25, 2010, patent owner filed the instant petition, accompanied by a second filing of the IDS, which patent owner requests the Office to consider.

9. The '9329 reexamination proceeding is in the final phase of the publication process for printing the reexamination certificate (*i.e.* it is in the publication cycle).

RELEVANT LAW AND PROCEDURE

35 U.S.C. 305 provides (in part):

... All reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, will be conducted with **special dispatch** within the Office. (Emphasis added.)

MPEP 2256 provides (in part):

.....Once the NIRC has been mailed, the reexamination proceeding must proceed to publication of the Reexamination Certificate as soon as possible. **Thus, when the patent owner provides a submission of patents and printed publications, or other information described in 37 CFR 1.98(a), after the NIRC has been mailed, the submission must be accompanied by (A) a factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier, and (B) an explanation of the relevance of the information submitted with respect to the claimed invention in the reexamination proceeding.** This is provided via a petition under 37 CFR 1.182 (with petition fee) for entry and consideration of the information submitted after NIRC. The requirement in item (B) above is for the purpose of facilitating the Office's compliance with the statutory requirement for "special dispatch," when the requirement in item (A) above is satisfied to provide a basis for interrupting the proceeding after the NIRC. (Emphasis added)

Once the reexamination has entered the Reexamination Certificate publication process, pulling the proceeding from that process provides an even greater measure of delay. 37 CFR 1.313 states for an application (emphasis added):

> "(c) Once the issue fee has been paid, **the application will not be withdrawn from issue upon petition by the applicant for any reason except:**
> (1) Unpatentability of one of more claims, which petition must be accompanied by an unequivocal statement that one or more claims are unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable;"

The publication process for an application occurs after the payment of the issue fee (there is no issue fee in reexamination), and thus 37 CFR 1.313(c) applies during the publication cycle for an application. Based on the statutory requirement for "special dispatch," the requirements for withdrawal of a reexamination proceeding from its publication cycle are at least as burdensome as those set forth in 37 CFR 1.313(b) and (c). **Accordingly, where a submission of patents and printed publications, or other information described in 37 CFR 1.98(a), is made while a proceeding is in its publication cycle, the patent owner must provide an unequivocal statement as to**

why the art submitted makes at least one claim unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable. This is in addition to the above-discussed (A) a factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier. The submission of patents and printed publications must be accompanied by a petition under 37 CFR 1.182 (with petition fee) for withdrawal of the reexamination proceeding from the publication process for entry and consideration of the information submitted by patent owner. A grantable petition must provide the requisite showing discussed in this paragraph. (Emphasis added)

DECISION

There is no issue fee in reexamination, and the present reexamination proceeding has entered the final phase of the publication process (the "printing cycle"). In a reexamination proceeding, there is no withdrawal under 37 CFR 1.313 of the proceeding from the publication process for consideration of an Information Disclosure Statement (IDS), because 37 CFR 1.313(a) applies to applications, and not to reexamination proceedings. Accordingly, in this instance, the petition for withdrawal of the present proceeding from the publication process for consideration of the accompanying IDS papers has been filed under 37 CFR 1.182.

While there is no regulatory provision for withdrawal of a reexamination proceeding from the publication process for consideration of an IDS, the policy for withdrawal from the publication process is explicitly set forth in MPEP 2256 as follows:

> ...Once the NIRC has been mailed, the reexamination proceeding must proceed to publication of the Reexamination Certificate as soon as possible. Thus, when the patent owner provides a submission of patents and printed publications, or other information described in 37 CFR 1.98(a), after the NIRC has been mailed, the submission must be accompanied by **(A) a factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier, and (B) an explanation of the relevance of the information submitted with respect to the claimed invention in the reexamination proceeding.** This is provided via a petition under 37 CFR 1.182 (with petition fee) for entry and consideration of the information submitted after NIRC. The requirement in item (B) above is for the purpose of facilitating the Office's compliance with the statutory requirement for "special dispatch," when the requirement in item (A) above is satisfied to provide a basis for interrupting the proceeding after the NIRC.
>
> ... The **publication process** for an application occurs after the payment of the issue fee (there is no issue fee in reexamination), and thus 37 CFR 1.313(c) applies during the publication cycle for an application. Based on the statutory requirement for "special dispatch," the requirements for withdrawal of a reexamination proceeding from its publication cycle are at least as burdensome as those set forth in 37 CFR 1.313(b) and (c). **Accordingly, where a submission of patents and printed publications, or other information described in 37 CFR 1.98(a), is made while a proceeding is in its publication cycle, the patent owner must provide an unequivocal statement as to why the art submitted makes at least one claim unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable. This is in addition to** the above-discussed (A) a factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier. The submission of patents and printed publications must be accompanied by a petition under 37 CFR 1.182 (with petition fee) for withdrawal of the reexamination proceeding from the publication process for entry and consideration of the information submitted by patent owner. A grantable petition must provide the requisite showing discussed in this paragraph. (Emphasis added)

In the present instance, the fact situation fails to satisfy the grounds for the entry of information after issuance of a NIRC, either before or after the proceeding has entered the publication cycle. The instant petition was filed very late in the reexamination proceeding, and it fails to provide a statement explaining the relevance of the submitted IDS items of information (art citations), with respect to the claim limitations in the present reexamination proceeding. The petition merely states, "The IDS statement was prepared and submitted in order to apprise the Office of

potentially material information submitted . . .." Further, the petition does not explain how the submitted IDS items of information make at least one claim unpatentable, and the petition is not accompanied with an amendment to the claim or claims with an explanation as to how the amendment causes such claim or claims to be patentable.

For *ex parte* reexamination, 35 U.S.C. 305 provides that all *ex parte* reexamination proceedings "will be conducted with special dispatch within the Office." Since it is required that the withdrawal criteria of 37 CFR 1.313(c) be complied with for an application, in which there is no statutory provision for special dispatch, such criteria must certainly be complied with for a reexamination proceeding *where there is a statutory mandate for special dispatch.* This is explicitly set forth in the MPEP, as set forth above.

A review of the record shows that the examiner terminated prosecution on the merits by issuing a NIRC on October 6, 2010, and the proceeding has now entered the final stages of the publication process, *i.e.* the publication cycle, as evidenced by the proceeding's 452 status. The proceeding is clearly not scheduled to come up for further action on the merits. In order to provide the requested relief, the present proceeding would need to be withdrawn from the publication process, thus significantly regressing the processing of the proceeding. This would run contrary to the statutory requirement of 35 U.S.C. 305 that "[a]ll reexamination proceedings under this section...will be conducted with special dispatch within the Office." The statutory mandate of special dispatch is based upon the public interest in providing certainty and finality as to the question of patentability raised by a request for reexamination. In view of the submission of the IDS information after termination of the prosecution in this reexamination proceeding, the failure explain why it could not have been submitted earlier, the failure to identify a question of patentability as to the claims, and the failure to provide the requisite discussion (explanation) of the submitted art citations, the present reexamination proceeding will not be reopened at this late date to consider the proffered IDS papers. Accordingly, the petition is dismissed as to the request for consideration of the IDS papers. The proceeding will not be withdrawn from the publication process.

If, however, the patent owner in fact believes that one or more references submitted raises a substantial question of patentability as to at least one claim of the patent *different* than raised in this proceeding, the patent owner can always file a new request for reexamination for consideration of such reference(s).

The IDS submitted by patent owner will be placed in the file, and will remain of record. However, since prosecution has been terminated for this reexamination proceeding, the IDS will not be considered by the examiner.

In view of the above, the petition is dismissed.

CONCLUSION

1. The petition is dismissed as to the request for consideration of the October 25, 2010 IDS.

2. The IDS papers have not been entered for consideration by the examiner. A copy of the October 25, 2010 IDS submission will, however, be placed in the electronic file of the proceeding.

3. The present proceeding will continue in the publication process, toward issuance of a reexamination certificate.

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

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

11-30-10

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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Knobbe Martens Olson & Bear LLP
2040 Main Street
Fourteenth Floor
Irvine, CA 92614

For Patent Owner

MAILED

AUG 0 2 2010

CENTRAL REEXAMINATION UNIT

Manuel F. de la Cerra.
The Law Office of Manuel de la Cerra
6885 Catamaran Drive
Carlsbad, CA 92011

For 3rd Party Requester
(both Requests)

Ex Parte Reexamination Proceeding
Control No. 90/009,335
Filed: November 17, 2008
For: U.S. Patent No. 5,393,170

Ex Parte Reexamination Proceeding
Control No. 90/009,583
Filed: September 22, 2009
For: U.S. Patent No. 5,393,170

DECISION MERGING
REEXAMINATION
PROCEEDINGS

The above noted reexamination proceedings are before the Supervisory Patent Examiner of Central Reexamination Unit 3993 for consideration of merger as provided in 37 CFR 1.565(c).

Consideration of Merger

Under 37 CFR 1.565(c):

> "If *ex parte* reexamination is ordered while a prior *ex parte* reexamination proceeding is pending and prosecution in the prior *ex parte* reexamination proceeding has not been terminated, the *ex parte* reexamination proceedings will be consolidated and result in the issuance of a single certificate under §1.570."

Reexamination in application control No. 90/009,335 was ordered in a decision mailed January 22, 2009. The decision granted reexamination for patent claims 1 and 2, the only claims for which reexamination was requested. On September 4, 2009, a non-final Office action was mailed rejecting claims 1 and 2. On October 5, 2009, patent owner filed a response to the Office action. The response amended claim 1, added new claims 33-36,

and presented arguments in favor of confirmation of claims 1, 2 and 33-36. On May 15, 2010, the examiner issued a final Office action rejecting claims 1 and 2 and indicating that new claims 33-36 contained allowable subject matter. Following an interview held May 26, 2010, patent owner filed a response on June 15, 2010, amending original claim 1 for the second time, cancelling new claim 34 and amending new claim 35. No Office action has been rendered since the receipt of patent owner's response.

Reexamination in application Control No. 90/009,583 was ordered in a decision mailed November 4, 2009. The decision indicating that claims 1 and 2, the only claims for which reexamination was requested, would be reexamined. No Patent Owner Statement under 37 CFR 1.530 was filed by patent owner. No Office action has been rendered since the mailing of the decision ordering reexamination.

As evidenced by the above facts, reexamination Control No. 90/009,335 and reexamination control No. 90/009,583 are currently pending. Since the order to reexamine has been mailed in both reexamination proceedings and both proceedings are pending, a decision under 37 CFR 1.565(c) is timely. Accordingly, the petition to merge the above-captioned proceedings is granted and the proceedings are hereby merged. A joint examination will be conducted in accordance with the following guidelines and requirements.

Requirement for Same Claims, Drawings, and Specification in Both Proceedings

As noted above, original patent claim 1 has been amended, and new dependent claims 33, 35 and 36 have been added by amendment in reexamination control No. 90/009,335. No amendment has been filed in reexamination control No. 90/009,583. As patent owner is required to maintain identical claims, drawings, and specification in both files, and keeping with the statutory requirement of 35 U.S.C. 305 that "All reexamination proceedings under this section ...will be conducted with special dispatch within the Office.", to expedite the proceedings, a copy of pages 2 and 3 of the response filed June 15, 2010 in reexamination control No. 90/009,335, which pages contain a complete copy of twice amended claim 1 and new claims 33, 35, and 36 (copy attached), will be entered into the file of reexamination control No. 90/009,583, and this version of the claims, which is the most recent, will be treated in the next Office action.

Conduct of Proceedings

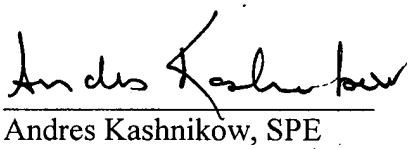
The reexamination proceedings are consolidated and will result in the issuance of a single certificate. As indicated above, original patent claims 1 and 2 as well as new claims 33, 35, and 36 will be reexamined. All papers mailed by the Office will take the form of a single action that jointly applies to both reexaminations. All papers issued by the Office will contain the identifying data for both cases, and each paper will be entered into both files (which will be maintained as separate files). Any paper filed by the patent owner must consist of a single response, filed in duplicate, each bearing an original signature for entry into each file. All papers filed by patent owner must be served on the third party requester and requester will be sent copies of all papers mailed by the Office. Where a

paper is filed that requires payment of a fee (e.g., petition fee, excess claims fee, appeal brief fee, brief fee, etc.) only a single feed need be paid. For example, only one fee need be paid for a patent owner's appellant brief, even though the brief relates to multiple proceedings and copies must be filed (as pointed out above) for each file in the merged proceeding. Further, upon return of the present merged proceedings to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior art patents and printed publications, and will cite such documents as necessary as part of the next action in order to place the files in identical condition.

Conclusion

Reexamination Control Nos. 90/009,335 and 90/009,583 are hereby merged into a single proceeding. Upon the mailing of this decision, the files will be forwarded to the examiner in the Central Reexamination Unit for issuance of an Office action on the merits that is consistent with this decision.

Any inquiry concerning this decision should be directed to Andres Kashnikow, Supervisory Primary Examiner, at telephone No. (571) 272-4361.



Andres Kashnikow, SPE
Central Reexamination Unit 3993

Attachment: copy of pages 2 and 3, containing amended claim 1, and new claims 33, 35, and 36, submitted with response received June 15, 2010 in reexamination control No. 90/009,335.

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Jonathan A. Barney
Knobbe Martens Olson & Bear
620 Newport Center Drive
Sixteenth Floor
Newport Beach, CA 92660[1]

For Patent Owner

MAILED

AUG 0 2 2010

CENTRAL REEXAMINATION UNIT

Manuel F. de la Cerra.
The Law Office of Manuel de la Cerra
6885 Catamaran Drive
Carlsbad, CA 92011

For 3rd Party Requester
(both Requests)

Ex Parte Reexamination Proceeding
Control No. 90/009,336
Filed: November 17, 2008
For: U.S. Patent No. 5,564,859

Ex Parte Reexamination Proceeding
Control No. 90/009,584
Filed: September 22, 2009
For: U.S. Patent No. 5,564,859

DECISION MERGING
REEXAMINATION
PROCEEDINGS

The above noted reexamination proceedings are before the Supervisory Patent Examiner of Central Reexamination Unit 3993 for consideration of merger as provided in 37 CFR 1.565(c).

Consideration of Merger

Under 37 CFR 1.565(c):

> "If *ex parte* reexamination is ordered while a prior *ex parte* reexamination proceeding is pending and prosecution in the prior *ex parte* reexamination

[1] It is noted that the current correspondence address of record within the USPTO for US Application Serial No. 08/393,071, the application that matured into US Patent No. 5,564,859, which patent is the subject of reexamination Control Nos. 90/009,336 and 90/009,584 is that of: Jonathan A. Barney, Knobbe Martens Olson & Bear, 620 Newport Center Drive, Sixteenth Floor, Newport Beach, CA 92660. Mail sent to that address has been returned undelivered. Patent owner must file a change in correspondence address in US Application Serial No. 08/393,071 to ensure that all mailed concerning the above identified reexamination proceedings is delivered to the correct address.

proceeding has not been terminated, the *ex parte* reexamination proceedings will be consolidated and result in the issuance of a single certificate under §1.570."

Reexamination in application control No. 90/009,336 was ordered in a decision mailed January 22, 2009. The decision granted reexamination for patent claims 13, 37, and 40, the only claims for which reexamination was requested. On September 4, 2009, a non-final Office action was mailed rejecting claims 13, 37, and 40. On October 5, 2009, patent owner filed a response to the Office action. The response amended claim 13, added new claims 45-47, and presented arguments in favor of confirmation of claims 13, 37, 40, and 45-47. On May 15, 2010, the examiner issued a final Office action rejecting claims 13, 37, 40, and 45-47. Following an interview held May 26, 2010, patent owner filed a response on June 15, 2010, amending original claim 13 for the second time, cancelling new claim 47 and adding claims 48-52. No Office action has been rendered since the receipt of patent owner's response.

Reexamination in application Control No. 90/009,584 was ordered in a decision mailed November 4, 2009. The decision indicating that claims 13, 37, and 40, the only claims for which reexamination was requested, would be reexamined. No Patent Owner Statement under 37 CFR 1.530 was filed by patent owner. No Office action has been rendered since the mailing of the decision ordering reexamination.

As evidenced by the above facts, reexamination Control No. 90/009,336 and reexamination control No. 90/009,584 are currently pending. Since the order to reexamine has been mailed in both reexamination proceedings and both proceedings are pending, a decision under 37 CFR 1.565(c) is timely. Accordingly, the petition to merge the above-captioned proceedings is granted and the proceedings are hereby merged. A joint examination will be conducted in accordance with the following guidelines and requirements.

Requirement for Same Claims, Drawings, and Specification in Both Proceedings

As noted above, original patent claim 13 has been amended and new claims 45, 46, and 48-52 have been added by amendment in reexamination control No. 90/009,336. No amendment has been filed in reexamination control No. 90/009,584. As patent owner is required to maintain identical claims, drawings, and specification in both files, and keeping with the statutory requirement of 35 U.S.C. 305 that "All reexamination proceedings under this section ...will be conducted with special dispatch within the Office.", to expedite the proceedings, a copy of pages 2-6 of the response filed June 15, 2010 in reexamination control No. 90/009,336, which pages contain a complete copy of twice amended claim 13 and new claims 45, 46, and 48-52 (copy attached) will be entered into the file of reexamination control No. 90/009,584, and this version of the claims, which is the most recent, will be treated in the next Office action.

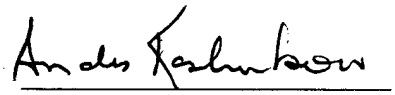
Conduct of Proceedings

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. As indicated above, original patent claims 13, 37, and 40, as well as new claims 45, 46, and 48-52 will be reexamined. All papers mailed by the Office will take the form of a single action that jointly applies to both reexaminations. All papers issued by the Office will contain the identifying data for both cases, and each paper will be entered into both files (which will be maintained as separate files). Any paper filed by the patent owner must consist of a single response, filed in duplicate, each bearing an original signature for entry into each file. All papers filed by patent owner must be served on the third party requester and requester will be sent copies of all papers mailed by the Office. Where a paper is filed that requires payment of a fee (e.g., petition fee, excess claims fee, appeal brief fee, brief fee, etc.) only a single feed need be paid. For example, only one fee need be paid for a patent owner's appellant brief, even though the brief relates to multiple proceedings and copies must be filed (as pointed out above) for each file in the merged proceeding. Further, upon return of the present merged proceedings to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior art patents and printed publications, and will cite such documents as necessary as part of the next action in order to place the files in identical condition.

Conclusion

Reexamination Control Nos. 90/009,336 and 90/009,584 are hereby merged into a single proceeding. Upon the mailing of this decision, the files will be forwarded to the examiner in the Central Reexamination Unit for issuance of an Office action on the merits that is consistent with this decision.

Any inquiry concerning this decision should be directed to Andres Kashnikow, Supervisory Primary Examiner, at telephone No. (571) 272-4361.



Andres Kashnikow, SPE
Central Reexamination Unit 3993

Attachment: copy of pages 2-6, containing amended claim 13, and new claims 45, 46, and 48-52, submitted with response received June 15, 2010 in reexamination control No. 90/009,336.

cc: Knobbe Martens Olson & Bear LLP
2040 Main Street
Fourteenth Floor
Irvine, CA 92614

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United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,347	11/26/2008	7302164	081174-0000003	7525

20995 7590 08/26/2010

KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 08/26/2010

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

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Roger R. Wise
Pillsbury Winthrop Shaw Pittman
725 S. Figueroa Street Suite 2800
Los Angeles CA 90017

MAILED
MAILED
AUG 26 2010
CENTRAL REEXAMINATION UNIT
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/009,347*.

PATENT NO. *7302164*.

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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Rabinder N. Narula (for Owner)
KNOBBE MARTENS OLSON & BEAR
2040 Main Street
Fourteen Floor
Irvine, CA 92314

MAILED

AUG 26 2010

CENTRAL REEXAMINATION UNIT

Roger R. Wise (for Requester)
PILLSBURY WINTHROP SHAW PTITMAN LLP
725 S. Figueroa St
Suite 2800
Los Angeles, CA 90017

In re Patent of: Wright et al.
Control No.: 90/009,347
Deposited: November 26, 2008
For: US Patent No. 7,302,164

DECISION ON PETITION UNDER 37 C.F.R. 1.59

This is a decision on the petition under 37 CFR 1.59(b), renewed January 27, 2010 to expunge information from the above identified proceeding.

The petition is granted.

Petitioner requests that the proprietary material submitted April 2, 2010 be expunged from the record. Petitioner states either: (A) that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in 37 CFR 1.17(g) has been paid.

The information in question has been determined by the undersigned to **not** be material to the examination of the instant proceeding. Applicant is required to retain the expunged material(s)

for the life of any patent which issues with a reexamination certificated based on the above-identified proceeding .

The expunged material has been removed from the official file.

Any questions regarding this decision should be directed to Jessica Harrison, SPE AU 3992 of the Central ReExamination Unit at 571-272-4449

PETITION GRANTED

/J. Harrison/

Jessica Harrison
SPE, AU 3992
Central ReExamination Unit

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.:20110314

DATE : March 14, 2011

TO SPE OF : ART UNIT 3992

SUBJECT : Request for Certificate of Correction on Patent No.: 7,302,164 C1

A response is requested with respect to the accompanying request for a certificate of correction.

Please complete this form and return with file, within **7** days to:
Certificates of Correction Branch - PK 3-910
Palm location **7590** - Tel. No. 305-8201

With respect to the change(s) requested, correcting Office and/or Applicant's errors, should the patent read as shown in the certificate of correction? No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Thank You For Your Assistance **Certificates of Correction Branch**

The request for issuing the above-identified correction(s) is hereby:
Note your decision on the appropriate box.

☒ **Approved** **All** changes apply.

☐ **Approved in Part** Specify below which changes **do not** apply.

☐ **Denied** State the reasons for denial below.

Comments:

Eric Keasel

SPE: Eric Keasel **Art Unit** 3992

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,160	03/24/2009	7210016	2805.001REX6	2351

26111 7590 09/30/2010

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 09/30/2010

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,357	12/08/2008	7210016	2805.001REX4	2148

26111 7590 09/30/2010

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 09/30/2010

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Date: SEP 30 2010

CENTRAL REEXAMINATION UNIT

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

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001160
PATENT NO. : 7210016
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

ORRICK, HERRINGTON & SUTCLIFFE LLP
ATTN: FABIO E. MARINO
1000 MARSH ROAD
MENLO PARK, CA 94025

Date: MAILED

SEP 30 2010

CENTRAL REEXAMINATION UN

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009357
PATENT NO. : 7210016
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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STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
1100 NEW YORK AVENUE, N.W.
WASHINGTON DC 20005

(For Patent Owner)

MAILED

SEP 30 2010

CENTRAL REEXAMINATION UNIT

HAYNES & BOONE, LLP IP SECTION
2323 VICTORY AVENUE
SUITE 700
DALLAS, TX 75219

(For *inter partes* Requester)

ORRICK, HERRINGTON & SUTCLIFFE, LLP
Attn: Fabio E. Marino
1000 Marsh Road
Menlo Park, CA 94025

(For *ex parte* Requester)

In re Ware *et al.*
Inter partes Reexamination Proceeding
Control No.: 95/001,160
Filed: March 24, 2009
For: U.S. Patent No. 7,210,016

In re Ware *et al.*
Ex Parte Reexamination Proceeding
Control No.: 90/009,357
Filed: December 8, 2008
For: U.S. Patent No. 7,210,016

: DECISION
: DISSOLVING
: MERGER OF
: REEXAMINATION
: PROCEEDINGS

This is a decision on patent owner's January 20, 2010 petition entitled "PETITION UNDER 37 C.F.R. §§ 1.182 AND 1.183 TO RECONSIDER AND SET ASIDE MERGER OF CO-PENDING REEXAMINATION PROCEEDINGS".

The fee set forth in 37 CFR 1.17(f) for the patent owner petition is $400, which was charged to Patent Owner's credit card on January 20, 2010, pursuant to the authorization for same in Patent Owner's EFS-WEB fee transmittal.

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

Patent Owner's petition is granted to the extent that the merger of the above-captioned proceedings is dissolved, for the reasons set forth below.

REVIEW OF FACTS

1. On April 24, 2007, the Office issued U.S. Patent No. 7,210,016 (the '016 patent) to Ware *et al.*

2. The '016 patent is subject to litigation in the United States District Court for the District of Northern California, in *Rambus Inc. v. Nvidia Corp.*, {Civil Action No. 3:08-cv-3343-SI}. The initial complaint was filed July 10, 2008. Based upon the record, patent owner is seeking to enforce at least one of claims 1-24 against the requester in the litigation.

3. On November 6, 2008, an International Trade Commission (ITC) action was filed. The ITC investigation is docketed as *Certain Semiconductor Chips Having Synchronous Random Access Memory Controllers and Products Containing Same, Including Graphics Cards and Motherboards*, Docket No. 2637.

4. On December 8, 2008, a request for *ex parte* reexamination of claims 7, 13, 21 and 22 of the '016 patent was filed by third party requester NVIDIA Corporation. The request was assigned Control No. 90/009,357 (the '9357 proceeding).

5. On January 16, 2009, the Office issued an order granting the '9357 request for *ex parte* reexamination and setting a two month time period for a patent owner's statement. The order stated that claims 7, 13, 21 and 22 of the '016 patent, would be subject to reexamination.

6. The time for filing a patent owner's statement pursuant to 37 CFR 1.530 in the '9357 *ex parte* reexamination proceeding expired on March 16, 2009.[1]

7. On March 24, 2009, a request for *inter partes* reexamination of all the claims (claims 1-24) of the '016 patent was filed by the same third party requester (NVIDIA Corporation). The request was assigned Control No. 95/001,160 (the '1160 proceeding).

8. On May 8, 2009, the Office issued a first Office action on the merits in the '9357 *ex parte* reexamination proceeding.

9. On May 26, 2009, the Office issued an order granting the '1160 request for *inter partes* reexamination and stating that a first action on the merits would be issued in due course. The order stated that all the claims of the '016 patent, claims 1-24, would be subject to reexamination.

---

[1] There is no provision for filing a patent owner's statement in an *inter partes* reexamination proceeding; instead, an Office action on the merits is issued prior to any input from the parties (other than that of the requester).

10. On August 10, 2009, Patent Owner filed a response in the '9357 *ex parte* reexamination proceeding. The response did not amend, cancel or add new claims.

11. On October 14, 2009, patent owner filed a petition in the '9357 *ex parte* proceeding to prevent merger with the '1160 *inter partes* proceeding.

12. On December 16, 2009 the Office issued a decision dismissing patent owner's October 14, 2009 petition requesting prevention of merger of the '1160 *inter partes* and '9357 *ex parte* reexamination proceedings and merged the reexamination proceedings (the merged proceeding).

13. On January 20, 2010, patent owner filed the present petition requesting reconsideration of the Office's December 16, 2009 decision.

14. On March 30, 2010, the Office issued a non-final Office action on the merits in the merged proceeding.

15. On June 1, 2010, patent owner timely filed responsive comments to the March 30, 2010 Office action, to include an amendment to the claims.[2]

DECISION

I. Issues Raised and Relief Requested

Patent owner raises issues, asserting as follows: (1) Merger of the present *ex parte* and *inter partes* reexamination proceedings violates 35 U.S.C. 305 and 37 C.F.R. § 1.501 *et seq.*; (2) Neither statue nor the rules permit merger of the present *ex parte* and *inter partes* reexamination proceedings; (3) Merger of the present *ex parte* and *inter partes* reexamination proceedings gives the *ex parte* third party requesters *inter partes* in an *ex parte* reexamination, contrary to 37 C.F.R. § 1.989(b); (4) The Office has ignored the statutory restrictions that govern *ex parte* reexamination in an effort to conduct the *inter partes* reexamination with special dispatch; (5) Merger of an *ex parte* and *inter partes* reexamination proceeding deprives patent owner of an "expectancy" to conduct an interview on the merits as to issues raised in the *ex parte* proceeding; and (6) A blanket reassertion of all arguments raised in patent owner's previous petition.

Patent owner requests as remedies in the now merged proceeding of: (1) Reversal of the decision to merge the present *ex parte* and *inter partes* proceedings; (2) Staying the merged proceeding until the present petition is decided; (3) Staying the *inter partes* proceeding upon dissolution of the merged proceeding; (4) Prosecution of the *ex parte* and *inter partes* proceedings in parallel

[2] Patent Owner petitioned for and was granted a one month extension of time to respond to the March 30, 2010 Office action. The new due date of May 30, 2010 was a Sunday and May 31, 2010 was a federal holiday, giving patent owner until June 1, 2010 to file a response. See 37 CFR 1.7(a).

upon dissolution of the merged proceeding; and (5) A blanket request for all requests for relief made in patent owner's previous petition.

II. Discussion of Previous Petition and Decision

In the original petition challenging merger, patent owner asserted: (1) 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); (2) Requester's reexamination filing pattern combined with a merger of the two reexamination proceedings denies patent owner of "*ex parte* reexamination rights"; and (3) Requester's reexamination filing pattern combined with a merger of the two reexamination proceedings expands the requester's *inter partes* rights. Patent owner's original petition requested 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 patent owner to exercise the *ex parte* interview right, if the *inter partes* and *ex parte* reexamination proceedings were neither vacated nor demerged.

The Office issued a decision dismissing patent owner's original petition challenging merger. The decision pointed out that the filing of an *ex parte* reexamination proceeding did not violate nor circumvent 35 U.S.C. 317(a), as an *ex parte* reexamination proceeding was not an *inter partes* reexamination proceeding. Furthermore, the decision noted that 35 U.S.C. 302 permits any member of the public the right to file a request for *ex parte* reexamination on an issued patent, even if the member of the public is the requester in an *inter partes* proceeding for the same patent. Finally, the decision noted that no statutory right to interview exists, and therefore, merging *ex parte* and *inter partes* reexamination proceedings could not divest patent owner of a right that did not exist. Accordingly, the decision found that patent owner had not established on the record a basis to justify the relief requested and the petition was dismissed. The merger of the present, concurrent *ex parte* and *inter partes* reexamination proceedings was done as an initial attempt to further special dispatch, as both proceedings were at an early stage and did not, at that time, appear to *per se* frustrate special dispatch as compared to patent owner's suggested alternatives in handling the proceedings.

III. Findings and Analysis

Reexamination of the '016 patent has been ordered in the '9357 *ex parte* proceeding and '1160 *inter partes* proceeding, and the proceedings have been merged. The issue to be decided is whether the merger of the above-captioned *ex parte* and *inter partes* reexamination proceedings will be retained in this instance.

As an initial matter, there is no legal requirement for the Office to merge two pending reexamination proceedings, and the statute is silent as to the matter. The determination whether

to merge two reexamination proceedings is an act reserved to the sole discretion of the Office. (See 37 CFR 1.565(c), 37 CFR 1.989(a), MPEP 2686.01 I.,[3] MPEP 2686.01 IV,[4] 2283,[5] MPEP 2286.[6])

The relevant regulation makes it clear that the Office has discretion when deciding whether or not to merge an *ex parte* reexamination proceeding with an *inter partes* reexamination proceeding. See 37 CFR 1.989(a).[7] To the extent that the MPEP states the Office will "normally" merge two reexaminations, this general policy does not address the various possible permutations that may occur with regard to any specific set of cases eligible for merger. Finally, the MPEP also notes that the decision to merge is within the "sole discretion" of the Office to facilitate/carry out the statutory mandate to conduct reexamination proceedings with special dispatch.[8] Therefore, while the Office retains the authority to merge, it is permissible for the Office to not merge proceedings, where special dispatch can be equally or better served absent merger. In summary, merge/non-merge determinations are made by the Office on a case-by-case basis, so that special dispatch can be achieved in view of the individual facts and circumstances of each proceeding.[9,10]

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[3] "Where a second request for reexamination is filed and reexamination is ordered, and a first reexamination proceeding is pending, the proceedings will be merged where the Office (**in its discretion**) deems it appropriate to do so, to facilitate the orderly handling of the proceedings. However, a decision not to merge is within the sole discretion of the Office to facilitate/carry out the statutory mandate of 35 U.S.C. 314(c) to conduct reexamination proceedings with 'special dispatch.'"[Emphasis added]

[4] "The instances where the Office may, or may not, merge an ongoing reexamination proceeding with a subsequent reexamination proceeding, are addressed on a case-by-case basis."

[5] "However, a decision not to merge is within the sole discretion of the Office to facilitate/carry out the statutory mandate of 35 U.S.C. 305 to conduct reexamination with 'special dispatch.'"

[6] "[T]he proceedings will be merged where the Office (in its discretion) deems it appropriate to do so, to facilitate the orderly handling of the proceedings. However, a decision not to merge is within the sole discretion of the Office to facilitate/carry out the statutory mandate of 35 U.S.C. 314(c) to conduct reexamination with 'special dispatch.'"

[7] "If any reexamination is ordered while a prior inter partes reexamination proceeding is pending for the same patent and prosecution in the prior inter partes reexamination proceeding has not been terminated, a decision **may** be made to merge the two proceedings or to suspend one of the two proceedings. . . ." (Emphasis added).

[8] Id.

[9] See "Revisions and Technical Corrections Affecting Requirements for *Ex Parte* and *Inter Partes* Reexamination," 72 Fed. Reg. 18892 (April 16, 2007-final rule) at 18901, where it states - "As was pointed out in the Notice of proposed Rule Making, there are instances where the Office does not merge (consolidate) an ongoing ex parte reexamination with a subsequent reexamination or reissue proceeding, which are addressed on a case-by case basis."

[10] "[T]he ability to decide the question of whether to merge/consolidate based on the merits of a particular fact pattern must be, and is, reserved to the Office." *Id.* at 18902.

At this juncture, it is noted that it was requester who chose to file two separate reexamination requests, to institute both *ex parte* and *inter partes* reexamination for all claims of the '016 patent, rather than to present all issues in one proceeding (giving requester the participation rights desired for the various issues identified in each request). Requester did so with full knowledge that the Office retains absolute discretion regarding whether or not to merge.[11] Therefore, it was requester that determined that the issues raised in each request need not be together, and the Office, by doing the same and not merging the proceedings, does not impact upon any rights or expectations of the requester.

Based upon the specific facts and circumstances of the reexamination proceedings on the '016 patent, the Office has decided that merger would not be the best alternative in this instance.

Accordingly, the merger is dissolved and the two proceedings revert to independent prosecution. However, the Office retains the right to merge the present proceedings or to suspend one (or more) of the proceedings for a limited time at a later date, should circumstances change such that the situation warrants such action.

IV. Procedural Considerations

1. Any Office action issued and responses submitted by the parties during the merged proceeding is hereby vacated by this decision.[12] All Office actions and party responses from the time of merger, to the present, will be expunged from the Image File Wrapper (IFW) of the proceedings by being closed and marked non-public. Reexamination will restart anew from the point of prosecution just prior to the merger of the two proceedings. The examiner will issue an Office action in the '9357 *ex parte* reexamination proceeding taking into account the August 10, 2009 patent owner response having been filed. The examiner will issue an Office action in the '1160 *inter partes* reexamination proceeding taking into account that no responses (and comments) have been filed.

2. The proceedings will be conducted in a manner that minimizes any overlap of issues between the proceedings by preventing the importation of issues from one proceeding into the other. Specifically, the examiner will not introduce, from one proceeding into the other proceeding, any rejection proposed in the request, requester's reply under 37 CFR 1.535, or requester's comments in the *inter partes* reexamination.

3. All new rejections initiated by the examiner are to be included in the *inter partes* reexamination proceeding, so as to permit the Office to have the benefits of third party requester's comments. The authority for inclusion of rejections initiated by the examiner is

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[11] See the rules, MPEP sections, and Office Notice referred to above in the body of the decision and the footnotes.
[12] This does not include the decisions to order reexamination; they are not deemed Office actions in this context, and they were not issued while the proceedings were merged.

based upon 35 U.S.C. 314(a) which provides for examination in an *inter partes* reexamination proceeding in accordance with 35 U.S.C. 132 and 133; which permit the examiner's introduction of rejections. It should also be noted, that 35 U.S.C. 312 provides for the Office to *sua sponte* add issues to a reexamination proceeding "with... consideration of other patents or printed publications." Of course any modification of the proposed rejections in the *ex parte* reexamination proceeding to add a new reference to address the prosecution and examination of the *ex parte* reexamination proceeding would be made in that proceeding, and not in the *inter partes* reexamination proceeding, since the *ex parte* reexamination proceeding is the exclusive vehicle to address those proposed rejections.

4. As pointed out above, the Office retains the right to merge the present proceedings or to suspend one (or more) of the proceedings for a limited time at a later time should circumstances change such that the situation warrants such action.

5. If a reexamination certificate issues, concluding one of the two proceedings, patent owner is required pursuant to 37 CFR §§ 1.565(a) and 1.985(a) to file a notice of concurrent proceedings (see MPEP §§ 2282 and 2686) in the still pending proceeding, informing the Office of the issuance and publication of the reexamination certificate. Additionally, patent owner is required to submit an amendment paper, making all necessary amendments to the still pending proceeding, such that the still pending proceeding is consistent with all changes implemented by the issued reexamination certificate in the concluded proceeding.

V. Discussion Regarding "Interview Rights"

Interview and "Right to Request" an Interview. No statutory or regulatory right to conduct an interview exists. While 37 CFR §§ 1.133 and 1.560 provide the guidelines for conducting and making a record of interviews, 37 CFR §§ 1.133(a) and 1.560 do not confer any right to an interview. *Inter partes* reexamination rule 37 CFR 1.955 states that no interviews on the merits are permitted in an *inter partes* reexamination.[13] The relevant sections of the MPEP provide guidance on the conduct of interviews to include denial of an interview.[14] None of the relevant rules or MPEP sections regarding interviews before the Office creates a right for an interview. While a party may request an interview, there is no requirement that the Office grant that request.

CONCLUSION

1. The January 20, 2010 patent owner petition is granted to the extent that the merger of the above-captioned proceedings is dissolved and the proceedings are reconstituted as separate proceedings.

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[13] In the extraordinary circumstance where the *inter partes* requester has opted to not participate in the *inter partes* reexamination proceeding, a Patent Owner can petition for a waiver of 37 CFR 1.955 under 37 CFR 1.183 to conduct an interview, on an as-needed-per-interview basis.

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

2. Any Office action issued and responses/comments submitted by the parties during the merged proceeding are hereby vacated by this decision.[15]

3. If a reexamination certificate issues, concluding one of the two proceedings, patent owner is required pursuant to 37 CFR §§ 1.565(a) and 1.985(a) to file a notice of concurrent proceedings (See MPEP §§ 2282 and 2686) in the still pending proceeding, informing the Office of the issuance and publication of the reexamination certificate in the still pending proceeding. Additionally, patent owner is required to submit an amendment paper, making all necessary amendments to the still pending proceeding, such that the still pending proceeding is consistent with all changes implemented by the issued reexamination certificate in the concluded proceeding.

4. Jurisdiction over the two reexamination proceeding is forwarded via the Director of the Central Reexamination Unit (CRU) to the examiner, for action not inconsistent with this decision.

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

/Kenneth M. Schor/

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

6-25-10

[15] As pointed out above, this does not apply to the decisions to order reexamination.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,357	12/08/2008	7210016	2805.001REX4	2148

26111 7590 01/07/2011

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 01/07/2011

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,160	03/24/2009	7210016	2805.001REX6	2351

26111 7590 01/07/2011

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
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WASHINGTON, DC 20005

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WASHINGTON DC 20005

MAILED

JAN 07 2011

CENTRAL REEXAMINATION UNIT

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DALLAS, TX 75219

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Menlo Park, CA 94025

In re Ware *et al.*
Inter partes Reexamination Proceeding
Control No.: 95/001,160
Filed: March 24, 2009
For: U.S. Patent No. 7,210,016

In re Ware *et al.*
Ex Parte Reexamination Proceeding
Control No.: 90/009,357
Filed: December 8, 2008
For: U.S. Patent No. 7,210,016

DECISION
ON
PETITION

This is a decision on third party requester's October 21, 2010 petition entitled "THIRD PARTY REQUESTER'S PETITION FOR RECONSIDERATION OF DECISION DISSOLVING MERGER OF REEXAMINATION PROCEEDINGS AND FOR REINSTITUTION OF THE PROSECUTION RECORD".

The fee set forth in 37 CFR 1.17(f) for the petition is $400, which was charged to requester's Deposit Account No. 08-1394 on October 22, 2010, pursuant to the authorization for same in requester's EFS-WEB fee transmittal.

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

SUMMARY

The petition is **dismissed.**

As discussed below, requester chose to present the issues in the first request as a request for *ex parte* reexamination, which does not provide requester with *inter partes* rights. Thus requester, at the time of filing the *ex parte* request, had no expectancy of any other rights, and has no basis to complain of the *ex parte* reexamination treatment of the first proceeding. Requester did so despite the fact the MPEP points out (see below in the body of this decision) that the Office retains absolute discretion regarding whether or not to merge, should an *inter partes* reexamination request be subsequently filed. The subsequent filing of an *inter partes* request for a reexamination proceeding does not alter the fact that the requester filed an initial request as a request for an *ex parte* reexamination proceeding. Therefore, it was requester that determined that the issues raised in first request would be given *ex parte* reexamination treatment. The Office's decision has not impacted upon any rights or expectations of the requester. Requester, at the time of filing the *ex parte* request, had no expectancy of any other rights, and thus, now, has no basis to complain that *inter partes* rights are not being afforded.

The September 30, 2010 merger dissolution decision has not been shown to be inappropriate; rather, the merger dissolution decision maintains the requester's and the patent owner's rights as to both the *ex parte* and *inter parte* reexamination proceedings. Merger and dissolution of the merger did not alter any party rights that were established in accordance with the relevant regulations and statutes, based on the filings. Further, the authority of the Office to dissolve (demerge, or sever) a merged proceeding at the point when it is found to frustrate/impede the Office's ability to conduct the reexamination proceedings in accordance with the Office's statutory mandate of special dispatch is no different than the Office's authority to merge when it is found to further/facilitate the Office's ability to conduct the reexamination proceedings with special dispatch.

REVIEW OF FACTS

1. On April 24, 2007, the Office issued U.S. Patent No. 7,210,016 (the '016 patent) to Ware *et al.*

2. The '016 patent is subject to litigation in the United States District Court for the District of Northern California, in *Rambus Inc. v. Nvidia Corp.*, {Civil Action No. 3:08-cv-3343-SI}. The initial complaint was filed July 10, 2008. Based upon the record, patent owner is seeking to enforce at least one of claims 1-24 against the requester in the litigation.

3. On November 6, 2008, an International Trade Commission (ITC) action was filed. The ITC investigation is docketed as *Certain Semiconductor Chips Having Synchronous Random Access Memory Controllers and Products Containing Same, Including Graphics Cards and Motherboards*, Docket No. 2637.

4. On December 8, 2008, a request for *ex parte* reexamination of claims 7, 13, 21 and 22 of the '016 patent was filed by third party requester NVIDIA Corporation. The request was assigned Control No. 90/009,357 (the '9357 proceeding).

5. On January 16, 2009, the Office issued an order granting the '9357 request for *ex parte* reexamination and setting a two month time period for a patent owner's statement. The order stated that claims 7, 13, 21 and 22 of the '016 patent, would be subject to reexamination.

6. The time for filing a patent owner's statement pursuant to 37 CFR 1.530 in the '9357 *ex parte* reexamination proceeding expired on March 16, 2009.[1]

7. On March 24, 2009, a request for *inter partes* reexamination of all the claims (claims 1-24) of the '016 patent was filed by the same third party requester (NVIDIA Corporation). The request was assigned Control No. 95/001,160 (the '1160 proceeding).

8. On May 8, 2009, the Office issued a first Office action on the merits in the '9357 *ex parte* reexamination proceeding.

9. On May 26, 2009, the Office issued an order granting the '1160 request for *inter partes* reexamination and stating that a first action on the merits would be issued in due course. The order stated that all the claims of the '016 patent, claims 1-24, would be subject to reexamination.

10. On August 10, 2009, patent owner filed a response in the '9357 *ex parte* reexamination proceeding. The response did not amend, cancel or add new claims.

11. On October 14, 2009, patent owner filed a petition in the '9357 *ex parte* proceeding to prevent merger with the '1160 *inter partes* proceeding.

12. On December 16, 2009 the Office issued a decision dismissing patent owner's October 14, 2009 petition requesting prevention of merger of the '1160 *inter partes* and '9357 *ex parte* reexamination proceedings and merged the reexamination proceedings (the merged proceeding).

13. On January 20, 2010, patent owner filed a petition requesting reconsideration of the Office's December 16, 2009 decision.

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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 (other than that of the requester).

14. On March 30, 2010, the Office issued a non-final Office action on the merits in the merged proceeding.

15. On June 1, 2010, patent owner timely filed responsive comments to the March 30, 2010 Office action, to include an amendment to the claims.[2]

16. On July 1, 2010, third party requester timely filed responsive comments.

17. On September 30, 2010, the Office issued a decision granted patent owner's January 20, 2010 petition and dissolved the merger of the '1160 and the '9357 proceedings.

18. Also on September 30, 2010, the Office issued a *sua sponte* decision modifying the order for *inter partes* reexamination withdrawing a substantial new question of patentability.

19. On October 21, 2010, third party requester filed the present petition, requesting reconsideration of the September 30, 2010 decision.

DECISION

I. Issues Raised and Relief Requested

Third party requester contends that the Office's September 30, 2010 decision is: (1) Arbitrary, capricious and an abuse of discretion; (2) A violation of third party requester's rights; (3) impermissible substantive rule making; (4) Contrary to public and Office policy; and (5) contrary to special dispatch.

Third party requester requests the relief of vacatur of the September 30, 2010 decision, to thereby restore the merged proceeding and to reinstate the prosecution history of the merged proceeding. If the Office does not grant the relief requested, third party requester requests the Office issue a final agency action.

II. Discussion of Previous Petitions and Decisions

a. The October 14, 2009 Patent Owner Petition and December 16, 2009 Office Decision

In the original petition challenging merger, patent owner asserted: (1) 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); (2) Requester's reexamination filing

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[2] Patent Owner petitioned for and was granted a one month extension of time to respond to the March 30, 2010 Office action. The new due date of May 30, 2010 was a Sunday and May 31, 2010 was a federal holiday, giving patent owner until June 1, 2010 to file a response. See 37 CFR 1.7(a).

pattern combined with a merger of the two reexamination proceedings denies patent owner of "*ex parte* reexamination rights"; and (3) Requester's reexamination filing pattern combined with a merger of the two reexamination proceedings expands the requester's *inter partes* rights. Patent owner's original petition requested 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 patent owner to exercise the *ex parte* interview right, if the *inter partes* and *ex parte* reexamination proceedings were neither vacated nor demerged.

The Office issued a decision dismissing patent owner's original petition challenging merger. The decision pointed out that: (1) the filing of an *ex parte* reexamination proceeding did not violate nor circumvent 35 U.S.C. 317(a), as an *ex parte* reexamination proceeding was not an *inter partes* reexamination proceeding and that 35 U.S.C. 302 permits any member of the public the right to file a request for *ex parte* reexamination on an issued patent, even if the member of the public is the requester in an *inter partes* proceeding for the same patent; (2) No "*ex parte* right" was being denied by the merger, e.g. no statutory right to interview exists, and therefore, merging *ex parte* and *inter partes* reexamination proceedings could not divest patent owner of a right that did not exist; and (3) Neither party's rights were altered. Accordingly, the decision found that patent owner had not established on the record a basis to justify the relief requested and the petition was dismissed.

b. The January 20, 2010 Patent Owner Petition and September 30, 2010 Office Decision

On January 20, 2010, patent owner filed a petition requesting reconsideration of the December 16, 2009 decision refusing to dissolve the merger. Patent owner asserted in the January 20, 2010 petition: (1) Merger of the present *ex parte* and *inter partes* reexamination proceedings violates 35 U.S.C. 305 and 37 C.F.R. § 1.501 *et seq.*; (2) Neither statue nor the rules permit merger of the present *ex parte* and *inter partes* reexamination proceedings; (3) Merger of the present *ex parte* and *inter partes* reexamination proceedings gives the *ex parte* third party requesters *inter partes* participation in an *ex parte* reexamination, contrary to 37 C.F.R. § 1.989(b); (4) The Office has ignored the statutory restrictions that govern *ex parte* reexamination in an effort to conduct the *inter partes* reexamination with special dispatch; (5) Merger of an *ex parte* and *inter partes* reexamination proceeding deprives patent owner of an "expectancy" to conduct an interview on the merits as to issues raised in the *ex parte* proceeding; and (6) A blanket reassertion of all arguments raised in patent owner's previous petition. Patent owner's January 20, 2010 petition requested the remedies of: (1) Reversal of the decision to merge the present *ex parte* and *inter partes* proceedings; (2) Staying the merged proceeding until the present petition is decided; (3) Staying the *inter partes* proceeding upon dissolution of the merged proceeding; (4) Prosecution of the *ex parte* and *inter partes* proceedings in parallel upon dissolution of the merged proceeding; and (5) A blanket request for all requests for relief made in patent owner's previous petition.

On September 30, 2010, the Office issued a decision granting patent owner's January 20, 2010 petition, dissolving the merger in accordance with special dispatch and based upon the specific facts and circumstances of the proceedings.

III. Findings and Analysis

a. The September 30, 2010 Office decision is not Arbitrary, Capricious and an Abuse of Discretion

Requester cites to an Office Federal Register rulemaking preamble comment[3] and argues that the September 30, 2010 decision overturns long standing Office policy regarding merger and is without any rational connection between the facts found and the decision rendered.

In response:

The September 30, 2010 decision to dissolve the merged proceeding is based upon factually distinct circumstances that are significantly different from the scenario which the cited Federal Register general policy comment is based upon.[4] The present circumstance involves the same third party requester first filing an *ex parte* reexamination request for the '016 patent on a limited number of claims; then later filing an *inter partes* reexamination proceeding for the same patent, but on all the claims. The later request uses the same prior art reference from the first filed *ex parte* proceeding, but in a more expansive manner, while also using additional prior art references. The cited comment by requester in the October 21, 2010 petition addressed a circumstance where an *inter partes* reexamination proceeding was the prior ordered proceeding, was under active examination, and a requester newly discovered relevant information that could not be admitted directly into the *inter partes* reexamination proceeding via 37 CFR 1.948.

Under circumstances where an *inter partes* request has already been ordered, the filing of a second *inter partes* request by the *inter partes* requester is proscribed by statute. No such proscription exists as to subsequent reexamination filings, when an *ex parte* proceeding is first filed and ordered. Nor is there any requirement upon the Office to merge multiple reexamination proceedings on the same patent. Previous Office decisions are not binding on the Office with regard to merger, since the decision to merge is addressed on a case-by-case basis.[5]

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[3] Third party requester petition at page 3, footnote 1 citing Federal Register, Vol. 65, No. 67 at 18154, 18164, 18168-69 (2000).
[4] Id.
[5] See MPEP 2686.01 IV.

In this instance:

Requester initiated reexamination proceedings before the Office, choosing to file an *ex parte* request based upon an SNQ analysis of the Coteus reference relative to only a few of the claims in the '016 patent. Subsequently requester filed an *inter partes* request providing an SNQ analysis of the Coteus reference relative to a substantial number of the claims in the '016 patent. There are two possibilities here as to what requester was aware of when it filed the first request:

1) If, at the time of filing the first request, requester was unaware of the issues of patentability that were newly presented in the second request (for *inter partes* reexamination) and requester wanted *inter partes* rights for the first request, requester should have filed the first request as an *inter partes* request. Requester chose not to do so.

2) If, at the time of filing the first request, requester was aware of the issues of patentability that were newly presented in the second request (for *inter partes* reexamination) and requester wanted *inter partes* rights for all issues of patentability then requester could have delayed the filing of the *ex parte* request for reexamination until the SNQ analysis was more fully developed. Given that the rules and the MPEP makes clear that merger is within the sole discretion of the Office, the requester could not reasonably rely upon the merger of two different types of proceedings in the hope of obtaining *inter partes* participation for all issues raised in both requests. See 37 CFR 1.565(c),[6] 37 CFR 1.989(a),[7] MPEP 2686.01 I,[8] MPEP 2686.01 IV,[9] MPEP 2283,[10] and MPEP 2286.[11] See also "Revisions and Technical Corrections Affecting Requirements for *Ex Parte* and *Inter Partes* Reexamination," 72 Fed. Reg. 18892 (April 16, 2007-final rule) at 18901, where it states - "As was pointed out in the Notice of proposed Rule Making, there are instances where the Office does not merge

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[6] "If *ex parte* reexamination is ordered while a prior *ex parte* reexamination proceeding is pending and prosecution in the prior *ex parte* reexamination proceeding has not been terminated, the *ex parte* reexamination proceedings will **usually** be merged and result in the issuance and publication of a single certificate under § 1.570. . . ." (Emphasis added).

[7] "If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision **may** be made to merge the two proceedings or to suspend one of the two proceedings. . . ." (Emphasis added).

[8] "Where a second request for reexamination is filed and reexamination is ordered, and a first reexamination proceeding is pending, the proceedings will be merged where the Office (**in its discretion**) deems it appropriate to do so, to facilitate the orderly handling of the proceedings. However, a decision not to merge is within the sole discretion of the Office to facilitate/carry out the statutory mandate of 35 U.S.C. 314(c) to conduct reexamination proceedings with 'special dispatch.'"

[9] "The instances where the Office may, or may not, merge an ongoing reexamination proceeding with a subsequent reexamination proceeding, are addressed on a case-by-case basis."

[10] "However, a decision not to merge is within the sole discretion of the Office to facilitate/carry out the statutory mandate of 35 U.S.C. 305 to conduct reexamination with 'special dispatch.'"

[11] "[T]he proceedings will be merged where the Office (in its discretion) deems it appropriate to do so, to facilitate the orderly handling of the proceedings. However, a decision not to merge is within the sole discretion of the Office to facilitate/carry out the statutory mandate of 35 U.S.C. 314(c) to conduct reexamination with 'special dispatch.'"

(consolidate) an ongoing *ex parte* reexamination with a subsequent reexamination or reissue proceeding, which are addressed on a case-by case basis."

In summary, requester made the conscious choice to present the issues in the first request as a request for *ex parte* reexamination, which does not provide requester with *inter partes* rights. Thus requester, at the time of filing the *ex parte* request, had no expectancy of any other rights, and has no basis to complain for obtaining *ex parte* reexamination treatment of the first proceeding.

b. The September 30, 2010 Office decision is not a violation of Requester's Rights

The requester asserts that the September 30, 2010 dissolution decision somehow alters requester's substantive rights.

The dissolution decision does not alter the requester's rights for each reexamination proceeding as filed by the requester. To the contrary, the dissolution decision retains the *status quo* of requester's rights upon filing of each request for reexamination. The Office's merger of proceedings does not alter a party's rights, as merger is an administrative consolidation of cases with common issues to further special dispatch and not a merger of legal claims nor a joinder of parties. The third party requester, upon filing of an *ex parte* request had no expectation of any *inter partes* rights as to the *ex parte* request issues. If third party requester wanted *inter partes* reexamination participation rights for the issues raised in the *ex parte* proceeding, then third party requester should have been filed an *inter partes* request raising the issues presented, instead of filing an *ex parte* request. Given that the MPEP makes clear that merger is within the sole discretion of the Office, the requester could not rely upon merger of the two proceedings as a vehicle to attempt to obtain *inter partes* participation on issues raised in the *ex parte* request.

c. The September 30, 2010 Office decision is not Substantive Rule Making

Requester has asserted the Office cannot dissolve merged reexamination proceedings due to the absence of any positive rule that permits the dissolution of previously merged reexamination proceedings.

The discretion to merge or not merge inherently includes the discretion to demerge in accordance with special dispatch. Furthermore, the Office retains the discretion to reconsider and vacate any previous decision. Petitioner implicitly recognizes this Office discretion to reconsider previously made decisions directed to the merger issue, by the filing of the present petition. Petitioner's listing of several rights that are altered by the decision to demerge is untenable, as the act of a consolidation of cases for administrative convenience does not alter the rights of the parties. Petitioner alleges that proof of the existence of substantive rule making by dint of the dissolution decision occurred because the following rights were altered: (1) The patent owner right to an interview; (2) Third party requester's right to comment; and (3) Third party

requester's right to appeal. Petitioner is in error, as none of the alleged rights were altered by either merger or the dissolution of the merger. Merger and dissolution of the merger left unchanged the 'rights' of all parties as their 'rights' were established in accordance with the relevant statutes before upon filing of the proceedings.

More significantly, withdrawal of an action by the Office is not substantive rule making, even if it does affect rights. The Office can always reconsider a position and restore an action to pre-action status. If the Office withdraws an Office action allowing claims, an applicant's (or patent owner's) rights as to the invention of that claim are altered; yet, clearly, no substantive rule making is involved. In so far as the petitioner argues that the dissolution of the merger in this instance is substantive rule making (and thus improper) due to rights it altered, then the original merger would also have altered those same rights from their pre-merger status and thus would also be substantive rule making (and thus improper). This would void the original merger, and the parties would be back to the pre-merger status anyway.[12]

In conclusion, the decision to demerge is not tantamount to substantive rule making. Both merger and dissolution decisions are purely administrative procedural determinations regarding the propriety of consolidating related proceedings to facilitate the Office's statutory mandate of special dispatch.

d. The September 30, 2010 Office decision is not Contrary to Special Dispatch

Requester has asserted the Office cannot dissolve merged reexamination proceedings as dissolution of merged proceedings runs contrary to special dispatch.

All determinations of merger are made on a case-by-case basis. In the present instance combining the two proceedings would require constant monitoring of the rights of each party due to the nature of the issues raised by each party in the various filings, coupled with decision on petitions and oppositions related to what the merger does or does not permit (as has been the case thus far). Stated another way, the confusion caused by the nuances of the issues raised by the parties in the present proceeding gives rise to a plurality of challenges by each party in the merged proceeding to the point that special dispatch is frustrated, e.g. the issue of merger itself. Contrary to requester's concerns regarding the decision's restarting the proceedings to a point from a year ago, since dissolution both proceedings have advanced without complication. Furthermore, inconsistencies can be resolved and prevented in accordance with the procedural guidance set forth in the September 30, 2010 dissolution decision along with current Office policy, practice and procedure regarding issuance of a reexamination certificate for a patent while another reexamination proceeding on the same patent is still pending. As both proceedings

[12] It is the Office's position that merger determinations are not substantive rule making. The point being made here is that even if a merger decision could be argued to be substantive rule making, that would mean the original merger decision also constituted substantive rule making. Thus, petitioner could not obtain the benefits of merger, because the Office would then be required to dissolve the merger, and the petition could not be granted.

have substantially advanced without complication and special dispatch would not be served by remerging the proceedings and re-opening prosecution.

Finally, the Office is in the best position to determine what will facilitate the Office's discharge its statutory duty of special dispatch in accordance with 35 U.S.C. §§ 305 and 314(c), since the Office best knows its inner workings. As noted previously, the Office has sole discretion regarding issues of merger. It is appropriate that the Office has sole discretion in this matter, since it is the Office that is charged by statute with duty of special dispatch – not the parties. In the present proceedings, the most efficient manner to address the issues raised in each request is to not merger. Previous Office decisions, are not binding on the Office with regard to merger, as the decision to merge is addressed on a case-by-case basis.[13] In the present instance, as noted in the September 30, 2010 decision, and for the reasons discussed above, the Office determined that special dispatch was best served by dissolution of the merger and requester's arguments to the contrary are found non-persuasive.

e. **The September 30, 2010 Office decision is not Contrary to Public and Office policy**

Requester has asserted the Office cannot dissolve merged reexamination proceedings as dissolution of merged proceedings runs contrary to policy considerations that keep reexamination proceedings from being slowed. Requester asserts that policy considerations dictate that merger is to be effected when multiple, co-pending proceedings on the same patent exist.

In response, the September 30, 2010 dissolution decision is in accord with and not contrary to public policy, since, for the reasons stated above in the previous section, the decision best achieves the special dispatch mandated by 35 U.S.C. §§ 305 and 314(c), in resolving the substantial new questions raised for both proceedings. The realization that the proceedings can be resolved most efficiently as separate proceeding serves the public policy of resolving the substantial new questions raised for both proceeding as rapidly as possible.

In addition, the September 30, 2010 dissolution decision is in accord with and not contrary to public policy, since the decision encourages the comprehensive filing of a single *inter partes* reexamination request instead of the piecemeal filing of multiple reexamination requests over an extended period of time. In other words, it encourages a complete analysis of the issues when a reexamination request is filed, rather than doing a "quick" request, simply to "get" something before the Office, and then supplementing with one or more later requests. By promoting the filing of a single, comprehensive reexamination request, the decision promotes the compact prosecution of all issues of patentability with regard to an issued patent, which will translate into more timely notice to the public regarding the rights ascribed to a given issued patent. Requester's institution of two separate reexamination proceedings for the same patent, albeit

[13] See MPEP 2686.01 IV.

each supported by distinct substantial new questions of patentability, is the source of the policy concerns requester voices, and not the Office's decision whether or not to merge requester's piecemeal reexamination request filings. Petitioner asked for separate proceedings for separate issues of patentability on the same patent, and the Office is honoring that request. The resolution of one separate and distinct substantial new question of patentability is not necessary to resolve a different, and distinct substantial new question of patentability found to exist in any other co-pending proceeding. However, the handling of multiple, distinct substantial new questions of patentability in a merged proceeding may deter and not promote special dispatch. Therefore, merger, in given instances, may very well result in the slowing of reexamination, contrary to requester's assertions.

The September 30, 2010 dissolution decision, the MPEP, and Office practice and procedure provide a mechanism by which the public is placed on notice as to the existence of related, unmerged pending Office proceedings on the same patent when a reexamination certificate issues.[14] The dissolution decision, minimizes the consumption of Office resources, promotes special dispatch, and will minimize the filing of merger related petitions and prevent delays caused by the filing of multiple reexamination proceedings to be considered for merger, because it will promote the filing of a single, comprehensive reexamination request. The September 30, 2010 dissolution decision does not alter the viability of reexamination as an alternative to litigation. Petitioner further argues that the merger dissolution decision will promote the filing of anonymous *ex parte* requests for reexamination to achieve merger.[15] As to whether the subsequent request filed is anonymous or not, the identity of the requester is not determinative/dispositive with regard to merger, since whether to merge is determined by the specific facts and circumstances of each proceeding on a case-by-case basis in accordance with special dispatch. It is noted that public policy does not call for providing an *ex parte* requester with *inter partes* rights. Finally, as pointed out public policy is best served by the resolution of a substantial new question of patentability in each reexamination by using the vehicle of reexamination that provides the optimal special dispatch in resolving the SNQs raised. Accordingly, the dissolution decision is not contrary to the relevant issues of public policy as asserted by requester.

IV. Summation

Accordingly, for all the reasons stated above requester's petition to reconsider the September 30, 2010 Office decision is dismissed. Despite the request the Office issue a final agency action, this decision is not made final.

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[14] See the September 30, 2010 Office decision section IV pgs. 6-7; See also MPEP §§ 2295 *et seq.* and 2695 *et seq.*; See *e.g. Ex Parte* Reexamination Certificate (7412th) No. 6188988 C1, right column notice under the abstract.
[15] See Petition at page 9, section E.

CONCLUSION

1. The petition is **dismissed**.

2. 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

1/6/11

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,357	12/08/2008	7210016	2805.001REX4	2148

26111 7590 07/14/2011

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 07/14/2011

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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MENLO PARK, CA 94025

Date:

MAILED

JUL 14 2011

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009357
PATENT NO. : 7210016
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)).

Decision on Petition for Extension of Time in Reexamination	Control No.: 90/009,357

MAILED

JUL 14 2011

CENTRAL REEXAMINATION UNIT

1. THIS IS A DECISION ON THE PETITION FILED 08 July 2011.

2. THIS DECISION IS ISSUED PURSUANT TO:
   - A. ☒ 37 CFR 1.550(c) – The time for taking any action by a patent owner in an *ex parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
   - B. ☐ 37 CFR 1.956 – 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.

   The petition is before the Central Reexamination Unit for consideration.

3. FORMAL MATTERS

   Patent owner requests that the period for responding to the Office action dated 21 June 2011 which sets a one (1) month period for filing a response to the Office action, be extended by one (1) month.

   - A. ☒ Petition fee per 37 CFR §1.17(g)):
     - i. ☐ Petition includes authorization to debit a deposit account.
     - ii. ☐ Petition includes authorization to charge a credit card account.
     - iii. ☐ Other: _____.
   - B. ☒ Proper certificate of service was provided. (Not required in reexamination where patent owner is requester.)
   - C. ☒ Petition was timely filed.
   - D. ☒ Petition properly signed.

4. DECISION (See MPEP 2265 and 2665)
   - A. ☐ Granted or ☒ Granted-in-part for two (2) weeks, because petitioner provided a factual accounting that established sufficient cause. (See 37 CFR 1.550(c) and 37 CFR 1.956).
   - B. ☒ Other/comment: see attached
   - C. ☐ Dismissed because:
     - i. ☐ Formal matters (See unchecked box(es) (A, B, C and/or D) in section 4 above).
     - ii. ☐ Petitioner failed to 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.
     - iii. ☐ Petitioner failed to explain why, in spite of the action taken thus far, the requested additional time is needed.
     - iv. ☐ The statements provided fail to establish sufficient cause to warrant extension of the time for taking action (See attached).
     - v. ☐ The petition is moot.
     - vi. ☐ Other/comment: see attachment.

5. CONCLUSION

   Telephone inquiries with regard to this decision should be directed to Mark Reinhart at 571-272-1611. In his/her absence, calls may be directed to Eric Keasel at 571-272-4929 in the Central Reexamination Unit.

/Mark Reinhart/	SPE, AU 3992 Central Reexamination Unit
[*Signature*]	(Title)

In consideration of providing the patent owner with a fair opportunity to present an argument against any attack on the patent as balanced with the statutory mandate of conducting reexamination proceedings with special dispatch that the Office must fully consider the facts presented in any petitions for extension of time. This is the second request for extension of time in this proceeding. While the petition speaks to the considerations of many other proceedings and litigation before council concurrent with preparing a response, these are the same considerations of any patent owner in any reexamination proceeding. It is Patent owner who must exercise diligence in responding to the Office action. It is agreed that patent owner needs to be given opportunity to complete all aspects of investigation prior to responding to the Office action in an *ex parte* reexamination proceeding. It is Patent owner who must exercise diligence in responding to Office action. The requirement for reasonably diligent behavior by patent owner includes a reasonable expectation of resource management insofar as expecting a complete Office action on the merits.

It is further noted that the petition raises notes that an expert was unavailable for an undisclosed period as well as the delay for an interview with the examiner in charge of the proceeding because of the independence day holiday. Additionally the summary notes time is needed for the preparation of declatory evidence, however, there are no facts presented to support how this preparation impacts the response time.

On balance, there is "sufficient cause to grant-in-part the petition for extension of time. The delay to schedule the interview was apparently out of the control of the patent owner and the time to prepare an appropriate response supports an extension of time for two (2) weeks.

The petition for extension of time is hereby granted-in-part.

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26111 7590 12/23/2011

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WASHINGTON, DC 20005

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 12/23/2011

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MENLO PARK, CA 94025

Date:
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CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

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CENTRAL REEXAMINATION UNIT

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(FOR PATENT OWNER)

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MENLO PARK, CA 94025

(FOR THIRD PARTY REQUESTER)

In re Ware et al.
Reexamination Proceeding
Control No. 90/009,357
Filed: December 8, 2008
For: U.S. Patent No. 7,210,016

DECISION RETURNING UNAUTHORIZED PAPER AND DISMISSING PETITION AS MOOT

This is a decision on the February 18, 2010 third party requester paper entitled "PETITION TO REQUEST A SHORTENED PERIOD TO RESPONSE TO OFFICE ACTIONS." This decision also addresses the March 2, 2010 patent owner opposition petition under 37 CFR 1.182 to the requester's February 18, 2010 petition.

The petitions are before the Director of the Central Reexamination Unit.

The February 18, 2010 petition is returned as an improper paper.

The March 2, 2010 petition is dismissed as moot.

STATEMENTS OF RELEVANT FACTS

1. Patent No. 7,210,016 (the '016 patent) issued on April 24, 2007.

2. The '016 patent is subject to litigation in the United States District Court for the District of Northern California, in Rambus Inc. v. Nvidia Corp., {Civil Action No. 3:08-cv-3343-SF}. The initial complaint was filed July 10, 2008. Based upon the record, patent owner is seeking to enforce at least one of claims 1-24 against the requester in the litigation.

3. On November 6, 2008, an International Trade Commission (ITC) action was filed. The ITC investigation is docketed as Certain Semiconductor Chips Having Synchronous Random Access Memory Controllers and Products Containing Same, Including Graphics Cards and Motherboards, Docket No. 2637.

4. A request for reexamination, assigned Control No. 90/009,357 (the '357 proceeding), was filed by a third party requester on December 8, 2008. Reexamination was requested for claims 7, 13, 21, and 22 of the '016 patent.

5. On January 16, 2009, the Office issued an order granting the '357 request for *ex parte* reexamination and setting a two month time period for a patent owner's statement. The order stated that claims 7, 13, 21 and 22 of the '016 patent, would be subject to reexamination.

6. On March 24, 2009, a request for *inter partes* reexamination of all the claims (claims 1-24) of the '016 patent was filed by the same third party requester (NVIDIA Corporation). The request was assigned Control No. 95/001,160 (the '160 proceeding).

7. On May 26, 2009, the Office issued an order granting the '160 request for *inter partes* reexamination.

8. On October 14, 2009, patent owner filed a petition in the '357 *ex parte* proceeding to prevent merger with the '160 *inter partes* proceeding.

9. On December 16, 2009, the Office issued a decision dismissing patent owner's October 14, 2009 petition requesting prevention of merger of the '160 *inter partes* and '357 *ex parte* reexamination proceedings and merged the reexamination proceedings (the merged proceeding).

10. On January 20, 2010, patent owner filed a petition requesting reconsideration of the Office's December 16, 2009 decision.

11. On February 18, 2010, third party requester filed a petition under 37 CFR 1.181 entitled "PETITION TO REQUEST A SHORTENED PERIOD TO RESPONSE TO OFFICE ACTIONS."

12. On March 2, 2010, patent owner filed an opposition petition under 37 CFR 1.182 to the requester's February 18, 2010 petition.

13. On September 30, 2010, the Office issued a decision granted patent owner's January 20, 2010 petition and dissolved the merger of the '160 and the '357 proceedings.

14. Prosecution has advanced and on October 3, 2011, the Office issued a final Office action that set a one month time period for response.

15. On November 3, 2011, the patent owner submitted a response to the October 3, 2011 Office action.

DECISION

37 CFR 1.4(c) provides as to correspondence with the Office:

> (c) Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects.

37 CFR 1.535 provides as to third party requesters:

> A reply to the patent owner's statement under § 1.530 may be filed by the *ex parte* reexamination requester within two months from the date of service of the patent owner's statement. Any reply by the *ex parte* requester must be served upon the patent owner in accordance with § 1.248. If the patent owner does not file a statement under § 1.530, no reply or other submission from the *ex parte* reexamination requester will be considered.

37 CFR 1.550 provides as to third parties in general:

> (g) ...no submissions on behalf of any third parties will be acknowledged or considered unless such submissions are:
>
> (1) in accordance with § 1.510 or § 1.535; or
>
> (2) entered in the patent file prior to the date of the order for *ex parte* reexamination pursuant to § 1.525.
>
> (h) Submissions by third parties, filed after the date of the order for *ex parte* reexamination pursuant to § 1.525, must meet the requirements of and will be treated in accordance with § 1.501(a).

37 CFR 1.181(a) provides that petitions to the Director may be made:

> (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 in interferences, see § 1.644.

The petition filed on February 18, 2010 in this reexamination proceeding ***will not*** be decided on the merits, and is being returned as an improper paper that does not have a right of entry. See MPEP 2267 and 2667.

Requester's February 18, 2010 petition combined issues under 37 CFR 1.181 and 1.183. The combined petition under 37 CFR 1.181 and 1.183 is deemed improper because it combines two distinct petitions, which is not compliant with 37 CFR 1.4(c). Accordingly, any relief requested under 37 CFR 1.183 is procedurally dismissed under 37 CFR 1.4. In summary, this decision treats the February 18, 2010 petition under 37 CFR 1.181.

As noted, *supra*, the request for reexamination of the '016 patent was filed on December 8, 2008. Reexamination was ordered on January 16, 2009. The record in the '357 reexamination proceeding showed that the patent owner did not file any statement pursuant to 37 CFR 1.530. Thus, the third party requester is not entitled to file comments or any other submission because the patent owner did not file a statement pursuant to 37 CFR 1.530. Thus, 37 CFR 1.535 prohibits the consideration of the present third party requester submission filed in the reexamination proceeding.

Furthermore, the present petition is not a request for reexamination in compliance with the requirements of 37 CFR 1.510, is not a reply to a patent owner's statement pursuant to 37 CFR 1.535, and does not qualify as a prior art citation under 37 CFR 1.501. Thus, 37 CFR 1.550 prohibits the consideration of the present third party requester submission in the reexamination proceeding.

To the extent that it could be argued that 37 CFR 1.535 and 1.550 are not determinative because the February 18, 2010 petition was filed during the time when the '357 proceeding was merged with the '160 *inter partes* proceeding, the February 18, 2010 petition does not have a right of entry for the following reasons. First, as explained above, the petition was not filed in compliance with the requirements of 37 CFR 1.4(c). Second, the petition is not proper under 37 CFR 1.181. 37 CFR 1.181(a)(1) provides for a petition to be taken from any action or requirement of the examiner. This provision limits petitions to issues that have been raised and does not provide for petitions, such as the instant petition, to challenge future decisions that fall within the Office's discretionary procedural process. 37 CFR 1.181(a)(3) provides for a petition when the Office did not follow its established procedure and policies. The February 18, 2010 does not assert that the Office did not follow its established procedure and policies. Furthermore, this petition is similar to a petition requesting that an extension of time be denied. MPEP 2667 clearly states that such petitions "... will be returned, since a requester does not have a statutory right to challenge this discretionary procedural process in the re-examination proceeding...." For these reasons, the February 18, 2010 petition does not raise issues permitted in a petition under 37 CFR 1.181. Accordingly, the February 18, 2010 petition is deemed an improper paper and will be returned in accordance with 37 CFR 1.939 and MPEP 2267 and 2667.

The March 2, 2010 opposition petition is dismissed as moot because the February 18, 2010 petition is deemed an improper paper.

In view of the above, the February 18, 2010 petition in the reexamination proceeding does not have an entry right under the rules. Therefore, the February 18, 2010 petition will not be made of record in the '357 reexamination proceeding, and it is being returned to the third party requester ***without consideration of the substance of the petition***. As the paper has been entered into the electronic Image File Wrapper (IFW) record, the paper will be "returned" by closing the paper in the IFW, and marking the paper nonpublic to expunge it from the record. The present decision will, however, be made of record in the reexamination proceeding. See also MPEP 2267 and 2667.

CONCLUSION

1. The February 18, 2010 petition paper filed in the '357 reexamination proceeding is returned to the third party requester with this decision as not having a right of entry.

2. No copy of the petition paper will be maintained in the electronic Image File Wrapper for the proceedings, or elsewhere in the Office.

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

4. The March 2, 2010 petition is dismissed as moot.

5. Telephone inquiries related to this decision should be directed Mark Reinhart, Supervisory Patent Reexamination Specialist, at (571) 272-1611.

Irem Yucel, Director
Technology Center 1600